

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 BEHRENS DIETMAR,
and HILMAR SCHROETER

Appeal No. 1997-2975
Application 08/518,856

ON BRIEF

Before COHEN, FRANKFORT, and GONZALES, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 2 through 16 and 20, all of the claims remaining in the application, as amended subsequent to the final rejection.

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Appellants' invention addresses an adhesive tape dispenser. An understanding of the invention can be derived from a reading of exemplary claim 20, a copy of which is appended to the brief (Paper No. 23).

As evidence of obviousness, the examiner has applied the documents listed below:

Donkin	2,640,656	Jun. 2, 1953
Hawthorne et al (Hawthorne)	2,790,609	Apr. 30, 1957
Yetter et al (Yetter)	3,301,518	Jan. 31, 1967
Puente ¹	3,322,262	May 30, 1967
Cooper	3,972,459	Aug. 3, 1976
Rudick	4,676,370	Jun. 30, 1987
Walker et al (Walker)	4,928,864	May 29, 1990
Ridenour	5,065,925	Nov. 19, 1991
Halstrick et al (Swiss '714) (Switzerland) ²	364,714	Sep. 30, 1962

¹ We have listed this reference since it was applied by the examiner in rejecting claim 10, but was, in error, omitted from the examiner's listing of applied references in the answer (page 3).

² Our understanding of this foreign language document is derived from a reading of a translation thereof prepared in the United States Patent and Trademark Office. A copy of the translation is appended to this opinion.

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The following rejections are before us for review.

Claims 20, 2, 9, and 11 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hawthorne in view of either Ridenour or Rudick, in view of Donkin, Walker, and Cooper, and further in view of Swiss '714 and Yetter.³

Claims 3 through 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hawthorne in view of Rudick, in view of Donkin, Walker, and Cooper, and further in view of Swiss '714 and Yetter.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hawthorne in view of Ridenour, in view of Donkin, Walker, and Cooper, and further in view of Swiss '714 and Yetter.

³ We have included the Cooper document in this statement of the rejection since Cooper was discussed by the examiner in the body of the rejection (answer, pages 5 through 7) but was obviously inadvertently omitted from the statement thereof.

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Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hawthorne in view of either Ridenour or Rudick, in view of Donkin, Walker, and Cooper, in view of Swiss '714 and Yetter, and further in view of Puente.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 24), while the complete statement of appellants' argument can be found in the brief (Paper No. 23).

OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the prior art teachings relied upon,⁴ and the respective viewpoints of

⁴ In our evaluation of the applied documents, we have considered all of the disclosure of each reference for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have

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appellants and the examiner. As a consequence of our review, we make the determinations which follow.

This panel of the board reverses the examiner's respective rejections of appellants' claims under 35 U.S.C. § 103.

It is quite apparent to us that the examiner's rejection of, for example independent claim 20, exemplifies a classic case of impermissible hindsight reconstruction, wherein many references are able to be particularly combined (answer, pages 4 through 13) only because of the knowledge of an appellants' own disclosure.

We fully comprehend the respective teachings of each of the applied references, and certainly recognize that the number of references applied in a rejection is not a determinative factor in an obviousness assessment.

been expected to draw from the disclosure. See In re Preda 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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Nevertheless, in the present case, it is abundantly clear to us that one having knowledge of the plurality of teachings of the applied references would not have been able to bring them together in the intricate fashion articulated by the examiner, without the benefit of appellants' application.

We also bring to the examiner's attention that a proposed modification of the Hawthorne dispenser would clearly not have been undertaken by one having ordinary skill in the art since it would have inappropriately destroyed the patentee's express intention that the adhesive tape "be fully enclosed for sanitary reasons" (column 1, lines 19 through 21). This consequential objective would certainly be defeated by the examiner's proposed modification in reworking the particular hollow annulus, surgical tape dispenser of Hawthorne to create an altogether different form of dispenser, i.e., one that is structurally configured with a generally triangular part such that the tape to be dispensed is exposed to ambient conditions, as exemplified by the Donkin disclosure.

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Since we have found that hindsight is clearly the primary underlying basis for bringing all of the prior art teachings together in the examiner's rejections, we are constrained to reverse each of the rejections under 35 U.S.C. § 103 before us.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN))
Administrative Patent Judge))
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)	BOARD OF PATENT
CHARLES E. FRANKFORT))
Administrative Patent Judge)	APPEALS AND
))
)	INTERFERENCES
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JOHN F. GONZALES))
Administrative Patent Judge))

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