

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte MARCEL-CLAUDE BRAUD

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Appeal No. 2003-0690  
Application No. 09/247,557

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ON BRIEF

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Before COHEN, 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 5 to 7, 9 to 16, 18 and 20 to 22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an automotive vehicle with a telescopic load carrying arm (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:

Hayward	4,280,783	July 28, 1981
van der Lely	4,585,084	April 29, 1986
van der Lely	4,618,016	Oct. 21, 1986
Brown	5,618,156	April 8, 1997
Braud	5,687,809	Nov. 18, 1997

Claims 5 to 7, 9 to 16, 18 and 20 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown in view of Braud, Hayward and van der Lely '016.

Claims 5 to 7, 9 to 16, 18 and 20 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown in view of Braud, Hayward, van der Lely '016 and van der Lely '084.

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. 24, mailed November 4, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 23, filed August 2, 2002) 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 case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 5 to 7, 9 to 16, 18 and 20 to 22 under 35 U.S.C. § 103. Our reasoning for this determination follows.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to

fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In this case, while the applied prior art (i.e., Brown, Braud, Hayward, van der Lely '016 and van der Lely '084) may individually disclose every element of the claimed invention, it is our opinion that the claimed subject matter as a whole would not have been obvious at the time the invention was made to a person of ordinary skill in the art from the teachings of the applied prior art. That is, the claimed vehicle having a

transversely oriented internal combustion motor between a front wheel and a rear wheel, a reservoir of onboard fluid between another front wheel and a rear wheel, and a gearbox oriented longitudinally and disposed substantially in a central position of the vehicle below the support of the telescopic load carrying arm is not suggested by the applied prior art. In particular, we find ourselves in agreement with the appellant's argument (brief, pp. 4-9) that there is insufficient reason, suggestion, teaching, or motivation in Braud for an artisan to have modified Brown in the manner set forth in the rejections (answer, pp. 3-5) under appeal.

For the reasons set forth above, the decision of the examiner to reject claims 5 to 7, 9 to 16, 18 and 20 to 22 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 5 to 7, 9 to 16, 18 and 20 to 22 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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