

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REN R. WEI

Appeal No. 98-0973
Application No. 08/538,419¹

ON BRIEF

Before ABRAMS, FRANKFORT and McQUADE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-6, which constitute all of the claims of record in the application.

¹Application for patent filed October 2, 1995.

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The appellant's invention is directed to a relaxing device comprising a hollow spherical ball having a sounding device located within. The subject matter before us on appeal is illustrated by reference to claim 1, which has been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Lambert 1918	1,286,657	Dec. 3,
Salisbury 4, 1935	2,003,957	Jun.

THE REJECTION

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Salisbury in view of Lambert.

The rejection is explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief and the Reply Brief.

OPINION

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The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). However, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In establishing a *prima facie* case of obviousness under 35 USC § 103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5

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USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825
(1988).

All of the claims stand rejected as being unpatentable over Salisbury in view of Lambert. It is the examiner's position that Salisbury lacks only one of the limitations set forth in independent claim 1, and that is "the teaching for the ball to have a decorative coating at a plurality of spaced locations" (Answer, page 3). We agree with the appellant that this is only one of the limitations lacking in Salisbury.

The initial limitation recited in independent claim 1 is that the relaxing device comprises a "hard" hollow spherical ball. The appellant has provided guidance as to the definition to be applied to "hard," in that the suggested materials from which it is to be made are "tough plastic, aluminum, steel or iron," with iron being preferred because of its "sounding properties" (specification, page 3). We agree with the appellant that this is not taught by Salisbury. The ball disclosed by Salisbury is intended to be a toy for dogs, and is described as being of "semihard rubber" (page 1, column 1, line 10) "to make the ball capable of withstanding the chewing" while providing sufficient hardness in the hollow

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interior to repel the noise making ball encapsulated therein to emit the desired jingling sound (page 1, column 2, line 3 *et seq.*). We also observe that the term "bounds" is used to refer to the action of the ball when in use (page 1, column 2, line 11), which indicates that the material from which it is made is sufficiently soft to allow the ball to bounce.

Furthermore, it is our view that the artisan would understand that a ball to be chewed by a dog must not have a surface that is of a hardness such as that of iron or steel, in that it could not be chewed and therefore would not be attractive to dogs.

Claim 1 further requires that the ball be "of a size to be completely encircled and gripped in the palm of the hand of the user." The appellant has provided guidance here, also, by stating on page 1 of the specification that the inventive ball is "smaller than a billiard ball," and on page 3 that in the preferred embodiment it has a diameter of "about one and one half inches so as to be easily held in the palm of the hand." Salisbury provides no explicit size information about the dog toy disclosed therein, and therefore it would be speculative to assume that it meets this term of the claim.

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The claimed ball also must have "a relatively thin walled rigid shell to resist any deformation in its normal range of use." The Salisbury ball is disclosed as being "so thick as to prevent pressure on the ball from inverting the curvature of any particular section of the ball" and must be capable of withstanding "the rough chewing of a dog" (page 1, column 1, lines 45-55). This suggests that it is contemplated that some deformation would occur. It therefore is our view that one of ordinary skill in the art would not have considered the Salisbury ball to have the required "rigid" shell.

There also is no indication in Salisbury that the ball has a "smooth, hard, decorative coating on the outer surface of the shell." In fact, it would appear, in our view, that in order for the Salisbury ball to function as a toy for dogs, such a coating would not be desirable.

Finally, as the examiner has admitted, Salisbury clearly does not disclose or teach placing a figure 8 on the surface at a plurality of locations.

Lambert discloses a billiard ball characterized by the presence of a number of "level areas" (7), where symbols can be placed. While no details are provided as to the material

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from which the ball is made, in view of its intended use it can safely be assumed that its surface is hard. It is described as being colored, although there is no clue as to whether this is accomplished by coating the outside surface, or by coloring the material from which it is made. As evidenced by the shading in Figure 2, the Lambert ball is solid, and does not have an interior chamber.

It is the examiner's opinion that it would have been obvious to one of ordinary skill in the art to provide the Salisbury ball with a decorative coating "for purposes of mere ornamental design" (Answer, page 3). We disagree with this because there is no clear teaching in Lambert that color is provided by a coating, as well as on the basis that there is no evidence from which to conclude placing a coating upon the Salisbury ball would serve a legitimate purpose, inasmuch as its intended use is as a chew toy for dogs. In fact, its intended use would seem to provide a disincentive for such a modification, since a "coating" would seem to be incompatible with a surface that is to be chewed by an animal.

In addition, as we pointed out above, there are several other shortcomings in the Salisbury reference which would not

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be alleviated by looking to the teachings of Lambert. To make the Salisbury ball hard, as in Lambert, would fly in the face of its intended use and thus, from our perspective, one of ordinary skill in the art would not have been motivated to do so. Nor does Lambert suggest that the ball be of lesser size than a billiard ball, about one and one half inches in diameter, since it is a billiard ball. Finally, although Lambert does not preclude the use of the figure 8 on the ball, it does not suggest that this particular numeral be used, which the appellant considers to be of significance in the present invention (specification, pages 2 and 4).

It therefore is our conclusion that the teachings of the two applied references fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in claim 1. This being the case, we will not sustain the rejection of independent claim 1 or, it follows, of claims 2-6, which depend therefrom.

The decision of the examiner is reversed.

REVERSED

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