

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL STEFFEN

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Appeal No. 1997-2076  
Application No. 08/175,718<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, KRASS and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-3, all of the claims pending in the present application.

The claimed invention relates to an internal vibrator for compacting concrete which has a vibrator housing containing an eccentric mass driven by an electric motor. Further included

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<sup>1</sup> Application for patent filed December 30, 1993.

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are a switch for controlling the electric motor and a transformer for supplying current to the motor at a frequency higher than line frequency. More particularly, Appellant indicates at pages 5 and 6 of the specification that the switch and the transformer are combined in a common housing to form a miniaturized built-in unit on the power supply cord.

Claim 1 is illustrative of the invention and reads as follows:

1. An internal vibrator for compacting concrete and having a vibrator housing in which is disposed an eccentric mass and an electric motor for driving said eccentric mass, said electric motor being supplied via a power supply cord with electric current having a frequency that is greater than line frequency, said power supply cord being disposed at least in part in a protective and operating tube, said vibrator further comprising:

switch means for controlling said electric motor, said switch means being disposed in said power supply cord in the vicinity of said protective and operating tube; and

a transformer for supplying to said electric motor said electric current having said frequency that is greater than line frequency, wherein said switch means and said transformer are combined in a common housing to form a miniaturized built-in unit on said power supply cord.

The Examiner relies on the following prior art:

Spitler	2,924,730	Feb. 09,
1960		
Strohbeck	3,782,693	Jan.
01, 1974		

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Claims 1-3 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Strohbeck in view of Spitler.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief and Answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer. It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-3. Accordingly, we reverse.

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In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825

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(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.

Cir. 1984). These showings by the Examiner are an essential part

of complying with the burden of presenting a prima facie case of

obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d

1443, 1444 (Fed. Cir. 1992).

The Examiner has grouped all of the appealed claims together in the 35 U.S.C. § 103 rejection and, as the basis for the obviousness rejection, proposes to modify the vibrator motor switch housing structure of Strohbeck by relying on Spitler to supply the missing teaching of providing a common housing incorporating a switch and a transformer. In the Examiner's view (Answer, page 3), the skilled artisan would

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have found it obvious to include a transformer in Strohbeck to provide higher vibrational speed as taught by Spitler.

In response, Appellant asserts that the Examiner has failed to set forth a prima facie case of obviousness since proper motivation for one of ordinary skill to make the Examiner's proposed combination has not been established. Upon careful review of the applied prior art, we are in agreement with Appellant's stated position in the Brief. 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, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). We can find no motivation for the skilled artisan to combine the transformer teachings of Spitler with the vibrator structure of Strohbeck. There is nothing in the disclosure of Strohbeck to indicate that a lack of operating speed, the problem addressed by the transformer of Spitler, was ever a concern. It is our opinion that the only basis for applying the teachings of Spitler to the vibrator structure of Strohbeck comes from an improper attempt to reconstruct Appellant's invention in hindsight.

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As to the Examiner's assertion (Answer, page 4) of the obviousness of making integral that which had formerly been separate elements, it is apparent that this contention is based on the premise that the skilled artisan would have found it obvious to add a transformer to Strohbeck's vibrator structure. From our previous discussion, we find this premise to be based on faulty reasoning. To the extent that the Examiner's contention as to the obviousness of making separate elements part of an integral whole is correct and relevant in the present factual situation, it is our view that such reasoning can not alone provide a proper basis for a proposed combination if one of ordinary skill were not motivated to combine the separate elements in the first instance.

For all of the reasons discussed above, we are of the view that the Examiner has not established a prima facie case of obviousness and, therefore, do not sustain the 35 U.S.C. §

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rejection of any of the claims on appeal. Accordingly, the  
Examiner's decision rejecting claims 1-3 is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
ERROL A. KRASS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	

jrg

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