

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte PEDER FAHRSEN PEDERSEN

Appeal No. 2001-1679
Application No. 08/849,336

ON BRIEF

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 6 to 8, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a stair or ladder steps of the plate-shaped step type, where plate members bent downwards are provided on all four rims of the stepping surface (specification, p. 1). A copy of the claims under appeal is set forth 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:

Lister	3,593,821	July 20, 1971
Layher	4,331,218	May 25, 1982
Miller	5,355,974	Oct. 18, 1994
Krämer et al. (Krämer)	DE 1,921,516 ¹	Nov. 5, 1970
Kümmerlin	EP 0 033 475 ²	Aug. 12, 1981

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lister or Kümmerlin in view of either Krämer or Layher.

¹ In determining the teachings of Krämer, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellant's convenience.

² In determining the teachings of Kümmerlin, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellant's convenience.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lister or Kümmerlin in view of either Krämer or Layher as applied to claim 6 above, and further in view of Miller.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 23, mailed December 19, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 22, filed October 11, 2000) 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 6 to 8 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).

As noted in Manual of Patent Examining Procedure (MPEP) § 2141

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere [Co.]*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy. . .

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will

result in that uniformity and definitiveness which Congress called for in the 1952 Act. [383 U.S. at 17-18, 148 USPQ at 467}

Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquires enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

In the rejections (answer, p. 3) before us in this appeal, the above noted methodology was not correctly followed by the examiner. First, in the rejection of claim 6 (the only independent claim on appeal) the examiner did not determine the scope and content of the applied prior art (i.e., Lister, Kümmerlin, Krämer and Layher). Instead of specifically pointing out what each reference taught vis-a-vis the subject matter of claim 6, the examiner just broadly provided that Lister and Kümmerlin both show a stepping platform and that Krämer and Layher show platforms having plate members terminating in rolled over pipes as a reinforcing means. Second, the examiner did not correctly ascertain the differences between the applied prior art (i.e., Lister or Kümmerlin) and the claims in issue. In that regard, the examiner ascertained that Lister and Kümmerlin "both show the claimed stepping platform with the exception of the rollers over [sic, front and rear rims rolled over to form a] cylindrical pipe." This ascertainment of the

differences is not correct. Lister and Kümmerlin also fail to disclose (1) each of the rims of the stepping surface (i.e., the front rim, the rear rim and the two side rims) being provided with plate members having downwardly bent portions welded together at corners where said plate members abut one another due to the bending; and (2) welds at locations where ends of the cylindrical pipes abut the plate members bent downward at the side rims.

Thus, even if Lister or Kümmerlin were to be modified in the manner set forth in the rejection of claim 6, one would not arrive at the claimed invention since such modifications of either Lister or Kümmerlin would not result in a plate-shaped stair step having a stepping surface with a front rim, a rear rim and two side rims wherein each of the rims are provided with plate members having downwardly bent portions welded together at corners where the plate members abut one another due to the bending.

In addition, it is our view that absent the use of hindsight knowledge derived from the appellant's own disclosure³ there is no motivation or suggestion in the applied prior art to have modified either Lister or Kümmerlin to have a stepping platform with the front and rear rims rolled over to form a cylindrical pipe as recited in claim 6. Lastly,

³ 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).

there is no evidence in the record that even if it would have been obvious to have modified either Lister or Kümmerlin to have a stepping platform with the front and rear rims rolled over to form a cylindrical pipe that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have welds at locations where ends of the cylindrical pipes abut the plate members bent downward at the side rims.⁴

Since the subject matter of claim 6 is not rendered obvious by the applied prior art for the reasons set forth above, the decision of the examiner to reject claim 6 under 35 U.S.C. § 103 is reversed.

We have also reviewed the reference to Miller additionally applied in the rejection of claims 7 and 8 (dependent on claim 6) but find nothing therein which makes up for

⁴ Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

the deficiencies of the applied prior art discussed above regarding claim 6. Accordingly, the decision of the examiner to reject claims 7 and 8 under 35 U.S.C. § 103 is also reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 6 to 8 under 35 U.S.C. § 103 is reversed.

REVERSED

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