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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES W. HICKMAN
and
PAUL L. HICKMAN

Appeal No. 1998-1029
Application 08/361,590¹

ON BRIEF

Before COHEN, STAAB and CRAWFORD, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 17 and 19-22 as amended by amendments

¹ Application for patent filed December 22, 1994. According to the appellants, the application is a division of Application 08/172,873, filed December 23, 1993, now Patent No. 5,376,040, issued December 27, 1994.

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filed subsequent to the final rejection.² Claims 1-3, 5, 6 and 8-10, the only other claims remaining in the application, have been allowed.

Appellants' invention pertains to a toy head comprising a face having an elastically deformable mouth. By deforming the mouth, facial features, such as the eyes and eyebrows, are altered for the amusement of a child. Independent claims 17 and 22, copies of which can be found in an appendix to appellants' brief, are illustrative of the appealed subject matter.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:

Sauer 1909	942,465	Dec. 7,
Exline 1939	2,184,639	Dec. 26,
Bunin 1963	3,070,920	Jan. 1,
Owens 1993	Des. 335,937	May 25,

The following rejections under 35 U.S.C. § 103 are before us for review:

²The amendments are amendment "C" (Paper No. 9, filed November 12, 1996) and amendment "D" (Paper No. 13, filed December 20, 1996).

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a) claims 17 and 19-21, unpatentable over Bunin;
b) claims 17 and 19-22, unpatentable over "Sauer in view
of Exline and vice versa" (answer, page 4); and

c) claims 17 and 19-22, unpatentable over Owens.

The rejections are explained in the final rejection
(Paper No. 8, mailed August 6, 1996) and the examiner's answer
(Paper No. 16, mailed June 24, 1997).

The opposing viewpoints of appellants are set forth in
the brief (Paper No. 15, filed March 11, 1997).

The § 103 rejection based on Bunin

Independent claim 17 is directed to a method of providing
an amusement toy comprising, inter alia, providing a toy head
of an elastically deformable material having a mouth allowing
at least two fingers to be inserted into the mouth, applying a
force to the mouth to deform it from an undeformed width to a
deformed width that is at least 50% greater than the
undeformed width, and removing the force from the mouth, such
that the mouth automatically returns to substantially its
undeformed width.

Bunin pertains to a puppet-like figure which may be continuously manipulated and deformed to simulate living or moving inanimate objects in, for example, animated movie cartoons, and television cartoons and commercials. The puppet-like figure is composed of flexible material such as sponge or foam polyurethane, polyester, or the like (column 1, lines 43-45). Thin wire rods, such as elements 11, that are nearly invisible to the audience are provided to manipulate the puppet-like figure (column 1, lines 57-68). Bunin discloses various shapes for the puppet-like figure, including one (Figure 2) that includes a toy head comprising a face having a deformable mouth 13 manipulated by rods 11, and other facial features including a nose and eyes. With respect to the physical properties of the material for the puppet-like figure, Bunin states the following:

Flexibility in the sense of being deformable without suffering permanently induced change in shape is the principal criterion for choosing the material to be used. Elasticity in the sense of extensibility is not a fundamental requisite although the materials indicated do have some elasticity. In other words, the material to be used must be readily continuously deformable so that the two-dimensional figures of my invention are supported and operated with the control apparatus. [Column 2, lines 34-42.]

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In rejecting claim 17 as being unpatentable over Bunin, the examiner implicitly concedes that Bunin does not disclose a toy having a mouth sized to allow at least two fingers to be inserted into the mouth, and that Bunin does not disclose that the material of the puppet-like figure is elastically deformable and capable of automatically returning to substantially its undeformed width when force is removed. Nevertheless, the examiner considers that

. . . the size of the mouth would have been obvious as an obvious matter of design choice. It would have been obvious to make the mouth opening of any size, including a size to allow at least two fingers to be inserted.

As to the elasticity of the material, Bunin merely does not require the material to be elastic. However, he does not say the material cannot be elastic. In fact, the material is elastic so that the material will not suffer permanent induced change. [Final rejection, page 2.]

With respect to the claim requirement that the elasticity of the material of the toy is such that the mouth can be deformed to a width that is at least 50% greater than its undeformed width, the examiner further contends that

. . . Bunin clearly discloses [that] the mouth of the figure is flexible and [has] elasticity (column

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2, lines 34-42). [When] [t]he explicit disclosure of elasticity [is] taken in view of the complexity of the invention and the skill of the ordinary skilled artisan, it is deemed that to make the mouth of the Bunin figure deformable over 50% would have been obvious, since the difference between the invention and the prior art is merely a matter of degree of elasticity and it is strongly believed that the ordinary skilled artisan would have the skill to modify the disclosed elasticity to any degree including over 50%. [Answer, page 5.]

