

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARVIN L. JONES

Appeal No. 96-0655
Application No. 08/052,507¹

ON BRIEF

Before METZ, JOHN D. SMITH, and WALTZ, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's second rejection of claims 9 through 16 (see the Rejection dated Dec. 7, 1994, Paper No. 7). Claims 1 through 8 and 22, the only other claims remaining in this application,

¹Application for patent filed April 26, 1993.

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stand withdrawn from further consideration by the examiner as being directed to a nonelected invention (Answer, page 1).²

According to appellant, the invention is directed to a composite, full length window covering constructed from short remnant lengths of panels of cellular fabric (Brief, page 2). Claim 9 is illustrative of the subject matter on appeal and is reproduced below:

9. A method of making a composite window covering from panels of cellular fabric, said fabric being constructed of tubular cells arranged in side by side relationship, comprising the steps of:
providing a first panel of cellular fabric of desired width;
trimming a cell of said first panel of cellular fabric to

leave a first attachment strip surface extending centrally of the thickness of said first panel of material and the full length of said cell;

²Appellant states that claims 9-16 stand rejected but that claims 9-16 and 22 are on appeal (Brief, page 2). Appellant argues that the restriction requirement applied to claim 22 is improper (Brief, page 4) and this issue is properly before the Board since it involves substantive claim construction (Reply Brief, Paper No. 11, page 2). However, as noted by the Examiner on page 2 of the Answer, the propriety of a restriction requirement is petitionable, not appealable. See 35 U.S.C.

§ 134; 37 CFR §§ 1.144, 1.181 and 1.191(a); and the *Manual of Patent Examining Procedure*, §§ 1002.02(c) and 1201, 7th ed., July 1998. Claim 22 has not been finally or twice rejected and therefore this merits panel has no jurisdiction in regard to this claim. Accordingly, the claims on appeal are claims 9 through 16.

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providing a second panel of cellular fabric of said desired width;

trimming a cell of said second panel of cellular fabric to leave a second attachment strip surface extending centrally of the thickness of said second panel the full length of said cell;

placing an adhesive along the length of said second attachment strip surface; and

pressing said second attachment strip surface to said first attachment strip surface in aligned relationship until bonding occurs between said first and second panels of cellular fabric.

The examiner has relied upon the following references as evidence of obviousness:

Rupe 1924	1,489,716	Apr. 8,
Elsas 1966	3,250,164	May 10,
Worcester 1986	4,564,542	Jan. 14,
Hull 1987	4,675,241	Jun. 23,
Lampe et al. (Lampe) 1988	4,746,395	May 24,
Judkins 1990	4,974,656	Dec. 4,
Schön 1992	5,078,195	Jan. 7,

Claims 9 and 13-16 stand rejected under 35 U.S.C. § 103 as unpatentable over Judkins in view of Worcester "and

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optionally in view of Schön" (Answer, page 5).³ Claim 10 stands rejected under 35 U.S.C. § 103 as unpatentable over the references as applied to claim 9 and further in view of Hull, Elsas, and Rupe (Answer, page 6). Claims 11 and 12 stand rejected under 35 U.S.C. § 103 as unpatentable over the references as applied to claim 10 further in view of Lampe

³The examiner's second rejection of the claims dated Dec. 7, 1994, Paper No. 7, included a rejection of claim 10 under the second paragraph of 35 U.S.C. § 112 (see page 1 of Paper No. 7). Appellant has submitted a *proposed* amendment to claim 10 and the examiner has stated that the rejection of claim 10 under the second paragraph of § 112 is withdrawn (see the Reply to Examiner's Answer dated Aug. 28, 1995, Paper No. 11, page 2, the Supplemental Examiner's Answer dated Nov. 6, 1995, Paper No. 12, page 3, and the Supplemental Examiner's Answer dated Mar. 12, 1996, Paper No. 14, page 1). However, appellant has only submitted a supplemental Appendix with amended claim 10 therein (see the Letter dated Nov. 20, 1995, Paper No. 13, and page 1 of Paper No. 14). No actual amendment to claim 10 has been submitted by appellant nor has any amendment to claim 10 been physically entered into the file record. Upon return of this application to the examiner, this deficiency must be corrected. For purposes of this appeal, we will consider the rejection of claim 10 under § 112 to be withdrawn.

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(Answer, page 7).⁴ We reverse all of the examiner's rejections for reasons which follow.

