

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL S. FREELANDER

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Appeal No. 1998-2851  
Application No. 08/756,901<sup>1</sup>

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ON BRIEF

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

NASE, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed December 2, 1996.

Appeal No. 1998-2851  
Application No. 08/756,901

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 10, 12 and 16, 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 an illuminated toy pail. An understanding of the invention can be derived from a reading of exemplary claim 10, 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:

Williams 1902	691,036	Jan. 14,
Newcomb et al. 7, 1986 (Newcomb)	4,563,726	Jan.
Hickey 1987	4,714,985	Dec. 22,
Gary 16, 1990	4,962,907	Oct.

Claims 10, 12 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hickey in view of Williams, Newcomb and Gary.

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

rejection, we make reference to the final rejection (Paper No. 4, mailed October 24, 1997) and the examiner's answer (Paper No. 9, mailed May 11, 1998) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 7, filed March 12, 1998) for the appellant's arguments thereagainst.<sup>2</sup>

#### 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 claims 10, 12 and 16. Accordingly, we will not sustain the examiner's rejection of claims 10, 12 and 16 under

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<sup>2</sup> The examiner's rejection of claim 12 under 35 U.S.C. § 112, second paragraph, made in the final rejection was withdrawn by the examiner in the answer (p. 4).

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, 458 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).

The appellant argues (brief, pp. 5-12) that the combination of prior art relied upon by the examiner is improper because there is no motivation in any of the references to combine the references as suggested by the examiner to arrive at the claimed invention. We agree.

All the claims under appeal recite a retainer including a retainer wall defining a vertical bore wherein the retainer wall includes "radially inwardly extending ridges which are circumferentially spaced around an interior surface of said bore." However, these limitations are not suggested by the **applied prior art**. In that regard, while Gary in Figure 9

does teach the use of support ribs 124, 126 to maintain the socket of a "mini-light" in substantially perpendicular alignment to a base member 106, it is our opinion that Gary would not have provided any suggestion or motivation to one of ordinary skill in the art at the time the invention was made to have modified either Williams struck-up fingers 23 or Hickey's rim 14 to have included circumferentially spaced ridges.

In our view, the only suggestion for modifying Hickey and/or Williams in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure and not the **applied prior art**. 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 Associates, 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 rejections of claims 10, 12 and 16.

CONCLUSION

To summarize, the decision of the examiner to reject claims 10, 12 and 16 under 35 U.S.C. § 103 is reversed.

REVERSED

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

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APPEAL NO. 1998-2851 - JUDGE NASE  
APPLICATION NO. 08/756,901

APJ NASE

APJ COHEN

SAPJ McCANDLISH

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 03 May 99

**FINAL TYPED:**