

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY H. WALLING

Appeal No. 1997-2107
Application No. 08/309,577¹

ON BRIEF

Before GARRIS, WARREN and SPIEGEL, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection

¹ Application for patent filed September 21, 1994.

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of claims 1 and 9 which are all of the claims remaining in the application.

The subject matter on appeal relates to a method of applying a filler material to a fill hole with a size and a shape in a surface comprising the steps of placing on said surface a putty application tool having an aperture approximately equal to said size and said shape of said hole, positioning the tool such that its aperture is substantially aligned over the hole, inserting the filler material into the hole through the aperture of the tool, removing excess filler material from the tool, and removing the putty application tool from the surface before the filler material dries. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. A method for applying a filler material to fill a hole with a size and a shape in a surface, comprising the steps of:

providing a putty application tool with an aperture, said aperture being approximately equal to said size and said shape of said hole;

placing said putty application tool on said surface such that said putty application tool is slidable thereon;

positioning said putty application tool such that said aperture is substantially aligned over said hole;

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inserting said filler material into said hole through said aperture of said putty application tool;

removing excess filler material disposed on said putty application tool; and

removing said putty application tool from said surface before said filler material dries.

The reference set forth below is relied upon by the examiner as evidence of obviousness:

Hardman
1982

4,351,508

Sep. 28,

Claims 1 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hardman.

We refer to the Brief and to the Answer for a complete exposition of the respective viewpoints expressed by the appellant and the examiner concerning the above noted rejection.

OPINION

The rejection before us cannot be sustained. As correctly indicated by the appellant, Hardman contains no teaching or suggestion of the independent claim step of

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"removing said putty application tool from said surface before said filler material dries." On the contrary, again as correctly indicated by the appellant, patentee explicitly discloses leaving his dam or tool in place until the filling compound or material is set and dried (e.g., see the paragraph bridging columns 4 and 5 and lines 22 through 35 in column 5).

The examiner describes her position concerning the step on page 5 of the Answer with the following language:

With respect to the instant step of removing the tool before the filler material dries, it is noted that this was a generally well known and conventional technique in the art at the time of appellant's invention to allow for quicker repeated use of the tool, and thus one having ordinary skill in the art would have readily recognized this as an alternative in the process of Hardman to allow for quicker plugging of more apertures, as was generally well known and conventional in the art at the time of appellant's invention.

As reflected by our earlier remarks, however, Hardman contains disclosure which reflects that the removal step under consideration "was a generally well known and conventional technique in the art at the time of appellant's invention" as asserted by the examiner. Rather, the only disclosure on the record before us which teaches such a technique appears in the appellant's own specification.

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These circumstances lead us to the determination that the examiner's conclusion of obviousness is based upon impermissible hindsight derived from the appellant's own disclosure rather than some teaching, suggestion or incentive derived from the applied prior art. It follows that the examiner's § 103 rejection of claims 1 and 9 as being unpatentable over Hardman is improper and cannot be sustained.

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The decision of the examiner of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES F. WARREN)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
CAROL A. SPIEGEL)	
Administrative Patent Judge)	

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