

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(2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARROLL J. VOISIN, JR.

Appeal No. 95-4673
Application 08/097,759¹

ON BRIEF

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

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed July 26, 1993.

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This is a decision on appeal from the examiner's final rejection of claims 10 through 20. Subsequent to the Notice of Appeal (Paper No. 9) and in response to an amendment filed January 13, 1995 (Paper No. 10), the examiner, in an advisory action mailed February 24, 1995 (Paper No. 11), has indicated that the rejection of claims 10 through 20 on non-reference grounds (i.e., under 35 U.S.C. § 112, second paragraph) has been overcome and that claims 13 and 17 through 20 are now objected to as being allowable subject to being rewritten in independent form. Accordingly, the appeal as to claims 13 and 17 through 20 is dismissed, leaving only claims 10 through 12 and 14 through 16 for our consideration on appeal. Claims 1 through 9 have been canceled.

Appellant's invention relates to a paint can holding device which can be suspended from a person's belt, support a paint can from the paint can's handle attachment members, and provide pivot means for keeping the paint can upright. Independent claim 10 is representative of the subject matter on appeal and a copy of that claim, as it appears in the Appendix to appellant's brief, is attached to this decision.

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The references of record relied upon by the examiner in rejections of the appealed claims under 35 U.S.C. § 103 are:

Haney, Jr. (Haney)	2,753,094	July 3, 1956
Kesterson	Des. 276,760	Dec. 18, 1984
Hayes	4,527,720	July 9, 1985

Claims 10 through 12 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hayes in view of Kesterson.

Claims 14 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hayes in view of Kesterson as applied to claim 10 above, and further in view of Haney.

Rather than reiterate the examiner's explanation of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 13, mailed April 21, 1995) for the examiner's full reasoning in support of the rejections, and to appellant's brief (Paper No. 12, filed March 13, 1995) for appellant's arguments thereagainst.

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OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's above-noted rejections of the appealed claims under 35 U.S.C. § 103 cannot be sustained. Our reasons follow.

The proper test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. See Cable Elec. Prods. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). The law followed by our court of review, and thus by this Board, is that "[a] prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA

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1976). A rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he/she advances. The examiner may not, because he/she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1016-17, 154 USPQ 173, 177-78 (CCPA 1967).

In this case, essentially for the reasons stated by appellant in the brief (pages 5-9), we find that the examiner's rejection of claims 10 through 12 and 14 through 16 under 35 U.S.C. 103 is not sustainable. Like appellant, we are of the opinion that the examiner has inappropriately relied upon hindsight and improperly used appellant's own disclosure and teachings as a guide through the prior art references and the individual features thereof in attempting to combine only a selected one of those features (i.e., the notches) in a modification of the Hayes paint can holder so as to arrive at the claimed subject matter.

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Unlike the examiner, we see nothing in the combined teachings of Hayes and Kesterson which would have led one of ordinary skill in the art to replace the bail receiving arrangement at the ends of each of the support arms of the support member (12) of Hayes with notches like those seen in the design patent to Kesterson. In this regard, we also share appellant's view that neither Hayes nor Kesterson teaches or suggests opposed notches in support arms of a paint can holder which are (1) sized to receive the can handle attaching members protruding from opposite sides of the paint can and (2) positioned on the support arms to permit the paint can to pivot about the attaching members when the attaching members are received in said opposed notches, as is required in appellant's independent claim 10 on appeal.

Our review of the Haney patent applied by the examiner against dependent claims 14 through 16 does nothing to change our view regarding the basic combination of references to Hayes and Kesterson. That is, there is nothing in Haney which supplies the above-noted deficiencies of the examiner's basic combination of references.

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Based on the foregoing, the decision of the examiner
rejecting claims 10 through 12 and 14 through 16 under 35
U.S.C. § 103 is reversed.

REVERSED

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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

APPENDIX

10. A holder attachable to a belt worn by a person to hold a can having a sidewall, a bottom and a removable top lid to form a liquid containing chamber and having attaching means protruding from opposite sides of said sidewall to which a handle is pivotally attached, said holder comprising:

(a) a can holding member comprising:

(i) a rigid back plate, and

(ii) rigid support arms extending from said back plate to form a gap between said support arms of sufficient distance to allow said can sidewall to pass between said arms, said support arms having opposing notches sized to receive said attaching means and positioned on said support arms to permit said can to pivot about said attaching means when said attaching means are received in said opposing notches; and

(b) a belt suspension member having two ends, said first end of said belt suspension member being attachable to said belt and said second end of said belt suspension member being pivotally attachable to said back plate.

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