

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD SPECTOR

Appeal No. 1998-0235
Application No. 08/709,764

ON BRIEF

Before CALVERT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1, 4, 5 and 8, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a toy projectile and platform assembly. A copy of claim 1 under appeal is set forth in the opinion section below. A copy of claims 4, 5 and 8 under appeal is set forth 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:

Uhrig 1904	773,692	Nov. 1,
Flora 1907	847,755	Mar. 19,
Fortunato 22, 1966	3,286,392	Nov.
Johnson 1985	4,512,690	Apr. 23,

Claims 1, 4, 5 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Uhrig in view of Fortunato, Johnson and Flora.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

rejection, we make reference to the answer (Paper No. 11, mailed October 24, 1997) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 10, filed June 25, 1997) and reply brief (Paper No. 12, filed November 5, 1997) 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, 4, 5 and 8 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 would have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 1, the only independent claim on appeal, reads as follows:

A toy projectile and platform assembly comprising:

A. A projectile molded of resilient foam plastic material in the form of a figure having a head forming a nose of the projectile, a torso joined to the head, a pair of aims outstretched to resemble wings extending from an upper end of the torso, and a pair of legs extending from a lower end of the torso and a crotch therebetween;

B. an internal elongated cavity formed in the torso having an open front end at said crotch and a closed rear end in an upper region of the torso in line with the head;

C. An elastic spring received in the cavity having a normal length which is shorter than the length of the cavity to allow for expansion of the spring, said spring being formed by a condom having a ring mounted at the front end of the cavity and a stretchable shank extending from the ring whose normal length is shorter than the length of the cavity; and

D. A platform provided with a probe which when a player pushes the figure down on the platform then enters

the front end of the cavity to engage and stretch the spring toward the rear end of the cavity and thereby develop a latent force which when the player releases the figure produces a thrust force as the spring resumes its normal length to propel the figure into space whereby the figure appears to be flying without any visible means of propulsion.

Uhrig's invention relates to "a springing and dancing puppet which first stands still and then after a certain time springs high of itself" (lines 10-13). As shown in Figure 1, Uhrig's invention includes (1) a box 1 provided with a border b, a bottom c and a pin d; (2) a puppet h provided with a tube e in which a spiral spring g is arranged; and (3) a rubber ring f provided on the tube e. Uhrig's invention operates (see lines 20-25) by

- (1) pressing the tube e of puppet h down over the pin d so that rubber ring f is below border b, thus compressing spring g;
- (2) permitting the rubber ring f to gradually proceed upwardly through the border b; and (3) upon the rubber ring f passing the border b, the puppet h springs high.

Fortunato's invention relates to toys designed to simulate actual weapons and rockets. As shown in Figures 1-2, Fortunato's invention includes a hollow rocket body 10 having therein a rubber band 16 to propel the rocket body through the air when the rubber band is stretched by a launcher push rod 19 of launcher assembly 24.

Johnson's invention relates to a toy glider. Johnson teaches (column 1, lines 60-68) that the toy glider can be made from Styrofoam® and be formed in the configuration of a super hero such as "Superman."

Flora's invention relates to a pneumatic toy. Flora teaches (page 1, lines 55-92) that the pneumatic toy is first inflated, then a pouch or sack 4 is pressed inwardly causing an increase in pressure in the pneumatic toy, and then upon release of the pneumatic toy, the pouch or sack 4 will assume its normal position causing the pneumatic toy to leap or jump.

The appellant argues (brief, p. 7) that nothing in the applied prior art suggests the claimed condom spring in an

internal cavity extending inwardly from the crotch of a projectile. We agree. In that regard, while the combined teachings of the applied prior art may suggest a rubber band be provided in an internal cavity extending inwardly from the crotch of a projectile, the combined teachings of the applied prior art do not teach or suggest using a condom spring in an internal cavity extending inwardly from the crotch of a projectile. In our view, the teachings of Flora are not sufficient for a person of ordinary skill in the art at the time the invention was made to have replaced either the elastic spring of Uhrig (i.e., spring g) or the elastic spring of Fortunato (i.e., rubber band 16) with a condom spring as recited in the claims under appeal (i.e., a condom having a ring mounted at the front end of the cavity (an internal elongated cavity formed in the torso having an open front end at the crotch and a closed rear end in an upper region of the torso in line with the head)) and a stretchable shank extending from the ring whose normal length is shorter than the length of the cavity because Flora's pouch is used to increase pressure in the toy and not as an elastic spring.

In our view, the only suggestion for modifying Uhrig in the manner proposed by the examiner to meet the above-noted condom spring limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejection of claims 1, 4, 5 and 8.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 4, 5 and 8 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 1998-0235
Application No. 08/709,764

Page 10

KEITH D. NOWAK
LIEBERMAN & NOWAK, LLP
350 FIFTH AVENUE
NEW YORK, NY 10118

Appeal No. 1998-0235
Application No. 08/709,764

Page 11

JVN/jg