

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 98-3306
Application 08/866,014¹

ON BRIEF

Before MEISTER, FRANKFORT and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 5 and 9, all the claims remaining in the application. Claims 2 through 4 and 6 through 8 have been canceled.

¹ Application for patent filed May 30, 1997. According to appellants, the application is a continuation of Application 08/676,682, filed July 10, 1996, now abandoned.

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Appellants' invention relates to an athletic souvenir display rack having athletic ball supporting structures in the form of alphabetic characters arranged to provide the alphabetic acronym initials of a particular institution. Independent claim 1 is representative of the subject matter on appeal and a substantially correct copy of that claim may be found in the Appendix to appellants' brief.²

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:³

Grave (British)	270,549	May 12, 1927
Holland (British)	593,934	Oct. 29, 1947

Claims 1, 5 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Grave in view of Holland.

² As indicated by the examiner (answer, page 2), in line 14 of claim 1 as it appears in the Appendix the word ---the--- should be inserted before the phrase "at least three tip portions."

³ Both of the applied references are published British provisional applications.

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Rather than reiterate the examiner's full statement of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 23, mailed May 20, 1998) for the examiner's reasoning in support of the rejection, and to appellants' brief (Paper No. 21, filed February 2, 1998) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination that the examiner's rejection will not be sustained. Our reasons follow.

Even if, as has been urged by the examiner, it would have been obvious to one of ordinary skill in the art to modify the

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ball supporting posts (b) of Grave to be in the form of flat, planar metal strips or panels as seen in Figure 5 of Holland, we fail to see any teaching, suggestion or incentive in the applied references that would have further motivated such an artisan to shape and arrange the planar strips or panels of the golf ball holder of Grave (as modified) so as to provide alphabetic characters arranged to depict the alphabetic acronym initials of a particular institution, as required in appellants' claims on appeal. The examiner's position (answer, pages 4-5) that

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to have shaped and arranged the panels in such a manner in order to increase the aesthetic appearance of the rack. Moreover, it would have been obvious as a matter of design choice to have shaped the planar panels in the shapes mentioned above (e.g., two alphabetic characters), since the applicant has not disclosed that having this feature solves any stated problems or is for any particular purpose and it appears that the planar panels would perform equally well with shapes other than that claimed by the appellant"

is, in our opinion, based on impermissible hindsight gained only from appellants' disclosure.

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Moreover, the examiner's position as stated above is also directly contrary to appellants' specification, e.g., at page 1, wherein it is indicted that an objective of the invention is to provide improved trophy ball displays

"wherein the balls are accompanied by specific visible decorative background display configurations related to the historical and sentimental history of a displayed ball by identification of a team or institution,"

which clearly belies the examiner's determination that applicants have not disclosed that this feature "solves any stated problem or is for any particular purpose" (answer, page 5). This portion of appellants' specification also refutes the examiner's position that the shaping of the support members as alphabetic characters in the form of an alphabetic acronym initial identifying a preselected institution, has no mechanical function, but merely increases the aesthetic appearance of the rack (answer, pages 9-10). In this regard, it is clear that, in addition to being ornamental, the alphabetic characters in the form of an alphabetic acronym initial of a particular institution have the function of 1) identifying the institution, 2) providing a specialized form of support for the souvenir ball, and 3) triggering memories

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of sentimental history specifically related to the displayed
souvenir ball and institution.

Based on the foregoing, the examiner's rejection of
claims 1, 5 and 9 under 35 U.S.C. § 103 relying on the
combined

teachings of Grave and Holland will not be sustained and the
decision of the examiner is, accordingly, reversed.

REVERSED

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JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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JOHN P. McQUADE)	
Administrative Patent Judge)	

CEF/kis
Laurence R. Brown
LAURENCE BROWN & ASSOCIATES
2001 Jefferson Davis Highway
Suite 408
Arlington, VA 22202