

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 UTA NAUERT

Appeal No. 2006-1147
Application No. 10/248,569
Technology Center 3600

ON BRIEF

Before FRANKFORT, OWENS, HORNER, *Administrative Patent Judges*.
HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-26, all of the claims pending in the application.

We reverse.

BACKGROUND

The appellant's invention relates to a hummingbird feeder having a liquid reservoir (14), a shade or hood (12), and a center post (16) connecting the hood to the reservoir. The hood is sized and positioned relative to the reservoir to provide shade to the reservoir. A copy of the claims, which provide further detail about the subject matter on appeal, can be found in the appendix to the appellant's brief.

The examiner relies upon the following as evidence of unpatentability:

Lathrop	697,343	Apr. 08, 1902
Barry	4,207,839	Jun. 17, 1980
Brown	5,269,258	Dec. 14, 1993
Runyon <i>et al.</i> (Runyon)	5,975,015	Nov. 02, 1999

The following rejections are before us for review.

1. Claims 1-4, 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Barry and Runyon.
2. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Barry and Runyon and further in view of Lathrop.
3. Claims 8, 9, 11-16, 18-23, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Barry.
4. Claims 10, 17 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Barry and Runyon.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the final office action (mailed January 12, 2005) and the examiner's answer (mailed March

23, 2006) for the examiner's complete reasoning in support of the rejections and to the appellant's brief (filed March 21, 2005) and reply brief (filed February 3, 2006) for the appellant's arguments.

OPINION

In reaching our decision in this appeal, we have carefully considered the appellant's specification and claims, the applied prior art, and the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow. It is our view that, after consideration of the record before us, the examiner has failed to establish a prima facie case of obviousness of the claims based on the prior art relied upon by the examiner.

Rejection of claims 1-4, 6, 7, 10, 17 and 24 as unpatentable over Brown as modified by Barry and further in view of Runyon

In the rejection of independent claim 1, the examiner has determined that Brown teaches a hummingbird feeder having a fluid reservoir (10) with a lid (40), a plurality of feed holes (42), a base (12), and a center post (20) with first and second ends. The fluid reservoir is attached to the first end of the center post (20). The examiner admits, "Brown is silent about an opaque shade having a diameter that is at least twice as large as a diameter of the fluid reservoir and connected to the second end of the center post such that the shade substantially covers the fluid reservoir." (Final Office Action, dated January 12, 2005, p. 2). The Examiner relies on Barry for the teaching of a bird feeder having an inverted, bowl-shaped

shade (1) having a diameter that is at least twice as large as a diameter of the fluid reservoir (2) and connected to the second end (5, 9, 7) of the center post such that the shade substantially covers the fluid reservoir. (Final Office Action, p. 2). The examiner found that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the bird feeder of Brown with the shade of Barry “in order to cover the fluid reservoir and its content therein from spoiling.” (Final Office Action, p. 3). The examiner relies on Runyon for the teaching of a feeder having an opaque shade (27). The examiner found that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an opaque shade on the bird feeder of Brown, as modified by Barry, “in order to further protect the food in the reservoir from being spoil [*sic*] by reflecting light from the sun.” (Final Office Action, p. 3).

The appellant contends that the examiner has failed to establish a prima facie case for obviousness, because (1) the examiner has failed to establish that one skilled in the art would have been motivated to combine Brown with Barry and Runyon, and (2) the examiner has failed to show that the references teach or suggest each and every element of the claimed invention. (Appellant’s Brief, p. 7). Specifically, the appellant argues that Brown teaches away from adding an opaque shade to its hummingbird feeder. (Appellant’s Brief, p. 6). The appellant further argues that Barry specifically teaches a shade that is dimensionally different from that called for in claim 1 and that is made from a transparent material. (Appellant’s Brief, pp. 6-7). The appellant argues that Runyon neither teaches nor suggests that its teachings relating to a seed feeder could be applied to a nectar-based

hummingbird feeder, and it does not teach a cover that provides the degree of coverage that is claimed. (Appellant's Brief, p. 7).

The examiner responded that shades are notoriously well known to be used in all types of feeders to protect the food from environmental factors that may spoil the food. (Examiner's Answer, pp. 3-4). The examiner further argued that the appellant failed to disclose a critical reason why the shade has to have a diameter that is at least twice the diameter of the reservoir and that a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). (Examiner's Answer, p. 4). The examiner also responded that it would have been obvious to use an opaque shade as taught in Runyon because it is merely a selection of a known material based on its suitability for the intended use as a matter of design choice. *In re Leshin*, 277 F.2d 197, 125 USPQ 416 (CCPA 1960). (Examiner's Answer, p. 5).

