

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM A. HENDERSON and RODNEY D. DAVIS

Appeal No. 2000-1616
Application 08/698,054

ON BRIEF

Before CALVERT, FRANKFORT, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 5, 6 and 10 through 12. Claims 4, 7 through 9 and 13 through 19, which are the only other claims remaining in the application, stand allowed. Claim 2 has been canceled.

Appellants' invention relates to a trolling motor

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mounting system for use on a boat, which mounting system allows the trolling motor to be displaced in any direction upon contact with an obstruction. Of further concern to appellants is the fact that the mounting system should include a single adjustment mechanism (e.g., 22, 23) to control both height and rotation of the motor. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim, as reproduced from the Appendix to appellants' brief, is attached to this decision.

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

Dewey	153,813	Aug. 4, 1874
Painter	424,572	Apr. 1, 1890
Klammer et al. (Klammer)	4,555,233	Nov. 26, 1985
Havins	4,982,924	Jan. 8, 1991
Maglica et al. (Maglica)	5,109,321	Apr. 28, 1992

Claims 1, 3, 5, 6 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Havins in view of Klammer

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and Dewey.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Havins in view of Klammer and Dewey as applied above, and further in view of Maglica.

Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Havins in view of Klammer, Dewey and Maglica as applied to claim 11 above, and further in view of Painter.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 22, mailed October 15, 1999) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 21, filed July 14, 1999) for the arguments thereagainst.

OPINION

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In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Before addressing the rejections on appeal, we observe that appellants have indicated on page 3 of their brief that "[n]o statement is made pursuant to 37 CFR 1.192(c)(7)." Accordingly, we have selected claim 1 as being representative of the issues on appeal and will decide the appeal on the basis of that claim alone.

Looking to the examiner's rejection of claims 1, 3, 5, 6 and 10 under 35 U.S.C. § 103 based on Havins, Klammer and Dewey, we agree with the examiner that Havins (e.g., in Fig. 8) discloses a mounting apparatus for mounting sonar transducers on a boat, which apparatus includes a frame (207) mountable to the boat, a column (143) supporting the submerged

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sonar transducer, and an adjustable swivel joint (151) supported by the frame and engaging the column (143), said swivel joint comprising a ball (201) rotatably mounted in a socket formed by two bracket plates (203) and an adjustment mechanism (219) for adjusting the compressive force exerted by the bracket plates on the ball to control the resistance of the ball to rotation relative to the plates. The swivel joint of Havins also includes a sleeve (199) secured to the ball for receiving the column (143) and an adjustment mechanism (209, 211, 213) on each end of the sleeve for permitting or restricting longitudinal movement of the column relative to the swivel joint so as to allow for adjustment of the depth of the transducer. As observed by the examiner, Havins lacks any teaching of a trolling motor.

The examiner relies on Klammer to show that it was well known at the time of appellants' invention to mount a trolling motor to a boat using a mounting apparatus of a type similar to that in Havins, i.e., wherein the column of the trolling motor is adjustably gripped by a portion (16) of the mounting

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apparatus. Like the examiner, we consider that it would have been obvious to one of ordinary skill in the art, based on the collective teachings of Havins and Klammer, to utilize a mounting apparatus like that of Havins for mounting a trolling motor to a boat in order to effect boat movement as taught by Klammer. Appellants have not directly taken issue with this aspect of the examiner's combination of the prior art references.

To the extent that appellants have urged (brief, page 8) that the mounting apparatus of Havins is incapable of supporting a "relatively heavy trolling motor," we agree with the examiner that trolling motors are manufactured in a variety of different sizes and weights, from a relatively lightweight small power unit to larger, heavier, higher powered units. Moreover, we point out that Havins expressly describes (col. 9, lines 55-56) the transducer (187) as typically being "heavy," and also describes an embodiment (Figs. 13-14) wherein the mounting apparatus (151) is used to support three such "heavy" transducer units carried on the

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column (143). Thus, this line of argument on appellants' part is unpersuasive.

The examiner has additionally observed that the mounting apparatus of Havins includes two mechanisms for individually adjusting the grip of the swivel joint on the column and the resistance of the swivel joint to rotation, while the apparatus of appellants' claim 1 requires "a singular adjustment mechanism" for achieving these operations. To account for this difference, the examiner has relied upon the teachings of Dewey, urging that Dewey discloses a similar swivel joint in which a column (B) is supported by a split ball and socket arrangement which includes a single adjustment mechanism (h) for controlling both column grip and column pivot resistance. On the basis of the collective teachings of these references, the examiner has concluded that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to further modify the support apparatus of Havins by substituting a split ball like that of Dewey for Havins' ball/collar element (201, 199, 213) seen in

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Figure 8 in order to simplify column adjustment as taught by Dewey and to provide a socket more fully matching the shape of the surface of the ball to increase surface area contact and thereby the gripping force as inherently taught in Dewey. We agree, noting that this would make the adjusting screw (219) of Havins the "singular adjusting mechanism" required by appellants' claim 1.

