

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BURTON S. RUBIN

Appeal No. 96-2860
Application No. 08/049,408¹

ON BRIEF

Before CALVERT, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 41 through 61, which are all of the claims pending in this application.²

¹ Application for patent filed April 20, 1993.

² The rejection of claims 41 through 61 under 35 U.S.C. § 112, second paragraph, made in the final rejection was overcome by the amendments filed on March 13, 1995 (Paper No. 10) and April 3, 1995 (Paper No. 13). See the Advisory Actions of March 21, 1995 (Paper No. 11) and April 26, 1995 (Paper No. 14).

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We REVERSE.

BACKGROUND

The appellant's invention relates to a hand-held implement. Claim 41 is representative of the subject matter on appeal and a copy of claim 41, as it appears in the appendix to the appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

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|-----------------------------|--------------|---------------|
| Bernstein | Des. 43,242 | Nov. 12, 1912 |
| Bingham | Des. 292,297 | Oct. 13, 1987 |
| Johnson et al. (Johnson) | 1,021,316 | Mar. 26, 1912 |
| Döppel | 1,497,363 | June 10, 1924 |
| Lipic, Jr. (Lipic) | 2,318,171 | May 4, 1943 |
| Wales | 2,621,688 | Dec. 16, 1952 |

Claims 41 through 61 stand rejected under 35 U.S.C. § 103 as being unpatentable over Döppel in view of Johnson, Wales, Lipic, Bingham and Bernstein.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 rejection, we make reference to the examiner's answer (Paper No. 17, mailed September 12, 1995) for the examiner's complete reasoning in

support of the rejection, and to the appellant's brief (Paper No. 16, filed June 7, 1995) 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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is not sufficient to establish a prima facie case of obviousness with respect to claims 41 through 61. Accordingly, we will not sustain the examiner's rejection of claims 41 through 61 under 35 U.S.C. § 103. Our reasoning for this determination follows.

The test for obviousness is what the combined teachings of the applied prior art 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). In rejecting claims under

35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art to make the modifications necessary to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

With this as background, we turn to the examiner's rejection of claim 41, the only independent claim on appeal.

Claim 41 recites a hand-held implement comprising, inter alia, a first curved body panel, a second curved body panel and an elongated snap-fit cartridge housing. Claim 41 further recites (1) that the first curved body panel has an elongated snap-fit post extending from an inner surface of the first panel, (2) that the elongated snap-fit cartridge housing has a first coaxial recessed groove, (3) that the elongated snap-fit post resiliently extends into the first coaxial recessed groove, and

(4) that the cartridge housing is substantially perpendicular to and non-coplanar with the elongated snap-fit post which extends beside the cartridge housing.

The examiner's complete statement of the rejection is:

Doppel discloses substantially similar structure including cartridge carrier (shank #11), plural grooves #24, and cooperating detent means #7. Doppel lacks the snap post detent means, plural panels and design shape. The use of a snap post detent means is disclosed by element #23 of Johnson, et al. It would have been obvious to a mechanic with ordinary skill in the art to substitute such detent means for the internal detent means of Doppel. The motivation for such a substitution is provide [sic, provided] by Wales which discloses both detent systems to be equivalent, see Figure 2 and Figure 9. Lipic, Jr. discloses the use of writing implement with reversible positions. Bingham discloses the use of a symmetrical panels and the design shape. Bernstein #43, 242 discloses the design shape. [answer, p. 3]

The appellant argues (brief, pp. 8-9) that a prima facie basis for the rejection of claim 41 was not presented since the applied prior art is "devoid of any evidence which would suggest any motivation for one of ordinary skill to modify the reference disclosures in the manner necessary to obtain the present invention." We agree. It is our opinion that when Döppel's detent means (ball 8 and spring 9) has been modified be a spring arm detent means as taught by Johnson's detent means (spring arm

22 and detent 23) that claim 41 is not readable on the resulting device. In that regard, the resulting device would not have an elongated snap-fit post which (1) extends from an inner surface of a panel, and (2) is substantially perpendicular to and non-coplanar with the cartridge housing. This is due to the fact that the resulting device would have been provided with a spring arm (similar to Johnson's spring arm 22) which would have extended parallel to the cartridge housing, not substantially perpendicular to the cartridge housing as recited in claim 41. We note that the spring arm of the resulting device must be considered to be part of the recited snap-fit post since the claim requires the snap-fit post to extend from the inner surface of the body panel.

The examiner's rejection set forth three differences between the claimed subject matter and Döppel (i.e., the snap post detent means, plural panels and design shape). The examiner's rejection then determined the obviousness of the snap post detent means. However, the examiner never determined the obviousness of the plural panels and the design shape.³ Thus, the examiner did not

³ While the examiner set forth the teachings of Bingham and Bernstein, this by itself, is not a determination of obviousness.

establish the obviousness of defining Döppel's cap 1 from plural panels. Additionally, Döppel's depressions 24 are not readable on the coaxial recessed groove as recited in claim 41. The examiner never determined that it would have been obvious to one of ordinary skill to modify Döppel's depressions 24 to be a coaxial recessed groove.

In summary, we see no motivation in the applied prior art of why one skilled in the art would have modified the device of Döppel to make the modifications necessary to arrive at the claimed invention. Thus, the examiner has failed to meet the initial burden of presenting a prima facie case of obviousness.⁴ Thus, we cannot sustain the examiner's rejection of appealed independent claim 41, or claims 42 through 61 which depend therefrom, under 35 U.S.C. § 103.

⁴ Note In re Rijckaert, supra; In re Lintner, supra; and In re Fine, supra.

CONCLUSION

To summarize, the decision of the examiner to reject claims 41 through 61 under 35 U.S.C. § 103 is reversed.

REVERSED

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| IAN A. CALVERT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHARLES E. FRANKFORT |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| |) | |
| JEFFREY V. NASE |) | |
| Administrative Patent Judge |) | |

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ATTN: DOUGLAS MUELLER
MERCHANT, GOULD, SMITH, EDELL,
WELTER & SCHMIDT, P.A.
3100 NORWEST CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS, MN 55402

APPENDIX

41. A hand-held implement comprising:

a first curved body panel having an inner surface and an outer surface;

an elongated snap-fit post extending from said inner surface of said first panel, having a first end attached to said inner surface of said first curved body panel and having a free second end;

a second curved body panel, having an inner surface and an outer surface, attached to said first body panel so as to define a receptacle for an elongated snap-fit cartridge housing; and

an elongated snap-fit cartridge housing having a first coaxial recessed groove, said cartridge housing being removably located within said elongated snap-fit cartridge housing receptacle by said elongated snap-fit post resiliently extending into said first coaxial recessed groove, said cartridge housing being substantially perpendicular to and non-coplanar with said elongated snap-fit post, said elongated snap-fit post extending beside said cartridge housing,

wherein said elongated snap-fit post is enclosed within an assembled body of the hand-held implement, said assembled body being defined by said first curved body panel and said second curved body panel.

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APJ NASE

APJ CALVERT

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 07 Jan 98

FINAL TYPED: