

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 52

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JACOB FRIEDMAN

Appeal No. 2001-2611
Application No. 08/566,576

HEARD: April 10, 2002

Before FRANKFORT, McQUADE, and NASE, 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, 3 to 9, 13 and 15 to 20, which are all of the claims pending in this application.¹

We REVERSE.

¹ Claims 3 and 9 were amended subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to a parting or grooving insert (specification, p. 1).

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:

Niemi	4,778,311	Oct. 18, 1988
Carl et al. (Carl)	4,890,961	Jan. 2, 1990
Satran	5,156,502	Oct. 20, 1992
Friedman et al. (Friedman)	5,697,271	Dec. 16, 1997

Claims 1, 3 to 9, 13 and 15 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Friedman in view of Carl and Niemi.

Claims 1, 3 to 9, 13 and 15 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Satran in view of Carl and Niemi.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 44, mailed March 15, 2001) for the examiner's complete reasoning in support of the

rejections, and to the brief (Paper No. 43, filed February 28, 2001) and reply brief (Paper No. 46, filed May 14, 2001) 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 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, 3 to 9, 13 and 15 to 20 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).

In the rejections before us in this appeal, the examiner has determined (answer, pp. 3-7) that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the cutting insert of either Friedman or Satran by (1) having the front relief flank include an upper relief flank surface, a lower abutment surface inset with respect to the upper relief flank surface, and an intermediate surface serving to bridge the upper and lower surfaces as suggested by Carl's reversible cutting plate 10²; and (2) inclining the cutting edge at a non-zero leading angle and the upper relief flank surface as suggested by Niemi's insert 10 having a cutting edge 12.³

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination

² Each frontal face of Carl's reversible cutting plate 10 includes an abutment surface 14 axially set back with respect to a cutting-edge section 16 (see Figure 6), such that they together with an oblique transition face 17 define a recess open at the edge.

³ Niemi's cutting edge 12 and front relief surface are inclined at a non-zero leading angle H as shown in Figure 2.

that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, we agree with the appellant's argument (brief, pp. 5-9; reply brief, pp. 2-3 and 7-8) that one skilled in the art would not have been motivated to modify the front relief surfaces/flanks of either the Friedman or the Satran insert based upon the front relief surface of Carl. In our view, the only suggestion for modifying either the Friedman or the Satran insert in the manner proposed by the examiner to arrive at the claimed invention stems 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 Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1, 3 to 9, 13 and 15 to 20.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3 to 9, 13 and 15 to 20 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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