

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte NOBORU KOBAYASHI
and YOSHIKI FUTAKI

JUN 18 1996

**PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Appeal No. 95-5007
Application 07/775,740¹

HEARD: June 5, 1996

Before McCANDLISH, Senior Administrative Patent Judge, and
FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the rejections of claims 1, 4, 6, 8, 9, 11, 12, 14, 16, 18 and 22 through 42 which were set forth in the

¹ Application for patent filed October 11, 1991.

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Office action dated October 26, 1994 (Paper No. 28).² Claims 43 through 50 and 52 through 64, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b) as being directed to non-elected inventions.

The subject matter on appeal pertains to a marine vessel having a speed braking indicator which is visible to following vessels. Claim 1 is illustrative and reads as follows:

1. A marine vessel comprising a hull, means carried by said hull for propelling said hull and for braking the forward speed of said hull, operator controlled operating means for operating said means for braking the forward speed of said hull, an indicator means remotely positioned from said operating means and operated in response to operation of said operating means for providing an indication of when the speed of said hull is being braked, said indicator means being positioned to be seen from a following marine vessel.

² This is nominally the second appeal involving the instant application. The first appeal was taken from the final rejection dated October 19, 1992 (Paper No. 6). In response to the brief (Paper No. 27) filed in the earlier appeal, the examiner withdrew the finality of the Office action appealed from and entered the rejections involved in the instant appeal, whereupon the appellants directly filed notice of the instant appeal (Paper No. 29). Under these particular circumstances, we are satisfied that we have jurisdiction to decide the instant appeal even though the Office action appealed from was not a final rejection and none of the appealed claims has been twice rejected (due to substantive amendments to independent claim 1 filed subsequent to the final rejection). See 35 U.S.C. § 134 and 37 CFR § 1.191(a). In this regard, the instant appeal is no more than a continuation of the proceedings set in motion by the earlier appeal from the examiner's final rejection.

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The references relied upon by the examiner as evidence of obviousness are:

Christen	1,947,332	Feb. 13, 1934
McCollum	2,412,825	Dec. 17, 1946
Siegel	4,200,055	Apr. 29, 1980
Lyons	4,362,516	Dec. 7, 1982
Takahashi	4,813,895	Mar. 21, 1989
Comfort	5,052,327	Oct. 1, 1991

(filed July 19, 1990)

The appealed claims stand rejected under 35 U.S.C. § 103 as follows:

- a) claims 1, 4, 6, 8, 9, 11, 12, 14 and 34 as being unpatentable over Christen;
- b) claims 16 and 18 as being unpatentable over McCollum in view of Comfort and Takahashi;
- c) claims 22, 23 and 26 as being unpatentable over Christen in view of Lyons;
- d) claims 27 through 33 as being unpatentable over Christen in view of Lyons and Siegel;
- e) claims 24 and 25 as being unpatentable over Christen in view of Lyons and Takahashi; and
- f) claims 35 through 42 as being unpatentable over Christen in view of Lyons, Takahashi and Siegel.

With regard to the rejection of claim 1, Christen discloses a ship having conventional marine telegraph devices A and B

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located, respectively, in the pilot house/bridge and in the engine room. These devices are interconnected to transmit navigational orders (full ahead, slow ahead, stop, slow astern, full astern) from the pilot house/bridge to the engine room and include, respectively, warning signal devices 36 and 35 which operate only when the ship's propeller shaft 60 is not operating in accordance with the orders.

The examiner finds correspondence between Christen's warning signal device 36 which is located in the pilot house/bridge and the indicator means recited in claim 1, but concedes that the device 36 does not meet the limitation in claim 1 requiring the indicator means to be positioned to be seen from a following marine vessel (see page 3 in the answer). Nonetheless, the examiner concludes that it would have been an obvious matter of design choice based on various visibility and appearance considerations to construct the pilot house/bridge such that Christen's warning signal device 36 would be visible to a following marine vessel (see pages 3 and 4 in the answer).

Rejections under 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1016-17, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, an examiner has the initial duty of supplying the requisite factual basis and may

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not, because of doubts that the claimed invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In the present case, the Christen reference provides no factual basis whatsoever for the examiner's conclusion that it would have been obvious to one of ordinary skill in the art to make the warning signal device 36 visible to a following marine vessel as required by claim 1. The rationale advanced by the examiner in support of his position is deeply flawed in that it is replete with speculation, unfounded assumptions and aspects of hindsight reconstruction.

Moreover, even if Christen's warning signal device 36 were visible to a following marine vessel, it would still not meet the additional limitation in claim 1 requiring the indicator means to operate in response to the operation of the means for operating the means for braking the forward speed of the hull. Christen's warning signal device 36 does not operate in response to similar conditions.

Thus, the Christen reference does not provide the factual basis necessary to support the examiner's conclusion that the subject matter recited in claim 1 would have been obvious to one of ordinary skill in the art. Accordingly, we shall not sustain

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the standing 35 U.S.C. § 103 rejection of this claim, or of claims 4, 6, 8, 9, 11, 12, 14 and 34 which depend therefrom, as being unpatentable over Christen.

Inasmuch as the Lyons, Siegel and Takahashi references fail to cure the foregoing shortcomings of Christen with respect to the subject matter recited in claim 1, we shall not sustain the standing 35 U.S.C. § 103 rejections of claims 22 through 33 and 35 through 42, all of which depend from claim 1.

Finally, we shall not sustain the standing 35 U.S.C. § 103 rejection of claims 16 and 18 as being unpatentable over McCollum in view of Comfort and Takahashi.

According to the examiner, it would have been obvious to one of ordinary skill in the art to modify the rather elementary marine vessel propulsion unit disclosed by McCollum by providing it with a direction-indicating flag member 32 as disclosed by Comfort and by adding a separate, relatively sophisticated propulsion unit having a reverse thrust bucket 21 as disclosed by Takahashi (see page 5 in the answer). It is not readily apparent, however, how the resulting amalgamation would meet the above discussed limitations in claim 1 from which claims 16 and 18 depend. Moreover, the only suggestion for combining the disparate teachings of McCollum, Comfort and Takahashi in the

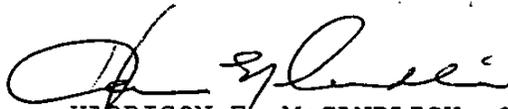
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manner proposed by the examiner stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support a conclusion of obviousness is, of course, impermissible.

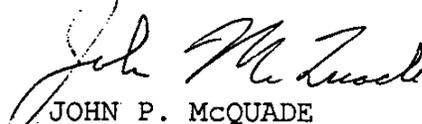
In summary, the prior art references applied by the examiner do not justify a conclusion that the differences between the subject matter recited in claims 1, 4, 6, 8, 9, 11, 12, 14, 16, 18 and 22 through 42 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

Therefore, the decision of the examiner to reject claims 1, 4, 6, 8, 9, 11, 12, 14, 16, 18 and 22 through 42 under 35 U.S.C. § 103 is reversed.

REVERSED


HARRISON E. McCANDLISH, Senior)
Administrative Patent Judge)


CHARLES E. FRANKFORT)
Administrative Patent Judge)


JOHN P. McQUADE)
Administrative Patent Judge)

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