

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte FRANCIS L. CONTE

---

Appeal No. 2000-2033  
Application 08/331,851

---

ON BRIEF

---

Before PATE, STAAB, and McQUADE, Administrative Patent Judges.  
PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is the second appeal of the final rejection of claims 1 and 4 through 15. Claims 2 and 3 have been canceled. These are all the claims in the application.

In a first *ex parte* appeal, this board rendered a decision on September 22, 1998 reversing all rejections of claims 1 and 4 through 15. Subsequent to the appeal the examiner reopened

Appeal No. 2000-2033  
Application 08/331,851

prosecution under 37 CFR § 1.198 and rejected all claims on art previously of record. The applicant petitioned under 37 CFR § 1.181 contending, *inter alia*, that the reopened prosecution failed to comply with 37 CFR § 1.198. In a petition decision rendered on May 21, 1999, applicant's petition was denied. Thereafter, the examiner issued a third office action rejecting all claims. On June 3, 1999, the applicant again filed a petition challenging the propriety of the reopened prosecution. Applicant subsequently filed a Notice of Appeal, and the petition was denied. Thereafter, applicant filed a brief and the examiner submitted an examiner's answer, and the case comes to us as a normal *ex parte* appeal.

The claimed subject matter is directed to an insect swatter which uses an elastic lash in the form of annular rubber band for swatting an insect. The swatter is in the shape of a pistol and the band is stretched along the barrel. A release means is actuated by a latch means to release the stretched rubber band toward the insect.

The references of record relied upon by the examiner as evidence of obviousness are:

Kopp	1,009,531	Nov. 21, 1911
Caron	2,054,719	Sep. 15, 1936
Watkins	2,642,057	June 16, 1953

THE REJECTIONS

Claims 1 and 4 through 6 stand rejected under 35 U.S.C. § 103 as unpatentable over Caron in view of Kopp.

Claims 1 and 4 through 6 stand rejected under 35 U.S.C. § 103 as unpatentable over Kopp in view of Caron.<sup>1</sup>

Claims 7 through 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Caron in view of Kopp and further in view of Watkins.

Claims 7 through 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Kopp in view of Caron and further in view of Watkins.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the conclusion that the applied prior art establishes a *prima facie* case of obviousness with respect to claims 1, 4 through 6 and 7 through 10 on appeal.

---

<sup>1</sup> Unlike the examiner, we do not consider the order in which prior art is applied in a rejection to be significant. See, for example, In re Bush 296 F.2d 491, 496, 131 USPQ 263, 267 (CCPA 1961) ("[i]n a case of this type where a rejection is predicated on two references each containing pertinent disclosure which has been pointed out to the applicant, we deem it to be a matter of no significance, but merely a matter of exposition, that the rejection is stated to be on A in view of B instead of B in view of A, or to term one reference primary and the other secondary."); In re Cook, 372 F.2d 563, 152 USPQ 615 (CCPA 1967).

Appeal No. 2000-2033  
Application 08/331,851

This *prima facie* case of obviousness has not been rebutted by additional evidence from the appellant. Accordingly, the rejections of claims 1, 4 through 6 and 7 through 10 are affirmed. The applied art does not establish the *prima facie* obviousness of claims 11 through 15. The rejection of these claims is reversed. Our reasons follow.

Appellant's first argument is that the new rejection of claims 1 and 4 through 15 is unwarranted under the doctrine of *res judicata*, or law of the case, in view of the full reversal of the same claims on evidence in the record by the prior decision of the Board. However, the predecessor to our reviewing court has previously dealt with this issue. The court stated in In re Borkowski, 505 F.2d 713, 718, 184 USPQ 29, 32-33 (CCPA 1974):

Appellants' contention that the prior board decision reversing a rejection under 35 U.S.C. § 103 over Borkowski et al. in a parent application should have been "res judicata" to the examiner in this case is unpersuasive. This court stated in In re Craig, 411 F.2d 1333, 56 C.C.P.A. 1438 (1969), that the policy and purpose of the patent laws preclude the applicability of any doctrine akin to the judicially-developed doctrine of "res judicata" to bar the granting of patents on inventions that comply with the statute. The same policy and purpose precludes reliance on any such doctrine to force the granting of patents on inventions that do not comply with the statute. The Patent Office must have the flexibility to reconsider and correct prior decisions that it may find to have been in error.

Next, appellant raises the issue of a rejection based on cited prior art that was never applied in a reexamination as was the case in In re Portola Packaging, Inc, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). However, it is clear, that the result in Portola was dictated by the narrow scope of reexamination afforded the PTO by the statute. In the case of an application for patent, the PTO has broad scope. The court explicitly recognized in Portola the PTO's goal of performing a thorough and conscientious examination before allowing applications to be patented. 110 F.3d at 791, 42 USPQ2d at 1300.

