

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LLOYD A. BABCOCK, JR.

Appeal No. 97-3068
Application No. 08/389,904¹

ON BRIEF

Before COHEN, MEISTER, 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 1 through 11, 14 and 15, which are all of the claims pending in this application.²

¹ Application for patent filed February 16, 1995.

² Claims 1, 3, 5, 11 and 15 were amended subsequent to the final rejection. Since the examiner did not include the rejection of claims 1 through 11, 14 and 15 under 35 U.S.C. § 112, second paragraph, in the examiner's answer, we presume that this ground of rejection raised in the final rejection

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We REVERSE.

has been withdrawn by the examiner.

BACKGROUND

The appellant's invention relates to a fence wire dispensing apparatus. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears 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:

Demmien	1,256,443	Feb. 12, 1918
Therrien	2,664,253	Dec. 29, 1953
Byfield, Jr. (Byfield)	4,579,358	April 1, 1986

Claims 1 through 5 and 7 through 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Byfield in view of Therrien.

Claims 6, 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Byfield in view of Therrien and Demmien.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14, mailed March 18, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 13, filed November 25, 1996) 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 1 through 11, 14 and 15 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 the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual 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). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt

that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we turn to the examiner's rejection of claim 1, the only independent claim on appeal.

Claim 1 recites an apparatus for dispensing wire strands from wire spools for construction of a wire fence, the apparatus comprising, inter alia, a frame, a plurality of wire spool receiving compartments wherein each compartment isolates each of the wire spools from all other wire spools, and guide means associated with each compartment. Claim 1 further recites that the plurality of wire spool receiving compartments include a first row of laterally disposed compartments and a second row of laterally disposed compartments disposed at a vertical location that is above the first row of laterally disposed compartments. Claim 1 also

recites that each of the guide means is laterally separated from adjacent guide means.

Byfield discloses a rack for spooled wire. As shown in Figure 1, the rack includes a plurality of shelves 12 containing numerous apertures 13 in which spindles 14 can be inserted. On or near the outer edge of each shelf 12 is a wire guide 16 through which wire from a spool of wire can be drawn.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Byfield and claim 1, it is our opinion that one difference is the limitation that the plurality of wire spool receiving compartments include a first row of laterally disposed compartments and a second row of laterally disposed compartments disposed at a vertical

location that is above the first row of laterally disposed compartments.

With regard to this difference, the examiner determined (answer, p. 5) that

[t]o provide a "compartment" (as disclosed) for each spool would have been obvious to a person having ordinary skill in the art seeking to protect each spool from the environment (including from adjacent spools) or for aesthetic purposes. However, it should also be noted that "compartment" is merely defined as a "partitioned space" which is shown by Byfield, Jr. since holes 13 for the spindles are spaced apart by a predetermined space.

We do not agree for the reasons set forth below.

First, Byfield does not disclose a rack having the recited compartments. While the rack of Byfield (see Figure 1) does define two compartments defined between the three shelves 12, Byfield does not disclose a first row of laterally disposed compartments and a second row of laterally disposed compartments disposed at a vertical location that is above the first row of laterally disposed compartments as recited in claim 1. In that regard, claim 1 recites that each compartment isolates each of the wire spools from all other

wire spools. Clearly, the space between Byfield's shelves 13 define but one compartment capable of isolating wire spools in one compartment from the wire spools in the other compartment.

Second, the examiner's determination that it would have been obvious to provide a "compartment" for each spool to protect each spool from the environment (including from adjacent spools) or for aesthetic purposes is unsupported by any evidence. There is no objective teaching in the applied prior art³ or knowledge generally available to one of ordinary skill in the art that would have led that individual to modify Byfield's rack to arrive at the claimed invention. Thus, we agree with the appellant's argument (brief, pp. 9-10, 13-14, and 16-18) that the applied prior art would not have been suggestive of the claimed invention, absent impermissible hindsight.

³ We have also reviewed the references to Therrien and Demmien applied by the examiner, but find nothing therein which makes up for the deficiencies of Byfield discussed above.

For the reasons set forth above, the decision of the examiner to reject claims 1 through 11, 14 and 15 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 11, 14 and 15 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APJ NASE

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APJ MEISTER

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 06 Oct 98

FINAL TYPED: