

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. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER D. LEWIS

Appeal No. 2000-1993
Application No. 09/157,130

ON BRIEF

Before ABRAMS, NASE, and GONZALES, 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, 9 and 12 to 14, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a reflective marker (claims 1 and 4 to 6) and a reflective marker kit (claims 9 and 12 to 14). 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:

Brudy	3,834,789	Sept. 10,
1974		

Bright Eyes All "Way" Shine Tacks (Bright Eyes)

Claims 1, 4 to 6, 9 and 12 to 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bright Eyes in view of Brudy.

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. 8, mailed April 25, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 7,

Appeal No. 2000-1993
Application No. 09/157,130

Page 3

filed September 14, 1999) 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, 9 and 12 to 14 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 when the combined teachings of the applied prior art would have led one of ordinary skill in the art to combine the relevant teachings of the applied prior art to arrive at the claimed invention. See In re Young, 927 F.2d

588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). 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, it is our opinion that the applied prior art does not contain motivation for a person having ordinary skill in the art at the time the invention was made to have modified the reflective central portion of the reflective marker of Bright Eyes to include a plurality of flat reflective side wall surfaces. In fact, the advantages of utilizing a plurality of flat reflective side wall surfaces in a reflective marker having a non-reflective flat top and bottom cap portions parallel to each other and overhanging the reflective flat side wall surfaces of the central portion are not appreciated by the prior art applied

by the examiner. In that regard, while Brudy does teach a reflecting device having a plurality of flat reflective side wall surfaces and a non-reflective flat top and bottom cap portions parallel to each other which do not overhang the reflective flat side wall surfaces of the central portion, we fail to find sufficient motivation therein for an artisan to have modified Bright Eyes in the manner set forth by the examiner in the rejection under appeal (answer, pp. 3-4) for the reasons set forth by the appellant in the brief (pp. 5-8).

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

. . . 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. Since the subject matter of the claims under appeal is not taught or suggested by the applied prior art for the reasons set forth above, we will not sustain the 35 U.S.C. § 103 rejection of claims 1, 4 to 6, 9 and 12 to 14.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 4 to 6, 9 and 12 to 14 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

Appeal No. 2000-1993
Application No. 09/157,130

Page 9

HARRY C. FNGSTROM
FOLEY & LARDNER
150 EAST GILMAN STREET
P O BOX 1497
MADISON, WI 53701-1497

Appeal No. 2000-1993
Application No. 09/157,130

Page 10

JVN/jg