

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER J. DUNN

Appeal No. 97-2722
Application No. 08/329,840¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge and
COHEN 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 7, which are all of the claims pending in this application.

¹ Application for patent filed October 27, 1994.

Appeal No. 97-2722
Application No. 08/329,840

We REVERSE and enter new rejections pursuant to 37 CFR
§ 1.196(b).

BACKGROUND

The appellant's invention relates to a combined rack and storage device for a bicycle. A copy of claims 1 through 7 is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Edmonds 1902	702,292	June 10,
Silverman 26, 1955	2,713,845	July
Zopfi 1971	3,578,027	May 11,
Shockley 1981	4,295,586	Oct. 20,
Bass et al. (Bass) 1988	4,760,943	Aug. 2,
Dworman et al. (Dworman) 7, 1989	4,878,867	Nov.
Laiti	2,681,039 ² (France)	Mar. 12, 1993
	112,504 ³	

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

³ The examiner referred to this as a French patent having a date of December 1941. Only copies of Figures 1-3 have been provided and relied upon by the examiner. The appellant has not challenged that this reference is prior art to their

Claims 1, 2, 4 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shockley in view of Edmonds and Laiti.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Shockley in view of Edmonds and Laiti as applied to claims 1 and 2 above, and further in view of the French reference 112,504, Zopfi, Dworman, and Silverman.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shockley in view of Edmonds, Laiti, the French reference 112,504, Zopfi, Dworman, and Silverman as applied to claims 1 and 4 above, and further in view of Bass.

Claims 1, 2, 4 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over the French reference 112,504 in view of Edmonds and Laiti.

invention.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over the French reference 112,504 in view of Edmonds and Laiti as applied to claims 1 and 2 above, and further in view of Zopfi, Dworman, and Silverman.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over the French reference 112,504 in view of Edmonds, Laiti, Zopfi, Dworman, and Silverman as applied to claims 1 and 4 above, and further in view of Bass.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 rejections, we make reference to the examiner's answer (Paper No. 12, mailed October 9, 1996) and the supplemental examiner's answer (Paper No. 14, mailed February 18, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 11, filed June 6, 1996) and reply brief (Paper No. 13, filed December 9, 1996) 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 not sufficient to establish a prima facie case of obviousness with respect to any of the claims on appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 7 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). 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 of the prior

art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

Claim 1, the only independent claim on appeal, recites a combined rack and storage device for a bicycle comprising, inter alia, an elongated hollow body having a front end and a rear open end, clamp means at the front end of the body for attaching the device to the bicycle seat post so that the body is cantilevered therefrom in substantially a horizontal position, closure means at the rear open end for forming a closed but accessible storage compartment, and frame means attached to the body and extending outwardly therefrom for supporting and carrying items.

The examiner determined (answer, pp. 3 and 5) that both primary references (i.e., Shockley and the French reference 112,504) disclose a combined rack and storage device for a bicycle but that each lack means for attaching their hollow body to the seat post in a cantilevered manner. The examiner then concluded that it would have been obvious to modify the

combined rack and storage device of each primary reference to be cantilevered since such is well known as shown by Edmonds and Laiti.

We agree with the appellant's argument that there is nothing in the applied prior art⁴ which would have suggested modifying the rack and storage device of either primary reference to be cantilevered. While the references to Edmonds and Laiti each disclose a cantilevered rack and storage device, we see no motivation, absent impermissible hindsight, for one skilled in the art to have modified the rack and storage device of either primary reference to arrive at the claimed invention. Accordingly, we do not sustain any of the examiner's rejections of claims 1 through 7 under 35 U.S.C. § 103.

New grounds of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new grounds of rejection.

⁴ The applied prior art is Shockley, Edmonds, Laiti, the French reference 112,504, Zopfi, Dworman, Silverman, and Bass.

Claims 1 and 2 are rejected under 35 U.S.C. § 103 as being unpatentable over Laiti in view of Shockley.

Laiti discloses a device for affixing a rear luggage rack to a bicycle. As shown in Figure 1, the device includes a tube 2 which slides on the seat pillar 1 and a supporting arm 3 for the luggage rack. The tube 2 is provided with a clamping system 4 to arrest translational and rotational movements of the tube 2 and supporting arm 3. The supporting arm 3 may be made of a tube, a shaped metal, or plastic and may be glued or soldered to the tube 2. Laiti teaches that the device may carry any type of luggage rack (not shown) which may be made of a metal wire or cloth. Lastly, Laiti's device utilizes only a single anchoring point on the seat pillar (i.e., the support arm 3 is cantilevered from the seat pillar 1 in substantially a horizontal position) to eliminate the drawbacks of the prior art wherein the luggage rack is supported near the wheel axle of the rear wheel.

Shockley discloses a receptacle support apparatus for a bicycle. As shown in Figures 1-4, the support apparatus 17

includes a hollow housing 18, a clamp bar 24, a supporting rod structure 43-45, and struts 27. The hollow housing 18 has a rear end portion covered by a door 19 hinged to the housing 18 by pins 20. Shockley teaches at column 2, lines 1-5, that the hollow housing is provided to store articles.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Laiti and claim 1, it is our opinion that the only difference is the limitation that a closure means is provided at the rear open end of the hollow body for forming a closed but accessible storage compartment.

With regard to this difference, we have determined that it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention to have provided Laiti's tubular supporting arm with a door thereon as suggested and taught by Shockley whereby the tubular

supporting arm may store articles therein as taught by Shockley.

Based on our analysis and review of Laiti and claim 2, it is our opinion that one additional difference is the limitation that the hollow body is made of rigid, metal material.

With regard to this additional difference, we have determined that it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention to have made Laiti's tubular supporting arm from a rigid, metal material as suggested by Laiti's teaching that the supporting arm 3 may be a shaped metal and may be soldered to the tube 2.

Claims 4 through 6 are rejected under 35 U.S.C. § 103 as being unpatentable over Laiti in view of Shockley as applied to claim 1 above, and further in view of Bass.

Based on our analysis and review of Laiti and claims 4 through 6, it is our opinion that while Laiti does teach a luggage rack (i.e., frame means) Laiti does not teach any of the limitations thereof recited in claims 4 through 6.

Bass discloses a platform 10 supported on a rear carrier rack 20 of a bicycle. As shown in Figure 2(b), the rear carrier rack (i.e., frame means) includes tubular members (i.e., rod material) formed in a generally rectangular shape with parallel sides 28 and an integral, generally U-shaped forward portion 30 interconnecting the sides 28 that slopes upwardly to provide a stop means for externally carried items. U-shaped members 32 and 34 are affixed to the sides 28 and provide two strut members between the sides 28. As shown in Figure 1, the platform 10 is attached horizontally between the sides 28 of the carrier rack.

With regard to the additional differences recited in claims 4 through 6, we have determined that it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention to have affixed a carrier rack and

platform as taught by Bass onto Laiti's tubular supporting arm 3 as suggested by Laiti's teaching that his device may carry any type of luggage rack.

Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over Laiti in view of Shockley as applied to claim 1 above, and further in view of Edmonds.

Based on our analysis and review of Laiti and claim 7, it is our opinion that while Laiti does teach a clamping system 4 Laiti does not teach any of the limitations thereof recited in claim 7.

Edmonds discloses a bicycle package carrier. As shown in Figures 1 and 2, the bicycle package carrier includes a semi-circular flange a'' having lateral ears a'''' and a semi-circular clamping-piece B having a lateral ear b'. The clamping-piece B is hinged at b to the semi-circular flange a'' and lateral ear b' of the clamping-piece B may be closed against one ear a'''' and secured thereto by means of a screw c and thumb-nuts c'. This provides a simple and effective means

to readily attach the carrier to the stem H of the bicycle frame.⁵

With regard to this additional difference, we have determined that it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention to have replaced Laiti's clamping system with the alternative clamping system as suggested and taught by Edmonds to provide a simple and effective means to readily attach/detach Laiti's device to the seat pillar of the bicycle frame.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 7 under 35 U.S.C. § 103 is reversed and a new rejection of claims 1, 2 and 4 through 7 under 35 U.S.C. § 103 has been added pursuant to provisions of 37 CFR § 1.196(b).

⁵ See page 1, lines 13-16 and 46-59, of Edmonds.

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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ROGER W ERICKSON
OWEN WICKERSHAM & ERICKSON
455 MARKET STREET 19TH FLOOR
SAN FRANCISCO, CA 94105

APPENDIX

1. A combined rack and storage device for a bicycle having a seat post, comprising:

- an elongated hollow body having a front end and a rear open end; said body having clamp means at said front end that is closeable for attaching said device to said bicycle seat post so that said body is cantilevered therefrom in substantially a horizontal position, and closure means at said rear open end for forming a closed but accessible storage compartment;

- frame means attached to said body and extending outwardly therefrom for supporting and carrying items that are too large to fit within said body compartment.

2. The device of claim 1 wherein said hollow body has a cylindrical shape and is made of rigid, metal material.

3. The device of claim 2 wherein said closure means comprises a plug portion of yieldable material which forms an interference fit with the open end of said body and an outer flange member fixed to one side of said plug portion and having an outer reflective surface.

4. The device of claim 1 wherein said frame means comprises metal rod material formed in a generally rectangular shape with side portions located parallel to and spaced from

opposite sides of said body, and strut members fixed to said side portions and said body for retaining said frame means in place on said body.

5. The device of claim 4 wherein said frame means includes an integral, generally U-shaped forward portion interconnecting said side portions that slopes upwardly from said body to provide a stop means for externally carried items.

6. The device of claim 4 including an internal plate member attached horizontally to the top of said body member and centered between said frame side portions.

7. The device of claim 1 wherein said clamp means comprises a pair of semi-cylindrical, flexible jaws, said jaws having outer flanges, and adjustable fastening means extending through said flanges.

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APJ NASE

APJ COHEN

APJ McCANDLISH

DECISION: **REVERSED;**
37 CFR § 1.196(b)

Prepared By: Delores A. Lowe

DRAFT TYPED: 20 Feb 98

FINAL TYPED: