

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 DONALD G. GILLIS
and
DANIEL JOHNSON

Appeal No. 2004-1753
Application No. 09/524,086

ON BRIEF

Before COHEN, 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 10 to 34, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to mobile ladder stands and an improved design which allows such a ladder stand to be used in small spaces where mobility of larger ladders is restricted (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:

Phillips	2,237,688	April 8, 1941
Christensen	2,563,919	Aug. 14, 1951
Easton	2,798,652	July 9, 1957
Borgman	3,155,190	Nov. 3, 1964
Rice	3,684,055	Aug. 15, 1972
Gutierrez	4,063,616	Dec. 20, 1977
Severin	DE 537641	Oct. 31, 1931
Chinn	GB 2 057 545	April 1, 1981

Claims 10 to 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rice in view of Christensen.

Claims 10, 11, 13 to 32 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gutierrez in view of Christensen.

Claims 17 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over either Gutierrez or Rice and Christensen as applied to claims 16 and 24 above, and further in view of Borgman.

Claims 20, 21, 27 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rice and Christensen as applied to claim 22 above, and further in view of Chinn.

Claims 10 to 12, 14, 16 to 18, 22 to 25 and 30 to 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Severin in view of either Easton or Phillips.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed January 14, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (filed December 2, 2002) and reply brief (filed March 17, 2003) 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, to the evidence of nonobviousness submitted by the appellants, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we will not sustain any of the rejections under appeal for the reason which follows.

In resolving the questions of obviousness/nonobviousness before us in this appeal, it is necessary to weigh the entire merits of the matter and to consider all of the evidence of record. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). We are mindful that objective evidence of nonobviousness in any given case is entitled to more or less weight depending on its nature and its relationship with the merits of the claimed invention. Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 1539, 218 USPQ 871, 879 (Fed. Cir. 1983). Thus, the evidence of nonobviousness submitted by the appellants must be considered en route to a determination of obviousness/nonobviousness under 35 U.S.C. § 103. Accordingly, we must carefully evaluate both the teachings of the applied prior art and the evidence of nonobviousness supplied by the appellants. See In re Oetiker, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 1992).

The teachings of the applied prior art relied upon by the examiner as establishing obviousness of the claimed subject matter are adequately set forth on pages 3 and 4 of the answer and pages 8 to 13 of the brief.

The examiner has not properly considered the evidence of nonobviousness supplied by the appellants (answer, p. 5). When determining obviousness/nonobviousness under 35 U.S.C. § 103, the subject matter as a whole must be weighed. Thus, even if the examiner were to be correct that the "crux of the invention" was not new, the evidence of nonobviousness submitted by the appellants still must be considered en route to a determination of obviousness/nonobviousness under 35 U.S.C. § 103.

In our view, the evidence of nonobviousness supplied by the appellants (see paragraphs 5-16 of the declaration of Donald G. Gillis dated December 19, 2000) establishes copying of the claimed invention by the appellants' competitors.¹ That declaration states that twelve companies are marketing a copy of the appellants' invention and that these twelve companies, along with the appellants' company, represent the major suppliers of mobile ladders in the United States. When this

¹ Copying is an indicium of nonobviousness. See *Advanced Display Sys., Inc. v. Kent State Univ. Kent State University*, 212 F.3d 1272, 1285, 54 USPQ2d 1673 (Fed. Cir. 2000); *Dow Chemical Co. v. American Cyanamid Co.*, 816 F.2d 617, 622, 2 USPQ2d 1350, 1355 (Fed. Cir. 1987).

evidence is properly weighed along with the teachings of the applied prior art, we conclude that, on balance, the evidence of nonobviousness presented by appellants outweighs the evidence of obviousness presented by the examiner in the rejections before us in this appeal. We thus reach the conclusion that it would not have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Rice, Gutierrez or Severin in the manner set forth by the examiner in the rejections under appeal. It follows that the examiner's rejections will not be sustained.

For the reasons set forth above, the decision of the examiner to reject claims 10 to 34 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 10 to 34 under 35 U.S.C. § 103 as being unpatentable over Rice in view of Christensen is reversed; the decision of the examiner to reject claims 10, 11, 13 to 32 and 34 under 35 U.S.C. § 103 as being unpatentable over Gutierrez in view of Christensen is reversed; the decision of the examiner to reject claims 17 and 25 under 35 U.S.C. § 103 as being unpatentable over either Gutierrez or Rice and Christensen and further in view of Borgman is reversed; the decision of the examiner to reject claims 20, 21, 27 and 28 under 35 U.S.C. § 103 as being unpatentable over Rice and Christensen and further in

view of Chinn is reversed; and the decision of the examiner to reject claims 10 to 12, 14, 16 to 18, 22 to 25 and 30 to 33 under 35 U.S.C. § 103 as being unpatentable over Severin in view of either Easton or Phillips is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

Appeal No. 2004-1753
Application No. 09/524,086

Page 8

LAFF WHITESEL & SARET LTD
401 NORTH MICHIGAN AVENUE
SUITE 1700
CHICAGO, IL 60611

JVN/jg