

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 37

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte MALCOLM G. BOCK

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Appeal No. 2001-1514  
Application No. 08/874,805

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ON BRIEF

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Before FRANKFORT, NASE, and 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 6, 8, 10, 11 and 13. Claim 12 has been objected to as depending from a non-allowed claim. Claims 9, 14 to 16 and 18 to 21 have been withdrawn from consideration. Claims 7 and 17 have been canceled.

We REVERSE.

BACKGROUND

The appellant's invention relates to intermittent pneumatic compression devices and more particularly to the interconnection between compression sleeves and controllers for a source of compressed air (specification, p. 1). 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:

|                        |           |                |
|------------------------|-----------|----------------|
| Arkans et al. (Arkans) | 4,253,449 | March 3, 1981  |
| Mogaki et al. (Mogaki) | 4,583,255 | April 22, 1986 |
| Wright et al. (Wright) | 4,922,893 | May 8, 1990    |
| Sikora                 | 5,121,746 | June 16, 1992  |

Claims 1 to 6, 10 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Arkans in view of Mogaki.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Arkans, Mogaki and Wright.

Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Arkans, Mogaki and Sikora.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the non-final Office action mailed October 14, 1999 (Paper No. 24) and the answer (Paper No. 29, mailed January 6, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 28, filed October 16, 2000) and reply brief (Paper No. 30, filed May 7, 2001) 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 to 6, 8, 10, 11 and 13 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).

In the rejection of claim 1 (see Paper No. 24, pp. 2-3), the sole independent claim on appeal, the examiner (1) set forth the teachings of Arkans and Mogaki; (2) ascertained that Arkans' separate manifold 96 and connector member 124 is not a unitary piece; and (3) determined that it would have been obvious to have incorporated a unitary design in Arkans for many reasons including the teachings of Mogaki.

The appellant argues that the applied prior art of Arkans and Mogaki does not suggest the subject matter of claim 1. We agree for the reasons that follow.

First, the limitation of claim 1 that the controller connection device comprises "a manifold and a connector member integrally formed with said manifold as a unitary piece" is not suggested by the applied prior art. As clearly recognized by the examiner, Arkans does not meet or suggest this limitation. Moreover, Mogaki does not meet or suggest this limitation. In that regard, as clearly shown in Figures 7, 9A and 9B of

Mogaki, the socket 47 and the distributor 26<sup>1</sup> are not integrally formed as a unitary piece (i.e., one-piece). While Mogaki teaches (column 4, lines 51-56) that the socket 47 is united with the stationary valve member 42, and the through-holes 46 separately communicate with openings 48 in socket 47, Mogaki does not teach or suggest that the socket 47 and the stationary valve member 42 be integrally formed as a unitary piece. Thus, Mogaki would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have integrally formed Arkans' manifold 96 and connector member 124 as a unitary piece. Accordingly, in the rejection of claim 1 before us in this appeal, the examiner has not set forth evidence of a suggestion, teaching, or motivation for a person of ordinary skill in the art at the time the invention was made to have modified Arkans to arrive at the claimed invention. In that regard, we note that a broad conclusory statement (such as set forth on page 6 of the answer) regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

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<sup>1</sup> Distributor 26 includes a d.c. motor 38, a rotary valve member 41 and a stationary valve member 42 brought into plane contact with the upper surface of the rotary valve member 41. The stationary valve member 42 is provided in the vicinity of the outer periphery with eight vertical through-holes 46 at regular intervals, which communicate alternately with an air-guiding groove 45 provided in rotary valve member 41.

Second, the limitations of claim 1 that a first set of uninterrupted conduits comprising continuous lengths of tubing unbroken from a first end to a second end and being integrally connected at the first end to the first compression sleeve and being fixedly joined at the second end to the manifold of the controller connection device and a second set of uninterrupted conduits comprising continuous lengths of tubing unbroken from a first end to a second end and being integrally connected at the first end to the second compression sleeve and being fixedly joined at the second end to the manifold of the controller connection device (i.e., the uninterrupted conduit limitations) are not met by conduit sets 90 and 92 of Arkans as alleged by the examiner (Paper No, 24, p. 2). As pointed out by the appellant (brief, pp. 5-7) Arkans teaches (column 7, line 57+) that the first and second conduit sets 90 and 92, respectively, also have connection devices of identical design intermediate their lengths. The connection device 150 for the first conduit set 90 is shown in Figures 13, 19 and 20. Thus, the first and second conduit sets 90 and 92 of Arkans are not continuous lengths of tubing unbroken from a first end integrally connected to a compression sleeve to a second end fixedly joined to the manifold of the controller connection device. Moreover, in the rejection of claim 1 before us in this appeal, the examiner has not set forth evidence of a suggestion, teaching, or motivation for a person of ordinary skill in the art at the time the invention was made to have modified the first and second conduit sets 90 and 92 Arkans to be continuous lengths of tubing unbroken from a first end integrally

connected to a compression sleeve to a second end fixedly joined to the manifold of the controller connection device.

For the reasons set forth above, the examiner has not presented a prima facie case of obviousness with respect to claim 1. Accordingly, the decision of the examiner to reject claims 1 to 6, 8, 10, 11 and 13 under 35 U.S.C. § 103 is reversed.<sup>2</sup>

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<sup>2</sup> We have also reviewed the references to Wright and Sikora additionally applied in the rejections of claims 8 and 11 but find nothing therein which makes up for the deficiencies of Arkans and Mogaki discussed above.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6, 8, 10, 11 and 13 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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DAVID J. KORIS  
THE KENDALL COMPANY  
15 HAMPSHIRE STREET  
MANSFIELD, MA 02048

JVN/jg