

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* NORMA F. ROSENHAIN

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Appeal No. 97-0672  
Application No. 08/329,086<sup>1</sup>

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ON BRIEF

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Before CALVERT, *Administrative Patent Judge*, McCANDLISH, Senior Administrative Patent Judge and ABRAMS, *Administrative Patent Judge*.

ABRAMS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 1 through 11, which constitute all of the claims of record in the application.

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<sup>1</sup> Application for patent filed October 25, 1994.

The appellant's invention is directed to a two piece utensil holding container. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. A two-piece utensil holding container comprising:

a rigid inner member having a body portion with an interior and exterior surface, an open top and a closed bottom;

a supple, sleeve member mounted about the exterior surface of the body portion of the inner member, said sleeve member having an inner and outer surface, said outer surface of said sleeve member having a three-dimensional decorative image molded thereon, said decorative image including a portion defining at least one gripping member, which is configured to engage and removably hold a utensil.

#### THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Zent et al. (Zent) 1949	2,484,776	Oct. 11,
Engvall 1993	5,178,354	Jan. 12,
United Kingdom Design Patent 22, 1993 (Chan)	2,023,013	Feb.

#### THE REJECTION

Claims 1-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chan in view of Engvall and Zent.

The rejection is explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

#### OPINION

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the

knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The appellant's invention is directed to a cup that is configured to retain a utensil, such as a toothbrush, upon its decorative exterior surface. As defined in independent claim 1, it comprises a two-piece container having a rigid inner member and a supple sleeve mounted about the exterior surface of the inner member. A three-dimensional decorative image is molded on the outer surface of the sleeve, and this decorative image includes "a portion defining at least one gripping member, which is configured to engage and removably hold a utensil."

It is the examiner's position that Chan shows the claimed structure except for the gripping member, but that it would have been obvious to one of ordinary skill in the art to add such a feature in view of the teachings of Engvall and Zent.

Chan discloses a design which is described as "a mug with a detachable outer coating." There is no clue as to whether the outer coating is "a supple, sleeve member" as is required by the claim. Although the drawings are barely discernible, it is clear that Chan has no structure which could function as a "gripping member . . . configured to engage and removably hold a utensil." Engvall discloses an aerosol dispenser that has a gripping member attached to its side to removably hold a tube through which the aerosol material can be dispensed. Zent discloses a decorative cover for a bottle which comprises a three-dimensional decorative figure. The decorative figure has bendable arms, to one of which is attached a candy cane. There is no explicit teaching that the arms be used to removably hold a receptacle, nor is it apparent that they are capable of doing so.

It is axiomatic that the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to perceive any teaching, suggestion or incentive in either of the secondary references which would

have suggested to one of ordinary skill in the art the desirability of modifying the Chan device so that it can removably hold a utensil, much less doing so by means of a gripping member defined in the decorative image. While it could be concluded that Engvall would have suggested to one of ordinary skill in the art that a utensil holder be installed on the outside surface of the Chan device, it would not have motivated the artisan to define the holder by a portion of the decorative image, as is required by the claims. As for Zent, we are at a loss to appreciate what this reference adds to the rejection.

It therefore is our conclusion that the combined teachings of the three applied references fail to establish a *prima facie* case of obviousness with regard to the subject matter of claim 1. This

being the case, we will not sustain the rejection of claim 1 or, it follows, of dependent claims 2-11.

The decision of the examiner is reversed.

**REVERSED**

IAN A. CALVERT )  
Administrative Patent Judge )  
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) BOARD OF PATENT  
HARRISON E. McCANDLISH ) APPEALS  
Senior Administrative Patent Judge )  
) AND )  
) INTERFERENCES  
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REVERSED

Prepared: July 18, 2000