

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT C. PERRY

Appeal No. 1998-1962
Application No. 08/213,933¹

ON BRIEF

Before FRANKFORT, 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 1 through 10 and 12 through 22. Claims 23 through 25 have been objected to as depending from a nonallowed claim. Claim 11 has been canceled.

¹ Application for patent filed March 16, 1994.

Appeal No. 1998-1962
Application No. 08/213,933

We REVERSE.

BACKGROUND

The appellant's invention relates to a security anchor. An understanding of the invention can be derived from a reading of exemplary claims 1, 7 and 13, which appear in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Perry	4,979,382	Dec. 25,
1990		

Claims 1 through 10 and 12 through 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Perry.²

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

² We note that the examiner set forth two rejections on pages 3-4 of the examiner's answer (Paper No. 15, mailed September 19, 1997). However, in the examiner's response to argument section of the answer (pp. 4-5) the examiner states that the first rejection "is moot" and that Perry is "being used singularly." Accordingly, we will treat the rejection of the claims under appeal as being based on 35 U.S.C. § 103 as being unpatentable over Perry alone.

rejection, we make reference to the examiner's answer for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 12, filed August 29, 1996) and reply brief (Paper No. 16, filed October 14, 1997) 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 reference³, 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 through 10

³ In the answer (p. 6), the examiner refers to prior art references to Geesaman and Challis '904. We have not considered these references since prior art evidence that is relied upon must be positively set forth in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342, 166 USPQ 406, 407 (CCPA 1970).

and 12 through 22 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 the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual 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). Rejections based on

§ 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Perry discloses a security apparatus to attach components of a personal computer together to deter their unauthorized removal. As shown in Figures 1-4, the security apparatus includes a central anchor 2 and several (up to five in the case of the illustrated embodiment) peripheral anchors 4.

Perry's central anchor 2 comprises first and second plates 8 and 10. Plate 8 is formed with five cylindrical holes 12, and plate 10 is formed with five cylindrical holes 20. Hexagonal-headed bolts 22 are fitted in holes 12, the heads of the bolts being received in the recesses 14 and being held

therein against rotation relative to plate 8. Plates 8 and 10 can be secured firmly together by fitting plate 10 so that bolts 22 extend through holes 20 and applying nuts to the bolts, the nuts being received in recesses 18. At their confronting surfaces, plates 8 and 10 are each formed with five grooves 40. Each groove is substantially horseshoe-shaped when viewed in plan, and is semi-circular in cross-section. The grooves in plate 10 register with the grooves in plate 8 when the two plates are secured together, so that passages 42 of circular cross-section are thereby formed.

Perry's peripheral anchor 4 comprises a flexible steel cable 44 having a neoprene jacket. Cable 44 is formed with a loop 46 at one end, a ferrule 48 being used to secure the loop. The loop 46 is sized to fit in one of the passages 42. At its opposite end, cable 44 is attached to a disc or plate 54. The disc 54 has a flat attachment surface. A hole is drilled in disc 54 from its periphery. The neoprene jacket is removed from the end of the cable so as to expose the twisted strands of steel. Epoxy adhesive material is introduced into

the hole in the peripheral surface of disc 54, and while the adhesive material remains liquid, the end of cable 44 is inserted into the hole. Liquid adhesive material penetrates among the strands of the cable and when the adhesive material is cured, the cable 44 is securely attached to disc 54.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Claim 1

Based on our analysis and review of Perry and independent claim 1, it is our opinion that the only difference is the limitation

an adhesive means securing said first end segment of the flexible cable in the channel by bonding to the cable and the attachment plate.

With regard to this difference, the examiner determined (answer, pp. 4 and 5) that the use of adhesive as a securing means is conventional and that it would have been an obvious mechanical expedient to adhesively bond Perry's cable 44 within a passage 42 as a substitute for Perry's ferrule 48.

The appellants argue (brief, pp. 6-7, and reply brief, pp. 1-2) that the claimed adhesive means is not suggested by Perry. We agree. The examiner's determination of obviousness has not been supported by any **evidence** that would have led an artisan to arrive at the claimed invention. In that regard, while Perry does disclose the use of liquid epoxy adhesive material in a hole in the peripheral surface of the disc 54, it is our view that this would not have provided any

suggestion to have provided "adhesive means" within the grooves 40 of plates 8 and 10 since Perry's plates 8 and 10 of the central anchor 2 were designed to permit the cable 44 to be removed therefrom. Furthermore, we note that Perry's peripheral anchor 4 which includes the epoxy adhesive material within the hole in the peripheral surface of the disc 54 is clearly not readable on the claimed invention.

In our view, the only suggestion for modifying Perry in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellant's 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). It follows that we cannot sustain the examiner's rejection of independent claim 1, and claims 2 to 6 and 15 to 18 dependent thereon.

Claim 7

Based on our analysis and review of Perry and independent claim 7, it is our opinion that one difference is the limitation

the channels being of first and second different widths respectively, for receiving end segments of the first and second cables respectively.

With regard to this difference, the examiner determined (answer, p. 6) that to provide different size channels and cables, depending on the desired use of Perry's device, is within the scope of a skilled mechanic in the art, and providing same would have been obvious.

The appellants argue (brief, p. 11) that the above-noted limitation of claim 7 is not suggested by Perry. We agree. The examiner's determination of obviousness has not been supported by any **evidence** that would have led an artisan to arrive at the claimed invention. Once again, it is our opinion that the only suggestion for modifying Perry in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellant's own disclosure. It follows that we cannot sustain

the examiner's rejection of independent claim 7, and claims 8 to 10, 12 and 19 to 21 dependent thereon.

Claim 13

Based on our analysis and review of Perry and independent claim 13, it is our opinion that two differences are the limitations concerning (1) the width of the first channel being slightly greater than the thickness of the first cable and the width of the second channel being slightly greater than the thickness of the second cable (the second cable is recited to have a thickness greater than the thickness of the first cable), and (2) adhesively bonding the first end segment of the selected cable to the attachment plate.

With regard to these differences, the examiner determined (answer, pp. 4 and 7) that these limitations would have been obvious for reasons previously set forth with respect to claims 1 and 7.

The appellants argue (brief, pp. 12-13) that the above-noted limitations of claim 13 are not suggested by Perry. We

agree. As with the examiner's determinations with respect to claims 1 and 7, the examiner's determination of obviousness with respect to claim 13 has not been supported by any **evidence** that would have led an artisan to arrive at the claimed invention. As with claims 1 and 7, it is our belief that the only suggestion for modifying Perry in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. It follows that we cannot sustain the examiner's rejection of independent claim 13, and claims 14 and 22 dependent thereon.

The reference to Monoson

We have also reviewed the Monoson reference⁴ cited by the examiner⁵ but find nothing therein which makes up for the deficiencies of Perry discussed above regarding claims 1, 7 and 13.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 10 and 12 through 22 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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) BOARD OF PATENT
JOHN P. McQUADE) APPEALS

⁴ U.S. Patent No. 5,076,079 issued December 31, 1991.

⁵ The examiner applied both Perry and Monoson in the two rejections set forth on pages 3-4 of the answer. However, as noted in footnote 2 above, stated that Perry is "being used singularly." Accordingly, we treated the rejection of the claims under appeal as being based on 35 U.S.C. § 103 as being unpatentable over Perry alone.

Administrative Patent Judge) AND
) INTERFERENCES
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JEFFREY V. NASE)
Administrative Patent Judge)

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APPEAL NO. 1998-1962 - JUDGE NASE
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APJ FRANKFORT

APJ McQUADE

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 15 Apr 99

FINAL TYPED: