

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(2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
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Ex parte DONALD E. WEDER  
\_\_\_\_\_

Appeal No. 96-1698  
Application 07/926,098<sup>1</sup>  
\_\_\_\_\_

ON BRIEF  
\_\_\_\_\_

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

DECISION ON APPEAL

This is a decision on an appeal from the final  
rejection of claims 1, 4, 6 through 10, 23 through 32, 34 through

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<sup>1</sup> Application for patent filed August, 5, 1992. According to appellant, this application is a continuation-in-part of Application 07/803,318, filed December 4, 1991; which is a continuation-in-part of Application 07/707,417, filed May 28, 1991, now abandoned; which is a continuation of Application 07/502,358, filed March 29, 1990, now abandoned; which is a continuation-in-part of Application 07/391,463, filed August 9, 1989, now abandoned; which is a continuation-in-part of Application 07/249,761, filed September 26, 1988, now abandoned; and a continuation-in-part of Application 07/687,701, filed April 18, 1991, now abandoned.

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38, 40, 41, 54 through 59 and 146 through 149, which are all of the claims remaining in the application.

The subject matter on appeal is directed to a method of forming a decorative cover for a flower pot. Claim 1 is exemplary of the invention and reads as follows:

1. A method for forming a decorative cover comprising:

providing a sheet of material having an upper surface, a lower surface and an outer peripheral surface and having a connecting bonding material comprising a cohesive or adhesive disposed thereon;

providing a flower pot having an upper end, a lower end, an outer peripheral surface and an opening extending through the upper end providing access to a retaining space with the flower pot having an inner peripheral surface encompassing a substantial portion of the retaining space and the flower pot having a bottom formed near the lower end of the flower pot;

forming the sheet of material about the flower pot to a position wherein the sheet of material extends about substantially the entire outer peripheral surface of the flower pot with a portion of the sheet of material near the outer peripheral surface thereof extending a distance above the upper end of the flower pot; and

crimping a portion of the sheet of material having the connecting bonding material and extending above the upper end of the flower pot forming a crimped portion for cooperating to hold the sheet of material in the form of the decorative cover extending about the flower pot and wherein the crimped portion extends a distance radially inwardly toward a central portion

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of the flower pot and wherein the decorative cover formed has an opening above the upper end of the flower pot.

The references of record relied upon by the examiner in rejections of the claims under 35 U.S.C. § 103 are:

Weder et al. (Weder)	4,773,182	Sep. 27, 1988
Brown (Great Britain)	1,096,058	Dec. 20, 1967
"Color Them Happy," Highland Supply Corporation, 1992		

Claims 1, 4, 6 through 10, 29 through 32, 34 through 38, 40, 41, 54 through 59 and 146 through 149 stand rejected under 35 U.S.C. § 103 as being unpatentable over the "Color Them Happy" article in view of Brown.

Claims 23 through 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over the "Color Them Happy" article in view of Brown and Weder.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellant, we refer to paragraph 2 of Paper No. 15 and to paragraph 6 of Paper No. 12 for the examiner's statement of the rejection, to pages 5 through 18 of the appellant's brief and to the reply brief for the appellant's

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arguments for patentability, and to the pages 3 through 5 of the examiner's answer for the examiner's response thereto.

#### OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art, and to the respective positions advanced by the appellant and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to all claims on appeal. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A prima facie case of obviousness is established by presenting evidence indicating that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See

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In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988), In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986) and ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Additionally, rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017,

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154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

Turning first to the examiner's rejection of claims 1, 4, 6 through 10, 23 through 32, 34 through 38, 40, 41, 54 through 59 and 146 through 149, under § 103 based on the combined teachings of the "Color Them Happy" article and Brown, we observe that the "Color Them Happy" article does disclose a decorative sheet that is applied to articles such as flower pots and which is affixed thereto by elastic bands (see appellant's Information Disclosure Statement, Paper No. 6) or ribbons rather than by adhesive in the manner claimed. Furthermore, Brown (Figures 1 through 4) discloses a wrapper for candy or other articles such as "fruit and vegetables" (page 2, line 91), which wrapper envelopes the article and the wrapper is twisted to maintain the wrapper about the article. The wrapper of Brown includes bands of self-sealing coating or adhesive 2 in

the zone or zones in which the twist is  
to be formed and the material is then

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twisted in this zone or zones and is maintained in a twisted position by means of the self-sealing coating (page 1, lines 39-42).

However, like the appellant, we find nothing in the disclosure of either the "Color Them Happy" article or Brown that would have suggested their combination in the manner proposed by the examiner in the rejection of the claims on appeal. While it is our opinion that the teachings of the "Color Them Happy" article and Brown can be combined, the method resulting from the combination would result in wrapping the material about the article and twisting either both wrapped ends (Figures 3 and 4 of Brown) or placing the article in a bag with the top of the bag being closed by a twist (note page 2, lines 93-95 of Brown). Either way, the method would not result in either the crimping step or the decorative cover forming an opening above the upper end of the article as required by all of the independent claims on appeal.

As stated in W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest

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that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is our conclusion that the only reason to combine the teachings of the "Color Them Happy" article and Brown in the manner proposed by the examiner results from a review of appellant's disclosure and the application of impermissible hindsight. Thus, we cannot sustain the examiner's rejections of appealed claims 1, 4, 6 through 10, 29 through 32, 34 through 38, 40, 41, 54 through 59 and 146 through 149 under 35 U.S.C. § 103.

We have also considered the teachings of Weder applied by the examiner in the rejection of claims 23 through 28 under 35 U.S.C. § 103, but we find nothing therein to supply the deficiencies of the combined teachings of the "Color Them Happy" article and Brown. Thus, we also cannot sustain the examiner's rejection of claims 23 through 28 on this ground.

Accordingly, the decision of the examiner rejecting claims 1, 4, 6 through 10, 23 through 32, 34 through 38, 40, 41, 54 through 59 and 146 through 149 under 35 U.S.C. § 103 is reversed.

REVERSED

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William E. Lyddane	)	
Administrative Patent Judge	)	
	)	
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Neal E. Abrams	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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Lawrence J. Staab	)	
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