

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS H. WHITE

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Appeal No. 1999-2456  
Application No. 08/655,649<sup>1</sup>

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ON BRIEF

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Before STAAB, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 7 to 15, which are all of the claims pending in this application.

We REVERSE.

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<sup>1</sup> Application for patent filed May 30, 1996.

BACKGROUND

The appellant's invention relates to a device and method for facilitating the proper function of, and avoiding improper functioning of, certain air vent intake systems of automobiles (specification, p. 1). An understanding of the invention can be derived from a reading of exemplary claims 1 and 11, which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Heintz 1974	3,845,983	Nov. 5,
Easterbrook et al. 1996 (Easterbrook)	5,479,984	Jan. 2,

In addition, the examiner also relied upon the admitted prior art of an MG automobile (specification, pp. 4 and 7).

Claims 1, 2 and 7 to 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Heintz in view of Easterbrook and the admitted prior art of an MG automobile.<sup>2</sup>

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 6, mailed October 14, 1997) and the answer (Paper No. 13, mailed November 25, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 12, filed July 16, 1998) and reply brief (Paper No. 14, filed February 1, 1999) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and

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<sup>2</sup> While the admitted prior art of an MG automobile was not set forth in the statement of this rejection, it is clear from our reading of this rejection that the examiner has relied upon the admitted prior art of an MG automobile in making this rejection.

claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 2 and 7 to 15 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues that the applied prior art does not suggest the claimed subject matter (brief, p. 3). We agree.

All the claims under appeal require "a generally planar intake cover having a perimeter configuration substantially the same as the intake opening [of the automobile air vent system]". However, this limitation is not suggested by the applied prior art. In that regard, while Heinz does teach the use of a removable cowling cover for automobiles, Heinz does not teach or suggest using a cowling cover having a perimeter configuration substantially the same as the intake opening of the automobile air vent system. In fact, Heinz specifically teaches that his cowling cover is a size, shape and contour for disposition over at least the cowl portion of the automobile (see for example column 2, line 38 to column 3, line 4, and Figure 2). It is our view that an artisan in applying the teachings of Heintz to the admitted prior art MG automobile would have sized the cowling cover for attachment to the cowl, not to the size of the grill over the intake

opening. Thus, the applied prior art would not have been suggestive of the claimed invention.<sup>3</sup>

In our view, the only suggestion for modifying the applied prior art to arrive at the claimed invention would stem from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, we cannot sustain the examiner's rejections of claims 1, 2 and 7 to 15.

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<sup>3</sup> We have also reviewed the reference to Easterbrook. The examiner applied this reference solely for its suggestion of replacing the material of the cowling cover of Heinz with a cowling cover made of a flexible magnetic material. While the shut-off panel of Easterbrook is a generally planar intake cover having a perimeter configuration substantially the same as the outlet register of a forced air system, we see no suggestion or motivation therein to have changed the size of the cowling cover of Heinz.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2 and 7 to 15 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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APPEAL NO. 1999-2456 - JUDGE NASE  
APPLICATION NO. 08/655,649

APJ NASE

APJ BAHR

APJ STAAB

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 18 Jan 00

**FINAL TYPED:**

**Gloria: Please enter the change of address filed  
Feb. 1, 1999.**