

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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOWELL W. KNAPP
and SAM E. STEWART

Appeal No. 1998-0127
Application 08/609,670

ON BRIEF

Before THOMAS, JERRY SMITH and RUGGIERO, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

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Application No. 08/609,670

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claim 6, which constitutes the only claim remaining in the application. An amendment after final rejection was filed on January 13, 1997 but was denied entry by the examiner.

The disclosed invention pertains to the field of reproduction machines. More particularly, the invention is directed to an arrangement for protecting the electrical cable interconnection between the mainframe of the machine and at least one modular component which is movable towards and away from the mainframe.

The single claim in this application is reproduced as follows:

6. A reproduction machine with a mainframe and at least one modular component comprising a slide out drawer movable in a linear direction of movement towards and away from said mainframe and an electrical cable interconnection between said mainframe and said modular component comprising at least one flexible electrical cable with one end of said flexible cable connected to said mainframe and the other end of said cable connected to said modular component, and an improved cable releasing and retracting system for protecting said electrical cable interconnection when said modular component is moved towards and away from said mainframe, said cable releasing and retracting system being mounted substantially parallel to the linear direction of said slide drawer, said cable releasing

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Claim 6 stands rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Abare in view of Kunkle.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the 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, the appellants' 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 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 claim 6. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is

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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 (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 Hosp. Sys., Inc. v. Montefiore Hosp., 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.

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1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

Abare teaches an electrical tape tensioner for connecting a paper tray which is movable towards and away from a copier to the mainframe of the copier. The examiner acknowledges that Abare does not teach the claimed spring system having a substantially constant force or the partially open sided C-shaped cable guide and protective channel member. With respect to the latter feature, the examiner cites Kunkle as teaching a cable releasing and retracting system having a partially open sided C-shaped cable guide and protective

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channel member. The examiner asserts that it would have been obvious to modify the Abare bare tape with the protective member of Kunkle. With respect to the spring feature, the examiner notes that appellants' specification admits that constant force springs were known in the art. The examiner finds nothing unobvious in using these known devices in the cable releasing or retracting systems of Abare or Kunkle [answer, pages 4-5].

Appellants argue that the examiner's position that Kunkle teaches a partially open C-shaped channel guide is an erroneous finding. Appellants argue that, to the contrary, Kunkle teaches a cable guide which is covered or sealed along its entire length by a cover plate [brief, pages 9-10]. The examiner responds that the cover plate in Kunkle is irrelevant because the use of "comprising" in claim 6 permits the prior art to have additional elements which are not claimed [answer, page 6]. Appellants argue that the integral structure of Kunkle cannot be ignored and selectively destroyed to meet the claimed invention [brief, page 11]. On this point we agree with appellants.

Although the examiner is correct that a prior art

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teaching may have additional extraneous features which are not claimed, the examiner is incorrect to hold that such extraneous features are always irrelevant to the consideration of obviousness. The prior art must teach the claimed details of the C-shaped cable guide and protective channel member regardless of the additional, extraneous features present in the prior art. Here, the cover plate in Kunkle defeats the very purpose of the claimed channel member being partially open sided and C-shaped and actually prevents the member in Kunkle from meeting the claimed recitation. Since the "extraneous" feature here, the cover plate, would destroy the very purpose and function of the claimed partially open sided C-shaped member, the examiner should not have treated this claim limitation as being fully met by the disclosure of Kunkle.

Appellants argue that neither Abare or Kunkle teaches or suggests the use of a pulley cable guide with a constant force spring system as recited in claim 6 [brief, page 14]. As noted above, the rejection simply noted that appellants' specification had indicated that constant force spring systems were known. The examiner found obviousness based on his

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opinion that "nothing unobvious is seen to have been involved in simply having applied this known expedient for a cable releasing and retracting system" [answer, page 5]. We agree with appellants on this point as well.

The examiner's position is tantamount to saying that the application of old ideas or old devices can never support patentability. The essence of invention, however, is the application of knowledge to make something which is novel and unobvious. Individual elements of a combination are usually known in the art. It is the placement of these elements in the combination which must be considered for obviousness. Although it may be obvious to use a substantially constant force spring system in a reproduction system as claimed, there is no evidence on this record to support such a conclusion. Obviousness is not established by the examiner failing to see nonobviousness in an

invention. The prior art must specifically suggest the claimed subject matter in order to find obviousness. Appellants are correct that there is nothing in the applied prior art to suggest the claimed substantially constant force

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spring system in a reproduction machine of the type set forth in the claim.

In summary, we disagree with the examiner that either of the acknowledged differences between Abare and the claimed invention is rendered obvious by the teachings of Kunkle or the knowledge of the artisan. Therefore, the decision of the examiner rejecting claim 6 is reversed.

REVERSED

James D. Thomas)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
Jerry Smith)	
Administrative Patent Judge)	APPEALS AND
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