

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BRENT MOLLER

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Appeal No. 2000-0941  
Application No. 09/077,362

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ON BRIEF

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Before ABRAMS, FRANKFORT, 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 5, 7, 8, and 10 to 12, which are all of the claims pending in this application.<sup>1</sup>

We REVERSE.

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<sup>1</sup> Claim 7 was amended subsequent to the final rejection.

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BACKGROUND

The appellant's invention relates to a roller blind (claims 1 to 5, 7, 8, and 10) and a kit for decorating a roller blind (claims 11 and 12). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Cadmus 1935	2,024,090	Dec. 10,
Koller et al. 1993 (Koller)	5,203,395	Apr. 20,

Claims 1, 2, 4, 5, 7, 8, 11 and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Cadmus.<sup>2</sup>

Claims 1, 2, 4, 5, 7, 8 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Koller.

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<sup>2</sup> On page 3 of the answer, it appears to us that the examiner inadvertently failed to carry forward claim 5 from this ground of rejection as set forth in the final rejection.

Claims 3 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cadmus.

Claims 3, 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koller.<sup>3</sup>

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. 13, mailed January 13, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 12, filed November 3, 1999) and reply brief (Paper No. 14, filed March 7, 2000) 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

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<sup>3</sup> On page 4 of the answer, the examiner inadvertently included claim 6 in this ground of rejection. However, claim 6 was canceled subsequent to the final rejection.

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

**The anticipation rejection based on Cadmus**

We will not sustain the rejection of claims 1, 2, 4, 5, 7, 8, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Cadmus.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claims 1 and 11, the only independent claims on appeal, read as follows:

1. A roller blind for use in connection with a roof window mounted in a pitched roof, the window having a frame having a top, comprising:
  - a roller tube (1) which is mountable at the top of the frame of the window;

a flexible roller blind cloth (2), said roller blind cloth having a rolled up condition in which the roller blind cloth is rolled up on the roller tube and a rolled out condition in which part of the roller blind cloth is rolled off the roller tube, the roller tube being resiliently biased toward rolling said roller blind cloth to its rolled up condition; and

means for retaining the roller blind cloth (2) in the rolled out condition against the resilient bias of the roller tube (1),

wherein at least one additional flat cloth (3) of flexible material is fastened on the roller blind cloth in a zone (4) in parallel with the roller tube (1), the additional flat cloth (3) hanging freely from the roller blind cloth (2) when the roller blind cloth is in its rolled out condition, and the additional flat cloth being rolled up on the roller tube together with the roller blind cloth when the roller blind cloth is in its rolled up condition.

11. A kit for decorating a roller blind for use in connection with a roof window mounted in a pitched roof, wherein the window has a frame having a top, and the roller blind includes a roller tube (1) which is mountable at the top of the frame of the window; a flexible roller blind cloth (2), said roller blind cloth having a rolled up condition in which the roller blind cloth is rolled up on the roller tube and a rolled out condition in which part of the roller blind cloth is rolled off the roller tube, the roller tube being resiliently biased toward rolling said roller blind cloth to its rolled up condition; and means for retaining the roller blind cloth (2) in the rolled out condition against the resilient bias of the roller tube (1), comprising:

a plurality of flat addition cloths (3) of flexible material each adapted to be fastened on the roller blind cloth in a zone (4) in parallel with the roller tube (1) in such a way that the additional cloths (3) hang freely from the roller blind cloth (2) when the roller blind

cloth is in its rolled out condition and are rolled up on the roller tube together with the roller blind cloth when the roller blind cloth is in its rolled up condition, each said flat additional cloth having means for detachably fastening said flat additional cloth to said zone.

We find ourselves in agreement with the appellant that Cadmus does not anticipate claim 1 for the reasons set forth in the brief (pages 5-6) and reply brief (pages 1-2). In that regard, it is our opinion that Cadmus' strips 14 do not "hang freely" from his shade 10 due to the presence of stitching 16.

