

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL E. KEELER

Appeal No. 98-1971
Application 08/575,125¹

ON BRIEF

Before CALVERT, FRANKFORT and GONZALES, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 24, all of the claims pending in the application.

Appellant's invention is directed to a dolly device for lifting and transporting an object, such as a snowmobile.

¹ Application for patent filed December 19, 1995.

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Claims 1, 10, 19 and 21 are representative of the subject matter on appeal and copies of those claims appear in the Appendix of appellant's brief.

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

Garellick	3,667,728	Jun. 6, 1972
Moisan	4,978,103	Dec. 18, 1990
Imbeault et al. (Imbeault)	5,299,659	Apr. 5, 1994
Vasilev (Russian Patent)	1,710,419	Feb. 7, 1992

Claims 1, 2, 5 through 7, 10 through 15 and 19 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Garellick in view of Moisan.

Claims 4, 8, 9, 16 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Garellick in view of Moisan as applied above and further in view of Imbeault.

Claims 3 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Garellick in view of Moisan as applied above and further in view of Vasilev.

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Reference is made to the examiner's answer (Paper No. 13, mailed January 7, 1998) for the examiner's reasoning in support of the above-noted rejections and to the appeal brief (Paper No. 12, filed November 17, 1997) for appellant's arguments thereagainst.

OPINION

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art references, and the respective positions advanced by appellant and the examiner. As a consequence of our review, we have come to the conclusion, for the reasons which follow, that the examiner's rejections of the appealed claims under 35 U.S.C. § 103 are not well founded and, therefore, will not be sustained. However, we have also entered a new ground of rejection against certain of the appealed claims pursuant to our authority under 37 CFR § 1.196(b).

Turning first to the examiner's rejection of claims 1, 2, 5 through 7, 10 through 15 and 19 through 24 under 35 U.S.C. §

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103 as being unpatentable over Garelick in view of Moisan, we note that the examiner has concluded that it would have been obvious to one of ordinary skill in the art to modify the apparatus of Garelick so as to include a first member, as claimed, in view of the teachings in Moisan (i.e., elements 59 and 61-64 of Moisan) as such modification would have merely involved the usage of an old and well known arrangement of mounting the wheels. After reviewing the teachings of Garelick and Moisan from the perspective of one of ordinary skill in the art, we are in full agreement with appellant that the examiner has improperly relied upon the disclosure of the present application and appellant's own teachings in attempting to import the member (59) and wheels from Moisan into the device of Garelick and in concluding that one of ordinary skill in the art would have found it obvious to modify the apparatus of Garelick in the manner urged above.

Moreover, we share appellant's view that if the apparatus of Garelick were modified in the manner posited by the examiner such modification would destroy the apparatus of Garelick for its intended purpose and preclude its functioning

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in the manner set forth in the Garelick patent. Like appellant, we consider that the absence of any connecting rod structure between the wheels of Garelick's apparatus is essential in order for the dolly of Garelick to be properly positioned around the snowmobile therein and to function in the manner envisioned by the patentee. Simply stated, we see nothing in the disclosure of Garelick and Moisan which would have fairly led a worker of ordinary skill in the art to the particular modifications of Garelick urged by the examiner.

As is well settled, a rejection based on §103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert denied*, 389 U.S. 1057 (1968).

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Based on the above determinations, we are compelled to reverse the examiner's rejection of claims 1, 2, 5 through 7, 10 through 15 and 19 through 24 under 35 U.S.C. § 103 as being unpatentable over Garelick in view of Moisan.

We have also reviewed the patents to Imbeault and Vasilev applied by the examiner in the other § 103 rejections on appeal. However, we find nothing in these references or in the examiner's additional comments regarding such references which would supply that which we have noted above to be lacking in the basic combination of Garelick and Moisan. Accordingly, the examiner's rejections of claims 3, 4, 8, 9 and 16 through 18 on appeal under 35 U.S.C. § 103 will likewise not be sustained.

As should be apparent from the foregoing, the decision of the examiner rejecting claims 1 through 24 of the present application is reversed.

Pursuant to 37 CFR § 1.196(b), we enter the following new ground of rejection against claims 21 through 24 on appeal.

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Claims 21 through 24 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Garelick. In this regard, we observe that Garelick discloses (in the language of claim 21 on appeal) a device for lifting and transporting an object, wherein said device comprises a first member (11, 11a); a second member (D) removably connectable to said first member; a handle assembly or lever means (B) operatively connectable to said first and second members for rotating said members between a first position where said members are in a bottom position beneath a first portion of the object to be lifted and transported, and a second position where said members are in a raised position having said first portion of said object resting on a top surface of said second member; and means (C) in the form of a bolt and chain assembly for maintaining a second portion of said object above the ground so that said object is substantially balanced on said second member to facilitate transporting said object. With respect to claims 22 and 23 on appeal, the device of Garelick additionally includes one or more wheels (12, 12a) connected to said first member and an arrangement wherein said lever means or handle assembly (B) includes an elongated third

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member (2 or 3) having a first end which is removably engaged with said first member. As for claim 24 on appeal, Garelick's maintaining means (C) includes a movable member (6, 7) which selectively engages along a predetermined portion of said object and with a second end of said third member (2 or 3) as can be seen in Figure 3 of the patent, and wherein said predetermined portion is proximal said second portion of said object and distal said first portion of said object.

As is apparent from the above determinations, the examiner's decision rejecting claims 1 through 24 under 35 U.S.C. § 103 has been reversed and a new rejection of claims 21 through 24 on appeal has been entered by this panel of the Board pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

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§ 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 ground 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).

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REVERSED, 37 CFR § 1.196(b)

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Administrative Patent Judge)	
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