

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEFFREY L. HILL, GREGORY S. HILL and ROBERT J. BRETL

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Appeal No. 96-2712  
Application 08/313,548 <sup>1</sup>

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HEARD: June 8, 1998

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Before COHEN, MEISTER and FRANKFORT, 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, 3 through 5, 9 through 12, 19 and 20.

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<sup>1</sup> Application for patent filed September 23, 1994. According to appellants, this application is a continuation of application 08/036,436, filed March 24, 1993, which is a continuation-in-part of application 08/019,865, filed February 19, 1993.

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Claims 13 through 18, the only other claims remaining in this application, stand allowed. Claims 2, 6, 7 and 8 have been canceled.<sup>2</sup>

Appellants' invention relates to a card carrying mailing form (10) which is adapted to allow automatic insertion, attachment and carrying of at least one card (30). Claim 1 is representative of the subject matter on appeal and a copy of that claim, as it appears in the Appendix to appellants' brief, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness of the claimed subject matter are:

Clark	1,141,172	Jun. 01, 1915
Coit	1,171,592	Feb. 15, 1916
Standal et al. (Standal)	1,932,536	Oct. 31, 1933
Jory	3,484,097	Dec. 16, 1969

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<sup>2</sup> Claims 1 and 3 have been amended (subsequent to the final rejection) in a paper filed August 7, 1995 (Paper No. 18). As indicated on page 2 of the examiner's answer, the rejections of claims 1, 3-5, 10 and 11 under 35 U.S.C. § 112, second paragraph, in the final rejection have now been overcome by the above-noted amendment and are therefore withdrawn.

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Claims 1, 3 through 5, 9 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Coit in view of Clark or Standal.

Claims 1, 10 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jory in view of Coit.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over "the art as applied to claim 1" (answer, page 4).

Reference is made to the examiner's answer (Paper No. 23 mailed March 6, 1996) for the examiner's reasoning in support of the above-noted rejections and to appellants' brief (Paper No. 22, filed December 18, 1995) for appellants' arguments thereagainst.

#### OPINION

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellants' specification and claims, the applied prior art references, and the respective positions advanced by appellants and the examiner. As a consequence of our review, we will sustain the examiner's rejections of the appealed claims. Our reasoning follows.

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Before addressing the examiner's rejection based on prior art, we note the statements on page 2 of the answer that claims 3 through 5, 10 and 11 are considered to stand or fall together and that claims 1, 9, 12, 19 and 20 have been separately argued by appellants. Finding no contrary statement in the brief and no separate argument in the brief for dependent claims 3 through 5, 10 and 11, we agree with the examiner's assessment. Accordingly, we select claim 1 as being representative of the group containing claims 1, 3-5, 10 and 11, and address separately the rejections of claims 9, 12, 19 and 20 (see 37 CFR § 1.192(c)(7)).

In rejecting claims 1, 3 through 5, 9 and 11 under 35 U.S.C. § 103 relying on Coit in view of Clark or Standal, the examiner has expressed the view that Coit (particularly, Figure 5) includes all of the claimed features except for a flap formed from a closed slot. To address this difference, the examiner has relied on the teachings of Clark (Figs. 3 and 4) or Standal (Figures 2 and 3), noting that the card carrying mailer of Clark shows a curved flap (unnumbered) which entraps an edge of the card (3), and that Standal shows a curved flap (17) in a carrier form for entrapping an edge of a card (16). According to the examiner,

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the lower edge of Coit's card, as seen in Figure 5, with an entrapping flap, as taught by either Clark or Standal et al., because it would provide an extra measure of security for Coit's card when the folder is unfolded. The flap would provide the sole means for releasably holding the card against movement out of the corner pockets in a fourth direction when Coit's mailer is folded and when it is unfolded. As can be seen from Figure 2 of Coit, the card is spaced from the fold. Therefore, when an entrapping flap is added, as taught by either Clark or Standal et al., the fold does not engage the card when Coit's mailer is folded and, thus, does not hold the card against movement. The particular shape of the flap (claim 9) would have been an obvious matter of design.

