

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte TOM BERNARD MATHISON and JOSEPH B. BUDZ

---

Appeal No. 2001-2625  
Application No. 09/458,052<sup>1</sup>

---

ON BRIEF

---

Before STONER, Chief Administrative Patent Judge, FRANKFORT and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 11, mailed December 4, 2000) of claims 1

---

<sup>1</sup> Application filed December 9, 1999, for reissue of U.S. Patent No. 5,971,234 (Application No. 09/143,337, filed August 28, 1998) which issued on October 26, 1999.

Appeal No. 2001-2625  
Application No. 09/458,052

to 20, which are all of the claims pending in this  
application.<sup>2</sup>

We REVERSE.

---

<sup>2</sup> Claims 5 and 13 were amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to dust/air pick-up systems for squeeze-type dust dispensers (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Chester 1966	3,241,726	Mar. 22,
Shay 15, 1977	4,007,858	Feb.
McRoskey et al. 1982	4,356,941	Nov. 2,

The following rejections set forth in the final rejection are before us for review:

- (1) Claims 1 to 20 stand rejected under 35 U.S.C. § 251 as being based upon a defective reissue declaration;
- (2) Claims 5 to 10 and 13 to 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shay and Chester; and
- (3) Claims 5 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shay and Chester as applied in the above rejection, and further in view of McRoskey.<sup>3</sup>

---

<sup>3</sup> In the answer (p. 5), it appears to us that the examiner combined the two rejections under 35 U.S.C. § 103 together in  
(continued...)

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection and the answer (Paper No. 17, mailed May 2, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 16, filed March 26, 2001) for the appellants' arguments thereagainst.

OPINION

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

---

<sup>3</sup>(...continued)  
view of the appellants grouping of claims set forth on page 6 of the brief. Accordingly, we believe that the rejections of the claims under appeal before us in this appeal are the rejections set forth in the final rejection.

**The 35 U.S.C. § 251 rejection**

We will not sustain the rejection of claims 1 to 20 under 35 U.S.C. § 251.

The examiner's basis for this rejection as set forth in the final rejection (p. 2) and the answer (p. 5) is that the reissue declaration filed with this application<sup>4</sup> is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. In support thereof the examiner cites 37 CFR § 1.175(a)(1) and MPEP § 1414 (final rejection, p. 2). In this rejection, the examiner determined that the appellants were not entitled to claims 5 to 20 as presented in this application (due to the 35 U.S.C. § 103 rejections set forth above) and therefore, the stated error in the reissue declaration can not exist.

---

<sup>4</sup> The appellants have filed two reissue declarations. The first reissue declaration was filed December 9, 1999 with the reissue application. The second reissue declaration was filed February 26, 2001 and apparently was entered by the examiner since the Advisory Action (Paper No. 13, mailed March 9, 2001) states "Declaration filed February 26, 2001 sufficient to address claims 13-20." Accordingly, both reissue declarations are before us in this appeal.

We find no authority for this rejection in 35 U.S.C. § 251, 37 CFR § 1.175(a)(1) or MPEP § 1414. In our view, a prior art rejection of all claims sought to be added to the patent does not, ipso facto, give rise to a rejection under 35 U.S.C. § 251 as set forth by the examiner in this case. Additionally, we note that from our review of the two reissue declarations, both reissue declarations comply with the requirement of 37 CFR § 1.175(a)(1) since the appellants have stated that they believe the original patent to be wholly or partly inoperative or invalid by reason of the patentee claiming more or less than the patentee had the right to claim in the patent and stating at least one error being relied upon as the basis for reissue. Moreover, given our disposition of the examiner's rejections under 35 U.S.C. § 103, as noted infra, the examiner's entire premise for this rejection is without foundation.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 20 under 35 U.S.C. § 251 is reversed.

**The 35 U.S.C. § 103 rejections**

We will not sustain the rejection of claims 5 to 10 and 13 to 18 under 35 U.S.C. § 103 as being unpatentable over Shay and Chester. Likewise, we will not sustain the rejection of claims 5 to 20 under 35 U.S.C. § 103 as being unpatentable over Shay, Chester and McRoskey.

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).

In both of the rejections under 35 U.S.C. § 103 before us in this appeal, the examiner determined (answer, p. 5) that Figures 7 to 13 of Shay disclose the following subject matter:

a dispensing device comprising: a container 12; a plug 18' including a bore 22'; an outlet tube 30' having an open top end (receiving 28) and a "closed" (by 37') bottom end; a dip tube 32' having an open top end (at 29) and a "closed" (by 34') bottom end; and vent holes (37a, at 29, 40).

The examiner ascertained (answer, p. 5) that Shay teaches all the claimed subject matter of claims 5 and 13 (the only independent claims rejected under 35 U.S.C. § 103) "except for

the dip tube being 'seatingly held by said plug.'" Next, the examiner concluded (answer, p. 6) that in view of the teachings of Chester, "it would have been obvious to one of ordinary skill in the art to associate a plug seat (and vent hole 40) with the Shay dip tube as being an art recognized equivalent method of providing an air flow passage in a dip tube."

The appellants argue (brief, pp. 13-14) that the applied prior art does not suggest the claimed subject matter. We agree.

Claims 5 to 20 under appeal require the dip tube (i.e., Shay's down tube element 32') to be seatingly held by the plug (i.e., Shay's dispensing head 18'). In our view, the teachings of Chester would not have been suggestive to a person of ordinary skill in the art to have modified Shay's down tube element 32' to be seatingly held by his dispensing head 18' since Shay teaches that air flows (as indicated in Figure 8 of Shay) into the open upper end of down tube element 32' and then up dip tube 30' and out discharge nozzle 24'. Chester would not have suggested any modification to the way

air flows into Shay's down tube element 32' (i.e., air flowing through vent holes in the down tube which is seatingly held by the plug) since Chester does not teach or suggest air flowing down a down tube and then up a dip tube to a discharge nozzle. Thus, it appears that the only suggestion for modifying Shay in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellants' 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 5 to 20.<sup>5</sup>

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 20 under 35 U.S.C. § 251 is reversed and the

---

<sup>5</sup> We have also reviewed the reference to McRoskey but find nothing therein which makes up for the deficiencies of Shay and Chester discussed above.

decision of the examiner to reject claims 5 to 20 under 35  
U.S.C. § 103 is reversed.

REVERSED

BRUCE H. STONER, JR.	)	
Chief Administrative Patent Judge	)	
)	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

Appeal No. 2001-2625  
Application No. 09/458,052

Page 12

KLEHR, HARRISON, HARVEY, BRANZBURG & ELL  
260 SOUTH BROAD STREET  
PHILADELPHIA, PA 19102

Appeal No. 2001-2625  
Application No. 09/458,052

Page 13

JVN/jg