

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN L. ALEXANDER

Appeal No. 2000-1296
Application No. 08/794,869

ON BRIEF

Before ABRAMS, NASE, and GONZALES, 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 to 6, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a dispensing device for a coating material. A copy of the claims under appeal is set forth 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:

Woodson 1989	4,815,241	Mar. 28,
Chabert 1994	5,353,995	Oct. 11,

Claims 1 to 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chabert in view of Woodson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 15, mailed July 27, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 14, filed July 1, 1999) and reply brief (Paper No. 16, filed August 16, 1999) for the appellant's arguments thereagainst.

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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 references, 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 1 to 6 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).

Claim 1, the sole independent claim on appeal, reads as follows:

A dispensing device for a coating material, the dispensing device including an outer portion including a first, inner surface, the outer portion having a central passageway for mounting the outer portion on a rotary shaft for rotating the dispensing device, and an inner portion having a second, outer surface shaped complementarily to the first surface and a somewhat bell- or cup-shaped third, inner surface, and means for retaining the inner portion in the outer portion with the first and second surfaces in engagement.

In the rejection before us in this appeal (answer, pp. 3-4), the examiner set forth the pertinent teachings of Chabert and Woodson. In addition, the examiner stated that "Chabert does not show an inner portion having a second outer surface shaped complementarily to the inner surface of the outer portion." Thereafter, the examiner concluded that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have added an inner portion of complementarily shape to the outer portion of Chabert's dispensing device so as to be able

to provide a suitable wear and erosion resistant liner as shown and taught by Woodson.

The Supreme Court observed in Graham v. John Deere Co.,
383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966):

While the ultimate question of patent validity is one of law, . . . the § 103 condition [that is, nonobviousness] . . . lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Thus, initially, the scope and content of the applied prior art are to be determined. This the examiner has done (answer, p. 3). Next, the differences between the applied prior art and the claims at issue are to be ascertained. The examiner has not correctly ascertained the actual differences

between the applied prior art (i.e., Chabert) and the claims at issue (e.g., claim 1) as explained below. Thus, the examiner has not determined if the ascertained differences between the subject matter sought to be patented and the prior art (i.e., Chabert) are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

Based on our analysis and review of Chabert and claim 1, it is our opinion that the differences are (1) "an inner portion having a second, outer surface shaped complementarily to the first [inner] surface [of the outer portion] and a somewhat bell- or cup-shaped third, inner surface," and (2) "means for retaining the inner portion in the outer portion with the first and second surfaces in engagement."

Since the examiner has not determined that the above-noted differences between the subject matter sought to be patented and the prior art (i.e., Chabert) are such that the subject matter as a whole would have been obvious at the time

the invention was made to a person having ordinary skill in the art, we are constrained to reverse the decision of the examiner to reject claims 1 to 6 under 35 U.S.C. § 103.

Moreover, assuming arguendo that Woodson is analogous art as explained by the examiner (answer, p. 4), we find ourselves in agreement with the appellant's argument (brief, pp. 5-8; reply brief, pp. 2-5) that there is no motivation in the applied prior art to modify Chabert's ionizer head by Woodson's wear liner tube. Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To 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." 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). It is essential that "the decisionmaker forget what he or she has been taught . . . about the claimed invention

and cast the mind back to the time the invention was made . . .
. to occupy the mind of one skilled in the art who is
presented only with the references, and who is normally guided
by the then-accepted wisdom in the art." Id.

For the reasons set forth above, the decision of the
examiner to reject claims 1 to 6 under 35 U.S.C. § 103 is
reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6 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
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JOHN F. GONZALES)	
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