

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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHARON B. SKINKISS

Appeal No. 2000-0226
Application No. 08/694,200

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, McQUADE
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 to 4 and 6 to 8, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a method of, and apparatus for sealing fireplaces to prevent the loss of conditioned air from the living quarters through such fireplaces (specification, p. 1). A copy of claims 1 to 4, 6 and 8 under appeal is set forth in the appendix to the appellant's brief (Paper No. 11, filed July 21, 1998). A copy of claim 7 under appeal is set forth on page 3 of the examiner's answer (Paper No. 12, mailed May 25, 1999).

The prior art of record relied upon by the examiner in rejecting the appealed claims is:

Knudson 1931	1,830,364	Nov. 3,
Reiner 1974	3,789,825	Feb. 5,
Le Brun 1975	3,888,232	June 10,
Gallagher 7, 1978	4,072,140	Feb.
Fox et al. (Fox) 1979	4,160,442	July 10,

The examiner also relied upon the appellant's admission of prior art (shown in Figure 1 and described in the specification at page 4, lines 6-10) relating to a conventional fireplace (Admitted Prior Art).

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Claims 1 to 4 and 6 to 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Gallagher, Le Brun, Knudson, Fox and Reiner.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer for the examiner's complete reasoning in support of the rejection, and to the brief 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, and to the respective positions articulated by the appellant and the examiner. Upon

¹ In the second paragraph of page 5 of the answer, the examiner for the first time refers to a well known custom. This well known custom will be given no consideration since it was not included in the statement of the rejection. See Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993). Additionally, it would be inappropriate to consider this new piece of evidence since that would constitute a new ground of rejection and 37 CFR § 1.193(a)(2) provides that an examiner's answer must not include a new ground of rejection.

evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 4 and 6 to 8 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The two independent claims on appeal read as follows:

1. A method of sealing the fire box of a fireplace wherein a natural draft of air flows into said fire box through a frontal opening and exits through an exhaust

flue, and wherein said frontal opening includes structural means, extending across said frontal opening, that closes-off said frontal opening when said fireplace is in use, comprising the steps of

a) providing a frameless, thin, sheet of air impermeable, pliable material,

b) placing said sheet of material over said structural means when said fireplace is not in use thereby permitting the natural draft of air through said fire box to draw said sheet of material against said structural means thereby blocking the flow of air there through.

3. In a domestic fireplace having a fire box, exhaust means for the removal of smoke and combustion gases from said fire box and at least one frontal opening for the introduction of combustible material into said fire box and means for closing-off said frontal opening when said fire box is in use whereby a natural draft of air may flow into said fire box through said means for closing-off said frontal opening and exiting said fire box through said exhaust means, the improvement comprising sealing means for blocking the flow of draft air through said means for closing-off said frontal opening when said fireplace is not in use, said sealing means comprising a frameless thin sheet of air impermeable, pliable material positioned across said means for closing-off said frontal opening whereby said natural draft of air draws said sheet of material against said means for closing-off said frontal opening.

In the rejection before us in this appeal, the examiner first sets forth the teachings of the Admitted Prior Art (answer, p. 4). Next, the examiner briefly sets forth the teachings of the patents to Gallagher, Le Brun, Knudson, Fox

and Reiner (answer, p. 5). Thereafter, the examiner determined (answer, p. 5) that

[t]o cover the conventional fireplace closure framework shown in applicant's Fig. 1 with a piece of air impermeable thin, pliable material such as conventional polyethylene to further seal the fireplace opening and hold the pliable material in place by a conventional securing means such as tape, adhesive or clips would have been obvious to one of ordinary skill in the art especially when viewed with the above prior art [i.e., Gallagher, Le Brun, Knudson, Fox and Reiner].

The appellant argues (brief, pp. 8-12) that the applied prior art does not disclose, teach or suggest the use of a frameless sheet of thin pliable material positioned across the means for closing-off the frontal opening of the fireplace (i.e., the door assembly 11) whereby the natural draft of air draws the sheet of material against the means for closing-off the frontal opening. We agree.

Obviousness is tested by what the combined teachings of the applied prior art would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be

established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the applied prior art contains none. None of the applied prior art suggests providing a frameless sheet of thin pliable material positioned across the means for closing-off the frontal opening of the fireplace. Instead, the patent to Le Brun teaches (column 4, lines 45-49; Figure 2) placing the fireplace shutoff behind the conventional removable screen, not in front of the conventional removable screen (i.e., the means for closing-off the frontal opening of the fireplace).

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest

that knowledge, is to fall victim to 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, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Since all the limitations of claims 1 and 3 are not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claims 1 and 3, and of dependent claims 2, 4 and 6 to 8.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 4 and 6 to 8 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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