

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KONRAD EIPPER,  
WOLFGANG FUSSNEGGER,  
and CHRISTOPH SCHLOTT

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Appeal No. 1998-0682  
Application 08/724,306<sup>1</sup>

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HEARD: DECEMBER 7, 1999

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Before FRANKFORT, STAAB and GONZALES, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4, 8 and 9, which are all of the claims remaining in this application. Claims 2, 3, 5 through 7 have been canceled.

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<sup>1</sup> Application for patent filed September 9, 1996. According to Appellants, this application is a continuation of Application 08/316,443, filed October 3, 1994.

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Appellants' invention relates to a method of producing metal sheets having a stepped cross-section and different wall thicknesses from a hollow tubular profile (claim 4), and to a method of using extruded profiles producible from a hollow profile (claim 1). Independent claims 1 and 4 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellants' brief.

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

Todd	2,798,604	July 9, 1957
Kennedy et al. (Kennedy)	3,540,117	Nov. 17, 1970
Otani et al. <sup>2</sup>	55-88942	July 5, 1980

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy in view of Hitachi Cable, while claims 4, 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy in view of Hitachi Cable and Todd.

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<sup>2</sup> A translation of this Japanese language document prepared by the U.S. Patent and Trademark Office is attached to this decision. In the examiner's answer the examiner has referred to this document by the name of the assignee "Hitachi Cable." In the interest of clarity, we will continue to refer to this document as Hitachi Cable.

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Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we make reference to the Office action mailed January 31, 1997 (Paper No. 13) and the examiner's answer (Paper No. 20, mailed November 4, 1997) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 17, filed September 10, 1997) for the arguments thereagainst.

#### OPINION

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

In rejecting claim 1 under 35 U.S.C. § 103(a) based on Kennedy and Hitachi Cable, the examiner points out that Kennedy teaches a rolling billet formed by disposing two profiled slabs with a thick portion of one slab facing a thin portion the other slab. It is also noted that the slabs of Kennedy are each formed by a casting operation. Hitachi Cable is then relied upon to show that profiled strips

for rolling operations can be produced by extrusion, which process is characterized by the examiner as being an efficient technique for forming strips having complicated sectional configurations. From the collective teachings of Kennedy and Hitachi Cable, the examiner concludes that it would have been obvious to one of ordinary skill in the art to produce the slabs for the rolling process in Kennedy by extrusion rather than casting by following the suggestion found in Hitachi Cable.

However, since Kennedy expressly deals only with tapered metal slabs, while the method of claim 1 on appeal specifically deals with metal profiles having a stepped portion defining different wall thicknesses and an opposing side of each profile that is a continuous flat face, the examiner has additionally taken the position that the particular profile provided in Kennedy as modified by Hitachi Cable is merely an obvious exercise of mechanical skill depending on the characteristics desired in the final product, i.e., stepped rather than tapered, and not a patentable distinction absent a disclosure of criticality in the solution of stated problems with the use of a specific profile.

Like appellants (brief, pages 8-10), we find the examiner's rejection of independent claim 1 on appeal to be improper. Simply stated, nothing in either Kennedy or Hitachi Cable teaches or suggests a method of using stepped extruded profiles (producible from a hollow profile) in the manner set forth in appellants' claim 1 on appeal, and the examiner's position that the stepped profile is merely an exercise

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of designer's choice, absent a showing of criticality on appellants' part, imposes an improper standard of patentability on appellants that is not provided for in 35 U.S.C. § 103(a). In our opinion, in searching for an incentive for modifying the process in Kennedy, the examiner has impermissibly drawn from appellants' own teachings and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is thus our view that the examiner's conclusion of obviousness is based on a hindsight reconstruction using appellants' own disclosure as a blueprint to arrive at the claimed subject matter. Since it is our determination that the teachings and suggestions found in Kennedy and Hitachi Cable would not have made the subject matter as a whole of claim 1 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103(a).

We have additionally reviewed the patent to Todd applied along with Kennedy and Hitachi Cable by the examiner against claims 4, 8 and 9 on appeal. However, we find nothing in the Todd patent which would change our view as expressed above, i.e., nothing which would supply that which we have indicated above to be lacking in the teachings of Kennedy and Hitachi Cable. Kennedy

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teaches a hot rolling process for forming tapered plates; Hitachi Cable teaches making metal sheets having a stepped profile by extrusion and then further working the stepped sheets by a rolling process using a profiled roller; Todd teaches forming multiple extruded sections from a single integral billet, which sections may be separated from the billet and transformed by a flattening operation to produce a part like that seen in Figure 15 of the patent. From our perspective, none of these references, nor any combination thereof, is even remotely suggestive of the process set forth in appellants' claim 4 on appeal. It is again our view that the examiner has impermissibly used appellants' own disclosure as a blueprint to piece together unrelated aspects of the processes described in the applied prior art references so as to arrive at the claimed subject matter. This the examiner may not do. Thus, the examiner's rejection of claims 4, 8 and 9 under 35 U.S.C. § 103(a) will not be sustained.

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In view of the foregoing, the examiner's decision rejecting claims 1, 4, 8 and 9 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT	)
Administrative Patent Judge	)
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	) BOARD OF PATENT
LAWRENCE J. STAAB	)
Administrative Patent Judge	) APPEALS AND
	)
	) INTERFERENCES
	)
JOHN F. GONZALES	)
Administrative Patent Judge	)

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