Appellants' argument (brief, page 6) that Dewey is nonanalogous art to the present invention has been adequately dealt with by the examiner on page 6 of the answer, and we incorporate that reasoning in our decision. As for appellants' assertion that Havins teaches away from the present invention, we see nothing in Havins that expressly teaches away from a broader area of contact on the ball so as to enhance the gripping force that the socket elements can apply to the ball. In that regard, we see nothing in Havins that in any way limits the contact area between the ball (201) and the plates (203) to line contact, as urged by appellant. Moreover, we agree with the examiner that the combined

teachings of Havins and Dewey clearly would have been suggestive to one of ordinary skill in the art of a greater area of contact between the ball and the support plates given the showing in Figure 1 of Dewey regarding the areas of contact between the ball and socket elements therein. In this regard, we also observe that while Dewey discloses use of the holding device therein with an umbrella-stick (B), it expressly notes (col. 2, lines 16-20) that the holding device is "equally applicable to the retention of . . . other objects which it is desired to adjust longitudinally or to an angle."

Appellants' assertions on pages 10 and 11 of the brief that the examiner has not shown that Dewey has the capability to adjust the grip on element (B) is also unpersuasive. This argument from appellants is belied by the teachings of Dewey at column 1, lines 12-18, that the semi-spherical blocks (A, A') of the holding device therein are "arranged to embrace the umbrella-stick B, and to be tightly clamped to the same by the pressure of [the] two recessed plates D, D', between which the said blocks are retained, and on which they can, together with

the stick, be adjusted to any angle." This adjustment aspect of the holding device in Dewey is also evident from the disclosure at column 1, line 31, *et seq.*, wherein it is noted that the semi-spherical clamping blocks (A, A') of the holding device are pressed toward each other and against the umbrella-stick (B), when the plates (D, D') are drawn together by the set-screw (h) so as to permit angular adjustment of the umbrella-stick to any desired angle relative to the plates, within certain limits, and after such adjustment to allow the parts to again be tightly clamped together by simply turning the set-screw.

Based on the foregoing, we will sustain the examiner's rejection of appellants' claim 1 on appeal under 35 U.S.C.

§ 103(a) based on the combined teachings of Havins, Klammer and Dewey. Finding no arguments from appellants regarding the separate patentability of claims 3, 5, 6 and 10 through 12, we consider these claims to fall with claim 1, from which they either directly or indirectly depend. Accordingly, the examiner's rejections of these additional claims under 35

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U.S.C. § 103(a) are likewise sustained.

In further response to appellants' arguments, we observe that where the issue is one of obviousness under 35 U.S.C. § 103, the proper inquiry should not be limited to the specific structure shown by a reference, but should be into the concepts fairly contained therein, with the overriding question to be determined being whether those concepts would have suggested to one skilled in the art the modification called for by the claims. See In re Bascom, 230 F.2d 612, 614, 109 USPQ 98, 100 (CCPA 1956). Furthermore, under 35 U.S.C. § 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests (In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976)), as well as the reasonable inferences which the artisan would logically draw from the reference. See In re Shepard, 319 F.2d 194, 197, 138 USPQ 148, 150 (CCPA 1963). As stated by the Court in In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

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The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

In addition, while there clearly must be some teaching or suggestion to combine existing elements in the prior art to arrive at the claimed invention, we note that it is not necessary that such teaching or suggestion be found only within the four corners of the applied references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). This is because we presume skill on the part of the artisan, rather than the converse. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

In light of the foregoing, the decision of the examiner rejecting claims 1, 3, 5, 6 and 10 through 12 on appeal under

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35 U.S.C. § 103(a) is affirmed.

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

AFFIRMED

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Administrative Patent Judge)	
)	
)	BOARD OF PATENT
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APPENDIX

1. In combination, an apparatus to support a trolling motor column from a boat including the column and motor, comprising:

a frame mountable to the boat;

an adjustable swivel joint supported by said frame and

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engaging said column, said swivel joint comprising a singular adjustment mechanism which controls the grip of said swivel joint on said column and the resistance of said swivel joint to rotation with respect to said frame, which occurs when said column is deflected; and

said swivel joint further comprises a ball rotatably mounted to a socket supported by said frame, said socket comprising a concave spherical surface which matches the shape of the surface area of said ball.