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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. GRETZ and THOMAS S. STARK

Appeal No. 1998-0432
Application No. 08/681,070[1]

HEARD: October 7, 1999

Before COHEN, STAAB, 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 1 through 4, which are all of the claims pending in this application.

We REVERSE.

[1] Application for patent filed July 22, 1996.

BACKGROUND

The appellants' invention relates to a one-piece water tight connector for flexible non-metallic conduit. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

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

Burd	4,133,312	Jan. 9, 1979
Alexander	249,146 (Australia)	Jan. 12, 1961

Claims 1 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Burd in view of Alexander.

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. 13, mailed September 15, 1997) for the examiner's complete

reasoning in support of the rejection, and to the brief (Paper No. 12, filed July 31, 1997) 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. 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 through 4 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).

The rejection of claims 1 through 4 is based on the examiner's ascertainment (answer, p. 3) that "Burd discloses all of the recited structure with the exception of the threads being formed on the exterior end."

With regard to this difference, the examiner determined (answer, pp. 3-5) that it would have been obvious to one skilled in the art to have modified the exterior end of Burd to have threads instead of Burd's sleeve to allow for a hose having interior threads as suggested by the teachings of Alexander.[2]

The appellants argue that the prior art as applied does not arrive at the claimed invention. Specifically, the appellants argue (brief, p. 7) that Burd lacks "a generally

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[2] The specific teachings of Burd and Alexander relied upon by the examiner are set forth on pages 3-5 of the answer.

cylindrical inner body section with a smooth bore therethrough" since Burd has a large diameter bore 14, a bevel portion 18, and a smaller diameter portion 16. We agree.

The examiner responded to this argument (answer, p. 6) by stating that the bore in Burd's connector 10 "is considered smooth with respect to its texture which shows no bumps." The examiner then stated that "[t]he change in diameter is considered to still provide a smooth bore therethrough with respect to its texture."

In proceedings before the Patent and Trademark Office (PTO) the verbiage of the claims before it are given the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

In this instance, the language "a generally cylindrical inner body section with a smooth bore therethrough" appears in original claims 1 and 4. In addition, the specification states (page 6, lines 13-14) that the connector 10 "has a cylindrical smooth surfaced inner body section 12." Figures 3 and 4 of the drawings depict the bore through the inner body section 12 as having a substantially constant diameter from end 40 to end 42. Lastly, the American Heritage Dictionary, Second College Edition, (1982) defines "smooth" as "Having a surface free from irregularities, roughness, or projections; even."

In view of the above, we conclude that the broadest reasonable meaning of the phrase "a generally cylindrical inner body section with a smooth bore therethrough" as it would be understood by one of ordinary skill in the art is that bore of the inner body section is generally cylindrical and free from irregularities, roughness, or projections from one end thereof to the opposite end thereof.

In applying this meaning to the phrase "a generally cylindrical inner body section with a smooth bore therethrough," it is clear to us that Burd does not teach or suggest a generally cylindrical inner body section with a smooth bore therethrough. In that regard, we note that the bore through connector 10, as shown in Figure 2, is not generally cylindrical and free from irregularities, roughness, or projections from one end thereof to the opposite end thereof due to the presence of bevel portion 18, the taper of the inner surface of sleeve 62 (see column 4, lines 17-19), and the unnumbered vertical wall extending between bevel portion 18 and large diameter portion 14.

Moreover, we agree with the appellants arguments (brief, pp. 18-20) that the "integral threads" as recited in the claims under appeal are not suggested by the applied prior art. In that regard, while Alexander does teach grooves on the outer surface of portion 4 to assist in securing a tube 7, which is in the process of solidifying, to be secured to the portion 4, Alexander does not teach or suggest integral threads of such a shape and pitch to create the claimed

pulling action. In our view, the only suggestion for modifying Burd in the manner proposed by the examiner to meet the "integral threads" limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Since the prior art as combined by the examiner in the rejection before us in this appeal fails to arrive at the claimed invention for the reasons set forth above, the decision of the examiner to reject claims 1 through 4 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 4 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
LAWRENCE J. STAAB Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

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APPEAL NO. 1998-0432 - JUDGE NASE
APPLICATION NO. 08/681,070

APJ NASE

APJ STAAB

APJ COHEN

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 15 Oct 99

FINAL TYPED:

Heard: 7 Oct 99