

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 CHRISTOPHER JAMES BROWN and DARRELL MICHAEL GRAMS

Appeal No. 2006-1513
Application No. 10/068,574
Technology Center [3600]

ON BRIEF¹

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21-33, which are all of the claims pending in this application.

We AFFIRM-IN-PART and enter a New Ground of Rejection under 37 CFR § 41.50(b).

¹ The Oral Hearing scheduled for June 8, was waived by appellants in a communication received, via facsimile, on June 5, 2006.

BACKGROUND

The appellants' invention relates to an animal decoy and a method for making an animal decoy (specification, page 1).

Claim 21 is representative of the invention, and is reproduced as follows:

21. A decoy comprising a three dimensional main body and a photograph containing animal features non-adhesively incorporated into said main body.

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

Palmer	3,029,541	Apr. 17, 1962
Tryon	3,707,798	Jan. 2, 1973

Claims 21-26, 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tryon.

Claims 27 and 30-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tryon in view of Palmer.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed November 19, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (filed September 2, 2003) and reply brief (filed December 21, 2005) for the appellants' arguments thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants 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, appellants' 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 21-26, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Tryon. We turn first to claim 21.

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. Rudkin-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 (final rejection, page 2) is that although Tryon uses an adhesive to attach the photograph to the main body, it would have been obvious to employ other means to attach the photographs, since the function is the same.

Appellants' position (brief, page 5) is that the claim requires the photograph containing the animal features to be non-adhesively incorporated into the main body. Appellants argue that the rejection fails because the examiner has not cited any reference that would teach or suggest non-adhesively incorporating the photograph containing the animal features into the main body. The examiner responds (answer, page 4) that:

The photos could be mounted by other means such as tacks, nails, clamps, paper clips, rivets, hook and loop fasteners, to name a few common ways to mount the photo to the main body. . . . if one did not have any adhesive, no stores were open and one wanted to go hunting for ducks or geese, then any of the above old and well known attachment means could be used to attach the photos to the main body.

From our review of the record, we find that Tryon refers to adhesively securing the printed photographs are applied to the body and wing with a suitable adhesive. The reference is silent as to securing the photographs in any manner other than with adhesives. In our view, the disclosure of securing the photographs, through the use of an adhesive is not, in and of itself, a teaching or suggestion to secure the photographs in a non-adhesive manner. The examiner's unsupported opinion is not a substitute for evidence. Accordingly, we find that Tryon fails to establish a prima facie case of obviousness of claim 21. The rejection of claim 21, along with claims 22-26 under 35 U.S.C.

§ 103(a) is reversed.

We turn next to independent claim 28. The claim recites “[a] decoy having a three dimensional main body formed from a plastic material and said main body having on its exterior surfaces a screen printed photograph containing animal features.”

Appellants assert (brief, page 6) that “[t]his claim is allowable because Tryon does not teach or suggest a decoy having a main body with a *screen printed photograph containing animal features* on the decoy exterior surfaces.”

We note at the outset that claim 28, unlike claim 21, does not recite that the photographs are attached in a non-adhesive manner. From our review of Tryon, we find that in describing the photographs taken, Tryon discloses that Kodachrome™ pictures are taken and that a four-color separation is made of each color picture. Following this, layouts are made. The layouts are printed on Scott Vellum Offset paper with Capital Inks, yellow, red, blue and black employed in the printing process (col. 3, lines 1-9). From the disclosure of Tryon, we find that the use of a four-color separation refers to the separate printing of one color at a time, which is done in a screen printing process. Thus, we find that Tryon teaches or suggests the use of a screen

printing of the photographs. Accordingly, we are not persuaded by appellants' assertion (brief, page 6) that Tryon is totally silent on the concept of screen printing. The rejection of claim 28 under 35 U.S.C. § 103(a) is affirmed.

We turn next to claim 29, which depends from claim 28. Appellants assert (brief, page 6) that the claim recites that the photograph contains corrections to allow the photograph to be screen printed, and argue that Tryon does not teach this because Tryon discloses trimming off excess material. The examiner's position (final rejection, page 3) is that "Tryon does not disclose the photographs containing corrections, but it would have been obvious to employ corrections in the photos to make the decoy as realistic as possible."

From our review of Tryon, we find that when the photographs are taken of a bird for use in the decoy, the photographs taken are used to make the layouts, which are printed. From the disclosure of making layouts from the photographs, we find that the making of layouts is silent as to whether the layouts are made from selecting photographs from among the group of photographs taken, or whether photographs, or portions thereof, are combined by a correction process. As a result, we would have to resort to speculation to find that Tryon teaches or suggests

the use of corrections for allowing a photograph to be screen printed onto the main body of the decoy. The examiner may not resort to speculation or unfounded assumptions to supply deficiencies in establishing a factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Stated differently, the subjective opinion of the examiner as to what is or is not obvious, without evidence in support thereof, does not provide a factual basis upon which the legal conclusion of obviousness can be reached. We therefore find that the examiner has failed to establish a prima facie case of obviousness of claim 29. The rejection of claim 29 under 35 U.S.C. § 103(a) is reversed.

