

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAMUEL G. MAZZARELLI

Appeal No. 1997-1765
Application No. 08/324,927¹

HEARD: July 14, 1999

Before McCANDLISH, Senior Administrative Patent Judge, COHEN 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 to 3, 6 to 9, 11 to 13, 15, 18 to 20 and 24. Claims 4, 5, 10, 14, 16, 21 and 22 have been objected to as depending from a non-allowed claim. Claims 7, 17 and 23 have been canceled.

¹ Application for patent filed October 18, 1994.

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We REVERSE.

BACKGROUND

The appellant's invention relates to a protective cover secured by differential pressure. An understanding of the invention can be derived from a reading of exemplary claims 1, 13 and 19 (the independent claims on appeal), which appear 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:

Herron et al. (Herron) 1990	4,938,522	July 3,
Robert ² 1984	2,543,891 (France)	Oct. 12,

Claims 1 to 3, 6 to 9, 11 to 13, 15, 18 to 20 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Herron in view of Robert.³

² In determining the teachings of Robert, we will rely on the translation provided by the appellant attached to the amendment filed on August 22, 1995 (Paper No. 5).

³ The examiner mistakenly included canceled claims 17 and 23 in the statement of the rejection (answer, p. 4).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 12, mailed November 12, 1996) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 11, filed July 25, 1996) 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 to 3, 6 to 9, 11 to 13, 15, 18 to 20 and 24 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).

The appellant argues (brief, pp. 9-11) that the applied prior art does not suggest the claimed subject matter. Specifically, the appellant asserts that nowhere is there any basis (i.e., suggestion) for applying the vents of Robert to the cover of Herron. We agree.

All the claims under appeal require (1) a unitary flexible cover member of material substantially impermeable to air; (2) at least one exhaust aperture in the cover member; and (3) a venting member disposed over the exhaust aperture.

However, these limitations are not suggested by the applied prior art. In that regard, while Robert does teach a venting member disposed over an exhaust aperture in a cover member, it is our opinion that Robert does not teach or suggest using such a venting member over the cover member of Herron since the cover member of Herron is not intended to cover a vehicle being driven at speed.⁴

In our view, the only suggestion for modifying Herron in the manner proposed by the examiner (answer, pp. 4-5) to meet the above-noted limitations 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 Associates, Inc. v. Garlock, Inc., 721 F.2d 1540,

⁴ We are aware of Herron's disclosure (column 5, lines 11-36) that a vehicle having his protective cover can be moved within a waiting area prior to pickup by a customer. However, this disclosure is insufficient in our view to suggest the a vehicle with Herron's cover thereon would have been driven at a speed sufficient to warrant the addition of Robert's vents 8 and semi-cone 9.

1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469
U.S. 851 (1984).

For the reasons stated above, the decision of the
examiner to reject claims 1 to 3, 6 to 9, 11 to 13, 15, 18 to
20 and 24 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 6 to 9, 11 to 13, 15, 18 to 20 and 24 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPEAL NO. 1997-1765 - JUDGE NASE
APPLICATION NO. 08/324,927

APJ NASE

APJ COHEN

SAPJ McCANDLISH

DECISION: **REVERSED**

Prepared By: Gloria

Henderson

DRAFT TYPED: 19 Jul 99

FINAL TYPED:

HEARD: July 14, 1999