

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KERRY K. PAULSON

Appeal No. 2003-1387
Application 09/479,576

ON BRIEF

Before COHEN, MCQUADE, and NASE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Kerry K. Paulson appeals from the final rejection (Paper No. 12) of claims 1 through 5, all of the claims pending in the application.

THE INVENTION

The invention relates to "a ball throwing machine that is of minimum size and weight" (specification, page 1). Representative claim 1 reads as follows:

1. A baseball throwing machine including a frame supporting at least one ball projecting wheel driven rotationally by an electric motor and mounting a pneumatic tire having a diameter ranging between about 15-32cm; a wall depth ranging between about 5-10cm; and a footprint ranging between about 4-13cm.

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THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Halstead	3,724,437	Apr. 3, 1973
Greene	4,834,060	May 30, 1989

THE REJECTIONS

Claims 1 through 3 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Halstead.

Claims 1 through 5 stand rejected under U.S.C. § 103(a) as being unpatentable over Greene in view of Halstead.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 14 and 16) and to the examiner's final rejection and answer (Paper Nos. 12 and 15) for the respective positions of the appellant and the examiner regarding the merits of these rejections.

DISCUSSION

Halstead discloses "a ball throwing machine . . . for pitching balls to a batter and for throwing fly or ground balls to fielders" (column 1, lines 5 through 8). The machine 10, which is portable, includes a frame 12, a pair of counter-rotating wheels 14 and 16, and separate variable speed motors 22 for independently driving the wheels. Halstead teaches that

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[a]s shown in FIG. 2, wheels 14, 16 are positioned so that the space between the peripheries thereof is slightly less than the diameter of ball 102. The ball engaging portions 104 of wheels 14, 16 are constructed from a resilient material having a low coefficient of friction, preferably are pneumatic tires as shown in FIG. 2, to minimize scuffing of the ball [column 4, lines 14 through 20].

Green, noting "[t]he widespread interest in ball sports, particularly baseball and tennis" (column 1, lines 12 and 13), discloses a portable, lightweight ball throwing apparatus 10 which includes a pair of counter-rotating wheels 48 equipped with cylindrical elastomeric tires 49, a pair of motors 35 for driving the wheels and an on-board 12-volt battery for powering the motors.

In applying Halstead alone to reject claims 1 through 3 and 5 and Greene in view of Halstead to reject claims 1 through 5, the examiner concedes that neither reference discloses the particular wheel dimensions set forth in independent claim 1. Indeed, neither Halstead nor Green provides any relevant information as to wheel dimensions. The examiner nonetheless concludes that the subject matter recited in claim 1 would have been obvious within the meaning of § 103(a) because

one of ordinary skill would know that the wheels should be an appropriate size based on the projectile to be launched. And one would also know that it is desirable for these [baseball or ball] throwing machines to be small and lightweight so they can be easily

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transported. Based on these considerations, it is believed that one of ordinary skill would be able to determine through routine experimentation that providing tires of a diameter of about 15-32 cm, wall depth of 5-10 cm, and a footprint of 4-13 cm would be appropriate [final rejection, page 2 and page 3].

Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In the present case, the rationale employed by the examiner to supply the above noted dimensional deficiencies of Halstead and Greene relative to the subject matter recited in claim 1 finds little, if any, factual support in the fair teachings of these references, and instead rests essentially on speculation, unfounded assumptions and hindsight reconstruction. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, and dependent claims 2, 3 and 5, as being unpatentable over Halstead, or the standing 35 U.S.C. § 103(a) rejection of claim 1, and dependent claims 2 through 5, as being unpatentable over Greene in view of Halstead.

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SUMMARY

The decision of the examiner to reject claims 1 through 5 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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)	APPEALS AND
JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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