Turning to the rejections based on prior art, it is our finding, that Kopp discloses a toy gun in the form of an elastic lash made of an annular rubber band having a first loop joined to the distal end of an elongated rod. When the lash is released, it spontaneously contracts and may be used to strike "some object such as a fly or an insect [sic]." Kopp releases the elastic lash by way of a trigger made of a single piece of resilient material 9. Thus, Kopp differs from the claimed subject matter in having a resilient trigger 9 which does not include a latch or a means pivotally joined adjacent to the latch for releasing the lash.

It is our finding that Caron also discloses a toy gun having an elongated rod wherein an elastic member formed of an annular rubber band is placed on the end of the rod. Caron teaches releasing the lash by means of a pivoting latch member 8 which is adjacent the proximal end of the rod and which engages the second loop of the elastic band. The pivotal latch is released by a trigger which is pivotally joined to the rod and placed adjacent to the latch for selectively releasing the latch and allowing the annular rubber band to spontaneously contract and be launched off the end of the toy gun. Caron differs from the subject matter claimed in that Caron does not disclose the utility of using the elastic lash for impacting an insect. Furthermore, Caron does not disclose the elastic lash fixedly joined to the distal end of the rod. Inasmuch as Caron discloses a latch and a means comprising a trigger for selectively releasing the latch for the benefit of providing discharge parts of a toy gun with positive control and shock absorption, it would have been obvious to use the pivotal latch and the latch releasing mean of Caron on the toy gun as disclosed in Kopp.

Appellant argues that Caron and Kopp are non-analogous art. We disagree. Turning first to Kopp, the reference teaching is within appellant's field of endeavor, i.e., killing insects with

an elastic lash attached to a toy pistol handle. Furthermore, since Caron is directed to a disclosure which is concerned with releasing an elastic band, Caron is clearly reasonably pertinent to appellant's problem.

Appellant argues that there is no suggestion for the examiner's proposed combination of references. This is clearly not the case. Caron specifically discloses that his release means and his latch are provided to enable a positive acting release of the elastic band. Furthermore, Caron teaches that the provision of spring 16 on his latch means provides a shock absorbing mechanism to preclude the possibility of damage to the pistol. These are express, written suggestions of the desirability of the mechanism of Caron which would have clearly motivate one of ordinary skill to include such modifications on the pistol of Kopp.

We are further in agreement with the examiner that claims 1 and 4 through 10 do not preclude the presence of a knot on the pistol of Kopp. We further disagree with the appellant's repeated assertion that the "primary function of Kopp's toy gun is a toy gun." It seems clear that the disclosure in Kopp mentions killing insects in several locations, and Fig. 1 of the patent clearly discloses using the gun to kill an insect.

Likewise, we affirm the rejection of claims 7 through 10 based on the combined teachings of Kopp, Caron and Watkins. Watkins is cited to disclose a preferred manner of securing the rubber band to the distal portion of the elongated rod of the pistol shaped frame. Watkins uses a keyhole slot which allows ready replacement of the rubber band, but insures that the rubber band will not become easily detached under even the most violent manipulation of the gun. Following this express disclosure of Watkins, it would have been obvious to use a keyhole slot to attach the rubber band to the insect killing gun of Kopp.

Appellant argues that Watkins is not within appellant's field of endeavor. Even if this were the case, appellant has not argued that Watkins is not reasonably pertinent to the problem with which appellant is concerned. In our view, the gun of Watkins is reasonably pertinent to appellant's problem. Appellant states there is no motivation for using the feature of Watkins with the combined teachings of Caron and Kopp. As noted above, Watkins provides express, written motivation or suggestion for the examiner's proposed combination for claims 8 and 9. We agree with the examiner that the exact orientation of the keyhole slot is a design choice. We note appellant's reliance on benefits such as loose support of the lash, easy replacement

Appeal No. 2000-2033  
Application 08/331,851

thereof, self retention upon firing, etc. The first three of these benefits are expressly disclosed in Watkins' disclosure.

With respect to claims 11 through 15, we are in agreement with the appellant that the applied prior art of Kopp, Caron and Watkins does not render obvious the provision of a thumb grip on the latch as claimed in claim 11. We are cognizant of the examiner's argument that such a thumb grip is prevalent in the art, but we are not convinced of the propriety of maintaining the rejection due to the lack of an evidentiary basis thereof. For this reason it is our conclusion of law that claims 11 through 15 would not have been obvious for the lack of any disclosure in the references of a thumb grip.

#### SUMMARY

Rejections of claims 1 and 4 through 10 are affirmed. The rejection of claims 11 through 15 is reversed.

Appeal No. 2000-2033  
Application 08/331,851

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

WILLIAM F. PATE, III	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

Appeal No. 2000-2033  
Application 08/331,851

Francis L. Conte  
6 Puritan Avenue  
Swampscott, MA 01907