

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte SEAN B. WEATHERILL and JAMES B.A. TRACEY

Appeal No. 2005-1040
Application No. 09/777,420

HEARD: September 14, 2005

Before MCQUADE, CRAWFORD and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-23, 25, 27 and 28, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to a reel housing provided with an access panel having facial indicia on the exterior surface thereof to give the reel housing an improved, aesthetically pleasing appearance (appellants' specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The Applied Prior Art

The examiner relied upon the following prior art reference of record in rejecting the appealed claims:

Ewald	2,286,904	Jun. 16, 1942
Hall	2,403,277	Jul. 2, 1946

The Rejections

The following rejections are before us for review.

Claims 1-23, 25 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hall.

Claim 27 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hall in view of Ewald.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (mailed July 26, 2004) for the examiner's complete reasoning in support of the rejection and to the brief (filed March 15, 2004) and reply brief (filed October 1, 2004) 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.

Each of appellants' independent claims 1, 14, 21 and 25 recites a reel housing comprising either an access panel (claims 1 and 14) or a detachable facial indicia element (claims 21 and 25) having an exterior surface having facial indicia to resemble "one of an animal, a human, a human-like character, and an alien creature" (claims 1, 21 and 25) or facial indicia including one or more of "(i) a pair of eyes, (ii) a nose or beak, and (iii) a mouth" (claim 14).

The examiner concedes on page 4 of the answer that Hall's traffic counter housing (casing 1) lacks facial indicia as claimed.¹ In order to account for the facial indicia feature the examiner's position is:

That the exterior surface of the access panel has a facial indicia to resemble one of an animal, human-like character, or alien creature (as recited in claims 1, 4-7, 9-19, 21, and 25) would have been an obvious matter of ornamental design choice to a person having ordinary skill in the art based on ornamental preference, providing no new or unexpected results. In other words, the ornamental design of the exterior surface of the access panel would have been an obvious matter of ornamental design choice to a person having ordinary skill in the art based on ornamental preference, providing no new or unexpected results [answer, page 3].

On page 4 of the answer, the examiner adds that:

¹ The examiner's statement on page 4 of the answer that "the facial indicia inherent in the device of Hall could very well resemble that of an alien creature, since the examiner has never seen an alien creature" is quite manifestly not supported by any evidence that Hall's casing has facial indicia resembling that of an alien creature. It is well settled that the language "[a] person shall be entitled to a patent unless" in 35 U.S.C. § 102 places a burden of proof on the examiner to produce the factual basis for its rejection of an application under sections 102 and 103. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). It follows that, when relying on the theory of inherency, the examiner has the initial burden of providing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic reasonably flows from the teachings of the applied prior art. See In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986).

The facial indicia is considered an ornamental feature because it does not affect the way the apparatus of Hall works or how it is used. And since the number of ornamental designs that can be applied is limitless, a particular ornamental design can only be a personal preference.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

In this case, the examiner has provided absolutely no evidence of a teaching or suggestion to modify the traffic counter casing of Hall to provide the exterior surface thereof with facial indicia of the type called for in appellants' claims 1, 14, 21 and 25. That the recited features are directed to aesthetic or ornamental features does not discharge the examiner's burden to supply evidence of a suggestion or motivation to modify the Hall reference to arrive at the claimed invention. It follows that the rejection of independent claims 1, 14, 21 and 25 and claims 2-13, 15-20, 22, 23 and 28 as being unpatentable over Hall cannot be sustained.

The examiner's application of the teachings of Ewald provides no cure for the deficiency of Hall noted above. Accordingly, the rejection of claim 27 as being unpatentable over Hall in view of Ewald also cannot be sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-23, 25, 27 and 28 under 35 U.S.C. § 103 is reversed.

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

REVERSED

JOHN P. MCQUADE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MURRIEL E. CRAWFORD)	APPEALS
Administrative Patent Judge)	AND
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JENNIFER D. BAHR)	
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