

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERBERT RICHTER

Appeal No. 1999-0605
Application No. 08/697,214¹

ON BRIEF

Before COHEN, FRANKFORT and PATE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1, 5 through 8 and 10 as amended subsequent to the final rejection in a paper filed March 11, 1998 (Paper No. 12). Claims 1, 5 through 8 and 10 are all of the claims remaining in the application. Claims 2 through 4 and 9 have been canceled.

¹Application for patent filed August 21, 1996.

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Appellant's invention relates to a support device which has a flexible support arm (1) comprised of an elastically flexible, corrugated, plastic tube (2) surrounding a bendable aluminum rod (3). The support arm is adapted to be supported at one end (6) thereof and to support an object at the opposite end (10). As noted on page 2 of the specification, the diameter of the aluminum rod is half the inner diameter of the plastic tube so as to impart strength to the flexible arm while at the same time making it possible to run an electrical wire through the plastic tube. A copy of independent claim 1 can be found in the Appendix to appellant's brief.

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

Simons	1,786,459	Dec. 30, 1930
Bast et al. (Bast)	4,560,831	Dec. 24, 1985
Sheppard et al. (Sheppard)	4,842,174	Jun. 27, 1989
Trimmer	5,592,749	Jan. 14, 1997

Claims 1, 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Trimmer in view of Simons.

Claim 1, 5 and 6 additionally stand rejected under 35 U.S.C. § 103 as being unpatentable over Sheppard in view of Trimmer and Simons.

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Claims 7, 8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sheppard in view of Trimmer and Simons as applied to claims 1, 5 and 6 above, and further in view of Bast.

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 appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 16, mailed April 27, 1998) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 15, filed April 2, 1998) and reply brief (Paper No. 17, filed June 9, 1998) for the arguments thereagainst.

OPINION

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

Looking first at the examiner's rejection of claims 1, 5 and 6 under 35 U.S.C. § 103 based on Trimmer and Simons, we note that the examiner has pointed to Figure 3 of Trimmer, urging that the support member seen therein is responsive to the subject

matter of claims 1, 5 and 6 on appeal, except for the fact that Trimmer fails to disclose that the rod (25) extending centrally through the elastically flexible, corrugated plastic tube of the flexible arm (24) is a “permanently bendable aluminum rod” as set forth in appellant’s claim 1. Simons is relied upon by the examiner as teaching permanently bendable metal rods (10) in a flexibly repositionable support arm (see Simons, page 1, lines 78-94). According to the examiner, it would have been obvious to one of ordinary skill in the art at the time appellant’s invention was made to have made the rod (25) of Trimmer as a permanently bendable rod as in Simons in order to support an object as disclosed by Simons.

Regarding the requirement that the claimed rod be a bendable aluminum rod, the examiner has urged that it would have been obvious to one of ordinary skill in the art to have fabricated the rod of the combination of Trimmer and Simons out of aluminum “in order to reduce the manufacturing costs and to provide a light-weight support arm and as a common type permanently bendable metal material” (answer, page 5).

Like appellant, we perceive that the support spine (25) seen in Figure 3 of Trimmer is composed of a plurality of rigid rod segments or members that are pivotally secured together at their ends so as to provide additional support and rigidity to the flexible arm (24). See, particularly, claim 6 of Trimmer and column 2, lines 57-59. As for Simon, this patent indicates that the inside of the conduit of the flexible arm (2) is “filled with a bundle of

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flexible nonresilient metal wires 10" (page 2, lines 87-89). Neither of the applied references teaches or suggests a permanently bendable aluminum rod sized as required in appellant's claim 1 on appeal.

After a review of the combined teachings of Trimmer and Simon, it is our opinion that in attempting to combine the applied patents in the manner set forth in the examiner's answer, the examiner has engaged in the use of impermissible hindsight derived from first having viewed appellant's disclosure and claims. Given the need in Trimmer for an articulated rigid central spine that provides additional support and rigidity to the flexible arm therein, it appears to us to be unlikely that one of ordinary skill in the art would have been led to substitute the flexible, bendable wires of Simons for the rigid rods of the central spine of Trimmer. Moreover, even if such a substitution were made, the resulting flexible arm would still lack a permanently bendable aluminum rod sized as required in appellant's independent claim 1 on appeal.

Accordingly, since a consideration of the collective teachings of Trimmer and Simons 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 appellant's invention, we must

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refuse to sustain the examiner's rejection of claim 1, and of dependent claims 5 and 6, under 35 U.S.C. § 103 based on Trimmer and Simons.

We have also reviewed the teachings of Sheppard applied by the examiner along with Trimmer and Simons against claims 1, 5 and 6 on appeal under 35 U.S.C. § 103. However, we find nothing in the combined teachings of these patents which would have made the subject matter as a whole of claim 1 on appeal obvious to one of ordinary skill in the art. Again, we note, as appellant has, that none of the applied references discloses, teaches or suggests "a permanently bendable aluminum rod" sized as required in appellant's independent claim 1 on appeal. In this regard, we note that the examiner's characterization of the helical coil spring (36) of Sheppard as a "permanently bendable metal rod" (answer, page 5) is factually incorrect. Moreover, given the disparate nature of the flexible, bendable arms in the various applied references, we share appellant's view that the examiner has relied upon improper hindsight in attempting to combine Sheppard, Trimmer and Simons in the manner urged in the examiner's answer. Thus, the rejection of claims 1, 5 and 6 under 35 U.S.C. § 103 based on Sheppard, Trimmer and Simons will not be sustained.

As for the additional patent to Bast applied against dependent claims 7, 8 and 10 on appeal, we have reviewed this patent, but find nothing therein which alters our view as

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expressed above. Therefore, the examiner's rejection of claims 7, 8 and 10 under 35 U.S.C. § 103 will likewise not be sustained.

In view of the foregoing, the examiner's decision rejecting claims 1, 5 through 8 and 10 of the present application under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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WILLIAM F. PATE III)	
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