

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte THOMAS GEORGE KOTSIPOULOS

Appeal No. 2003-1288
Application No. 09/338,158

ON BRIEF

Before STAAB, McQUADE, 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 5 to 12. Claims 2 to 4, the only other claims pending in this application, have been allowed.

We REVERSE.

BACKGROUND

The appellant's invention relates to apparatus and methods for inserting coupons into containers moving along a high volume handling system (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

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|--------------------------|-----------|---------------|
| Roetter et al. (Roetter) | 4,261,497 | Apr. 14, 1981 |
| Lewis et al. (Lewis) | 4,468,912 | Sept. 4, 1984 |

Claims 5 to 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roetter in view of Lewis.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 20, mailed December 20, 2002) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 19, filed November 5, 2002) and reply brief (Paper No. 21, filed February 20, 2003) 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 insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 5 to 12 under 35 U.S.C. § 103. Our reasoning for this determination follows.

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 would have led one of ordinary skill in the art to combine the relevant teachings of the references 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, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the obviousness rejection before us in this appeal (answer, p. 3), the examiner (1) set forth the relevant teachings of Roetter; (2) ascertained that Roetter does not show "the concept of supplying coupons into a particular location as claimed;"

(3) determined that Lewis teaches "the basic concept of inserting coupons onto cartons;" and (4) concluded that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Roetter with coupon inserting means as taught by Lewis to insert a desired product.

The rejection fails to set forth a prima facie case of obviousness with respect to the claims under appeal since the teachings of Lewis fail to suggest the stated shortcomings of Roetter. The examiner ascertained that Roetter does not show supplying coupons **into** a particular location as claimed and determined that Lewis teaches inserting coupons **onto** cartons. In our view, absent the use of impermissible hindsight,¹ the combined teachings of Roetter and Lewis would have, at best, suggested placing coupons separated from a web of coupons as taught by Roetter **onto** a carton as taught by Lewis. The combined teachings of Roetter and Lewis do not teach or suggest supplying coupons **into** a particular location as claimed. Accordingly, the decision of the examiner to reject claims 5 to 12 under 35 U.S.C. § 103 is reversed.

¹ The use of hindsight knowledge derived from the appellant's own disclosure to support an obviousness rejection under 35 U.S.C. § 103 is impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

CONCLUSION

To summarize, the decision of the examiner to reject claims 5 to 12 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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STEVEN & TRYBUS
ROPER & QUIGG
200 SOUTH MICHIGAN AVENUE
SUITE 1000
CHICAGO, IL 60604

JVN/jg