

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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MUHAMMAD Z. MIRZA

Appeal No. 2000-0951
Application No. 08/640,160

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, 4 to 6, 11, 14 to 16, 18 to 21, 25 and 28 to 33, which are all of the claims pending in this application.¹

¹ Claims 4, 16 and 18 were amended subsequent to the final rejection.

We REVERSE.

BACKGROUND

The appellant's invention relates to a transportable sign or message holder for supporting and displaying replaceable signs or messages. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Griggs 1966	3,237,327	March 1,
Romaine 1990	4,953,315	Sept. 4,
Blanchard 15, 1991	5,056,248	Oct.

Claims 1, 4, 14 to 16, 18, 21 and 28 to 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griggs in view of Romaine.

Claims 5, 6, 11, 19, 20 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griggs in view of Romaine and Blanchard.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 23, mailed January 18, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 22, filed November 1, 1999) and reply brief (Paper No. 24, filed April 3, 2000) 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. 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, 4 to 6, 11, 14 to 16, 18 to 21, 25 and 28 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).

Griggs discloses an automobile certificate holder. As shown in Figures 1-5, the holder includes a single transparent sheet 12 folded to create a bottom edge 14 and a foldable flap element 22; edges 28 and 30 of sheet 12 are compressed together under heat conditions and sealed at points 32 to form an inner compartment for an automobile certificate; and a plurality of flexible magnets 34, 36 and 38 secured to face 18

of the holder by staples 40 which penetrate from the inside of the compartment 33 towards the outside. Griggs teaches that the magnets are secured to the sheet 12 prior to formation of the sealing points 32 and that the magnets are used to secure the holder to metallic surfaces of a vehicle dashboard.

Romaine discloses a display device for automobiles and other vehicles which alternately displays two different messages in an interesting manner calculated to attract attention. The display device comprises an outer case 14 having a plurality of spaced windows 22 and, mounted within the case, a slide 16 having a plurality of spaced indicia spelling out the two messages. The windows and indicia are positioned in such a manner that upon relative movement of the slide and case, produced by inertial, centrifugal or gravitational forces generated by the vehicle movement, the slide alternates between two positions within the case, thereby alternately spelling out the two messages. In the illustrated form of Romaine's invention the mounting means employed for mounting the display device on the vehicle comprises, a plurality of suction cups 30. As shown in

Figures 4 and 5, the suction cups are mounted on threaded posts 32 which penetrate transversely the ends of the case and are of sufficient length to span the distance between the front and back faces of the case. Nuts 34 releasably secure the suction cups to the assembly. Romaine teaches that the posts 32 serve the dual functions of mounting the suction cups and also of providing stops which limit the reciprocating motion of slide 16 between the two positions in which the device spells out its respective messages.

In our view, while the combined teachings of Griggs and Romaine would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have replaced Griggs' magnets with suction cups, such a modification of Griggs does not arrive at the claimed invention. In that regard, such a modification of Griggs does arrive at either (1) "mounting means for detachably mounting the panels on a supporting structure, said mounting means including a pair of suction cup holders having rear ends and passing through and connecting side edge portions of said panels to hold the side portions of the front and rear panels

together and also limiting lateral movement of a sign or message received between the two panels, and a pair of suction cups attached to the rear ends of said suction cup holders" as recited in claim 1, or (2) "fastening means for detachably fastening the panels to a solid surface behind the rear panel, said fastening means including a pair of suction cup holders having rear ends and passing through and connecting side edge portions of said panels to hold the side portions of the front and rear panels together and also limiting lateral movement of a sign or message received between the two panels, and a pair of suction cups attached to the rear ends of said suction cup holders" as recited in claim 16. That is, the combined teachings of Griggs and Romaine would have suggested stapling suction cups to Griggs' face 18 so that the staples would penetrate from the inside of the compartment towards the outside so as to not interfere with the placing of the automobile certificate within the compartment of the holder.

In our view, the only suggestion for modifying Griggs to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. The

use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 and 16, and claims 4, 14, 15, 18, 21 and 28 to 33 dependent thereon.

We have also reviewed the Blanchard reference additionally applied in the rejection of dependent claims 5, 6, 11, 19, 20 and 25 but find nothing therein which makes up for the deficiencies of Griggs and Romaine discussed above regarding claims 1 and 16. Accordingly, we cannot sustain the examiner's rejection of appealed claims 5, 6, 11, 19, 20 and 25 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 4 to 6, 11, 14 to 16, 18 to 21, 25 and 28 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON D. 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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