

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS R. SPAULDING, SR.

Appeal 2006-0636
Application 10/281,474
Technology Center 3600

Decided: March 29, 2007

Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and JENNIFER D. BAHR, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing of our decision mailed September 14, 2006, wherein we affirmed the rejection of claims 1 and 12 and reversed the rejection of claims 3, 4, 6, 7, 8, 9, 10, 17 and 18.

In this request, the Appellant argues that the board erred by determining that Appellant did not argue the separate patentability of claim 12. The Appellant

directs our attention to page 10 of the brief and page 4 of the reply brief as evidence of argument regarding the separate patentability of claim 12.

On these pages of the brief and the reply brief, Appellant argues that the prior art does not disclose a bird decoy that “may pivot with respect to the support stand, on an axis extending generally perpendicular to said support stand....from one side to the opposite side when said upper and lower body members are engaged by a current of wind.”

In our decision at page 5, we stated that a person of ordinary skill in the art would have been motivated to modify the decoy of McKnight so that the lower body pivots in the wind so as to simulate the movement of a bird in flight (see Lamkin, col. 1, ll. 21-23 and 52-53).

The language of claim 12 is that the bird decoy *may* pivot from side to side when engaged by a current of wind. In our view, our discussion regarding the pivoting of the modified McKnight bird decoy addressed the pivoting of the bird in all directions. However, for clarity, we state that the modified McKnight bird certainly has the ability to pivot in all directions including from side to side on an axis extending perpendicular to, for example, the top face of the post, when engaged by a current of wind. Such would necessarily be the case because the connection disclosed in Lamkin of the body 1 to the post 2 would permit the bird

to pivot from side to side at least to some extent, especially when engaged by a strong enough wind. We note that by its use of the word *may*, all that the claim requires is that this pivoting from side to side is possible when engaged by a current of wind. This would be met by the pivotal connection disclosed in Lamkin.

In view of the foregoing, we modify our decision to remove the sentence at page 5 of our decision regarding Appellant's lack of making a separate argument regarding the patentability of claim 12. However, we also modify our decision to state that the subject matter of claim 12 is taught by the combined teachings of McKnight and Lamkin as discussed above. Therefore, the request for rehearing is granted. However, we decline to change our decision regarding the patentability of claim 12 for the reasons stated above.

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

GRANTED

JRG

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THOMTE, MAZOUR & NIEBERGALL, L.L.C.
2120 S. 72ND STREET, SUITE 1111
OMAHA, NE 68124