

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 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 ARY A. FANTINELLI

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Appeal No. 1996-3880  
Application No. 08/305,441<sup>1</sup>

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HEARD: February 9, 1999

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Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 12, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

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<sup>1</sup> Application for patent filed September 13, 1994.

The appellant's invention relates to a pencil. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

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

Chapman	Des. 141,631	June 19, 1945
Beder 1949	2,491,296	Dec. 13,
Richardson 1939	509,664 (British)	July 19,
Okumura	01-229700 <sup>2</sup> (Japan)	Sep. 13, 1989
Muliterno 16, 1990	0 381 818 (European Patent Application)	Aug.

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<sup>2</sup> In determining the teachings of Okumura, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

Claims 1 through 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Richardson in view of Chapman, Muliterno, Okumura and Beder.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 15, mailed April 11, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 11, filed November 20, 1995) 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 references, and to the respective positions articulated by the appellant and 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 the claims under appeal. Accordingly, we will

not sustain the examiner's rejection of claims 1 through 12 under 35 U.S.C. § 103. 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). A prima facie case of obviousness is established by presenting evidence 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 In re Lintner, 9 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). 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 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 for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Richardson discloses a set of pencils that are provided tongues and grooves to enable several pencils to be picked up *en bloc* but are easily separated when required for individual use. As shown in Figure 1, the pencils are differently colored and have a substantially rectangular shape.

Chapman discloses a pencil. As shown in Figures 1-3, the pencil includes a hexagonal pencil body with a series of depressions therein.

Muliterno discloses an ink level inspection means for writing devices. As shown in Figure 3, a ball point pen is provided with windows or openings 9 so that the decrease of ink in the pen may be observed.

Okumura discloses a pencil-surface decorating method. The figure shows a pencil 1 having a pattern area 2 printed thereon by Okumura's pencil-surface decorating method.

Beder discloses puzzle sticks. As shown in Figure 1, a plurality of square sticks 11-15 are provided with pictorial segments 18 and 19 on one side thereof.

The examiner determined (answer, p. 3) that

[i]t would have been obvious to a mechanic with ordinary skill in the art to provide these features [i.e., the cutouts of Chapman and Muliterno and the indicia of Okumura and Beder] to the British patent [Richardson].

The motivation is to view the lead, and to provide a puzzle.

The appellant argues (brief, pp. 4-6) that the claimed "lateral cut-out"<sup>3</sup> exposing a portion of said lead" was not suggested by the applied prior art. We agree.

While Chapman does teach depressions in a pencil, Chapman does not teach or suggest that the depth of those depressions are deep enough to expose a portion of the pencil's lead. Thus, there is no suggestion in Chapman to modify Richardson to provide the claimed "lateral cut-out exposing a portion of said lead."

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<sup>3</sup> Terminology used in claims in an application is to be given its broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). In applying that principle to the phrase "lateral cut-out," it is our determination that it means a piece of the side of the pencil intermediate its ends has been removed. Thus, the phrase "lateral cut-out" is not readable on the sharpened point of a typical wooden pencil.

While Muliterno does disclose windows or openings 9 so that the decrease of ink in the pen may be observed, there is no reason, absent hindsight knowledge derived from the appellant's own disclosure, to modify Richardson to provide the claimed "lateral cut-out exposing a portion of said lead" since one can determine the amount of lead left in Richardson's pencil just by observing the remaining length of the pencil.

We have also reviewed Okumura and Beder but find nothing therein which would have suggested the claimed "lateral cut-out exposing a portion of said lead." Since the claimed "lateral cut-out exposing a portion of said lead" is not suggested by the teachings of the applied prior art, the decision of the examiner to reject claims 1 through 12 under 35 U.S.C. § 103 is reversed.

REMAND

We remand this application to the examiner to determine the patentability of claims 1 through 12 under 35 U.S.C. § 103 over the combined teachings of a typical mechanical pencil and

Muliterno. Claim 1 is not restricted to a wooden pencil. Accordingly, the examiner should consider whether or not it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified a mechanical pencil in accordance with the teachings and suggestion of Muliterno to observe the decrease in lead and thereby effect the claimed invention.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 12 under 35 U.S.C. § 103 is reversed. In addition, this application is being remanded to the examiner to determine the patentability of at least claim 1 under 35 U.S.C. § 103 over the combined teachings of the typical mechanical pencil and Muliterno.

REVERSED AND REMANDED

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

JVN/gjh

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APPEAL NO. 1996-3880 - JUDGE NASE  
APPLICATION NO. 08/305,441

APJ NASE

APJ COHEN

APJ FRANKFORT

DECISION: **REVERSED; REMANDED**

Prepared By: Gloria

Henderson

**DRAFT TYPED:** 09 Feb 99

**FINAL TYPED:**

**HEARD: 09 Feb 99  
Three Member Conf.**