We disagree with the appellant's argument that Brown teaches away from adding a shade to its birdfeeder. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Kahn*, 441 F.3d 977, 990, 78 USPQ2d 1329, 1338 (Fed. Cir. 2006) (*quoting In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994)) (internal quotation marks omitted). Brown's description of its "perfect feeder" omits any mention of a shade of any kind. We do not agree that merely because Brown refers to the proposed feeder as "perfect" and omits any reference to a shade that this disclosure would lead one of

ordinary skill away from adding a shade to protect the reservoir from the elements.

As such, we do not find that Brown's description of its "perfect feeder" would discourage a person of ordinary skill from adding a shade to the Brown feeder to shelter the reservoir from the elements.

Nonetheless, we agree with the appellant that the examiner has failed to provide a convincing basis for a motivation to combine Runyon with Brown and Barry to make a hummingbird birdfeeder with an opaque shade. Neither Brown, Barry, nor Runyon teach or suggest using an opaque cover to provide shade to a fluid reservoir of a hummingbird feeder. As discussed above, Brown does not teach any cover on its hummingbird feeder. Barry teaches using a cover made of transparent material on a seed feeder to keep out the elements and pests. (Barry, col. 2, lines 64-65 "The cover and the container are constructed of polycarbonate.") Barry does not teach or suggest using its transparent cover to provide shade to the seed container. Likewise, Runyon relates to a seed feeder and thus does not face the same problem of spoilage of the feed from exposure to the sun as a nectar feeder. As such, although Runyon teaches generally that its cover (27) "may be opaque, translucent or transparent" (col. 4, lines 60-62), there is nothing in the teaching of Runyon that would have led one of ordinary skill in the art at the time of the invention possessed with the prior art Brown and Barry devices to have modified the cover of Barry to make it opaque as taught in Runyon absent the suggestion of the present specification, based on hindsight. Accordingly, we do not sustain the rejection of the claims based on the combination of Brown, Barry, and Runyon.

Rejection of claims 8, 9, 11-16, 18-23, 25, and 26 as unpatentable over Brown as modified by Barry

In the rejection of claims 8, 9, 11-16, 18-23, 25, and 26,¹ the examiner has determined that Brown discloses a hummingbird feeder as claimed except that Brown is silent about a hood positioned over the reservoir and having the dimensions as recited in the claims. (Final Office Action, pp. 4-8). The examiner found that it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the shade of Barry in the bird feeder of Brown, “in order to provide full coverage of the reservoir, thus preventing the food in the reservoir from being spoiled.” (Final Office Action, p. 5).

The appellant contends that Brown teaches away from using a cover at all in its “perfect feeder” and that Barry teaches a transparent cover that would not provide shade from direct sunlight as called for in the claims. (Appellant’s Brief, p. 10).

We agree with the appellant that the teachings of Brown and Barry would not have led a person of ordinary skill in the art at the time the invention was made to have constructed a hummingbird feeder having a cover that functions as a shade. As discussed above, Brown does not teach using any shade or cover on its

¹ Independent claims 8, 16, and 22 all require a structure to provide shade to the reservoir. Claim 8 requires a hood that is “constructed to shade the liquid reservoir from direct sunlight.” Claim 16 requires that a hood that “casts a shadow entirely over the reservoir for a majority of a travel distance of a light source passing over the feeder as the light source moves from a first horizon to a second horizon 180° from the first horizon.” Claim 22 requires that the feeder include, “means for providing shade to the means for providing sugar solution.” The appellant makes the same argument for patentability for independent claims 8, 16 and 22.

hummingbird feeder. Barry teaches using a transparent cover on a seed feeder “to protect the container and its contents from the elements and to provide a reduced access to pests.” (Barry, col. 1, lines 19-20). We find no suggestion in Barry to construct the cover for the feeder so that it provides shade to the feeder, because Barry relates to a seed feeder. Barry does not teach protecting the seed container from sun exposure. As such, there is no suggestion to use the cover of Barry to provide shade to the hummingbird feeder of Brown.

Further, even if the teachings of Brown and Barry were combined, the combination would not teach or suggest a hood or other means for providing shade to the reservoir. Rather, the combination would merely result in a hummingbird feeder with a transparent cover. Accordingly, we do not sustain the rejection of the claims based on the combination of Brown and Barry.²

² We note with regard to claim 22 that it recites, “wherein the means for providing sugar solution is a distance below the means for providing shade and the distance is less than a diameter of the *means for providing sugar solution*.” We question whether this is what the appellant intended to claim. The specification discusses a ratio of the distance 50 that the liquid reservoir 14 extends below the hood 12 to the diameter 30 *of the hood 12*. (Specification, page 6, para. [0030]). If further prosecution of this application is pursued, the appellant is encouraged to review this claim limitation for correctness.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-26 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

LINDA E. HORNER
Administrative Patent Judge

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