

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte ELLIS P. LIPP and BENJAMIN F. CHESTNUT

Appeal No. 2004-0763
Application No. 09/758,641

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-11 and 17-22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to the securement of a control knob to a control shaft in an appliance timer (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Amonett	5,684,281	Nov. 04, 1997
Yamane et al. (Yamane)	6,213,677	Apr. 10, 2001 (filed Nov. 03, 1998)

Claims 1-11 and 17-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Amonett in view of Yamane.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 8) for the examiner's complete reasoning in support of the rejection and to the brief (Paper No. 7) for the appellants' arguments thereagainst.

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. As a consequence of our review, we make the determinations which follow.

Amonett discloses an appliance timer assembly comprising a shaft control knob 504, a control shaft 438 and a shaft locking pin 502. The control shaft 438 includes a shaft base end 496, a shaft hub bearing 498 and a shaft control end 500. The control shaft 438 cooperates with the base control shaft mount 142 (Figure 3b) and camstack hub to provide a rotational axis for the camstack 62. The shaft control knob 504

includes a knob spring arm slot 552, knob barb seats 554 and a knob stop 556. The knob spring arm slot 552 receives the spring arms 536 of the control shaft 438 to permit the control knob to rotate the control shaft 438 bi-directionally. The knob barb seats 554 receive the shaft spring arm barbs 538 to prevent the control knob from being pulled off when the control shaft 438 is indexed out away from the base platform 84, with the stop 556 cooperating with the shaft control end stop 542 to prevent the knob 504 from sliding down the control shaft. The shaft locking pin 502 includes a shaft locking pin knob groove 544, a shaft locking pin stop 546, a shaft locking pin retention spring 548 and a shaft locking pin base end 550. The shaft locking pin knob groove 544 receives control shaft spring arm ribs 540 to secure the shaft locking pin 502 in position. The shaft locking pin stop 546 extends from the shaft locking pin 502 to interfere with shaft bore 494 to limit movement of the shaft locking pin 502 toward the shaft control end 500. The shaft locking pin retention spring 548 also interferes with the housing base control shaft mount 142 to restrict movement of the shaft locking pin 502 out of the shaft base end 492 prior to the control knob being installed on the shaft control end 500. As acknowledged by the examiner on page 6 of the answer, Amonett lacks an opening in the sidewall of the control shaft and the first retention member (locking pin retention spring 548) being received into said opening as called for in each of appellants' independent claims 1, 7 and 17.

Yamane discloses a joint mechanism for a mowing machine which can be easily assembled and disassembled, the joint mechanism including a holder 2, clamp 4 and vibrational damper 3. The clamp has a pair of flexible arms 4a on radially opposite sides of the clamp with an engagement hook 4b being formed on each of the flexible arms 4a. The holder, clamp and damper are secured to a support member 1a of a casing 1 by simply inserting the clamp 4 together with the holder 2 and damper 3 into the support member 1a of the casing and causing the engagement of hooks 4b with engagement holes (through holes) 1b formed in the support member 1a. In this state, engagement of the hooks 4b with the engagement holes 1b prevents the clamp 4, damper 3 and holder 2 from unintentionally separating from the support member 1a (column 6, lines 38-41).

The examiner relies on Yamane for its teaching that providing a shaft with an opening to receive spring type retention members prevents unintentional separation of components (answer, page 8). According to the examiner (answer, pages 6 and 7), it would have been obvious to one of ordinary skill in the art at the time of appellants' invention, in light of the teachings of Yamane, to provide the control shaft of Amonett with an opening in the sidewall thereof that receives the spring retention member 548 of Amonett's locking pin 502 "for the purpose of preventing unintentional separation of the components."

As stated by our reviewing court in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. 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 that was made by the applicant [citations omitted].

In this instance, we agree with appellants that the applied references fail to provide any motivation, suggestion or teaching of the desirability of making the modification proposed by the examiner. From our perspective, Amonett discloses one means (interference of the shaft locking pin retention spring 548 with the housing base control shaft mount 142) for restricting movement of one component (the locking pin) out of another component (the control shaft) and Yamane discloses a different means (engagement of the engagement hooks 4b of arms 4a of the clamp with engagement holes 1b of a support member) for preventing separation of one component (the clamp, holder and damper assembly) from a second component (the support member). There is no indication in Amonett or Yamane of the recognition in the prior art¹ of a problem of

¹ The discussion of a “potential problem” when manufacturing tolerances result in the locking pin being too thin, thereby causing the locking pin to gradually back out of the control shaft against its friction fit, on page 8 of appellants’ brief, referred to by the examiner on page 8 of the answer, appears to us to reflect a recognition by appellants, not a recognition in the prior art, of the problem.

unintentional separation of Amonett's locking pin from the control shaft or of the need or desirability of combining the retention means of Yamane with another retention means, such as that taught by Amonett. We thus reach the conclusion that the only suggestion for putting the selected pieces from the references together in the manner proposed by the examiner is found in the luxury of hindsight accorded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

In light of the above, we cannot sustain the examiner's rejection of independent claims 1, 7 and 17 or claims 2-6, 8-11 and 18-22 depending therefrom.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-11 and 17-22 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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