

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 MORTIMER HUBER and SALVADOR MENDEZ

Appeal No. 2001-0193
Application No. 09/182,138

ON BRIEF

Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-7, which are all of the claims pending in this application.

We REVERSE AND REMAND TO THE EXAMINER.

BACKGROUND

The appellants' invention relates to a convertible sign mechanism. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

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

Pessina et al. (Pessina)	4,075,896	Feb. 28, 1978
Ahlgren	4,189,859	Feb. 26, 1980

Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ahlgren in view of Pessina.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 12) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 10) for the appellants' arguments thereagainst.

OPINION

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

The appellants' invention is directed to a sign mechanism of the type in which multiple prisms are rotated together to show three different displays. As explained in the specification, the appellants have provided a system for rotating the sign members through successive turns in which the speed of motion is varied so that it gradually increases from the fully stopped condition to reach a maximum velocity during the changing of the display surfaces, and then gradually decreases as it approaches the position corresponding to the new display. This avoids the shock of abrupt starts and stops and minimizes wear on components (specification, page 4). It is the examiner's view that all of the subject matter recited in this claim is taught by Ahlgren, except that Ahlgren utilizes belt and gear drive whereas the claim requires a cam and follower drive. However, it is the examiner's position that the claimed drive system is disclosed by Pessina, and it would have been obvious to one of ordinary skill in the art to modify the Ahlgren mechanism by replacing the chain system with the system of Pessina.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973

(Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellants' disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Ahlgren moves the rotating sign members by means of an electric motor driving a gear, which can be of various designs, for example, intermittent or slow motion (column 2, line 27 et seq.).

Pessina is concerned with a drive mechanism for operating a rotating drum of an automatic sheet feeder in such a fashion that grippers mounted on the drum can effectively grasp a single sheet. Pessina accomplishes this by providing a drive mechanism that causes the drum to rotate at a minimum speed during the sheet-gripping phase and then accelerate to the maximum speed until the machine again reaches the next sheet-gripping phase, "without any abrupt accelerations or decelerations" (column 2, lines 47 and 48). The drive means can be in the form of a cam and follower drive system, as shown in the drawings, or "[t]he same effect could be also obtained by means of elliptic gears" (column 2, lines 23-30). The cam and follower system appears to operate in the same manner as that which is recited in the appellants' claim 1.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even assuming, arguendo, that Pessina is analogous art, we fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to modify the Ahlgren system in the manner proposed by the examiner. Ahlgren explicitly teaches that different motions, such as intermittent and slow, can be imparted to rotating sign panels by the use of suitable gears, and provides no basis from which to conclude there is a problem in the rotating sign art caused by abrupt accelerations or decelerations in rotating the sign panels. From our perspective, the fact that problems caused by abrupt acceleration and deceleration may exist in the single sheet feeding art would not, in and of itself, provide motivation for one of ordinary skill in the rotating sign art to utilize the drives disclosed by Pessina to overcome sheet feeding problems in sign rotating mechanisms. Moreover, Pessina discloses two means for overcoming this problems in sheet feeders, one being a gear drive and the other a cam and follower drive, and the examiner has provided no reason why one of ordinary skill in the rotating sign art would have selected the cam and follower drive over the gear drive, especially since gear drives are used by Ahlgren. It is our view that the only suggestion for modifying the Ahlgren sign drive in the manner proposed by the examiner is found in the hindsight afforded one

who first viewed the appellants' disclosure. This, of course, is not a proper basis for a Section 103 rejection. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

We therefore conclude that the teachings of Ahlgren and Pessina fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we will not sustain the rejection of claim 1 or of claims 2-4, which depend therefore. The same reasoning applies to independent claim 5, which contains the same limitations regarding the cam and follower drive, and the rejection of claims 5-7 also is not sustained.

REMAND TO THE EXAMINER

On page 2 of the specification the appellants point out that problems present in the prior art with gear transmissions were solved in commonly assigned Huber U.S. Patent No. 5,343,645, which issued on September 6, 1994. The appellants go on to describe the Huber invention as moving the sign in 120 degree increments "while varying the speed of rotation from a maximum velocity occurring during the changing of display surfaces to a minimum velocity occurring as the position corresponding to the new display surface . . . is approached." This would appear to indicate that the problem to which the appellants have directed their inventive efforts had been recognized and solved by Huber, and the appellants' invention constitutes an improvement to the solution offered in the Huber patent. In fact, the appellants' final statement in the background of the invention section of

the specification is “[w]hat is needed is an alternate drive mechanism for driving display sign arrangements and other devices that require frequent starts and stops.”

This application is remanded to the examiner for consideration of the teachings of Huber in view of those of Pessina with regard to the obviousness of the claimed subject matter. In this regard, we point out that the Huber invention “addresses the problem of rotating a sign face member while avoiding the shock of braking, starting and stopping again while minimizing wear on the mechanism itself” (column 3, lines 31-34), and discloses a sign rotation mechanism that is described as an improvement over gear transmission drives and which varies the speed of rotation in the same manner as the appellants’ invention (see columns 1 and 3).

SUMMARY

The rejection is not sustained.

The decision of the examiner is reversed.

The application is remanded to the examiner for action in accordance with the above directions.

This application, by virtue its "special" status, requires an immediate action, M.P.E.P. § 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED AND REMANDED TO THE EXAMINER

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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