

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARRY D. ARBUCKLE

Appeal No. 97-2780
Application 08/456,109¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge and
FRANKFORT and NASE, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL
and
REMAND TO THE EXAMINER

This is a decision on an appeal from the examiner's final rejection of claims 1 through 6 under 35 U.S.C. § 103. No other claims are pending in the application.

¹ Application for patent filed May 31, 1995.

Appeal No. 97-2780
Application 08/456,109

Appellant's claimed invention relates to a novelty display device or novelty display item, as it is called in the appealed claims. According to claim 1, the only independent claim on appeal, the novelty display item comprises a plurality of lightweight objects (4-6) each formed of a soft foam resilient material, a rigid base (7) having an array of holders for holding the lightweight objects, and a label (8-10) with a different lettered message attached to the base under each object.² As disclosed in appellant's specification, the novelty display item may be used in a meeting in which participants are free to select one of the lightweight objects, depending upon the message on the associated label, and to toss the selected object at the speaker.

A copy of the appealed claims is appended to appellant's brief.

² The recitation of "a respective cavity" in line 7 of claim 1 lacks antecedent basis. However, when read in context with the remainder of the claim, it is apparent that the cavity is intended to refer to the specific form of the holder for each lightweight object. Although this informality does not obscure the metes and bounds of the claimed invention, it nonetheless is deserving of correction in the event of further prosecution before the examiner.

Appeal No. 97-2780
Application 08/456,109

The following references are relied upon by the examiner as evidence of obviousness in support of his rejection under 35 U.S.C. § 103:

Kelling	3,073,661	Jan. 15, 1963
Alton	4,955,485	Sep. 11, 1990

Claims 1 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Alton in view of Kelling. According to the examiner's findings (see pages 3-4 of the answer), Alton discloses a display base having a plurality of cavities for displaying baseballs or other items. Based upon his analysis of the scope and content of the Alton reference, the examiner concedes that Alton lacks a teaching of labels on the base (see page 3 of the answer) and, also, a teaching of forming the displayed items or objects from a soft, foam resilient material as called for in appealed claim 1 (see pages 4-5 of the answer).

With regard to the difference pertaining to the labels, the examiner concludes that the teachings of Kelling would have made it obvious "to modify Alton by attaching labels to

Appeal No. 97-2780
Application 08/456,109

the base since this would allow additional information to be displayed with regard to the balls placed on the base" (answer, page 4). With regard to the difference pertaining to the material used to form the displayed objects, the examiner asserts that because "soft foam rubber balls are well known in the art, it is considered to have been obvious to one [of ordinary skill] in the art to modify Alton by using soft foam rubber balls instead of baseballs since foam balls are just one of the many types of balls that could be stored on the base" (emphasis added; answer, page 4). The examiner additionally maintains on page 5 of the answer that "[i]t is considered to be within one skilled in the art [sic, within the skill of the art] to place any known type of spherical object on the stand of Alton . . ."

Even if it is assumed arguendo that it would have been obvious to provide labels on Alton's base, we nonetheless cannot agree that the examiner has made out a prima facie case of obviousness with respect to the claimed subject matter. In the first place, the mere fact that Alton's display device "could be" modified to form the balls from a soft foam

Appeal No. 97-2780
Application 08/456,109

material as proposed by the examiner, would not have made the modification obvious unless the prior art suggested the desirability of making the modification. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Moreover, the mere fact that soft foam rubber balls "are well known in the art," presumably in the prior art, also is insufficient basis by itself for establishing the requisite motivation for modifying the display device of Alton. See Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1549, 220 USPQ 193, 199 (Fed. Cir. 1983) and Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F.2d 955, 959, 1 USPQ2d 1196, 1198 (Fed. Cir. 1986). Furthermore, in making a determination of obviousness under § 103, the criterion is not measured in terms of what would have been within the level of ordinary skill in the art as intimated by the examiner on page 5 of the answer. Instead, there must be some teaching, suggestion or inference in the prior art as a whole or some knowledge generally available to one of ordinary skill in the art that would have led one of ordinary skill in the art to make the modification needed to arrive at the claimed

Appeal No. 97-2780
Application 08/456,109

invention. See inter alia, In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed Cir. 1988). No such suggestion is found in the prior art relied upon by the examiner.

Based on the prior art before us, we therefore cannot sustain the examiner's § 103 rejection of the appealed claims.

This application is herewith remanded to the examiner to consult with the examiner who examines in Class 273 to determine if there is a relevant field of search in Class 273.

The examiner's decision rejecting appealed claims 1 through 6 is reversed.

Appeal No. 97-2780
Application 08/456,109

REVERSED

)
HARRISON E. McCANDLISH, Senior))
Administrative Patent Judge))
))
))
) BOARD OF PATENT)
CHARLES E. FRANKFORT))
Administrative Patent Judge) APPEALS AND)
))
) INTERFERENCES)
))
JEFFREY V. NASE))
Administrative Patent Judge))

HEMc:yr

Appeal No. 97-2780
Application 08/456,109

John R. Benefiel
280 Daines Street
Suite 100 B
Birmingham, MI 48009-6244