The limitations which relate to automatic insertion add no structure to the claimed form.

Appellants argue that none of the references relied upon by the examiner in this rejection show carriers adapted for automatic insertion (brief, page 8). More specifically, appellants contend (brief, page 9) that Coit is not adaptable for automatic insertion and "expressly teaches manual insertion of a mailing folder," that Clark "emphasizes manual insertion and teaches away from a flap," and that Standal "relates to envelopes with paper inserts which are shared [sic] separately by hand." In addition, appellants urge that Coit clearly teaches away from a flap by "emphasizing wedge trapping of a card across preweakened fold lines."

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Notwithstanding appellants' above-noted arguments to the contrary, we find nothing in Coit, Clark or Standal which would preclude each of the clearly flexible card carrying mailing folders of these references from being considered to be an "automatic insertion adapted carrier form" (emphasis added), as set forth in appellants' claims on appeal. In this regard, we note particularly that Coit (page 1, lines 86-90) indicates that the sheet (1) of the mailer therein is formed of "suitable stock, which is preferably somewhat heavier and somewhat stiffer than the usual writing paper." Thus, it is apparent to us that the paper stock used in Coit would inherently possess a degree of stiffness and flexibility so as to be capable of use in an appropriate automatic insertion apparatus and that the corner pockets (defined by the slits 2 and tabs 3, or slits 7) would be inherently capable of resiliently flexing from the planar body of the mailer when the planar body is automatically bent to open the pockets for receipt of one of the two pairs of opposed corners of the card to be received therein. As a further point regarding appellants' argument that the carriers of Coit, Clark and Standal are not "adapted for automatic insertion," we expressly note that appellants have provided no explanation or evidence in support of this bare assertion.

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As for appellants' contention that Coit "expressly teaches," and that Clark "emphasizes," manual insertion of the cards therein, we find absolutely no mention whatsoever of "manual insertion" in these references, and no indication that the insertion of the cards therein necessarily must be done by hand. Nor do we find in Coit any emphasis placed on "wedge trapping" of the card therein across preweakened fold lines, as urged by appellants.

Moreover, we do not share appellants' view that Coit "clearly teaches away from a flap" (brief, page 9), merely because Coit shows no flap and happens to show a fold line adjacent the side of the card opposite the pair of opposed corners received in the corner pockets of the mailing folder therein. Like the examiner, when we consider the combined teachings of the applied references (Coit and Clark, or Coit and Standal), we are of the opinion that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to provide the mailing folder of Coit with a flap formed from at least one closed slot cut through the body of the

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mailer and positioned opposite the pair of opposed card corners received in the corner pockets of the mailing folder, so as to provide additional securement for the card therein when the mailing folder is in an unfolded condition. Appellants' own arguments (brief, page 13) note that the mailing folder of Coit has "nothing to prevent the... inserted card from falling out the bottom (i.e. fourth rectilinear direction) of the mailing folder... when the mailing folder envelope is opened."

In this regard, we note that it is well settled that where the issue is one of obviousness under 35 U.S.C. § 103, the proper inquiry should not be limited to the specific structure shown by a reference, but should be into the concepts fairly contained therein, with the overriding question to be determined being whether those concepts would suggest to one skilled in the art the modification called for by the claims. See In re Bascom, 230 F.2d 612, 614, 109 USPQ 98, 100 (CCPA 1956). Furthermore, under 35 U.S.C. § 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976)), as

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well as the reasonable inferences which the artisan would logically draw from the reference. See In re Shepard, 319 F.2d 194, 197, 138 USPQ 148, 150 (CCPA 1963). In addition, while there clearly must be some teaching or suggestion to combine existing elements in the prior art to arrive at the claimed invention, we note that it is not necessary that such teaching or suggestion be found only within the four corners of the applied reference or references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see In re Boezk, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), this is because we must presume skill on the part of the artisan, rather than the converse. See In re Sovish, 769 F.2d, 738, 743, 226 USPQ 771, 774 (Fed. Cir 1985).

