

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID F. OTT and DANIEL J. PAPISH

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Appeal No. 97-0081  
Application No. 08/226,532<sup>1</sup>

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ON BRIEF

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Before LYDDANE, NASE, and CRAWFORD, 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 through 14, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

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<sup>1</sup> Application for patent filed April 12, 1994.

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The appellants' invention relates to mounting hardware for a toolbar. Claim 1 is representative of the subject matter on appeal and a copy of claim 1, as it appears in the appellants' brief, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Robinson	823,292	June 12, 1906
Zvanut et al. (Zvanut)	4,909,463	March 20, 1990

Claims 1 through 14<sup>2</sup> stand rejected under 35 U.S.C. § 103 as being unpatentable over Zvanut in view of Robinson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the § 103 rejection, we make reference to the final rejection (Paper No. 5, mailed September 28, 1995) and the examiner's answer (Paper No. 12, mailed June 11, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 11, filed April 29, 1996) for the appellants' arguments thereagainst.

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<sup>2</sup> It appears to us that claim 10 should be dependent on claim 8 or 9 to provide proper antecedent basis for the second circular aperture and the first circular aperture.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all 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 claims 1 through 14. Accordingly, we will not sustain the examiner's rejection of claims 1 through 14 under 35 U.S.C. § 103. Our reasoning for this determination follows.

With regard to the 35 U.S.C. § 103 rejection of claims 1 through 14 as being unpatentable over Zvanut in view of Robinson, the examiner concluded that "[i]t would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Zvanut et al. to include the mounting nut as taught by Robinson, for the purpose of providing a more secured connection between the u-shaped bolt and the toolbar." We do not agree.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of

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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 the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual 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). This the examiner has not done. The examiner points to nothing in the cited Robinson reference, either alone or in combination with Zvanut, suggesting or teaching the appellants' claimed invention.

Zvanut teaches the use of clamping arrangement 10 for affixing first and second members 12 and 14 to a support member 11. The clamping arrangement 10 includes a U-bolt 16 for clamping the first and second members 12 and 14 about the support member 11. The U-bolt 16 is inserted through holes 18, 20 in the

first member 12, around the support member 11, and through holes 22, 24 of the second member 14. Nuts 26, 28 are threaded onto the lower threaded portions of the legs 30, 32 of the U-bolt 16. Accordingly, when the clamping arrangement 10 is assembled, the bight 34 of the U-bolt 16 clamps the first member 12 against the support member 11 and the nuts 26, 28 draw the second member 14 against the support member 11.<sup>3</sup>

Robinson teaches the use of a rail-bond to insure an exceedingly firm electrical connection between adjacent rails. The conductor A, in the form of a metallic rod, abuts against one side of the webs B, B' of adjacent rails. The conductor is provided with angular screw-threaded ends A', A<sup>2</sup> projecting through apertures B<sup>2</sup> and B<sup>3</sup> formed in the webs B and B', respectively. On the threaded ends A' and A<sup>2</sup> are screwed nuts C and C'. The nuts are provided with frustro-conical ends C<sup>2</sup> and C<sup>3</sup> adapted to contact at their sides with the walls of the apertures B<sup>2</sup> and B<sup>3</sup> to insure a firm electrical connection between the nuts and the webs B and B' of the adjacent rails.<sup>4</sup>

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<sup>3</sup> See column 2, lines 39-62, of Zvanut.

<sup>4</sup> See page 1, lines 27-49, of Robinson.

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We agree with the appellants that nothing in the applied prior art teaches or suggests providing the second mounting nut of Zvanut with a camming/conical surface which engages the edge of the second aperture for driving the first and second legs together for applying clamping force to the toolbar between the first and second legs as the mounting nuts are tightened as recited in independent claims 1, 8 and 12. While Robinson certainly teaches the use of nuts C and C' having conical surfaces, they are disclosed as being drawn into firm contact with the walls of the apertures B<sup>2</sup> and B<sup>3</sup> "to insure an exceeding good electrical connection between adjacent rails" (page 1, lines 47-49), not drive the legs of conductor A together in the manner claimed by the appellants.

As stated in W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is our conclusion that the only reason to combine the teachings of the applied prior art references in the manner

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proposed by the examiner results from a review of the appellants' disclosure and the application of impermissible hindsight. Thus, we cannot sustain the examiner's rejection of independent claims 1, 8 and 12, or of claims 2 through 7, 9 through 11, 13 and 14 dependent thereon, under 35 U.S.C. § 103.

Moreover, even assuming arguendo that one having ordinary skill in the art would have found it obvious to substitute the nuts of Robinson with their conical surfaces for the nuts in the device of Zvanut, it is our opinion that the ensuing structure would not necessarily result in engagement of the conical surface of the nut with the edge of the second aperture for driving the first and second legs together for applying clamping force to the toolbar between the first and second legs as the mounting nuts are tightened as recited in independent claims 1, 8 and 12. The appellants accomplish this driving of the first and second legs together as the mounting nuts are tightened by (1) locating the second leg off center in the second aperture away from the first leg, (2) applying first and second mounting nuts to the threaded portions of the first and second legs, and (3) providing a conical surface on the second mounting nut to engage the edge of the second aperture to pull the second leg towards the center of the second aperture, thereby applying a clamping force between

the legs.<sup>5</sup> As stated by the appellants, "[a]n integral part of the present invention is how the holes are located to cooperate with the conical nuts so that a clamping force is applied by the legs of the U-bolts to the toolbar, such an arrangement is not taught by these references.<sup>6</sup>" Thus, it is our opinion that even if the teachings of Zvanut and Robinson could be combined in the manner proposed by the examiner, such combination would not result in the appellants' claimed invention. Therefore, we cannot sustain the examiner's rejection of the claims on appeal under 35 U.S.C. § 103 for this additional reason.

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<sup>5</sup> See page 2, lines 20-27, of the specification.

<sup>6</sup> See page 4, lines 15-17, of the first amendment (Paper No. 3, filed June 26, 1995).

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 14 under 35 U.S.C. § 103 is reversed.

REVERSED

WILLIAM E. LYDDANE	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

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Appendix

1. A mounting system comprising:  
a tool bar having opposite sides;  
a mounting bolt having first and second legs, both legs having threaded portions, the legs are located on opposite sides of the tool bar;  
a mounting plate having first and second apertures, both apertures having edges, the first aperture receives the first leg and the second aperture receives the second leg;  
first and second mounting nuts, the first mounting nut is screwed onto the threaded portion of the first leg, the second mounting nut is screwed onto the threaded portion of the second leg, the second mounting nut is provided with a camming surface which engages the edge of the second aperture for driving the first and second legs together for applying clamping force to the toolbar between the first and second legs as the mounting nuts are tightened.

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APPLICATION NO. 08/226,532

APJ NASE

APJ CRAWFORD

APJ LYDDANE

Decision: **REVERSED**

Prepared by: Delores A. Lowe

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1ST Rev. 18 Jul 97  
2nd Rev. 22 Jul 97

**Final typed:**

**3 PERSON CONF**