

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD E. CHRISTENSON

Appeal No. 2000-0006
Application No. 08/868,480

ON BRIEF

Before ABRAMS, 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 3, 5, 6, 12, 15, 26, 31 to 33, 36, 39, 40 and 46, which are all of the claims pending in this application.¹

¹ Claims 8 and 9 were canceled subsequent to the final rejection.

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We REVERSE.

BACKGROUND

The appellant's invention relates to an improved tag axle system (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's reply brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims (i.e., the applied prior art) are:

Christenson 1992	5,090,495	Feb. 25,
Gottschalk et al. 1995 (Gottschalk)	5,403,031	April 4, (filed Dec. 8, 1993)
Tweedie 1958	229,651 (Australia)	Oct. 9,

Claims 3, 5, 6, 12, 15, 26, 31 to 33, 36, 39, 40 and 46 stand rejected under 35 U.S.C. § 103 as being unpatentable over Christenson in view of Gottschalk and Tweedie.

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 (mailed November 2, 1998) and the answer (mailed March 25, 1999) for the examiner's complete reasoning in support of the rejection, and to

the brief (filed March 12, 1999) and reply brief (filed May 6, 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 claims, to the applied prior art, and to the respective positions articulated by the appellant 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 the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 3, 5, 6, 12, 15, 26, 31 to 33, 36, 39, 40 and 46 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). When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellant. It is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellant's invention. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the

desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In this case, the examiner determined (final rejection, p. 3) that to arrive at the subject matter on appeal that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Christenson to include (1) fixed nonpivot attachment of Christenson's springs to the mounting supports as taught by Gottschalk in order to attach the springs conventionally and (2) a common shaft with the axle assemblies of Christenson rotating with the shaft as taught by Tweedie in order to simplify structure supporting both assemblies in a manner well known in the art.

The appellant argues in the brief and reply brief that the applied prior art does not suggest the claimed subject matter. We agree. We have reviewed the combined teachings of

the applied prior art and fail to see any suggestion or motivation in the applied prior art for a person having ordinary skill in the art at the time the invention was made to have modified Christenson by the teachings of the Tweedie as set forth by the examiner in the rejection under appeal. In our view, the only suggestion for so modifying Christenson in the manner proposed by the examiner

stems from hindsight knowledge derived from the appellant's own disclosure.² It follows that we cannot sustain the examiner's rejections of claims 3, 5, 6, 12, 15, 26, 31 to 33, 36, 39, 40 and 46.

CONCLUSION

To summarize, the decision of the examiner to reject claims 3, 5, 6, 12, 15, 26, 31 to 33, 36, 39, 40 and 46 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)
Administrative Patent Judge)
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) BOARD OF PATENT
JEFFREY V. NASE) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES

² 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).

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JENNIFER D. BAHR)
Administrative Patent Judge)

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