

**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(2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JACK W. JETER

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Appeal No. 1998-0252  
Application 08/555,795<sup>1</sup>

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HEARD: Oct. 6, 1999

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Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS  
and GONZALES, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

**DECISION ON APPEAL**

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<sup>1</sup> Application for patent filed November 9, 1995.  
According to appellant, this application is a continuation of  
Application No. 08/378,927, filed January 25, 1995, now  
abandoned; which is a continuation of Application No.  
07/823,978, filed January 22, 1992.

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This is an appeal from the decision of the examiner finally rejecting claims 1, 3, 4, 9-11 and 15-17, which constitute all of the claims remaining of record in this application.

The appellant's invention is directed to a file label system (claims 1, 3, 4, 9 and 10) and to a method for filing files (claims 11 and 15-17). The claims on appeal have been reproduced in an appendix to the Brief.

#### **THE REFERENCES**

The following references were relied upon by the examiner to support the final rejection:

Barber	4,329,191	May 11, 1982
Colavito <i>et al.</i> (Colavito)	4,715,621	Dec. 29, 1987

The prior art admitted by the appellant on pages 1 and 2 of the specification.

#### **THE REJECTIONS**

The following claims stand rejected under 35 U.S.C. § 103:

(1) Claims 1, 3, 4 and 9 on the basis of Colavito.<sup>2</sup>

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<sup>2</sup> This rejection erroneously was stated in the Answer as being under 35 U.S.C. § 102.

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(2) Claim 10 on the basis of Colavito and Barber.

(3) Claims 11 and 15-17 on the basis of Colavito, Barber and the admitted prior art.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejections, we make reference to the Examiner's Answer (Paper No. 26) for the reasoning in support of the rejections, and to the Briefs (Papers Nos. 25 and 27), for the arguments thereagainst.

#### OPINION

All three of the standing rejections are under 35 U.S.C. § 103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ

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972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, ***Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

*The Rejection Of The Method Claims*

We shall first consider the rejection of method claims 11 and 15-17 as being unpatentable over the combined teachings of Colavito, Barber, and the admitted prior art. In the opening pages of the specification, the appellant explains that health care providers often have large filing systems containing the records of thousands of patients, and that the prior art systems typically arranged the files alphabetically by the patient's last name or numerically by social security number. According to the appellant, the latter system suffers from the fact that many patients either do not have a social security number or cannot recall it, and the former gives rise to large collections of the same names, such as John Smith, which

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causes the searcher to go through many such files in order to obtain the correct one. The appellant seeks to improve upon the prior art systems by his inventive method, which utilizes as its main set the month and day of the associated individual's birth, and as a subset the initial of the individual's last name. The professed advantages of such a system in reducing errors and lost time are set forth on pages 2-7 of the specification.

As manifested in independent method claim 11, the appellant's inventive system comprises the steps of affixing to each file a first sticker indicating a month and a second sticker indicating a year of the individual's birth, affixing to each file a third sticker bearing a letter initial of the last name of the individual, with the first and second stickers preceding the third sticker, and placing the files in a main set corresponding to the first and second stickers and a subset corresponding to the third sticker. The examiner notes that systems utilizing both alphabetical and numerical bases for filing systems were admitted by the appellant as being known in the art, and then points out that Colavito teaches that it was known to use coded stickers affixed to a

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file, taking the position that it would have been obvious to one of ordinary skill in this art to utilize "a two-tier filing system with the social security number as the principle [sic] base and the alphabetical labeling based on the individual's name as a subbase . . . with the Colavito et al labeling system . . . color coded adhesive labels" (Answer, page 7). Acknowledging that the content of the main set and the subset differ from that recited in claim 11, the examiner takes the point of view that using the individual's month and date of birth instead of the social security number would have been obvious because "[t]he plain fact is that the date of birth of an individual has long been used to identify that individual on written records," with Official Notice being taken that this "was old and well-known in this art many years before the filing date of this application" (Answer, page 8). While we might quarrel with the "Official Notice" ingredient of the rejection on the basis of relevancy in that the issue here is not using the date of birth on official records to identify an individual but using it as a main set in a filing system, and because the information so categorized is not so notorious as to fall within the prescribed definition (see

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Manual of Patent Examining Procedures (MPEP) § 2144.03 (7th ed., July 1998)), as it turns out this matter is not material to our decision.

