

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YAT-MING HO

Appeal No. 1999-2776
Application No. 08/714,249

ON BRIEF

Before COHEN, FRANKFORT and JENNIFER D. BAHR, 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, 2, 7, 8 and 12, all of the claims remaining in this application. Claims 3 through 6 and 9

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through 11 have been canceled.

Appellant's invention relates to a toy, for example, a flying disc or a toy golf club, having the ability to generate bubbles in use. One embodiment of the invention (the flying disc) is seen in Figures 1 through 3 of the application, while the other embodiment (the golf club) is seen in Figures 5 and 6. Independent claims 1, 7 and 12 are representative of the subject matter on appeal and a correct copy of those claims can be found in the Appendix to appellant's reply brief (Paper No. 12, filed February 2, 1999).

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

Knerr et al. (Knerr)	3,295,248	Jan. 3, 1967
Rogahn	4,184,284	Jan. 22, 1980
Sasse	4,541,631	Sept. 17, 1985
Danielak et al. (Danielak)	5,102,381	Apr. 7, 1992

As stated in the final rejection (Paper No. 7), claims 1, 2, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being

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unpatentable over Rogahn in view of Danielak; claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Knerr in view of Sasse; while claims 1, 2, 7 and 8 additionally stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 5,620,351.¹

Rather than attempt to reiterate the examiner's full

¹While the examiner has not expressly repeated all of the rejections applicable to the claims before us on appeal in the examiner's answer (Paper No. 11), it is clear from a review of the final rejection, appellant's brief (Paper No. 10) and the totality of the examiner's answer (particularly section 6) that the rejections as stated above are those that are before us for consideration on appeal. More specifically, we note that the rejection of claims 1, 2, 7 and 8 based on the judicially created doctrine of obviousness-type double patenting is still a valid rejection and is before us in this appeal. We are at a loss to understand why all of the applicable rejections were not repeated in the examiner's answer. Normally, rejections of claims which are not repeated in the examiner's answer are considered to have been withdrawn by the examiner. See, for example, Ex parte Emm, 118 USPQ 180 (Bd. App. 1957). In the present case, we note that appellant's statement of the issues on appeal as set forth on page 3 of the brief, with particular regard to the double patenting rejection, in no way relieves the examiner of the obligation to expressly state in the examiner's answer exactly what rejections are before the Board for review.

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commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the final rejection (Paper No. 7, mailed January 23, 1998) and the examiner's answer (Paper No. 11, mailed December 2, 1998) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 10, filed September 23, 1998) and reply brief (Paper No. 12, filed February 2, 1999) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking at page 3 of the brief, we note that appellant has indicated with regard to the rejection of claims 1, 2, 7

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and 8 based on obviousness-type double patenting that a terminal disclaimer will be filed once all other grounds of rejection have been resolved. Given that no such terminal disclaimer has been filed by appellant and no argument made with respect to this ground of rejection, we summarily sustain the examiner's rejection of claims 1, 2, 7 and 8 based on obviousness-type double patenting.

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Regarding the examiner's rejection of claims 1, 2, 7 and 8 under 35 U.S.C. § 103(a) based on the combined teachings of Rogahn and Danielak, we note that Rogahn discloses a flying toy of the saucer type having a flat or domed plate-like body (10) with a plurality of apertures (19) extending therethrough. A reservoir (e.g., 32) which holds bubble forming solution (33) is positioned at the center of the body (10) and is designed so that the bubble forming solution is released from the reservoir during and as a result of flight, with the solution then being spread quickly over the upper surface (13) of body (10) and forming a film over the ends (34) of apertures (19), thereby allowing the formation of bubbles when air passes through the apertures and the film of bubble producing solution. Danielak discloses a bubble producing jump rope that includes reservoirs in the hollow handles (17) and bubble producing diffusors (15) connected adjacent thereto by flexible tubes (21). Each diffusor consists of a pair of coaxial cylindrical tubes (27, 29) having openings (31) provided therein. An annular space (30) is defined between the tubes and receives the bubble producing solution from the reservoir during use so that a film of the

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solution spreads across the openings (31) and allows the formation of bubbles when air moves through the openings. According to the examiner, it would have been obvious to one of ordinary skill in the art to have provided a Rogahn disc with dual apertured layers as taught by Danielak, "in order to make the maximum use of the bubble fluid by causing most to be used in bubbles with little being spun off or allowed to dry before use" (answer, pages 3-4).

Like appellant (brief, pages 4-6), absent knowledge of appellant's invention, we see nothing in Rogahn and Danielak which would have suggested their combination in the manner urged by the examiner. In our opinion, the examiner has used impermissible hindsight derived from appellant's own teachings to reconstruct the flying toy of Rogahn based on concepts found in the jump rope of Danielak so as to result in a structure which is responsive to that set forth in claims 1, 2, 7 and 8 on appeal. Moreover, the examiner has hypothesized concerning certain advantages to be derived in the flying toy of Rogahn by making the proposed modifications therein, without any teaching or suggestion of any such advantages in

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the prior art relied upon. Since we have determined that the teachings and suggestions found in Rogahn and Danielak would not have made the subject matter as a whole of claims 1, 2, 7 and 8 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a).

Looking next to the examiner's rejection of independent claim 12 under 35 U.S.C. § 103 based on Knerr and Sasse, we are in total agreement with the appellant's position as set forth in the brief (pages 3-4) and reply brief (pages 6-8) regarding the hindsight nature of the examiner's proposed modification of the simple bubble paddle of Knerr in view of the shiftable weight golf club of Sasse. Thus, the examiner's rejection of claim 12 under 35 U.S.C. § 103(a) will not be sustained.

In view of the foregoing, the examiner's decision rejecting claims 1, 2, 7, 8 and 12 of the present application under

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35 U.S.C. § 103(a) is reversed. However, the decision to reject claims 1, 2, 7 and 8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 5,620,351 is affirmed. Accordingly, the decision of the examiner is affirmed-in-part.

No period For taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES

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