

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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY M. BRO, DANIEL SEIFERT, TERRY J. SANCHEZ,
SYED J. HANSAN and MARTIN J. HIRSCH

Appeal No. 2002-1181
Application No. 09/576,154

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-21, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a bubble-blowing apparatus. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

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

McNett <u>et al.</u> (McNett)	4,995,844	Feb. 26, 1991
Novak	5,304,085	Apr. 19, 1994

Claims 1-21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 12 and 15-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Novak in view of McNett.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 10) and the final rejection (Paper No. 7) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 9) 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.

The Rejection Under The Second Paragraph Of Section 112

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. Evaluating the three issues raised by the examiner in this rejection in the light of this guidance from our reviewing court leads us to conclude that the rejection should not be sustained.

The first issue raised by the examiner under this rejection is that independent claims 1, 8 and 17 are indefinite because the description of the container as having an annular neck, a rounded bottom surface and a container side wall having a portion that is spaced from the rounded bottom surface "does not support" the functional limitation "so that" an outer three-dimensional space is disposed between the side wall portion

and the rounded bottom surface outside of the interior volume and not occupied by bubble solution (Paper No. 7, paragraph bridging pages 2 and 3). The appellants urge that this is not the case, and point out on pages 3-6 of the Brief how the structural elements recited in the claims establish the presence of the “outer three-dimensional space disposed between the side wall and the rounded portion of the bottom surface.”

The “space” upon which the examiner has focused is the annular space designated in Figure 1 as 70, which surrounds the interior portion containing the bubble solution. In this regard, and with reference to Figure 1, claim 1 recites that the bubble solution container has an annular neck [20], a rounded bottom portion [26], and a container side wall [24] that connects those two elements and at least partially defines “an interior volume.” Claim 1 goes on to establish that the container side wall has a portion [24c, 24d] that is spaced from the rounded bottom surface [26] so that it “at least partially defines a centrally located three-dimensional space within said interior volume [which holds bubble solution 66] and so that an outer three-dimensional space [70] is disposed between said side wall portion [24c, 24d] and said rounded bottom surface [26].” It is our view that, especially when considering this language in the light of the disclosure, one of ordinary skill in the art would have understood the structure and the relationships of the various elements recited, and therefore claim 1 is not indefinite on this ground. We reach the same conclusion with regard to the manner in which space 70 is described in claims 8 and 17.

The second indefiniteness issue raised by the examiner is that the language regarding “a weight distribution” in claims 1, 8, 12 and 17 is indefinite “since it is not clear how it structurally limits the claim structure,” and how “the weight distribution causing [sic] the container to automatically move to an upright position from a tilted position angularly displaced from said upright position” (Paper No. 7, page 3). From our perspective, the claim language in issue sets forth a limitation which one of ordinary skill in the art would understand to mean that the structure of the container described in the previous portion of the claim must have a distribution of weight which, when the container is at least partially filled with bubble solution, causes it to right itself from a tilted position. We do not agree with the examiner that this manner of expressing the structure renders the claims indefinite.

The final problem under this rejection is directed to claims 15, 16, 19 and 20, which the examiner determines are indefinite because “the additional structure sought to be encompassed in a particular claim can not be determined” (Paper No. 7, page 3). Independent claims 12 and 17 each recite a “tilted position” from which the container must be self-rightable. Claims 15 and 16, which depend from claim 12, and claims 19 and 20, which depend from claim 17, add to the parent claims the further requirement that the “tilted position,” from which the container must be self-rightable by virtue of its weight distribution, be “at least about 30 degrees relative to vertical” and “at least about 45 degrees relative to vertical.” Thus, these claims do further restrict the limitations set

forth in the claims from which they depend. We do not agree with the examiner that such a recitation causes the claims to be indefinite.

For the reasons set forth above, the Section 112 rejection of claims 1-21 is not sustained.

The Rejection Under Section 103

It is the examiner's view that the subject matter of claims 12 and 15-21 would have been obvious to one of ordinary skill in the art in view of the combined teachings of Novak and McNett (Paper No. 7, page 5). The appellants argue that no suggestion exists for modifying the Novak bubble-blowing toy in the manner proposed by the examiner, specifically, that the references provide no motivation for one of ordinary skill in the art to modify the Novak device by providing it with a rounded bottom.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or

from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Applying this guidance to the matter at hand, we find ourselves in agreement with the appellants that the rejection should not be sustained, essentially for the reasons expressed on pages 11-14 of the Brief.

At the outset, we point out that neither reference is concerned with providing a bubble container having a weight distribution such that it will move to an upright position from a tilted position. The essence of the examiner's position seems to be that it would have been obvious to provide the Novak device with a rounded bottom, and that doing so would cause the device to be self-rightable. This reasoning is defective, for several reasons. While it has an interior volume for receiving bubble solution, the Novak container has a flat bottom, and thus clearly lacks the rounded bottom required by the claims. McNett does not provide a container for bubble fluid, but teaches that this material be placed on mouthpiece 28 (column 4, line 53 et seq.). It is the squeeze bulb that is provided with a rounded bottom disclosed in the McNett device, and not a container for bubble solution, and hence, McNett cannot be relied upon for teaching that the bubble-containing container have a rounded bottom. Moreover, the entire McNett device is installed inside a toy animal, and therefore the rounded bottom

provided on the squeeze bulb would appear not to be inherently capable of functioning to cause the device to be self-righting.

We fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to modify the Novak container in the manner proposed by the examiner. Nor, even if such were deemed to be present, we are of the view that suggestion exists for providing the device with the weight distribution limitation required by independent claims 12 and 17. This being the case, the teachings of the two applied references fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claims 12 and 17, and we will not sustain the rejection of those claims or, it follows, of claims 15, 16 and 18-21, which depend therefrom.

CONCLUSION

The rejection of claims 1-21 under 35 U.S.C. § 112, second paragraph, is not sustained.

The rejection of claims 12 and 15-21 under 35 U.S.C. § 103 as being unpatentable over Novak in view of McNett is not sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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LAWRENCE J. STAAB)	
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NEA/lbg

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APPEAL NO. 2002-1181 - JUDGE ABRAMS
APPLICATION NO. 09/576,154

APJ ABRAMS

APJ COHEN

APJ STAAB

DECISION: **REVERSED**

Prepared By: Lesley Brooks

GAU: 3700

OB/HD

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