

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 1999-1975
Application No. 08/963,460¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS
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 claim 1, which is the only claim pending in this application.

¹ Application for patent filed November 3, 1997.

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Application No. 08/963,460

We REVERSE.

BACKGROUND

The appellant's invention relates to a miniature-sized toy vehicle. An understanding of the invention can be derived from a reading of 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:

Emmert	485,351 ²	Oct. 31, 1929
Yeremenko ³	1,664,348 ⁴	July 23, 1991

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Yeremenko in view of Emmert.

² In determining the teachings of this German reference, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

³ The examiner referred to this reference as "Eremenko."

⁴ In determining the teachings of this Russian reference, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

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. 17, mailed November 23, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 15, filed October 13, 1998) 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 claim, 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 claim under appeal. Accordingly, we will not sustain the examiner's rejection of claim 1 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).

The examiner's rejection of claim 1 is founded on his determination (answer, p. 4) that Yeremenko's vehicle, shown in Figure 5, is "*capable* of traveling consistent with the claimed functional language." Based on this determination, the examiner appears to have ascertained that the only difference between Yeremenko and claim 1 relates to the recited ball bearing-mounting plate. With regard to this difference, the examiner determined (answer, p. 4) that

[i]t would have been obvious to have used such a ball bearing retaining mounting plate [Emmert's ball bearing

retaining mounting plate] with that of Eremenko [sic, Yeremenko] so as to revolvably retain the ball bearing.

The appellant argues (brief, p. 5) that in Yeremenko's vehicle, there is "no provision for the body 1 to revolve about the vertical axis of the ball." We view this argument as asserting that Yeremenko's vehicle, shown in Figure 5, is **not capable** of traveling consistent with the claimed functional language.

Yeremenko teaches (translation, p. 3) that wheel 7 displays resistance to the displacement of the body 1 in a transverse direction and allows itself to be displaced in a longitudinal direction. From this teaching of Yeremenko, we conclude that the examiner's determination that Yeremenko's vehicle, shown in Figure 5, is "*capable* of traveling consistent with the claimed functional language" is incorrect. Thus, even if it were obvious to have modified Yeremenko by the teachings of Emmert as set forth above, one would not arrive at the claimed invention.

For the reasons stated above the applied prior art is not suggestive of the claimed invention, thus, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
))	
)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/963,460

APJ NASE

APJ ABRAMS

SAPJ McCANDLISH

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 04 Oct 99

FINAL TYPED: