

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLARK MORRISON and VITTORIO STRAPAZZINI

Appeal No. 1997-2252
Application No. 08/225,965

HEARD: May 18, 2000

Before COHEN, STAAB, 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 10, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention is especially useful in producing vehicle interior doors and trim panels having an undercut edge

(specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Kozlowski et al. (Kozlowski)	4,692,199	Sept. 8, 1987
Swenson et al. (Swenson)	4,793,793	Dec. 27, 1988
Spengler et al. (Spengler)	4,923,539	May 8, 1990
Alesi, Jr. et al. (Alesi)	5,401,456 (effective filing date Oct. 7, 1987)	Mar. 28, 1995

Claims 1 to 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Spengler in view of Alesi or Kozlowski in further view of Swenson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 15, mailed January 22, 1997) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 14, filed

November 12, 1996) and reply brief (Paper No. 16, filed March 24, 1997) 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 prior art references, and to the respective positions articulated by the appellants 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 10 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 appellants argue (brief, pp. 4-7; reply brief, pp. 2-3) that the applied prior art does not suggest the claimed subject matter. We agree.

Claim 1 (the sole independent claim on appeal) recites a method of forming a panel having an undercut edge comprising, inter alia, the following seven steps: (1) providing a die pair, one of said die pair having a cavity; (2) positioning a ring including a cut out portion in said cavity; (3) loading a blank into said cavity over said ring; (4) closing said die pair together over said blank; (5) adding a substrate into said cavity onto said blank; (6) molding said substrate and blank into a panel; and (7) removing said panel from said cavity.

Spengler discloses a method of manufacturing trim panels which are made of several trim components or trim materials, such as door trim panels of automobiles. A vinyl cover film (12) is formed, trim inserts (10, 11) are laminated onto the cover film with the aid of a nesting die (8a, 8b), soft touch inserts (26)

are laminated underneath the cover film and the so produced laminate is further laminated onto a rigid substrate (2 or 2'). The substrate may be a prefabricated substrate (2), or may be a rigid foam substrate (2') back-foamed onto the formed vinyl film (12). An apparatus for carrying out the method is essentially a forming station with an upper form or mold (1) and a lower form or mold (15). The lower mold (15) includes nest dies (8a, 8b) for securely holding and then pressure laminating the trim inserts (10, 11), whereby a high placement precision of the inserts (10, 11) is achieved.

Based on our analysis and review of Spengler and claim 1, it is our opinion that one difference is the step of "positioning a ring including a cut out portion in said cavity."

The examiner determined (answer, pp. 4-6) that this difference would have been obvious at the time the invention was made to a person having ordinary skill in the art from the teachings of Alesi or Kozlowski and Swenson. We do not agree.

In that regard, while the examiner is correct that both Alesi and Kozlowski do teach the use of rings in the molding art,

neither Alesi or Kozlowski teach or suggest positioning a ring including a cut out portion in a cavity of one of the dies. Likewise, while the examiner is correct that Swenson does teach the use of an undercut edge shaping means (i.e., a cut out) in the molding art, Swenson does not teach or suggest positioning a ring including a cut out portion in a cavity of one of the dies. Additionally, it is our opinion that the combined teachings of the applied prior art would not have suggested the step of "positioning a ring including a cut out portion in said cavity." In our view, the only suggestion for modifying Spengler in the manner proposed by the examiner to meet the above-noted step 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). It follows that we cannot sustain the examiner's rejections of claims 1 to 10.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 10 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 1997-2252
Application No. 08/225,965

Page 8

BERNARD J. CANTOR
HARNESS DICKY PIERCE
P O BOX 828
BLOOMFIELD HILLS, MI 48303

JVN/ks