

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLAND HOLMQUIST

Appeal No. 95-3943
Application 08/050,318¹

ON BRIEF

Before CALVERT, LYDDANE and ABRAMS, Administrative Patent Judges.
LYDDANE, Administrative Patent Judge.

¹ Application for patent filed May 10, 1993.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 4, 5 and 7², which are all of the claims pending in the application.

The subject matter on appeal is directed to a vertically adjustable desk. Claim 4 is exemplary of the invention and reads as follows³:

4. A vertically adjustable desk which comprises:

a support stand,

a desktop which includes an underbody,

first and second linkage means connected between said support stand and said underbody for vertically adjustably positioning said desktop in a generally horizontal orientation above said lower stand, each of said first and second linkage means comprising two parallel links, and

first and second gas spring means connected between said first linkage means and said underbody and between said second linkage means and said underbody, respectively, for

² Amendments to claims 4 and 7 were requested in a separate paper accompanying the reply brief on January 30, 1995 (Paper No. 18) in response to the examiner's new ground of rejection set forth in the examiner's answer (Paper No. 17). Although entry of this amendment was not specifically approved by the examiner in the subsequent responses, approval can be inferred from the examiner's statement in the response dated March 1, 1995 (Paper No. 19) that the reply brief "has been entered and considered" since the reply brief notes the amendment of the claims and directs the arguments to the amended claims.

³ As amended January 30, 1995 (Paper No. 18)

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assisting in vertical lifting of said desktop above said support stand and for locking said desktop in vertical position above said support stand, each of said first and second gas spring means including a handle for manual operation thereof.

The references of record relied upon by the examiner in a rejection of the claims under 35 U.S.C. § 103 are:

Guglielmi	3,080,835	Mar. 12, 1963
Sema	4,703,700	Nov. 3, 1987
Pülz (German Offenlegungsschrift) ⁴	25 39 713	Mar. 17, 1977

Claims 4, 5 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pülz in view of Guglielmi and Sema.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellant, we refer to pages 4 and 5 of the examiner's answer, to the supplemental answer (Paper No. 21), to pages 2 through 4 of the appellant's brief and to the reply brief for the full exposition thereof.

⁴ Our understanding of this reference results from our reading of a translation of this reference which was prepared for the U.S. Patent and Trademark Office. A copy of the translation has been appended to this decision for the convenience of the appellant.

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OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art, and to the respective positions advanced by the appellant and by 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 all claims on appeal. 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); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A prima facie case of obviousness is established by presenting evidence indicating 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, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject

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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); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), and ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

Moreover, rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies

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in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). Our reviewing court has repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

Having carefully reviewed the disclosures of each of the references applied by the examiner in the rejection of the claims on appeal in light of the comments of both the examiner and the appellant, we find ourselves in agreement with the appellant's position as expressed in pages 2 through 4 of the reply brief that nothing in the teachings of the references would have suggested or made "obvious" their combination in the manner proposed by the examiner. In particular, it is apparent that Pülz discloses a vertically adjustable surface 5 utilizing a pair of linkage means each having two parallel links 11, 12. However, the means for adjusting the height of the surface includes a pair of slotted scissors linkages 14, 17 that are respectively

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connected to the surface 5 and to link 11 and frictionally held in adjusted position via a "fixing device" (cam and spring clamping arrangement) depicted in Figures 4 and 5 (note pages 5 and 6 of the translation).

Appealed claim 4 requires, in part,

first and second gas spring means . . . for assisting in vertical lifting of said desktop . . . and for locking said desktop in vertical position,

and appealed claim 7 requires, inter alia,

first and second gas spring means for assisting in vertical lifting of said desktop . . . and for locking said desktop in a vertical position above said support stand.

The scissors linkages and "fixing device" of Pülz certainly provide a means for locking the surface 5 in vertical positions, but they do not and cannot assist in vertical lifting thereof as required by the claims on appeal.

Furthermore, although the patent to Guglielmi discloses an hydraulic cylinder for vertical adjustment of a desk or table and the patent to Sema discloses a gas spring 16 for driving and retaining support elements of a table or desk in vertically

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adjusted position, neither of these references would have suggested their application to the adjustable table or desk structure of Pülz. There is simply no suggestion or motivation from the combined teachings of these references for replacing the frictionally held adjustment links 11, 12 of Pülz with means for assisting vertical lifting, much less the particular gas (or hydraulic) spring devices of Sema or Guglielmi.

As stated in W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983),

[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 references in the manner proposed by the examiner results from a review of appellant's disclosure and the application of impermissible hindsight. Thus, we cannot sustain the examiner's rejections of appealed claims 4, 5, and 7 under 35 U.S.C. § 103.

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Accordingly, the decision of the examiner rejecting claims
4, 5 and 7 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
WILLIAM E. LYDDANE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
NEAL E. ABRAMS)	
Administrative Patent Judge)	

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