We turn next to the rejection of claims 27 and 30-33 under 35 U.S.C. § 103(a) as being unpatentable over Tryon in view of Palmer. We begin with claim 27. We reverse the rejection of claim 27, which depends from claim 21, because although Palmer would have suggested to an artisan having a decoy head that is attachable to the decoy body, Palmer does not disclose attaching a photograph to the decoy in a non-adhesive manner. Accordingly, Palmer fails to make up for the deficiencies of Tryon. The rejection of claim 27 under 35 U.S.C. § 103(a) is reversed.

We turn next to independent claim 30. Appellants assert (brief, page 7) that neither reference teaches or suggests a decoy having a main body with a photograph containing animal features incorporated therein. Appellants acknowledge that although Palmer shows a main body having an orifice and a decoy having a head with a flange insertable into the orifice, that there is no motivation to modify Tryon to provide this feature.

From Palmer's disclosure (col. 1, lines 30-33) of providing a decoy of knockdown construction for transport in a compact condition, and Tryon's disclosure (col. 1, lines 35-38) that silhouette type decoys are preferred because they can be knocked down for easy storage when not in use, we find a suggestion of providing Tryon's decoy with a detachable head decoy. In addition, from Palmer's disclosure of a decoy having a body and an orifice and a head with a flange that is insertable into the orifice, we find that an artisan would have been motivated to provide Tryon's decoy with a head that is insertable into the body. We are not persuaded by appellants' assertion (brief, page 7) that the advantage of such a feature would be lost in Tryon once the photograph is attached to the head and body portion, because claim 30 does not recite a photograph attached to the head of the decoy. Rather the claim recites that a photograph is

incorporated into the body of the decoy. From all of the above, we find that the teachings of Tryon and Palmer would have suggested the language of claim 30. The rejection of claim 30 under 35 U.S.C. § 103(a) is affirmed. As claims 32 and 33 have not been separately argued by appellants, they fall with claim 30, from which they depend. The rejection of claims 32 and 33 under 35 U.S.C. § 103(a) is affirmed.

We turn next to claim 31. Appellants assert (brief, page 7) that the references do not teach or suggest a plurality of heads that are insertable into the body. From our review of the record, we are in agreement with the examiner (answer, pages 4-5) that from the disclosure of having an insertable head in Palmer, it would have been obvious to have provided a plurality of heads so that if one was lost, another could be inserted in its place. We add that it would have been an obvious duplication of parts to provide extra decoy heads in the kit. The rejection of claim 31 under 35 U.S.C. § 103(a) is affirmed.

We enter a New Ground of Rejection (37 CFR § 41.50(b)) of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Tryon in view of either Cromett (U.S. Patent No. 6,157,865) or Culp (U.S. Patent No. 6,057,012). As we found, supra, with respect to claim 21, Tryon discloses that the photographs are

secured to the decoy using an adhesive. Appellants assert (brief, page 5) that "the rejection fails because the Examiner has not cited any reference which would teach or suggest *non-adhesively incorporating the photograph containing the animal features into the main body.*" These two prior art references, located by the Board, teach attaching pictures or photographs to objects such as curios or propane tanks, through the use of non-adhesive processes (see col. 2, line 37; col. 3, lines 15-17, and col. 1, lines 42-45 of Cromett and col. 3, lines 12 and 13; col. 4, lines 7 and 8, and col. 1, lines 66 and 67 of Culp). From the disclosures of Cromett and Culp, we find that an artisan would have found it obvious to have secured the photographs of Tryon to the decoy without the use of adhesives as an obvious substitution of equivalent means for connecting the photograph to the decoy.

We add that because we are primarily a Board of review, that we have only applied the prior art to independent claim 21. We leave it to the examiner to determine whether this prior art and/or other prior art should be applied to any or all of the other claims whose rejection has been reversed in this decision on appeal.

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellants elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

CONCLUSION

To summarize, the decision of the examiner to reject claims 21-27 under 35 U.S.C. § 103(a) is reversed. The decision of the examiner to reject claims 28-33 under 35 U.S.C. § 103(a) is affirmed. In addition, we have entered a New Ground of Rejection of claim 21; 37 CFR § 41.50(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED IN PART; 37 CFR § 41.50(b)

TERRY J. OWENS)	
Administrative Patent Judge)	
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