With respect to appellants' argument (brief, page 15) that Clark teaches away from use of a flap by showing a corner slit (e.g., 6) engaging the edge of the card which the flap also engages, we note that it is clear from the disclosure of the Clark patent (page 1, lines 71-78) that the arc slit flap seen in

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Figures 3 and 4 of Clark is meant to be an alternative to the corner slit seen therein, and that the flap seen in Figures 3 and 4 may thus be used alone as the sole means to prevent displacement of the card (3) in that direction.

As for appellants' argument that the examiner is using hindsight reconstruction in light of appellants' teaching and disclosure to render the claimed invention obvious, in light of the foregoing determinations, we do not find such argument to be persuasive of error in this case on the examiner's part. In the present case, we are convinced that it would have been obvious to the person of ordinary skill in the art at the time of appellants' invention to combine the teachings and suggestions found in Coit, Clark and Standal in the manner urged by the examiner so as to arrive at an "automatic insertion adapted card carrier" like that claimed by appellants in claim 1 on appeal. The examiner's rejection of claim 1 on appeal under 35 U.S.C. § 103 based on Coit and Clark or Standal, accordingly, is sustained.

Given our above determination that claims 1, 3 through 5, 10 and 11 should be considered as standing or falling together, it

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follows that claims 3 through 5, 10 and 11 will fall with claim 1 and that the rejection of these claims on appeal under 35 U.S.C. § 103 on the basis of Coit and Clark or Standal is likewise sustained.

With respect to dependent claims 9, 19 and 20, we must agree with the examiner that the specific shape of the flap (i.e., triangular as in claim 9) and the specific shape of the corner pocket so as to result in an ear which is acutely angled or rounded as in claims 19 and 20, would have been obvious matters of design choice to one of ordinary skill in the art given the fact that appellants' specification merely indicates (e.g., page 6) that the flap is "preferably" of such a shape and further that appellants' have provided no indication in their specification that the shapes in question solve any stated problem or provide any unexpected result. Thus, we consider that the recitations regarding the shape of the flap and of the ears do not serve to patentably distinguish the claimed invention over the structure of the mailing folder suggested by the applied prior art. See In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975). We further consider that this position is bolstered by the

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disclosure in Clark (page 1, lines 71-78) regarding the flap therein and in Coit (page 2, lines 61-72) regarding the configuration of the ears or tabs (3) therein. In each instance, it is indicated that the shape of these elements may be of varying forms so long as they perform their function in a satisfactory manner, thus, in our view, indicating that the specific configuration of these elements is well within the skill of the art.

Based on the foregoing, the examiner's rejections of claims 1, 3 through 5, 9, 11, 19 and 20 based on the teachings of Coit and Clark or Standal are sustained.

The next of the examiner's rejections for our consideration is that of claims 1, 10 and 12 under 35 U.S.C. § 103 based on the combined teachings of Jory and Coit. In this rejection, the examiner is of the opinion that Jory (e.g., Figure 3) discloses the claimed invention with the exception that the flap (66) of Jory is not the sole means for releasably holding the card (14) against movement out of the corner pockets (formed by slits 20) in a fourth direction, and that such corner pockets are not L-shaped, as required in appellants' claim 1 on appeal. However,

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the examiner is of the opinion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to eliminate the closed slits (18) and resulting pockets

since it has been held that the elimination of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. In re Karlson, 136 USPQ 184. (answer, page 4).

The examiner is also of the view that it would have been obvious to one of ordinary skill in the art to make Jory's pockets (formed by slits 20) L-shaped, as taught by Coit, because such a modification is considered to be an obvious matter of design.

