

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte CRAIG B. PARKER  
and  
WALTER ROLSTON

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Appeal No. 2003-0717  
Application No. 09/549,118

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ON BRIEF

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Before ABRAMS, NASE, and BAHR, 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 26, which are all of the claims pending in this application.<sup>1</sup>

We REVERSE.

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<sup>1</sup> Claim 12 was amended subsequent to the final rejection.

### BACKGROUND

The appellants' invention is directed to an aircraft course deviation indicator having improved flags for indicating when the course deviation indicator is providing a reading that is known to be in error (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:

Brady et al. (Brady)	4,415,879	Nov. 15, 1983
Masuzawa et al. (Masuzawa)	4,811,679	Mar. 14, 1989
Koenig	5,610,600	Mar. 11, 1997

Claim 12 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 1 to 9, 12 to 16, 18, 20 to 24 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koenig.

Claims 10 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koenig in view of Brady.

Claims 11, 19 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koenig in view of Masuzawa.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 17, mailed May 8, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15, filed February 22, 2002) and reply brief (Paper No. 18, filed July 9, 2002) 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. As a consequence of our review, we make the determinations which follow.

#### **The indefiniteness rejection**

We will not sustain the rejection of claim 12 under 35 U.S.C. § 112, second paragraph.

The basis for this rejection (answer, p. 4) is that the limitations "said horizontal deviation bar" and "the horizontal deviation data" lack antecedent basis. However, the after-final amendment of claim 12 amended the two limitations to read "said lateral deviation bar" and "the lateral deviation data."

Since the limitations the examiner found objectionable in claim 12 are no longer present in claim 12, the decision of the examiner to reject claim 12 under 35 U.S.C. § 112, second paragraph, is reversed.

### **The obviousness rejections**

We will not sustain the rejection of claims 1 to 26 under 35 U.S.C. § 103.

In the rejection claims 1, 12, 20, 23 and 26, the independent claims on appeal, the examiner (answer, pp. 4-9) after setting forth the pertinent teachings of Koenig ascertained<sup>2</sup> that Koenig did not teach either (1) indicator(s) comprising arrow(s) as recited in claims 1 and 23; or (2) an indicator oriented in a vertical direction with respect to the display as recited in claims 12, 20 and 26. Despite this failure of Koenig to teach

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<sup>2</sup> After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

these two claimed features, the examiner concluded that such differences were not patentable absent proof that the claimed novel indicator would improve noticeability.

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 have modified the applied primary reference 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). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

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. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." 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).

In this case, Koenig does not teach either (1) indicator(s) comprising arrow(s) as recited in claims 1 and 23; or (2) an indicator oriented in a vertical direction with respect to the display as recited in claims 12, 20 and 26. Likewise, Koenig does not suggest either (1) indicator(s) comprising arrow(s) as recited in claims 1 and 23; or (2) an indicator oriented in a vertical direction with respect to the display as recited in claims 12, 20 and 26. To supply these omissions in the teachings of Koenig, the examiner made determinations (answer, pages 4-9) that these differences would have been obvious to an artisan. However, these determinations have not been supported by any evidence that would have led an artisan to arrive at the claimed invention. Accordingly, we must conclude that the examiner has not provided any evidence of a suggestion, teaching, or motivation to have modified Koenig to arrive at the claimed subject matter.

In our view, the only suggestion for modifying Koenig in the manner proposed by the examiner to meet the above-noted limitations 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 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).

Since Koenig is not suggestive of the subject matter recited in claims 1, 12, 20, 23 and 26 for the reasons set forth above, the decision of the examiner to reject claims 1, 12, 20, 23 and 26, and claims 2 to 11, 13 to 19, 21, 22, 24 and 25 dependent thereon, under 35 U.S.C. § 103 is reversed.<sup>3</sup>

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<sup>3</sup> We have also reviewed the Brady reference additionally applied in the rejection of claims 10 and 17 and the Masuzawa reference applied in the rejection of claims 11, 19 and 25 but find nothing therein which makes up for the deficiencies of Koenig discussed above regarding claims 1, 12, 20, 23 and 26.

CONCLUSION

To summarize, the decision of the examiner to reject claim 12 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 1 to 26 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS	)	
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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