BASIS FOR PRIMA FACIE CASE FOR OBVIOUSNESS

The law is clear that in order to establish a proper *prima facie* case of obviousness based on a combination of references, the prior art must contain some reason, purpose, motivation, incentive or teaching of the proposed combination. One of the leading cases in this regard is Ex parte Clapp, 227 USPQ 972, where the Honorable Board stated:

> Presuming arguendo that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination.

The same is true in the present case. Applicant here also has presented claims to a new combination of elements.

> To support the conclusion that the claimed combination is directed to obvious subject matter either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. . . . Based on the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the

> various references so as to arrive at the claimed invention without using the claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness. Note In re Horn, 203 USPQ 969, 971 (CCPA 1979). Accordingly, we will not sustain any of the rejections presented.

A number of other cases are similar including Ex parte Chicago Rawhide, 226 USPQ 438, 440 (PTOBA, 1984):

> . . . , in order to meet the terms of the claims on appeal, the elements of Baney device would have to be arranged in a manner different from that disclosed by Baney. The elements of the reference would also be required to coact differently from the way they coact in the arrangement disclosed by the reference. The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant's specification, to make the necessary changes in the reference device. The examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the Baney device to render the here claimed device unpatentable.

One of the leading cases in this area is In re Imperato, 179 USPQ 730, 732 (CCPA 1973) where the Court stated:

> With regard to the principal rejection, we agree that combining the teaching of Schaefer with that of Johnson or Amberg

> would give the beneficial result observed by appellant. However, the mere fact that those disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. In re Bergel, 48 CCPA 1102, 292 F.2d 955, 130 USPQ 206 (1961). We find no such suggestion in these references. (emphasis in original)

In re Imperato, supra, was cited with approval by the CAFC in In re Sernaker, 217 USPQ 1, 5-7 (CAFC 1983). On the question of the combinability of references, the Court stated (page 5) that a question in determining obviousness was:

> whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, ...

And from pages 6 and 7:

> The lesson of [In re Imperato] appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings. . . .
>
> For the foregoing reasons, it is clear that the principal rejection . . . cannot be sustained. The four references relied upon . . . , either separately or in combination, do not suggest that transfer printing techniques should be combined with embroidery techniques. . . .

Lastly, attention is invited to Ex parte Acosta, 211 USPQ 636, 637 (PTOBA 1979):

> We cannot subscribe to the examiner's reasoning. There is simply no basis in the record from which it can be reasonably inferred that one of ordinary skill in this art would have been led or motivated to modify the Soreinte '016 filter tank in the manner proposed by the examiner.

As seen from the above analysis of Baker and Anderson, there is not the remotest inference in either reference, or any other prior art known to Applicant, leading the skilled worker in this art toward the proposed combination. The combination is obvious only in retrospect, i.e. after having looked at Applicant's specification, but it was not (would not have been) obvious to a person of normal skill in the art at the time the present invention was made. The prior art does not provide the incentive, motive, reason, purpose, teaching or basis for the combination, and therefore the combination would not have been obvious.

Further, even if the Anderson and Baker combination were obvious, it does not produce the claimed subject matter, as the Examiner himself notes by further combining Hardy and Bauman to finally end with Applicant's claimed invention. Of course, this combination (Hardy and Bauman to Anderson and Baker) is equally subject to the same line of case law Applicant has cited above regarding the Anderson and Baker combination. However, Applicant submits that the latter combination (Hardy and Bauman to Anderson and Baker) is even less obvious in light of the questionability of combining Anderson and Baker in the first instance.

Applicant submits that the invention is new and unobvious and not disclosed by the cited art. Accordingly, Applicant respectfully solicits the Examiner's early review and issuance of this application.

Respectfully submitted,

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