

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 JAMES NORKUS and RANDY MICHAEL BUGNACKI

Appeal No. 2005-0072
Application No. 09/656,351

ON BRIEF

Before KIMLIN, OWENS and KRATZ, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4-6, 8-15, 17-25, 27-29, 31 and 33. Claims 7, 30 and 32 stand objected to by the examiner. Claim 1 is illustrative:

1. A shock isolating mount for securing a mounting part of a structure onto a support, said shock isolating mount comprising:

a one-piece rigid spacer having a spacer flange and a spacer tube projecting from the spacer flange, the spacer tube having a homogeneously formed, inwardly projecting shoulder having an inner diameter;

a thimble comprising:

a metal thimble base having a flange and an internally threaded post projecting from the flange, and

a plastic hollow thimble stem, said stem and said base having mating means for securing said stem to said base, said stem having projecting from a top end thereof a plurality of fingers spaced about a periphery thereof, each of the fingers having an outwardly projecting portion defining a circumferential lip having an outer diameter larger than the inner diameter of the shoulder of the spacer tube of said spacer; and

wherein the stem is telescopically receivable in the spacer tube such that when the stem is fully inserted in the spacer tube, the lip engages the shoulder in a snap fitted arrangement.

The examiner relies upon the following references as

evidence of obviousness:

Mason	72,409	Dec. 17, 1867
Mansel	4,118,134	Oct. 3, 1978
Tillman et al. (Tillman)	5,031,266	Jul. 16, 1991
Norkus	5,570,867	Nov. 5, 1996

The appealed claims stand rejected under 35 U.S.C. § 103(a) as follows: (a) claims 1, 2, 4-6, 8-11 and 31 over Norkus; (b) claims 12, 14, 15, 18, 19, 24, 25, 27-29 and 33 over Norkus in view of Tillman; (c) claims 13, 17, 20, 21 and 23 over Norkus in view of Tillman and Mason; and (d) claim 22 over Norkus in view of Tillman, Mason and Mansel.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we find ourselves in agreement with appellants that the examiner has

Appeal No. 2005-0072
Application No. 09/656,351

failed to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejections for essentially those reasons set forth by appellants.

Appellants' invention is directed to a shock isolating mount comprising a thimble having a plurality of fingers which define a circumferential lip projecting from a stem, which allows the stem to be snap fitted into a spacer tube of a one-piece rigid spacer. On the other hand, Norkus, the primary reference, although directed to a shock isolating mount, employs a tabbed washer 28 comprising a plurality of engaging fingers in the spacer tube rather than as part of the thimble. The flaw in the examiner's rejections is that Norkus fails to provide any teaching or suggestion of modifying the depicted spacer and thimble such as to result in the presently claimed thimble having projecting fingers. Nor has the examiner cited any other prior art which would have suggested eliminating the tabbed washer of Norkus and replacing its function with appellants' thimble.

The examiner's citation of In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955) is tantamount to the application of a per se rule for patentability that has been consistently rejected by our reviewing court. The examiner has not set forth an

Appeal No. 2005-0072
Application No. 09/656,351

analysis which demonstrates that the facts of Gazda are so alike the facts of the present case that a finding of obviousness is inescapable. Furthermore, the requisite modification of Norkus to arrive at the claimed invention requires more than merely a reversal of parts, e.g., appellants have not simply repositioned the tabbed washer of Norkus on the thimble.

In conclusion, based on the foregoing, we are constrained to reverse the examiner's rejections.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	
TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

ECK:clm

Appeal No. 2005-0072
Application No. 09/656,351

Lisa M. Celtis
Illinois Tool Works Inc.
3600 West Lake Ave.
Glenview, IL 60025