

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(2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANDRA K. ELLISON

Appeal No. 1998-0045
Application 08/699,135¹

HEARD: October 4, 1999

Before PATE, McQUADE and BAHR, ***Administrative Patent Judges.***

¹ Application for patent filed August 16, 1996. According to appellant, the application is a continuation of Application 08/420,025, filed April 11, 1995, abandoned.

Appeal No. 1998-0045
Application 08/699,135

PATE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 13. These are all of the claims in the application.

The claimed invention is directed to a greeting card which includes a stained glass ornament. The card portion of the combination includes an aperture through which the stem of a suction cup projects. The ornament is affixed to the stem of the suction cup and is thereby held on the card. When the user receives the card, the user removes the ornament from the suction cup, removes the suction cup from the card, and then affixes the suction cup to a structure where the ornament is to be displayed. The ornament is then reattached to the suction cup. The claimed subject matter can be further understood with reference to claims 1 through 13 appended to appellant's brief.

Appeal No. 1998-0045
Application 08/699,135

The references of record relied upon by the examiner as evidence of obviousness are:

Plante 1933	1,922,900	Aug. 15,
Transport 1982	4,319,418	Mar. 16,
Sy, Jr. 1992	5,131,177	July 21,

THE REJECTIONS

Claims 1 through 8 and 12 stand rejected under 35 U.S.C. § 103 as unpatentable over Transport in view of Sy, Jr. The examiner states that Transport teaches a folded paper greeting card with a collapsible ornament affixed therein by staple 129. The examiner acknowledges that Transport does not teach an affixing means which partly projects from an aperture in the card. The examiner has cited Sy, Jr. for the teaching of affixing a suction cup to a card via an aperture in the card. The examiner concludes that it would have been obvious to utilize the affixing means of Sy, Jr. in the card of Transport to provide a means for affixing the ornament to a

Appeal No. 1998-0045
Application 08/699,135

variety of surfaces without the need for any other hanging hardware (such as a hook or nail).

Claims 9 through 11 and 13 stand rejected under 35 U.S.C. § 103 as unpatentable over Transport and Sy, Jr. as applied to claims 1 through 8 and 12 above, and further in view of Plante. Plante has been cited to show a figure eight-shaped wire to affix a card to a suction cup. The examiner concludes that it would have been obvious to one of ordinary skill to apply such a wire to the device of Transport to securely retain the ornament on the suction cup.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have determined that the applied prior art does not establish a ***prima facie*** case of obviousness with respect to the claimed subject matter. Consequently, we reverse the rejections on appeal. Our reasons follow.

Appeal No. 1998-0045
Application 08/699,135

We are in agreement with appellant's argument that the examiner has misinterpreted the teaching of Sy, Jr. Appellant argues that the teaching of the Sy, Jr. reference is to mount the **card** by a suction cup. There is no teaching in the prior art taken as a whole of using the suction cup to releasably connect the ornament to the card.

We further credit appellant's argument that Transport's staple is not intended to do double duty by first affixing the ornament to the card and then affixing the ornament to the suction cup of Sy, Jr. when the teachings of the patents are combined. We can only conclude that the suggestion for using a releasable connection between the ornament and the suction cup to temporarily mount the ornament on the suction cup and card for mailing finds its genesis in impermissible hindsight reconstruction of appellant's claimed subject matter. As such, it cannot provide a legitimate basis for a **prima facie** case of

Appeal No. 1998-0045
Application 08/699,135

obviousness. Therefore, we are constrained to reverse the rejection of claims 1 through 8 and 12.

With respect to claims 9 through 11 and 13, the reference patent to Plante does not alleviate the shortcomings of the basic references discussed above. The rejection of these claims is also reversed.

REVERSED

	WILLIAM F. PATE, III)	
	Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT)	
	JOHN P. McQUADE)	APPEALS AND
	Administrative Patent Judge)	
INTERFERENCES)	
)	
)	
	JENNIFER D. BAHR)	
	Administrative Patent Judge)	

Appeal No. 1998-0045
Application 08/699,135

WFP:psb

Appeal No. 1998-0045
Application 08/699,135

Stefan V. Stein
Dominik & Stein
600 N. Westshore Boulevard
Suite 1000
Tampa, FL 33609