

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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK A. KRULL

Appeal No. 2000-0869
Application No. 09/150,225

ON BRIEF

Before STAAB, 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 21, 24, 32 and 34 to 45. Claims 22, 23 and 25 to 27, the only other claims pending in this application, have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention.

We REVERSE.

BACKGROUND

The appellant's invention relates to a toy ball. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Knight 1925	1,548,531	Aug. 4,
Rosenberg 2, 1926	1,575,281	Mar.

Claims 21, 24, 32 and 34 to 45 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rosenberg in view of Knight.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 10, mailed July 6, 1999) and the answer (Paper No. 13, mailed January 6, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 12,

filed December 2, 1999) and reply brief (Paper No. 14, filed January 27, 2000) 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 references, 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 21, 24, 32 and 34 to 45 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 would

have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue in the briefs that the applied prior art does not suggest the claimed subject matter. We agree.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the prior art contains none.

In our view, the only suggestion for modifying Rosenberg in the manner proposed by the examiner (final rejection, pp. 3-4) to replace Rosenberg's stuffed material B, such as cotton batting or other suitable material, with Knight's practice golf ball 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 Assocs., 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 rejections of claims 21, 24, 32 and 34 to 45.

CONCLUSION

To summarize, the decision of the examiner to reject claims 21, 24, 32 and 34 to 45 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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MARK A. KRULL
POST OFFICE BOX 57
GREENCASTLE, IN 46135

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