

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN MUELLER

Appeal No. 1997-3814
Application No. 08/601,461

ON BRIEF

Before FRANKFORT, McQUADE, 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 to 8, which are all of the claims pending in this application.¹

¹ Claim 1 was amended subsequent to the final rejection. While the examiner has approved entry of the amendment after final rejection (filed January 7, 1997), we note that this amendment has not been clerically entered.

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We REVERSE.

BACKGROUND

The appellant's invention relates to a "push-up" type package for a frozen confection which includes a plunger member which can be used as a novelty ink stamp after consumption of the confection (specification, p. 1). A substantially correct copy of the claims under appeal is set forth in the appendix to the appellant's brief.²

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

Chamberlain 1878	204,421	June 4,
Wheless 1888	377,974	Feb. 14,
Zabriskie 23, 1926	1,607,660	Nov.
Collier 1963	3,085,883	Apr. 16,
Stump 1971	3,595,449	July 27,
Hodska 1976	3,968,262	July 6,
Mueller 1992	5,111,973	May 12,

² Claim 1 as set forth in the appendix to the brief does not reflect the amendments made to Claim 1 subsequent to the final rejection.

Perez ³ 1953	1,047,276 (France)	Dec. 14,
D'Avignonet et al. ⁴ 16, 1979 (D'Avignonet)	2,397,793 (France)	Feb.
Caggiano ⁵ 1992	0 488 447 (European Patent Application)	June 3,

In addition, the examiner also relied upon the appellant's admission of prior art found on page 1 of the specification.

Claims 1, 2 and 4 to 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over appellant's admission of prior art as further evidenced by Stump in view of Collier further in view of Perez, D'Avignonet, Hodska and Caggiano, further in view of Zabriskie, further in view of Chamberlain and Wheless.

³ In determining the teachings of Perez, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

⁴ The examiner has referred to this reference as "Reference L." In determining the teachings of D'Avignonet, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

⁵ The examiner has referred to this reference as "Unilever."

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over the references as applied to claim 1 above, and further in view of Mueller.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 11, mailed April 15, 1997) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed January 7, 1997) 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 to 8 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 would have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues (brief, pp. 4-8) that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require a "push-up" type package for a frozen confection having a plunger member with a raised printing surface which can be used as a novelty ink

stamp after consumption of the confection. However, these limitations are not suggested by the applied prior art. In that regard, while some of the applied prior art (i.e., Collier, Perez, D'Avignonet, Hodska and Caggiano) do teach a frozen confection having a toy and some of the applied prior art (Zabriskie, Chamberlain and Wheless) do teach a hand stamp combined with another conventional element, the applied prior art would not have suggested providing the plunger member of a "push-up" type package for a frozen confection with a raised printing surface which can be used as a novelty ink stamp after consumption of the confection. In our view, the only suggestion for modifying the appellant's admission of prior art as evidenced by Stump to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 to 8.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 8 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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