We find ourselves in agreement with the appellant that Cadmus does not anticipate claim 11 for the reasons set forth in the brief (pages 6-7) and reply brief (page 2). In that regard, we agree with the appellant that the claimed means for detachably fastening the flat additional cloth to a zone on a roller blind cloth<sup>4</sup> is not readable on Cadmus' stitching 15.

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<sup>4</sup> In order to meet a "means-plus-function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir.

(continued...)

Since all the limitations of independent claims 1 and 11 are not disclosed in Cadmus for the reasons set forth above, the decision of the examiner to reject claims 1, 2, 4, 5, 7, 8, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Cadmus is reversed.

**The anticipation rejection based on Koller**

We will not sustain the rejection of claims 1, 2, 4, 5, 7, 8 and 10 under 35 U.S.C. § 102(b) as being anticipated by Koller.

We find ourselves in agreement with the appellant that Koller does not anticipate claim 1 for the reasons set forth in the brief (pages 7-8 and reply brief (pages 3-4)). It is our opinion that claimed limitation that "the additional flat cloth being rolled up on the roller tube together with the roller blind cloth when the roller blind cloth is in its

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<sup>4</sup>(...continued)  
1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989).

rolled up condition" is not readable on Koller's ruffle 8. In that regard, we find no disclosure in Koller that his ruffle 8 rolls up with shade panel 6 onto the roller assembly 4. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939))

(internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Since all the limitations of independent claim 1 are not disclosed in Koller for the reason set forth above, the decision of the examiner to reject claims 1, 2, 4, 5, 7, 8 and 10 under 35 U.S.C. § 102(b) as being anticipated by Koller is reversed.

**The obviousness rejection based on Cadmus**

We will not sustain the rejection of dependent claims 3 and 10<sup>5</sup> under 35 U.S.C. § 103 as being unpatentable over Cadmus.

As set forth above, it is our opinion that Cadmus' strips 14 do not "hang freely" from his shade 10 due to the presence of stitching 16. In this rejection, the examiner appears (answer, page 4) to have concluded that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to eliminate Cadmus' stitching 16 to permit Cadmus' strips 14 to hang freely. However, since the examiner has not

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<sup>5</sup> Claims 3 and 10 indirectly depend from claim 1.

cited any evidence<sup>6</sup> to support this conclusion, it appears to us that the examiner relied on impermissible hindsight<sup>7</sup> in reaching his obviousness determination. Since the "hang freely" limitation is not taught or suggested by the applied prior art, the decision of the examiner to reject claims 3 and 10 under

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<sup>6</sup> Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

<sup>7</sup> The use of hindsight knowledge derived from the appellant's own disclosure to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

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35 U.S.C. § 103 as being unpatentable over Cadmus is reversed.

**The obviousness rejection based on Koller**

We will not sustain the rejection of claims 3, 11 and 12 under 35 U.S.C. § 103 as being unpatentable over Koller.

The decision of the examiner to reject claim 3 under 35 U.S.C. § 103 as being unpatentable over Koller is reversed for the reasons set forth above with respect to its parent claim 1.

With regard to claims 11 and 12, the examiner has not cited any evidence to support his conclusion (answer, page 4) that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide Koller's shade with additional cloths (i.e., ruffles). Instead, it appears to us that the examiner once again has relied on impermissible hindsight in reaching his obviousness determination. Accordingly, the decision of the examiner to reject claims 11 and 12 under 35 U.S.C. § 103 as being unpatentable over Koller is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 4, 5, 7, 8, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Cadmus is reversed; the decision of the examiner to reject claims 1, 2, 4, 5, 7, 8 and 10 under 35 U.S.C. § 102(b) as being anticipated by Koller is reversed; the decision of the examiner to reject claims 3 and 10 under 35 U.S.C. § 103 as being unpatentable over Cadmus is reversed; and the decision of the examiner to reject claims 3, 11 and 12

under 35 U.S.C. § 103 as being unpatentable over Koller is reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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