

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

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER C. MROTZ, DAVID P. NOEL and THOMAS A. LANGWORTHY

Appeal No. 2000-1660
Application No. 08/868,081

HEARD: October 24, 2001

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 19 to 22, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to an overhead storage unit for use with modular office systems (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:

Aylworth 1976	RE 28,994	Oct. 5,
White 1991	5,022,541	June 11,

Claims 19 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Aylworth in view of White.

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. 16, mailed May 7, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 15,

filed April 5, 1999) and reply brief (Paper No. 18, filed July 8, 1999) 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 19 to 22 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).

In the rejection before us in this appeal, the examiner determined (answer, pp. 3-4) that Aylworth taught all the claimed subject matter except for the engagement tabs having angled portions as claimed (i.e., the first end panel having a first back edge including first engagement tabs having a first angled portion which projects inward towards the first inner side thereon and the second end panel having a second back edge including second engagement tabs having a second angled portion which projects inward towards the second inner side). The examiner then concluded that such differences would have been obvious from White's teaching of elements 52 and 86 shown in Figures 2 and 9 as having tabs 96 and 98.

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

In our view, the only suggestion for modifying Aylworth in the manner proposed by the examiner to include angled portions on the engagement tabs as claimed stems from hindsight knowledge

derived from the appellants' own disclosure.¹ In that regard, we view White's teaching of tabs 96 and 98 of elements 52 and 86 engaging slots 102 in the return flange 100 of horizontal brace 88 to rigidly connect the elements to the brace as providing no teaching, suggestion or motivation for a person of ordinary skill in the art at the time the invention was made to have modified the engagement tabs of Aylworth. It follows that we cannot sustain the examiner's rejections of claims 19 to 22.

¹ 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 Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

CONCLUSION

To summarize, the decision of the examiner to reject claims 19 to 22 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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