

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte THOMAS R. SPAULDING SR.

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Appeal No. 2006-0636  
Application No. 10/281,474

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ON BRIEF

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

#### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4, 6 to 10, 12, 17 and 18 which are all of the claims pending in this application. Claims 2, 5, 11, 13 to 16 and 19 to 20 have been cancelled.

The appellant's invention relates to a bird decoy shaped to resemble a bird having a body and wings that move when engaged by the wind to mimic lifelike bird movement (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The Prior Art

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

|                            |           |               |
|----------------------------|-----------|---------------|
| Lamkin                     | 2,704,908 | Mar. 29, 1955 |
| Jackson                    | 5,036,614 | Aug. 6, 1991  |
| McKnight et al. (McKnight) | 5,682,702 | Nov. 4, 1997  |
| Samaras                    | 6,092,322 | Jul. 25, 2000 |
| Weiser et al. (Weiser)     | 6,572,428 | Jun. 3, 2003  |

The Rejections

Claims 1, 8, and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over McKnight in view of Lamkin.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over McKnight in view of Lamkin and Samaras.

Claims 6, 7, 10 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over McKnight in view of Lamkin, Samaras and Jackson.

Claims 3, 4 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over McKnight in view of Lamkin, Samaras, Jackson and Weiser.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed June 15, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed April 6, 2006) and reply brief (filed July 14, 2005) for the appellant's arguments thereagainst.

OPINION

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

We turn first to the examiner's rejection of claims 1, 8 and 12 under 35 U.S.C. § 103 as being unpatentable over McKnight in view of Lamkin. We initially note that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

In regard to claim 1, the examiner's findings regarding the McKnight reference can be found on pages 3 and 4 of the answer. The examiner, recognizing that McKnight does not disclose that the elongated support stand is operatively pivotably connected to the lower body member, relies on Lamkin for this teaching. The examiner concludes:

Lamkin does disclose the support stand- at 2-3, is operatively pivotably connected to the lower body member-at 1- see for example figure 2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of McKnight et al. and add the support stand pivotably connected to the decoy body of Lamkin, so as to allow for the decoy to be movable into a variety of positions depending on the users preference [answer page 4].

Appellant argues that McKnight does not show that the first end portion 30 is shaped in three dimensions to resemble the head of a bird species.

We do not find this argument persuasive because Lamkin clearly discloses an artificial bird which is depicted in Figure 1 and thus discloses and suggests a lower body member which is shaped in three dimensions to closely resemble the head and neck of a bird species.

Appellant also argues that there is no motivation to modify the teachings of McKnight so as to pivotably connect the lower body member to the elongated support stand because McKnight discloses that the non pivotable support described in McKnight maintains the bird decoy in the proper orientation.

We do not find this argument persuasive because McKnight discloses that it is desirable to increase realism of the decoy by having the wing panels flap slightly in the wind (col. 3, lines 8 to 10). A person of ordinary skill in the art at the time of the invention would have been motivated to modify the decoy of McKnight so that the lower body portion pivots in the wind, so as to simulate the movement of a bird in flight, as taught by Lamkin (col. 1, lines 21 to 22) to thereby increase the realism of the McKnight decoy.

In view of the foregoing, we will sustain the rejection as it is directed to claim 1. We will also sustain this rejection as it is directed to claim 12 because the appellant does not argue the separate patentability of this claim.

In regard to claim 8, the appellant argues that neither McKnight nor Lamkin discloses an elongated support with a plurality of elongated prongs that are shaped and positioned to be received by a plurality of openings formed in the lower body member.

The examiner is of the opinion that the rivets 50 of McKnight are prongs that are shaped and positioned to be received in a plurality of openings formed in the lower body member at 22 (answer at page 5).

Even if we were to consider the rivets 50 to be elongated prongs, these prongs certainly are not shaped and positioned to be received by a plurality of openings in the lower body 22 in McKnight. There are not plurality of openings in McKnight but rather a

single notch 42 and the rivets 50 engage the flanges 48 and not openings in the flanges 48. Therefore, we will not sustain the rejection as it is directed to claim 8.

Each of the remaining claims is dependent on claim 8 and thus includes the subject matter of elongated prongs which engage a plurality of openings in the lower body member. Each of the remaining rejections relies on McKnight for teaching elongated prongs which engage a plurality of openings in the lower body member. Therefore, we will not sustain these rejections.

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**

TERRY J. OWENS )  
Administrative Patent Judge )  
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MURRIEL E. CRAWFORD ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS  
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JENNIFER D. BAHR )  
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