The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ROBERT R. SHEARER and MICHAEL W. VADNEY

_____

Appeal No. 2004-1892
Application No. 10/197,472

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ON BRIEF

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Before COHEN, ABRAMS, and McQUADE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 27, 31, and 32. Claims 28 through 30, the only other claims remaining in the application, are indicated to contain allowable subject matter but are objected to as being dependent upon a rejected base claim.

Appellants' invention pertains to a boat windshield bottom trim element. A basic understanding of the invention can be

derived from a reading of exemplary claim 27, a copy of which appears in the APPENDIX to the main brief (Paper No. 10).

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

Muhlberger	4,815,410	Mar. 28, 1989
Vadney	5,839,388	Nov. 24, 1998

The following rejection is before us for review.

Claims 27, 31, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhlberger in view of Vadney.

The full text of the examiner's obviousness rejection and response to the argument presented by appellants appears in the final rejection and answer (Paper Nos. 6 and 11), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 10 and 12).

OPINION

In reaching our conclusion on the obviousness issue[1] raised in this appeal, this panel of the Board has carefully considered appellants' specification and claims,[2] the applied teachings,[3] and the respective viewpoints of appellants and the examiner. As

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[1] The test for obviousness is what the combined teachings of references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

[2] Claim 27 sets forth a boat windshield bottom trim element in its preamble but the claim also encompasses, by positive recitation (a bottom portion "connected to"), a boat and a plurality of fixing elements. Similarly, the boat windshield bottom trim element of dependent claim 32 additionally encompasses at least one fastener and a boat cover or canopy. We understand the fastener-receiving side opening of the middle portion as being separate and independent from the upper and bottom portions since the trim element is disclosed as being an extrusion, i.e., all portions of the trim element are joined together.

[3] In our evaluation of the applied prior art, we have considered all of the disclosure of each document 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 been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

a consequence of our review, we make the determinations which follow.

We cannot sustain the obviousness rejection.

Claim 27, the sole independent claim on appeal, is drawn to a boat windshield bottom trim element comprising, inter alia, a middle portion including a fastener-receiving side opening.

Like appellants' bottom trim element, the extruded mounting member M of Muhlberger is secured to a boat (Figs. 1 and 3) and receives the bottom of a boat windshield W. However, Muhlberger does not teach a bottom trim element with any structure whatsoever (in a middle portion or otherwise) for association with a boat canopy or cover. On the other hand, Vadney discloses an extruded frame 16 (Figs. 1 and 2) that receives the top of a boat windshield 17 and further includes a side opening receiving fasteners for securing a boat top 11. We note that the frame of Vadney is not connected to a boat and that the windshield is not covered by the boat top. As we see it, the Vadney disclosure would have instructed those having ordinary skill in the art to use a frame atop a windshield to secure a boat top in place. We

simply do not perceive any suggestion from the two applied references to modify a bottom trim element to secure a boat top in place (and across the face of a windshield). The examiner has not proffered any references that reveal the knowledge in the art of a bottom trim element that secures a boat top in place, at the time of appellants' application. Thus, akin to appellants' point of view, it is clear to this panel of the Board that a conclusion of obviousness based upon the combined teachings of Muhlberger and Vadney can only be achieved with reliance upon impermissible hindsight. It is for this reason that the rejection on appeal cannot be sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
NEAL E. ABRAMS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN P. McQUADE Administrative Patent Judge	)	

ICC/lbg

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