

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORMAN PAUL GIERTZ

Appeal 2007-1887
Application 10/401,475
Technology Center 3700

Decided: December 13, 2007

Before BRADLEY R. GARRIS, THOMAS A. WALTZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is a decision on Appellant's Request for Rehearing (hereafter the "Request") dated July 11, 2006, filed pursuant to 37 C.F.R. § 41.52(a)(1) (2006), requesting rehearing of the Decision dated June 8, 2007 (hereafter the "Decision"), where this merits panel affirmed the six rejections based on 35 U.S.C. § 103(a) presented for review in the appeal (Decision 5).

Appellant contends that the Board has not considered the established functions of Potter as compared to the established function set forth by Appellant (Request 2). Appellant further contends that to characterize the problem as brush wires tending to work loose is assigning a problem essentially generic to every brush ever made (Request 2). Appellant states that in Potter the fingers disappear with hammering, and the notches have no established function, purpose, or intent remotely similar (Request 3).

Appellant cites *KSR Int'l Co. v. Teleflex, Inc.* for the holding that prior art elements must be tied to their established functions, and the analysis required for obviousness cannot be sustained by mere conclusory statements (Request 3-5).

We do not find Appellant's arguments convincing of error in our Decision for the following reasons. In establishing obviousness, it is well settled that the reason in the prior art to combine features or elements does not have to be identical to that of Appellant. *See In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996); and *In re Dillon*, 919 F.2d 688, 693 (Fed. Cir. 1990). As the Supreme Court held in *KSR*, 127 S. Ct. at 1742, “[u]nder the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” As clearly set forth in the Decision, we determined that Potter discloses a retaining plate for brushes with fingers and notches, with holes located on the fingers for receiving bristle tufts, where this construction solves the problem of the brush wires tending to work loose (Decision 6; *see* factual finding (5)). We also determined that this construction of fingers and notches was within the scope of the claimed subject matter as properly construed (Decision 7). Contrary to Appellant's

argument (Request 3-5), we determined that the Examiner had stated an explicit reasoned analysis establishing obviousness (Decision 8, citing the Answer 4-6). Appellant does not argue that a retaining plate with fingers and notches construction was unknown at the time of their invention. As held by the Court in *KSR*, 127 S. Ct. at 1741:

Neither the enactment of § 103 nor the analysis in *Graham* disturbed this Court’s earlier instructions concerning the need for caution in granting a patent based on a combination of elements found in the prior art. For over a half century, the Court has held that a “patent for a combination which only unites old elements with no change in their respective functions ... obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950). This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

Accordingly, we determine that the claimed twisted tuft knot type end brush simply arranges old elements with each performing the same function it had been known to perform, yielding no more than one would have expected from such an arrangement.

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For the foregoing reasons and those presented in the Decision, we have considered Appellant's Request for Rehearing but find no argument convincing of error in our original Decision. Therefore, the Request for Rehearing is DENIED.

DENIED

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