

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEXANDER FERDINANDSEN
and BENDIX FERDINANDSEN

Appeal No. 97-3347
Application No. 08/302,864¹

HEARD: April 7, 1999

Before McCANDLISH, Senior Administrative Patent Judge, COHEN,
and MEISTER, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of October 25, 1996 (Paper No. 14) of claims 1 through 8. These claims constitute all of the claims in the application.

¹ Application for patent filed September 14, 1994.

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Appellants' invention pertains to a mask. An understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears below.

1. A mask for superimposing upon a photograph having a portion which is to be accentuated, characterized by the mask being made of a thin sheet having an opaque, peripheral region which, across a transitional zone, gradually fades out into a transparent, central area.

As evidence of obviousness, the examiner has applied the documents listed below:

James	816,861	Apr. 3, 1906
Sibley	3,587,187	Jun. 28, 1971
Blegen	5,261,174	Nov. 16, 1993

The following rejections are before us for review.

Claims 1 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sibley in view of James.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103 as

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being unpatentable over Sibley in view of James, as applied to claim 1 above, further in view of Blegen.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 19), while the complete statement of appellants' argument can be found in the brief (Paper No. 17).

In the brief (page 4), appellants indicate that claims 1 through 8 stand or fall together as a single group. Accordingly, we select independent claim 1 for review, pursuant to 37 CFR § 1.192(c)(7), and focus our attention exclusively thereon, infra.

OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claim 1, the applied

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patents,² and

² In our evaluation of the applied patents, we have considered all of the disclosure thereof for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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he respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We reverse the examiner's rejection of claim 1. It follows that we likewise reverse the rejection of claims 2 through 8 since these claims stand or fall with claim 1, as previously indicated.

As is quite evident from a reading of claim 1, appellants' invention expressly requires a mask made from a thin sheet having "an opaque, peripheral region which, across a transitional zone, gradually fades out into a transparent, central area."

We turn now to the examiner's evidence of obviousness.

We find that the patent to Sibley discloses a photograph album leaf construction. The leaf 10 comprises a single flexible sheet folded on itself to form front and back pages

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10a, 10b (Fig. 2). Pockets 16 are attached on the outer surface of each page (Fig. 1). Each pocket has a printed decorative border 18 to

impart a framed appearance and is formed of transparent sheet material, with the printed border framing the clear window section 20.

As to the James patent (sole page of specification, lines 47 through 51), we find that, somewhat akin to the known phototechnical method for gradually fading out a central area of a photograph to a neutral peripheral region as discussed by appellants in the specification (page 2), the patentee teaches a photographic sheet "B" that includes a sight part "a" (designed to bear a picture "b") with a blended border "C" comprising an outer dark or dense portion "c" and an inner portion "d" of mezzo shade interposed between the dark portion and the sight part.

When we set aside what appellants have taught us in the

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present application, it is apparent to this panel of the board, from our collective assessment of the teachings of Sibley and James, that the now claimed invention would not have been obvious to one having ordinary skill in the art. It is our opinion that, at best, the references would have been suggestive of inserting a photograph with a blended border C, as taught by James, into a

pocket of the photoalbum leaf 10 of Sibley. Of course, this would not have effected the particular mask expressly defined in claim 1. A review of the patent to Blegen indicates to us that it does not overcome the deficiencies of the Sibley and James patents. Since the examiner's evidence does not support a conclusion of obviousness relative to the claimed subject matter, we are constrained to reverse each of the rejections on appeal.

NEW GROUND OF REJECTION

Under the authority of 37 CFR § 1.196(b), this panel of the board introduces the following new ground of rejection.

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Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Dependent claim 2 (lines 3 and 4) sets forth a transparent thin sheet having a "coverage of preferably 100% in the peripheral region," while parent claim 1 (lines 3 and 4) recites a thin sheet having "an opaque peripheral region."

³ There is no

uncertainty in our minds but that the word opaque denotes an entity exhibiting opacity, i.e., an entity that is not

³ The interview summary record of November 26, 1996 (Paper No. 15) indicates that an exhibit was shown or demonstration conducted. Since the application file includes a brochure (HOLME PATENT A/S) with a mask therein, it is apparent to us that the brochure and mask constituted the exhibit shown to the examiner. At the oral hearing of April 7, 1999, counsel for appellant had a brochure and mask which appeared to be identical to the brochure and mask in the application file. We understand the mask exhibit to reflect what appellants consider to be the present invention. However, this panel of the board pointed out at the hearing that the white peripheral region of the mask exhibit was not opaque, i.e., the photograph of the woman appearing in the brochure was visible through the translucent white peripheral region of the mask when the mask was placed against the photograph.

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pervious to radiant energy (light).⁴ It follows that the thin sheet of claim 1 is understood as having an opaque peripheral region in the sense that this region is not pervious to light. With this understanding, it is clear to this panel of the board that the recitation in claim 2 of "preferably 100%" relative to the coloration coverage renders this claim indefinite in meaning, for the following reasons.⁵ The term "preferably 100%" indicates to us that less than 100% coverage in the peripheral region is intended to be encompassed within the scope of claim 2. This would effect a peripheral region that is not opaque, inconsistent with the express requirement of parent claim 1. Accordingly, the content of claim 2 is appropriately rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

In summary, this panel of the board has:

⁴ Webster's New Collegiate Dictionary, G. & C. Merriam Company, Springfield, Massachusetts, 1979.

⁵ As we understand the claimed invention, a coloration coverage of 100% in the peripheral region corresponds to an opaque peripheral region, since the coloration is gradually reduced to 0% at the central area (transparent).

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reversed the rejection of claims 1 through 6 under 35 U.S.C. § 103 as being unpatentable over Sibley in view of James; and

reversed the rejection of claims 7 and 8 under 35 U.S.C. § 103 as being unpatentable over Sibley in view of James and Blegen.

Additionally, we have introduced a new ground of rejection in accordance with 37 CFR § 1.196(b).

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The decision of the examiner is reversed.

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

§ 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 (37 CFR § 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. . . .

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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).

REVERSED; 37 CFR § 1.196(b)

HARRISON E. McCANDLISH))
Senior Administrative Patent Judge))
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)	BOARD OF PATENT
IRWIN CHARLES COHEN))
Administrative Patent Judge)	APPEALS AND
))
)	INTERFERENCES
))
JAMES M. MEISTER))
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ICC/sld

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