Applying the test for obviousness set forth in In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981), which is ~~wa~~ that the combined teachings of the applied references would have suggested to those of ordinary skill in the art, it is our conclusion th~~a~~ the artisan, armed with the disclosures of Jory and Coit, wou~~ld~~ have found it obvious to eliminate the slits (18) adjacent he side of the card (14) where the flap (66) is located and the function

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of these slits, so as to provide a more simplified mounting arrangement for the card therein when a less refined or less sophisticated mounting would be sufficient. Unlike appellants, we do not see that Jory necessarily teaches away from removal of the slits (18), or "expressly" teaches and requires a carrier form that must have a five point restraint system. In this regard, we note that the claims of the Jory patent do not in any way require that the web carrier form include a five point restraint system. See particularly, claims 1 through 5 and 13 through 15 of Jory, with specific emphasis on claims 5 and 15, which define apparatus for coupling a flexible sheet (card) to a web carrier having only a pair of spaced slits." In reaching the conclusion that it would have been obvious to one of ordinary skill in the art to eliminate the slits (18) of Jory and their corresponding function, we again presume skill on the part of those versed in this art rather than the converse. See In re Sovish, supra.

While we have fully considered each of the arguments advanced by appellants in their brief, we are not convinced thereby of any error in the examiner's position. Like the examiner, we note that appellants have not expressly indicated in the brief exactly why it would not have been obvious to the ordinarily skilled artisan to

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modify Jory in the manner posited by the examiner in the rejection under 35 U.S.C. § 103. Instead, appellants have merely made broad assertions that the form of Jory as modified "would not be operable in the insertion apparatus of Jory" (brief, page 20) and that the card "could pivot on the intermediate slit 22 and become disengaged with opposing slits 20" (brief, page 21). We find these assertions to be based on pure speculation or mere attorney argument without any evidence in this record to support such assertions.

As for the examiner's position that it would have been obvious to one of ordinary skill in the art to make the slits (20) of Jory in the form of L-shaped slits as in Coit, we are in agreement with the examiner. From our perspective, the clear teaching of Coit, at page 2, lines 61-72, is that the shape of the slits in such a mailing folder is generally somewhat optional, as long as they perform their intended function. Appellants' argument that Jory fails to disclose a flap which resiliently flexes in the manner set forth in claim 1 on appeal, is also unpersuasive. In our opinion the flap of Jory is capable of such resilient flexing when the mailer form web (12) is used in an appropriate automatic insertion

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apparatus. See, in this regard, Figure 7 of Jory wherein the flap (66) is clearly resiliently flexed as a result of a portion of the web body being bent by the finger (64), so that the flap can ride up and over the edge of the card.

With respect to dependent claim 12, we note that appellants have not specifically disputed the examiner's position that the holes (24) of Jory are located adjacent the edge of the card therein or that these holes serve to mark the "relative position" of the pair of pockets (defined by slits 20) and flap (66). Absent some specific argument from appellants, we see no reason to overturn the examiner's position with regard to the holes (24).

For the reasons stated in the examiner's answer, as amplified above, the decision of the examiner rejecting appealed claims 1, 10 and 12 under 35 U.S.C. § 103 based on the combined teachings of Jory and Coit is sustained.

Turning next to the examiner's rejection of claims 19 and 20 based on Jory in view of Coit, for reasons similar to those advanced above in our earlier discussion of claims 19 and 20, we are in agreement with the examiner that it would have been an

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obvious matter of design choice to form the slots/slits of Jory (as modified) in the particular manner set forth in these claims. We again point to the clear teachings of Coit (page 2, lines 6172) in support of this position. Moreover, we observe that Figures 1 and 2 of Coit appears to show slits like those required in appellants' claim 20, while Figure 3 of Coit shows slits (5) in a configuration like that required in appellants' claim 19.<sup>3</sup> Thus, the examiner's rejection of claims 19 and 20 under 35 U.S.C. § 103 based on Jory and Coit is sustained.

Given that each of the examiner's respective rejections of the appealed claims has been sustained, it follows that the examiner's decision to reject claims 1, 3 through 5, 9 through 12, 19 and 20 on appeal under 35 U.S.C. § 103 is affirmed.

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<sup>3</sup> It appears to us that the dependency of claim 20 is in error, since we find no antecedent basis for "the intersection" set forth in claim 20, or "the pair of rectilinear slots" set forth therein, in parent claim 1. Correction of this error should be attended to in any further prosecution of the application before the examiner.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JAMES M. MEISTER	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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