

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER A. NASVIK and PAUL C. NASVIK

Appeal No. 1997-0635
Application No. 08/375,183

ON BRIEF

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 4 to 8 and 11, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a gang form for molding a natural stone surface having multiple stone regions. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The references of record relied upon by the examiner in rejecting the appealed claims are:

Ford 22, 1924	1,491,205	Apr.
Urschel 1927	1,636,396	July 19,
Scott 1974 (Scott (527))	3,844,527	Oct. 29,
Di Giacomo 1976	3,950,477	Apr. 13,
Ward 26, 1978	4,116,415	Sep.
Scott 1979 (Scott (945))	RE 29,945	Mar. 27,
Nasvik et al. 1995 (Nasvik)	5,386,963	Feb. 7,
Rice July 27, 1948	450,070	(Canada)

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Scott (945) or Scott (527) taken together with either Di Giacomo or Ward, and further in view of Urschel.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over any one of Scott (527), Scott (945) and Urschel taken together with Ward.

Claims 6 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over the applied art as applied to claim 4 in the rejections set forth above, and further in view of Rice.

Claims 5, 7 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over the applied art as applied to claim 4 in the rejections set forth above, and further in view of Ford.

Claims 4 to 8 and 11 stand rejected under the judicially created doctrine of double patenting over claims 1 to 12 of Nasvik in view of Di Giacomo and Scott (945).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 34, mailed September 20, 1996) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 33, filed July 22, 1996) and reply brief (Paper No. 36, filed November 27, 1996) 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 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.

The obviousness rejections

We will not sustain any of the rejections of claims 4 to 8 and 11 under 35 U.S.C. § 103.

Claim 4, the only independent claim on appeal, reads as follows:

A gang form for molding a natural stone surface having multiple stone regions, said gang form comprising:

(a) a plurality of form liners each including a front surface and a back surface, said front surface of each form liner including only one lateral relief mold face for contouring a single stone region on a wall formed against said lateral relief mold face, the lateral relief mold face including:

(i) a central surface portion located central to the lateral relief mold face, the central surface portion having a reverse contour to a single natural stone for forming a natural stone region in the wall; and

(ii) a border surface portion contiguous with and completely surrounding the central surface portion, the border surface portion having a reverse contour to a mortar region of a natural stone wall for forming a mortar region contiguous with and surrounding the natural stone region in the wall;

(b) a backing member; and

(c) means for mounting said back surface of each of said form liners to said backing member wherein said form liners are mounted in an adjacent mating relationship to create a continuous lateral relief mold face.

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 addition, the Federal Circuit has stated that "[the] mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The appellants argue (brief, pp. 4-8, and reply brief, pp. 1-3) that the applied prior art does not suggest the claimed subject matter. We agree. Specifically, the limitations of claim 4 are not suggested by the applied prior art. In that regard, while various mosaic pieces of the claimed invention are shown in each reference of the applied

prior art, the applied prior art would not have taught or suggested a gang form having a plurality of form liners as recited in claim 4 mounted to a backing member.¹

In our view, the only suggestion for modifying the applied prior art in the manner proposed by the examiner to meet all the limitations of claim 4 stems from hindsight knowledge derived from the appellants' 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 Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Thus, 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

¹ We have also reviewed the references additionally applied in the rejection of dependent claims 5 to 8 and 11 but find nothing therein which would have suggested the subject matter of claim 4.

with respect to the claims under appeal. Accordingly, the decision of the examiner to reject claims 4 to 8 and 11 under 35 U.S.C.

§ 103 is reversed.

The double patenting rejection

We will not sustain the rejection of claims 4 to 8 and 11 under the judicially created doctrine of double patenting.

The appellants argue (brief, pp. 10-11, and reply brief, pp. 5-6) that the rejection is in error since the subject matter of the claims under appeal is patentably distinct from the claims in Nasvik. We agree. The limitations of claim 4 are not suggested by the claims of Nasvik taken together with the applied prior art. In that regard, while various pieces of the claimed invention are shown in each reference, it is our view that the applied prior art would not have taught or suggested modifying the claimed gang form of Nasvik to have a plurality of form liners as recited in claim 4 mounted to a backing member. Accordingly, the decision of the examiner to

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reject claims 4 to 8 and 11 under the judicially created
doctrine of double patenting is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 4 to 8 and 11 under 35 U.S.C. § 103 is reversed and the decision of the examiner to reject claims 4 to 8 and 11 under the judicially created doctrine of double patenting is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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MERCHANT GOULD SMITH EDELL
WELTER & SCHMIDT
3100 NORWEST CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS, MN 55402

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APJ NASE

APJ McQUADE

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: Feb 9, 2000

FINAL TYPED: