

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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Appeal No. 2006-1012  
Application No. 10/199,891  
Technology Center 3611

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ON BRIEF

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Before LEVY, NAPPI, and FETTING, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 4-9, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an advertising information display which is to be mounted on an exterior structure such as the front edge of a product supporting shelf

within a store specification, page 1). In particular, a spindle rotatably mounted on a housing has a pair of projections located on the spindle, and forming a gap therebetween (specification, page 8).

Claim 4 is representative of the invention, and is reproduced as follows:

4. A scroll advertising display device comprising:

a housing having an internal chamber;

a spindle mounted within said internal chamber, a sheet member having an inner end and an outer end, said inner end being attached by connection means to said spindle, a pull handle mounted on the outer end;

a windup spring located within said internal chamber, whereby said sheet member is to be wound on said spindle compressing of said windup spring and exerting a bias onto said spindle tending locate said sheet member in a tightly wound position with said handle located directly adjacent said housing, whereby said pull handle can be manually moved away from said housing causing extension of said sheet member exteriorly of said housing and upon release of said handle said bias of said windup spring will cause said sheet member to be rewound on said spindle; and

said spindle having a first collar formed at one end thereof, a first pair of thin, rod-like projections located in a spaced apart arrangement mounted on said collar forming a gap therebetween, said windup spring terminating at one end in a hook, said hook being slid within said gap.

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

Young

1,701,601

Feb. 12, 1929

Hwang	5,271,446	Dec. 21, 1993
Singletary et al. (Singletary)	4,346,749	Aug. 31, 1982
Milano et al. (Milano)	4,731,905	Mar. 22, 1988
Seidel	6,038,800	Mar. 21, 2000

Claims 4 and 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Seidel in view of Singletary or Milano.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Seidel in view of Singletary or Milano and further in view of Hwang.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Seidel in view of Singletary or Milano, and further in view of Young.

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 17, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed April 25, 2005) for the appellant's arguments thereagainst.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could

have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claims 4 and 7-9 under 35 U.S.C. § 103(a) as being unpatentable over Seidel in view of Singletary or Milano. We turn first to claim 4, the sole independent claim before us for decision on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467

(1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Ruskin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, page 3) is that Seidel does not disclose placing a pair of projections on a first collar formed on the spindle and placing a hook at the end of the spring. To overcome this deficiency of Seidel, the examiner turns to Singletary for a teaching of placing a hook on an end of a spring and a hook-shaped projection onto a collar formed on a spindle, in order to allow the spring to be securely attached to the housing (answer, page 4). In the alternative, the examiner (id.) relies upon Milano for a teaching of placing a pair of projections (on opposite sides of recess 27) onto a collar 14b, which is formed on a spindle. The examiner adds (id.) that "[t]he single hook shaped projection taught by Singletary et al. is considered to be equivalent to the applicant's pair of projections and would work equally as well."

Appellant's position (brief, page 5) is that the combination of Singletary with Seidel is in error because in Singletary, the hook end of the spring is attached to a housing and not a spindle. With regard to Milano, appellant asserts (brief, page 6) that the overhead door is quite far afield from a scroll advertising device, and that Milano does not disclose thin rod-like projections.

From our review of Singletary, we find that the reference does not disclose thin rod-like projections mounted on the collar, as recited in claim 4. Rather, the reference recites a hook-shaped end 20 on spring 18, which engages hook-shaped projection 19 of housing 11 (see figure 2). We are not persuaded by the examiner's assertion (answer, page 4) that the single hook-shaped projection taught by Singletary is the equivalent to appellant's pair of projections. The examiner's unsupported statement is not a substitute for evidence. As Singletary does not teach or suggest the claimed pair of thin rod-like projections mounted on the collar, we find that the combined teachings of Seidel and Singletary would have suggested the invention of claim 4.

Turning to Milano, we find that collar 14 has an enlarged cylindrical body portion 14a and a reduced integral neck portion 14b. Bore 20 extends through the neck and body portions (col. 2, lines 62-65). Neck portion 14 is provided with a longitudinal or axial slot 26. One of the inner walls defining the slot is provided with a semi-cylindrical and radially extending depression or recess 27 (col. 3, lines 11, 12 and 18-21).

From the disclosure of Milano, we find that the portion of neck portion 14b that has recess 27 does not include

a pair of rod-like projections mounted to the collar, and do not agree with the examiner (answer, page 6) that collar 14b of Milano includes a pair of rod-like projections. Rather, the edges of the recess are simply edges of neck 14b that have a recess therein. There are no rod-like projections and no rod-like projections mounted on the collar. Thus, even if we combined the teachings of Seidel and Milano, the resultant structure would not meet the limitations of claim 4.

From all of the above, we find that the examiner has failed to establish a prima facie case of obviousness of claim 4. The rejection of claim 4, and claims 7-9 which depend therefrom, under 35 U.S.C. § 103(a) as being unpatentable over Seidel in view of Singletary or Milano is reversed.

Turning to claims 5 and 6, we cannot sustain the rejections of these claims because the references to Hwang and Young fail to make up for the basic deficiencies of Seidel, Singletary and Milano. The rejection of claims 5 and 6 under 35 U.S.C. § 103(a) is reversed.

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CONCLUSION

To summarize, the decision of the examiner to reject claims  
4-9 under 35 U.S.C. § 103 is reversed.

REVERSED

STUART S. LEVY )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
ROBERT E. NAPPI ) APPEALS  
Administrative Patent Judge ) AND  
 ) INTERFERENCES  
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ANTON W. FETTING )  
Administrative Patent Judge )

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**Comment [jvn1]:** Type address

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