

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JULIAN E. RENTON

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Appeal No. 1999-2290  
Application No. 08/763,955

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ON BRIEF

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Before FLEMING, BARRETT, and LEVY, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 7-14 and 16-18<sup>1</sup>, which are all of the claims pending in this application.

BACKGROUND

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<sup>1</sup> Both the examiner's answer and the final rejection (Paper No. 13, filed November 6, 1998) include claim 15 in the statement of the rejection. We note that claim 15 has been canceled (Paper No. 12, filed August 26, 1998). Accordingly, only claims 7-14 and 16-18 remain before us on appeal.

Appellant's invention relates to a time keeper having two or more discs that are at least partly visible from the front

of the timekeeper. Specifically, the discs rotate at the same angular velocity and direction as each other and at the same angular velocity and direction as the second hand. An understanding of the invention can be derived from a reading of exemplary claim 7, which is reproduced as follows:

7. A time keeper such as a clock or watch, said time keeper having a front and comprising:

a time keeper mechanism;

a second hand physically connected to said time keeper mechanism such that said time keeper mechanism can urge said second hand to rotate, and said second hand having an axis of rotation;

two or more discs having respective axes that are substantially parallel to said axis of rotation of said second hand, said two or more discs being positioned apart from each other so as to be at least partly visible from the front of said time keeper, and said two or more discs being located in a plane selected from the group consisting of the same plane as the front of said time keeper and a plane that is substantially parallel to the front of said time keeper; and

means for urging said two or more discs to rotate about their respective said axes such that said two or more discs rotate at the same angular velocity and direction as each

other and at the same angular velocity and direction as said second hand.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Kamiyama et al (Kamiyama)	5,339,293	Aug.
16, 1994		

Claims 7-14 and 16-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kamiyama.

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

we make reference to the examiner's answer (Paper No. 17, mailed June 17, 1999) for the examiner's complete reasoning in support of the rejection, and to appellant's brief (Paper No. 16, filed May 3, 1999) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer. It is our view, after consideration of the record before us, that the evidence

relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 7-14 and 16-18. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual

determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467

(1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings

by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument

and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages<sup>2</sup> 3 and 4) is that Kamiyama:

teaches all features claimed except for using a disc in lieu of hands. The use of disc in lieu of hands is well known in the art and in fact two subclasses are dedicated to these. Thus [i]t would have been obvious to adapt KAMIYAMA ET AL to include discs in lieu of hands in order to take advantage of this technology. Further to add "second disk" i.e. a disk with hand painted on it which displays seconds, to the disks of Kamiyama as modified above would be obvious. Thus each second disk would rotate as claimed.

Appellant asserts (brief, page 6) that Kamiyama lacks more than just using a disc in lieu of hands. Kamiyama

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<sup>2</sup> The pages of the examiner's answer are unnumbered. We have numbered the pages starting with one representing the cover page.

additionally lacks means (claim 7) or interconnecting means (claim 16) for urging the discs to rotate at the same angular velocity and direction as the second hand. In addition, appellant asserts (id., page 8) that even if "discs in lieu of hands" is well known in the art, this would still not provide the necessary motivation. Appellant argues (id., page 7) that although the examiner states that two subclasses are dedicated to patents showing the claimed features of the present invention, that the examiner chooses to reject the claims over Kamiyama. Appellant states (id., page 8) that "it is submitted that the Examiner's reference to unidentified phantom prior art falls far short of the requirement of providing the requisite factual basis and establishing the requisite motivation to support a conclusion of obviousness." Appellant further asserts (id., pages 7 and 8) that the examiner has failed to set forth an explanation of why or how Kamiyama, or the general knowledge in the art, provides a teaching, suggestion, or motivation to modify the watch of Kamiyama to produce the timekeeper recited in claims 7 and 16.

The examiner responds by asserting (answer, page 4) that the issue is whether it would have been obvious to add second hands to the displays 4, 5, and 6 of Kamiyama, and then

replace the added second hands with discs having hands thereon. The examiner

points out in the remarks (id.), that the use of discs having hands thereon is shown by the Musy reference of record.

We note at the outset that the Musy reference is not referred to in the statement of the rejection, and has not been argued by appellant in the brief. "Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection." In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Here, although the examiner refers to Musy in the remarks, the examiner fails to include the reference in the rejection of the claims. Accordingly, the Musy reference will not be considered in deciding this appeal since the reference was not included in the rejection of the claims, and has not been argued in the brief by appellant. See also Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993).

We find that Kamiyama does not disclose the use of discs, and does not disclose the use of discs that rotate in the same direction and have the same angular velocity as the second hand. We agree with the examiner that the minute hands 4b, 5b, and 6b rotate in the same direction and have the same angular velocity. However, the claims recite, inter alia, that the discs have the

same angular velocity as the second hand. In Kamiyama, the minute hands 4b, 5b, and 6b do not have the same angular velocity as the second hand 3, as the second hand rotates at a faster rate.

With respect to the examiner's assertion (answer, page 4) that second hands be added to the displays 4, 5, and 6, we agree that one of ordinary skill in the art would have been motivated to have added a second hand to each display having a minute hand and an hour hand. However, in the absence of a teaching in the prior art, we find no suggestion in Kamiyama or the general knowledge level in the art for additionally

replacing the added second hands with discs having hands formed on the disks. We do not know whether the examiner is asserting that each of the hour and minute hands of displays 4, 5, and 6 will all be replaced with discs having hands formed thereon, or whether the examiner intends to leave the minute and hours hands as disclosed by Kamiyama and add second hands formed on discs.

The examiner states (answer, pages 3 and 4) that two subclasses are dedicated to the use of discs in lieu of hands. However, the examiner has not stated which subclasses are being referred to. Nor has the examiner provided any subclass definitions that would establish contents of the patents

found in the two subclasses.

We do not know if prior art exists that could be combined with the teachings of Kamiyama in order to arrive at the claimed invention. If such prior art exists, it is the examiner's burden to locate the prior art and set forth a rejection of the claims that can be argued by appellant. Thus, we agree with appellants (brief, page 8) that the examiner is relying upon "phantom prior

art" to reject the claims on appeal. The examiner's unsupported assertions are not a substitute for evidence, and do not amount to the substantial evidence required to establish a prima facie showing of obviousness of the claimed invention. Accordingly, the examiner's rejection of claims 7-14 and 16-18 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 7-14 and 16-18 under 35 U.S.C. § 103 is reversed.

REVERSED

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

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