Legal conclusions of obviousness must be supported by facts. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). An examiner has the initial burden of supplying the requisite factual basis and may not, because of doubts that the claimed invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id.*

We are aware that the material of Bunin's puppet-like figure has at least some elasticity. We also are aware that Bunin's Figure 2 embodiment includes a mouth that may be manipulated by rods 11 to change the expression of the face. However, Bunin is silent as to the size of the mouth, and expressly states that the principal criterion for choosing the material of the puppet-like figure is flexibility, not

elasticity. Based on the lack of specifics in these matters, the examiner's conclusions that it would have been obvious to one of ordinary skill in the art to (1) make the mouth opening of Bunin's Figure 2 embodiment of a size allowing at least two fingers to be inserted therein, and (2) select the material of Bunin's Figure 2 puppet-like figure such that its mouth is capable of being deformed over 50% of its undeformed width and then automatically return to substantially its undeformed width when a deforming force is removed, lack suggestion in the applied prior art. In this regard, the test for obviousness is not that the ordinarily skilled artisan "would have the skill to modify the disclosed elasticity to any degree including over 50%" (answer, page 5), as the examiner appears to believe.

In light of the foregoing, we are constrained to reverse the standing § 103 rejection of claims 17 and 19-21 as being unpatentable over Bunin.

The § 103 rejection based on Sauer and Exline

Sauer is directed to a picture device that may be manipulated so that the expression or attitude of the picture

thereof may be changed. The Sauer device

consists of a continuous strip of thin, flexible material 5, such as paper or tape, wound tightly upon itself, and having on the surface of the outside portion of the strip a flexible band of substantial material 7 preferably rubber, leather or bicycle tire tape. This flexible band . . . serves to hold securely in place the successive windings of the strip 5, allowing at the same time sufficient play of the windings to secure the changes in the lines of the picture. [Specification, lines 43-55.]

When light pressure is applied to the edge surface, successive folds of material move and the picture takes on another expression or attitude. Compare Figures 1 and 2. Sauer expressly states (lines 33-37) that the friction between the successive folds is sufficient to keep the device in any position secured by the pressure upon the outside band and that a selected position is retained until other pressure is applied.

Exline pertains to a toy comprising the head and face of a figure that is constructed of a resilient or elastic material such as sponge rubber that is capable of distortion to change the expression of the face. This is accomplished by embedding an operating element such as rod 14 in the material of the head, and manually manipulating the rod to deform the

face. Compare Figures 1 and 4. Due to the elasticity of the material, when the distorting force is removed, Exline's figure returns to its original undistorted position.

In rejecting the appealed claims on the combined teachings of Sauer and Exline, the examiner has taken the position that it would have been obvious in view of Exline to make the Sauer device of an elastic material "for allowing the structure to automatically return to its undistorted condition" (answer, page 4). We do not agree. Sauer's express teaching that the device thereof should be constructed in a manner that permits it to retain a selected distorted position presents a disincentive to the modification proposed by the examiner. Because the modification proposed for Sauer would render it unsuitable for its intended purpose of remaining in a selected distorted position until another force is applied, it cannot be said that the proposed modification would have been obvious to one of ordinary skill in the art. *Ex parte Rosenfeld*, 130 USPQ 113, 115 (Bd. App. 1961).

The examiner also contends that it would have been obvious "to provide an opening at the mouth of the Exline head

as suggested by Sauer as an obvious alternative in design and/or to allow an easier movement of the mouth" (answer, page 4). Implicit in the rejection is the examiner's position that the modified Exline device, and its method of use, would correspond to the claimed article (claim 22) and method (claims 17 and 19-21) in all respects. Once again, we do not agree. From our perspective, there is no suggestion in either reference, or need in view of their divergent objectives, for their combination. Moreover, even if combined in the manner proposed by the examiner, it is questionable whether the claimed requirements concerning, for example, the size of the mouth opening and the degree of deformability of the mouth would result in the absence of the hindsight knowledge gleaned from first reading appellants' disclosure.

We therefore also will not sustain the standing § 103 rejection of the appealed claims as being unpatentable over the combined teachings of Sauer and Exline.

The § 103 rejection based on Owens

The Owens reference is a design patent directed to the ornamental design of a face mask, as shown and described. The

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drawing figures depict a mask made of thin sheet material for covering the face of the wearer. The mask includes what appears to be a mouth opening and areas depicting eyes that may be openings covered with transparent or translucent material.

The examiner acknowledges that Owens is silent as to the material of the mask. We further note that Owens does not disclose or suggest deforming the mouth of the mask at least 50% greater than its undeformed width, as required by claim 17, and further that Owens does not disclose or suggest providing a toy body such that the center of gravity of the toy is not within the toy head, as required by claim 22. Notwithstanding these deficiencies, the examiner has taken the position that it would have been obvious to make the mask of Owens of an elastic material "since it is commonly done" (final rejection, page 2), and has implicitly concluded that this would result in the subject matter of the appealed claims. We disagree.

Simply put, the Owens design patent alone does not provide a sufficient evidentiary basis to support the examiner's conclusions of obviousness. *In re Warner, supra.*

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Accordingly, the standing § 103 rejection of the appealed claims based on Owens will not be sustained.

Summary

The reference evidence adduced by the examiner is insufficient to support a conclusion of obviousness of the claimed subject matter. This being the case, we are constrained to reverse each of the standing rejections under 35 U.S.C. § 103.

Reversed

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IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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MURRIEL E. CRAWFORD)	
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