OPINION

The method of appealed claim 9 recites, *inter alia*, "trimming a cell of said first panel of cellular fabric to leave a first attachment strip surface extending centrally of the thickness of said first panel of material and the full length of said cell" and a corresponding trimming step for a cell of a second panel to form a second attachment strip surface such that these surfaces can be adhered together to form the composite window covering (see also the specification, page 5, line 25-page 6, line 2).

The examiner applies Judkins as the primary reference to "show[s] a method of forming a tubular honeycomb shade wherein a splice joint may be used to secure two pieces of material either for repair of a defective or damaged material, to achieve a desired aesthetic effect or to customize the length

⁴The restatement of this rejection on page 7 of the Answer omits the Elsas and Rupe references although referring to the rejection "as applied to claim 10", which included Elsas and Rupe along with Hull. In view of our disposition of this appeal as noted *infra*, this inconsistency by the examiner is harmless error.

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or width of the shade" (Answer, page 5, citing Judkins, Abstract; column 1, lines 43-58; column 2, lines 33-68; and column 9, lines 56+).

Appellant and the examiner agree that Judkins is silent with respect to the trimming of the honeycomb pieces to form attachment strip surfaces (Brief, page 5, and the Answer, page 5). The examiner concludes that it would have been obvious to trim the honeycomb pieces "so as to provide complimentary mating faces of the honeycomb pieces", especially in view of Worcester, which is cited "as exemplary to show that it is well known to shear the ends of pieces to be joined to provide complimentary mating faces" (Answer, page 5). With regard to Worcester, appellant states that this reference represents an entirely different technology and the specific splicing method disclosed by Worcester would be impractical to apply to a honeycomb shade construction (Brief, page 6).

"When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references or make the modification. [Citation omitted]." *In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997). The examiner has not

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identified any suggestion or motivation to modify the tabular formation shown by Judkins by trimming or shearing. The tabs **22** of Judkins are formed from either a single piece of material (Figure 4) or when splicing together two different pieces of material (**14** and **14'** in Figure 4A). These tabs can also be formed when the material is fashioned in a honeycomb structure (Judkins, column 9, lines 56-63). However, the examiner has not identified any suggestion in the prior art to modify the splicing or tab formation in Judkins by the shearing of the ends of a belt in Worcester to achieve the method recited in appealed claim 9. The examiner has not identified why the shearing of the *ends* of a belt in Worcester to provide mating faces (see Worcester, column 2, lines 17-29) would have suggested a trimming step of the overlapping material forming a tab in Judkins.

Additionally, Worcester is directed to improving the strength of a spliced section of a belt that does not have overlapping sections by cutting grooves into the belt, cementing cords such as KEVLAR® in the grooves and then curing the product (column 1, lines 17-18 and 40-44). The examiner

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does not identify any teaching or suggestion in Worcester that the step of cutting or shearing to provide the respective faces **14** and **15** of end belt sections **10** and **11** for subsequent abutting engagement (column 2, lines 27-29) would improve the splice strength of the overlapping material forming tabs in a honeycomb construction of Judkins.

The examiner has also "optionally" applied the Schön reference to show including an additional attachment strip between the attached pieces of a shade to increase the stiffness (Answer, page 6). However, as argued by appellants on page 6 of the Brief, none of the claims on appeal require an additional stiffening or attachment strip. The trimming step of appealed claim 9 does not form any additional attachment strip but trims "a cell of said first panel of cellular fabric to leave a first attachment strip surface".⁵

⁵The remaining references to Hull, Elsas, Rupe and Lampe have been applied by the examiner for showing the use of a trimming member in a honeycomb cell, the use of a backing member during the trimming, and that it is well known to move a surface past a stationary glue applicator (Answer, pages 6-7). The examiner has not applied any of these references to show the trimming step of appealed claim 9. We find that these references do not remedy the deficiencies in the rejection as noted above.

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Therefore the Schön reference does not supply the suggestion or teaching missing from Judkins and Worcester.

For the foregoing reasons, we determine that the examiner has not established a *prima facie* case of obviousness in view of the applied prior art. Accordingly, the rejections of all of the claims on appeal are reversed. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The decision of the examiner is reversed.

REVERSED

ANDREW H. METZ)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN D. SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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THOMAS A. WALTZ)	
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DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: March 20, 2000

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT