

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARROL H. GENEREUX

Appeal No. 97-4078
Application No. 08/232,947¹

ON BRIEF

Before FRANKFORT, NASE and DIXON, **Administrative Patent Judges.**

DIXON, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-5,² which are all of the claims pending in this application.

¹ Application for patent filed April 25, 1994.

² Claim 1 was amended by entry of the amendment after final filed August 7, 1996.

BACKGROUND

The present invention relates to an apparatus for temporarily retaining sunglasses on a vehicle sunvisor. The invention is an improvement in a retaining clip which uses several retaining features to provide positive retention of the sunglasses, easy insertion of the sunglasses past camming surfaces of plural nubs and ready removal of the sunglasses by actuation of a lever which pivots the clip jaw to release the sunglasses taking advantage of the differential camming of the nubs.

Appellant has indicated that claims 1 and 5 stand or fall together, but claims 2, 3 and 4 do not stand or fall together. (See brief³ at page 5.)

Independent claim 1 is representative of the invention and reproduced as follows:

1. A clip for securing sunglasses and like articles to a vehicle sunvisor comprising a pair of longitudinally extended jaws extending from a common base in opposed relation along substantially their entire lengths and arranged for clasping a sunvisor there-between, one of said jaws being separable from said sunvisor, a plurality of nubs along said one jaw longitudinally spaced to receive said articles therebetween in mounting relation to said sunvisor, each of said nubs having a differential camming surface preferentially facilitating sliding of said articles out of position between said nubs over sliding into position between said nubs, and a lever extending from one of said jaws for pivoting said one jaw relative to the sunvisor a distance which taken with said preferential camming surface of said nubs allows said articles to pass readily into or out of position between said nubs.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

³ Appellant filed a substitute appeal brief, February 25, 1997, (Paper No. 18) to replace the non-compliant appeal brief filed November 8, 1996, (Paper No. 16). We will refer to this substitute appeal brief as simply the brief.

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Gaudino	3,300,168	Jan. 24, 1967
Carter-Mann	5,314,151	May 24, 1994 (filed Dec. 11, 1992)

Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gaudino in view of Carter-Mann.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the appellant, we make reference to the brief and answer⁴ for the details thereto.

OPINION

After a careful review of the evidence before us, we disagree with the Examiner that claims 1-5 are properly rejected under 35 U.S.C. § 103 and we will not sustain the rejection of claims 1-5.

As a consequence of our review, we make the determinations which follow.

Turning to the rejection of independent claim 1, we find that the Examiner has not met the burden of setting forth a *prima facie* case of obviousness in rejecting claim 1. As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). The claim sets forth "a plurality of nubs along said one jaw longitudinally spaced to receive said articles therebetween in mounting relation to said

⁴ The Examiner responded to the brief (Paper No. 18) with an examiner's answer mailed May 28, 1997, (Paper No. 19). We will refer to this examiner's answer as simply the answer. The case was remanded to the Examiner on July 21, 1998 for entry of an after-final amendment. The file jacket indicates a second examiner's answer, but this is merely a letter to appellant indicating entry of the after-final amendment dated August 7, 1996.

sunvisor, each of said nubs having a differential camming surface preferentially facilitating sliding of said articles out of position between said nubs over sliding into position between said nubs." The Examiner has not addressed this limitation in the rejection of claim 1 nor in the argument section of the examiner's answer. Appellant argues that Gaudino does not address the problem solved by appellant. (See brief at page 8 and page 6.) The clip is "more or less permanently mounted" and "readily opened again and again so as to repeatedly insert and remove, e.g. sunglasses, without dislodging the clip. . . there is no preferential camming of the nubs to facilitate insertion [sic, removal] , but not removal [sic, insertion] as in applicant's device." (See brief at page 8). A review of the Gaudino patent shows merely uniform nubs which do not contain differential camming surfaces preferentially facilitating sliding articles out of position as required by the language of claim 1. Furthermore, the Examiner has not provided a line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Gaudino to have the differential camming surfaces rather than the uniform camming surfaces as illustrated in Figures 1 and 2 of Gaudino.

Appellant argues throughout the brief that the Gaudino patent does not teach a "lever extending from the jaws" and neither does the Carter-Mann patent. (See brief at page 6-10.) We agree, but note that Gaudino discloses extensions of flat members, 12 and 14, which extend beyond the web member, 16, which acts as a fulcrum "so that the visor clip 10 may be easily and with facility applied to a vehicle sun visor." (See Gaudino,

col. 1, lines 44-45.) These extensions ending with nubs, 50 and 52, would act as levers rather than the asserted levers, 60 and 62, as asserted by the Examiner. We do not agree with the Examiner that "the levers [60 and 62 of Gaudino] *inherently* provide a moment arm to open the jaws of the visor secured clip upon pulling them." (See answer at page 3; emphasis added.) Furthermore, we disagree with the Examiner that it would have been obvious "in view of Carter-Mann (figure 5) in which the flanges 18 and 20 are similarly *inherently* readily manipulable to open the jaws 14, 16. These levers can also be pulled if so desired so as to separate the jaws by providing a moment arm about the base 12." (See answer at page 3-4; emphasis added.) We note that the disclosure of Carter-Mann is silent as to the function of these flanges beyond the support and placement of trash can liner bags. Appellant argues "the grand fallacy in the Action is the reliance on alleged inherency to put into the Carter-Mann reference alleged disclosure of levers." (See brief at page 8.) We agree with appellant, and we do not find that these flanges are intended to function in the manner asserted by the Examiner. We find that these inherencies asserted by the Examiner are merely speculation by the Examiner in hindsight reconstruction of appellant's claimed invention. The Examiner has further elaborated upon the asserted inherent properties of the flanges/levers without considering the overall teachings of the Gaudino patent and Carter-Mann patent. The asserted levers of Gaudino, 60 and 62, are clearly disclosed for retaining pencils, pens or the like (see col 2, lines 1-5) and further may retain cigars or cigarettes. (See col. 2, lines 9-15.) Both Gaudino and Carter-Mann

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are silent as to the use of the asserted structures to function as "a lever for pivoting one of the jaws relative to the sun visor . . . allows said articles to pass readily into or out or position between said nubs." The flanges 18 and 20 disclosed by Carter-Mann are merely disclosed to support/attach trash can liners for different size liners and different size cans. The Examiner has not provided any suggestion why it would have been obvious to one of ordinary skill in the art at the time of the invention to use any of the flanges in the Gaudino patent or Carter-Mann patent as "a lever . . . allows said articles to pass readily into or out of position between said nubs" as recited in the language of claim 1.

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, 178 (CCPA 1967), ***cert. denied***, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., *Grain Processing Corp. v. American Maize-Products Co.***, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). Since all the limitations of independent claim 1 are neither taught nor suggested by the applied prior art, we cannot sustain the Examiner's rejection of appealed claim 1 under 35 U.S.C. § 103.

