

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAXWELL GATES

Appeal No. 2000-0863
Application No. 08/760,303

ON BRIEF

Before COHEN, NASE, and JENNIFER D. BAHR, 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 22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a clothes hanger pad and a method of making clothes hanger pads. A substantially correct copy of the claims under appeal is set forth in the appendix to the appellant's brief.¹

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

Mino	JP 5-293029 ²	Nov. 9,
1993		
Osaki et al. (Osaki)	JP 6-205724 ³	July 26, 1994

In addition, the examiner also relied upon Official Notice that foams are well known to be covered with "dimensionally stable" materials to protect the foam from damage on the exposed surfaces (Official Notice).

¹ In claim 22, line 4; "an other" should be --another-- and in line 5, "outer" should be --one--.

² In determining the teachings of Mino, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellant's convenience.

³ In determining the teachings of Osaki, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellant's convenience.

Claims 1 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Osaki in view of Mino and Official Notice.⁴

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 12, mailed October 14, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 11, filed July 7, 1998) and reply brief (Paper No. 13, filed December 31, 1998) 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

⁴ Procedurally, when a reference is relied on to support a rejection even in a "minor capacity," ordinarily that reference should be positively included in the statement of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). The examiner relies on Official Notice in the body of the rejection, and accordingly, Official Notice should have been positively included in the statement of rejection.

respective positions articulated by the appellant and the examiner. Upon 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 22 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). Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." 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.

We are constrained to reverse the decision of the examiner to reject claims 1 to 22 under 35 U.S.C. § 103 since there is no **evidence** in the applied prior art that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have laminated a layer of a dimensionally stable material to the foam hanger pad of Osaki. While foams are well known to be covered with dimensionally stable materials to protect the foam from damage on the exposed surfaces, we fail to find any suggestion therein for an artisan to have modified the foam hanger pad of Osaki for the reasons set forth in the brief (pp. 7-9) and the reply brief (pp. 2-4). In fact, the advantages of utilizing a

foam hanger pad having a layer of a dimensionally stable material laminated thereto (see pages 1-2 of the specification) are not appreciated by the prior art applied by the examiner.⁵

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). It is essential that "the decisionmaker forget what he or she has been taught

⁵ The examples provided on pages 9-10 of the answer supporting the examiner's taking of Official Notice have not been considered by this panel of the Board since they were not included in the rejection. See In re Hoch, supra. Moreover, it appears to us that the appellant is correct as characterizing these examples as non-analogous art (reply brief, p. 2).

. . . about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 22 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 22 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
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)	
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