

GTHIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEROME WARSHAWSKY

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Appeal No. 96-3132  
Application No. 08/248,521<sup>1</sup>

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ON BRIEF

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Before ABRAMS, FRANKFORT, and NASE, 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, 5, 14 and 15, which are all of the claims pending in this application.

We REVERSE.

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<sup>1</sup> Application for patent filed May 24, 1994.

BACKGROUND

The appellant's invention relates to a zinc-based spray faucet hose collar weight. Claims 1 and 15 are representative of the subject matter on appeal and a copy of those claims is attached to the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Heimann et al. (Heimann)	4,827,538	May 9, 1989
Hochstrasser	5,090,062	Feb. 25, 1992

Claims 1, 5, 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hochstrasser in view of Heimann.<sup>2</sup>

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 rejection, we make reference to the final rejection (Paper No. 7, mailed May

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<sup>2</sup> It is not clear to us why the examiner applied these two references instead of the admitted prior art (specification, pp. 1-2). While the actual structural details of this admitted prior art have not been disclosed by the appellant, the examiner has the authority to issue a requirement for information requiring applicant to provide the structural details of the admitted prior art so that the examiner could properly determine patentability thereover under 35 U.S.C. § 103. See MPEP § 706.02(c).

23, 1995) and the examiner's answer (Paper No. 15, mailed April 12, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 14, filed March 18, 1996) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's rejection of the appealed claims under 35 U.S.C. § 103 is not well founded and will therefore not be sustained. Our reasoning for this determination follows.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

With regard to the examiner's rejection of claims 1,<sup>3</sup> 5, 14 and 15 under 35 U.S.C. § 103, we share the appellant's view that the combined teachings of the applied prior art would not have suggested the claimed invention. In fact, as pointed out by the appellant (brief, pp. 15-16), the applied prior art fails to teach or suggest most of the limitations recited in independent claims 1 and 15. While both applied prior art patents teach a weight mounted on a flexible hose, they do not teach or suggest the claimed invention. In particular, it is our determination that the combined teachings of the applied prior art would not have suggested the outwardly extending flat surfaces of the upper and lower portions of the collar weight being spaced apart as recited in independent claim 1 or the collar portions of the collar weight being spaced apart as recited in independent claim 15. We also find the examiner's expressed reasoning concerning the obviousness of substituting zinc for lead to be somewhat tenuous in that (1) the applied prior art does not teach lead or

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<sup>3</sup> Consistent with the appellant's specification (page 2, lines 14-18), we have interpreted the phrase from lines 5-7 of claim 1 "said collar comprises a composition of a zinc-based alloy wherein said zinc-based alloy is provided in an amount of about 95 percent by weight" to mean "said collar comprises a composition of a zinc-based alloy wherein zinc is provided in an amount of about 95 percent by weight." The appellant should amend claim 1 to reflect this interpretation.

zinc, and (2) very little motivation for the selection of zinc has been provided. It is our view, after a careful review of the combined teachings of the applied prior art, that in searching for an incentive for modifying the weight 68 of Hochstrasser, the examiner has impermissibly drawn from the appellant's own teachings and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Since we have determined that the subject matter of independent claims 1 and 15 would not have been suggested by the combined teachings of the applied prior art, it follows that we will not sustain the examiner's rejection of appealed independent claims 1 and 15, or claims 5 and 14 which depend therefrom, under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 5, 14 and 15 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPEAL NO. 96-3132 - JUDGE NASE  
APPLICATION NO. 08/248,521

APJ NASE

APJ FRANKFORT

APJ ABRAMS

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

**DRAFT TYPED:** 11 Dec 98

**FINAL TYPED:**