

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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SALLY A. McNALLY

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Appeal No. 2000-0608  
Application No. 08/799,499

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ON BRIEF

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Before ABRAMS, McQUADE, and STAAB, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10-15, which are all of the claims pending in this application.

We REVERSE.

### BACKGROUND

The appellant's invention relates to a cover for protecting outdoor plants from the elements. 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 reference of record relied upon by the examiner in rejecting the appealed claims is:

Ball	2,009,867	Jul. 30, 1935
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Claims 10-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ball.

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. 16) and the final rejection (Paper No. 11) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No.15) 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 claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention provides an anchored outdoor cover which functions to protect shrubs and plants from long periods in the elements and is also sufficiently decoratively attractive to enhance the appearance of the lawn or garden in which it is installed (specification, page 5). Examples of such decorative attractiveness disclosed by the appellant are a snowman, an angel, and a Christmas tree (Figures 1 and 7). As manifested in independent claim 10, the invention comprises a frame having elongated portions adapted to be penetrated into the ground to anchor the frame, a sheath covering open at the bottom and adapted to overlie the frame and extending to the ground and defining an enclosed space adapted to receive a plant, "said sheath covering being formed in a shape simulating an ornamental figure." The examiner is of the view that Ball discloses a plant cover including all of the limitations of claim 10 "with the exception of the sheath covering (15 or 20) being in the form or simulating the form of a specific figure, such as a snowman or evergreen tree." The examiner goes on to take the position that "[t]o construct or modify the exterior sheath covering to simulate a figure . . . is considered to be a matter of design choice . . . to achieve a desired or intended result, such as an aesthetic and decorative effect, and as such, would have been an obvious modification of the apparatus of Ball" (final rejection, Paper No. 11, page 2). The examiner adds in the Answer that the language of the appellant's claims "is entirely subjective as to what constitutes an ornamental figure," and that the Ball cylindrical sheath could be considered

to be ornamental “in that it covers the aesthetically unappealing wire frame and also could be considered to be in the form of an ornamental object such as a candle” (page 3). The appellant argues in rebuttal that the examiner’s rejection is defective in that no prior art citing such a simulated figure has been cited, and that “[t]his approach reduces an obviousness determination to the subjective opinion of the Examiner” (Brief, page 3).

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The appellant has explained that plant covers remain on a lawn for long periods of time, and her invention provides them with a pleasing decorative appearance that enhances the lawn in the course of protecting the plants (see specification, pages 4 and

6). In keeping with this, claim 10 recites that the cover simulates “an ornamental figure” (emphasis added), and the disclosure provides examples in the form of a snowman, an angel, and a Christmas tree, which are commensurate with the common definition of “ornament” as being “something that lends grace or beauty.”<sup>1</sup> In view of these factors, we do not agree with the examiner that the cylindrical cover disclosed by Ball constitutes “an ornamental figure” in the manner in which the claim requires, for in our view one of ordinary skill in the art would consider it as possessing neither grace nor beauty. Nor can we agree that it would have been obvious to replace the cylindrical cover with a decorative figure, on the basis that the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so,<sup>2</sup> and we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to do so. From our perspective, the rejection is grounded in the hindsight afforded one who first viewed the appellant’s disclosure, which, of course, is not a proper basis for a rejection under Section 103.<sup>3</sup>

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<sup>1</sup>See, for example, Merriam Webster’s Collegiate Dictionary, 10<sup>th</sup> Edition, 1996, page 820.

<sup>2</sup>In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

<sup>3</sup>In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

For the reasons expressed above, it is our conclusion that Ball fails to establish a prima facie case of obviousness with regard to the subject matter recited in independent claim 10. This being the case, we will not sustain the rejection of claim 10 or, it follows, of claims 11-15, which depend therefrom.

SUMMARY

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

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NEA:pgg

JOHN R. BENEFIEL  
280 DAINES STREET  
SUITE 100B  
BIRMINGHAM, MICHIGAN 48009

APPEAL NO. 2000-0852 - JUDGE ABRAMS  
APPLICATION NO. 09/061,314

APJ ABRAMS

APJ McQUADE

APJ STAAB

**DECISION: REVERSED**

Prepared By:

**DRAFT TYPED:** 28 Jan 02

**FINAL TYPED:**