

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATHEW MCPHERSON

Appeal No. 2003-0348
Application 09/567,145

ON BRIEF

Before JERRY SMITH, BLANKENSHIP and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 17-20 and 25-37, which constitute all the claims remaining in the application. An amendment after final rejection was filed on July 23, 2002 and was entered by the examiner. The rejection of claims 25 and 29-36 in the final rejection on the ground of obviousness-type

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double patenting has been withdrawn by the examiner [answer, page 6]. Since this was the only rejection against claims 30-36, these claims have now been indicated to contain allowable subject matter. Therefore, this appeal is now directed to the rejection of claims 17-20, 25-29 and 37.

The disclosed invention pertains to an acoustic guitar.

Representative claim 17 is reproduced as follows:

17. In an acoustic guitar the guitar having a sound box having a sound board, a neck, a plurality of strings positioned above the sound board, the improvement comprising the sound board comprising no more than [sic] two layers of wood bonded together, wherein the grain direction of the two layers of wood are in substantially parallel planes, running in substantially perpendicular directions.

The examiner relies on the following references:

Oehrlein	168,665	Oct. 11, 1875
Besnainou et al. (Besnainou)	5,171,926	Dec. 15, 1992

Sloane, Steel-String Guitar Construction, 1975 by E. P. Dutton & Co., Inc., page 19.

Claims 17-20, 25-29 and 37 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Oehrlein in view of Besnainou and Sloane.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

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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 appellant's arguments set forth in the briefs 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 the claims on appeal. Accordingly, we reverse.

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

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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. 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

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actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

With respect to independent claims 17, 25 and 37, the examiner cites Oehrlein as teaching a guitar in which two layers of wood are used in which the grains of the layers run in substantially perpendicular directions. The examiner notes that Oehrlein does not teach no more than two layers for the sound board. The examiner cites Besnainou as teaching a sound board using at least two superposed sheets of crossed and directed long fibers and Sloane as teaching using no more than two layers for the sound board of a guitar. The examiner finds that it would have been obvious to the artisan to modify Oehrlein in view of Besnainou and Sloane [answer, page 5].

With respect to independent claim 17, appellant argues that Oehrlein is directed to the construction of the bottom board of a guitar and not to the sound board as claimed. Appellant argues that the sound board and bottom board of a guitar have entirely different functions, and the examiner has not identified any motivation for using the bottom board teachings of Oehrlein for the sound board [brief, pages 6-10].

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The examiner responds that the claim on appeal is in Jepson format, and Oehrlein is only relied on to teach what is admitted as old in the preamble of the claim. The examiner notes that Besnainou and Sloane teach the making of a sound board having no more than two layers where the grains are parallel and run perpendicular to one another for a layered wood string instrument. The examiner concludes that the "combination of the references reads on the claims" [answer, pages 6-7].

In addition to the arguments made in the main brief, appellant responds that the grains of the sheets in Besnainou are not running perpendicular to each other as asserted by the examiner. Appellant also responds that Sloane merely teaches that two-ply plywood is better than three-ply plywood when making a soundboard for a guitar. Finally, appellant argues that the modification proposed by the examiner would destroy the purpose of the Besnainou invention [reply brief, pages 5-7].

We will not sustain the examiner's rejection of independent claim 17 or of claims 18-20 which depend therefrom for essentially the reasons argued by appellant in the briefs. At the outset, we cannot find any basis for considering the teachings of Oehrlein at all. As noted by appellant, Oehrlein relates to the bottom board of a guitar and not to the sound

board. In fact, Oehrlein specifically states that his invention has nothing to do with sound boards [column 3, lines 5-8]. We can find no useful teaching in Oehrlein which is related to the sound board of the claimed invention on appeal before us. Although appellant is correct that the fibers in Besnainou are not perpendicular, we find Besnainou to be irrelevant here because it is not directed to the use of wood layers in making the sound board of a guitar. Besnainou relates to a bow instrument such as a violin, viola and cello, and Besnainou relates to a sound board made from a composite material rather than wood. Thus, there can be no perpendicular wood grains in the layers of Besnainou because there is no wood in Besnainou. Although the examiner's rejection clearly represents an attempt to reconstruct the claimed invention in hindsight, the fact of the matter is that the claimed invention has not been achieved even in hindsight. It is interesting to note the examiner's statement that the combination of the references reads on the claims. This "fact" does not establish obviousness. The fact that all the elements of the claimed invention can be separately found in a plurality of references does not, by itself, establish obviousness. The examiner must also provide a convincing rationale as to why the artisan would have found it obvious to

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combine the plurality of references to arrive at the claimed invention.

Although appellant nominally argues independent claims 25 and 37 separately, the arguments with respect to these claims are the same arguments made with respect to claim 17. Therefore, for all the reasons discussed above, we also do not sustain the examiner's rejection of independent claim 25, each of the claims which depends therefrom, and independent claim 37.

In summary, we have not sustained the examiner's rejection with respect to any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 17-20, 25-29 and 37 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	
HOWARD B. BLANKENSHIP)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
MAHSHID D. SAADAT)	
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