

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte M. DAVID BOOTHE

Appeal No. 2004-2282
Application No. 09/989,555

ON BRIEF

Before MCQUADE, NASE, and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is a decision on appellant's request for rehearing of our decision mailed November 17, 2004, wherein we affirmed the examiner's decision to reject claims 9-11 under 35 U.S.C. § 103 as being unpatentable over Recchione in view of any of Lacey, Dollman and Coultaus and unpatentable over Finch in view of any of Lacey, Dollman and Coultaus. Notwithstanding appellant's reference to 37 CFR § 1.197, we have treated this request under 37 CFR § 41.52(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

Appellant's request for rehearing alleges that this panel committed two errors in affirming the examiner's decision. First, the request (page 9) urges that this panel applied the incorrect legal standard for obviousness when we pointed out on pages 5-6 of our decision that

the differences between a springless and a spring-loaded latch mechanism are not of such a nature that one of ordinary skill in the art would have been dissuaded from providing on the springless latch mechanism of either Recchione or Finch an enlarged loop disposed through a hole in the spring bolt, as taught by any of Lacey, Dollman and Coultaus, to obtain the self-evident advantage of a vehicle for applying a pulling force to the latch.

The above-quoted statement from our decision is not a statement of motivation for the modification proposed by the examiner but, rather, a response to appellant's argument in the appeal brief (page 8) that the teaching by Lacey, Dollman and Coultaus of using a loop in a spring-loaded bolt or latch to pull the bolt or latch to the open or unlocked position against the bias of a spring, with closing movement of the latch being a result only of a compressed spring returning to a relaxed position, in fact teaches away from using a loop to close the latch. As to the specific question of "teaching away," our reviewing court in In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) stated:

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

Simply that there are differences between two references is insufficient to establish that such references "teach away" from any combination thereof. See In re Beattie, 974 F.2d 1309, 1312-13, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). As we pointed out in our earlier decision, we do not consider the differences between the primary references Recchione and Finch and the secondary references Lacey, Dollman and Coultaus, namely, that the primary references are directed to springless latch mechanisms which are manually moved in both directions while the secondary references are directed to spring-loaded latch mechanisms which are manually pulled to the open or unlocked position against the bias of the spring and are moved to the locked position by a return of the spring to its relaxed state, to be of such a nature as to discourage a person of ordinary skill in the art from using a loop in a springless latch to provide a convenient vehicle for applying a pulling force to the latch, as appellant has done.

As for appellant's second argument (request, pages 9-10), that this panel has substituted its hindsight opinion as to the obviousness of the invention, while "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so" (ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)), the motivation to modify the prior art "need not be expressly stated in one or all of the references used to show obviousness" (Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985); In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969)).

Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. Cable Electric, 770 F.2d at 1025, 226 USPQ at 886-87. Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Having reviewed the entirety of the applied references, it is inconceivable to us that a person of ordinary skill in the art would have failed to appreciate the role of the ring or loop of Lacey, Dollman and Coultaus of providing a convenient vehicle for applying a pulling force to the latch (see, for example, column 3, lines 42-45, of Dollman). Further, to conclude that such a person would not have recognized that the benefits of providing such a ring or loop as a convenient vehicle for applying a pulling force apply equally to a springless latch wherein the latch is manually pulled in either direction would be to improperly assume that the artisan possesses less than ordinary skill. Sovish, 769 F.2d at 743, 226 USPQ at 774.

For the foregoing reasons, the arguments in appellant's request for rehearing fail to persuade us that we committed any error in affirming the examiner's decision. Thus,

appellant's request for rehearing is granted to the extent of our reconsidering our earlier decision but denied with respect to our making any modifications thereto.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REHEARING - DENIED

JOHN P. MCQUADE)	
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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GARY L. BUSH
ANDREWS & KURTH
600 TRAVIS
SUITE 4200
HOUSTON, TX 77002