Our problem with this rejection resides in the lack of proper suggestion to combine the teachings in the manner proposed by the examiner. The mere fact that the prior art could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). That the elements of a claim exist separately in the prior art is not enough. In the present case, there is no teaching in the art of organizing files based upon the month and day of the individual's birth, much less that this be a main set and that there be a subset based upon the letter of the individual's last name. We fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to combine the teachings of the admitted prior art and Colavito in such a manner as to meet these requirements, which are recited in independent claim 11, other than the luxury of the hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not a proper

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basis for a rejection under 35 U.S.C. § 103. See, for example, *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Considering further the teachings of Barber, which actually was cited only with regard to a limitation added by claim 15, does not alleviate the deficiencies in the other references.

It therefore is our conclusion that the combined teachings of the admitted prior art, Colavito, and Barber fail to establish a *prima facie* case of obviousness with regard to the subject matter of independent claim 11, and we will not sustain the rejection of that claim or of claims 15-17, which depend therefrom.

#### *The Rejections Of The File Label System Claims*

We reach the opposite conclusion with regard to claims 1, 3, 4, 9 and 10. The rejections advanced by the examiner in this regard are that claims 1, 3, 4 and 9 are unpatentable over Colavito, and claim 10 is unpatentable over Colavito and Barber. These claims are directed to a file label system for identifying a file associated with a specific individual. As

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recited in independent claim 1, the system comprises "an elongated sheet" on which there are first, second and third "areas" that are "adapted for receiving," respectively, "a first indicia indication [*sic* indicating] a month of the year" and "a second indicia indicating a day of said month . . . representing the birthday of the individual," and "a third indicia indicating the initial letters of the last name of said individual." The claim concludes by stating that these indicia comprise first, second and third color-coded adhesive labels received upon the sheet and that the first and second indicia precede the third indicia on the sheet.

Colavito is directed to a color coded filing system for use with the expandable files that are "used in law offices and other business offices" (column 1, lines 9-10). Each file comprises an elongated sheet upon which can be placed a plurality of color coded adhesive labels (24) in a plurality of areas in excess of the three required by claim 1. As noted by the examiner, Colavito does not teach that the labels contain the precise indicia specified in the claims. However, it is the examiner's view that the indicia is not functionally related to the substrate upon which it is placed, and

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therefore it is not entitled to patentable weight (Answer, page 5). The appellant argues that it is functionally related to the extent that is required by the case law, and therefore the examiner's position is in error.

From our perspective, however, the case law cited by the appellant in support of his position dictates the opposite result. Basic guidance is provided by *In re Miller*,<sup>3</sup> where the invention solved the problem of quickly measuring out fractions of recipes, such as one-half of that which is specified, by placing quantity measuring indicia on a receptacle in a selected ratio that is proportional to, but different from, the actual quantity present in the receptacle. As in the present situation, the examiner refused to give the indicia patentable weight because it was printed matter, rejecting the claims as being unpatentable over any ordinary measuring vessel. In its reversal, the court provided the following explanation:

The fact that printed matter *by itself* is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination. Here there is an new and unobvious functional relationship between a

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<sup>3</sup> 418 F.2d 1392, 164 USPQ 46 (CCPA 1969).

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measuring *receptacle*, volumetric *indicia* thereon indicating volume in a certain ratio to actual volume, and a *legend* indicating the ratio, and in our judgment the appealed claims define this relationship. 418 F.2d at 1396, 164 USPQ at 49.

Thus, the court regarded the fact that indicia indicating the level of the contents of an ordinary measuring cup to be something other than what it actually was established a "functional relationship" between the indicia and the structure that gave the indicia patentable weight.

*In re Gulack*<sup>4</sup> also states that differences between an invention and the prior art cited against it cannot be ignored merely because they reside in the content of the printed matter (703 F.2d at 1385, 217 USPQ at 403). In *Gulack*, indicia was placed on an endless band in order to exploit certain arithmetic properties of particular prime numbers. In reversing the examiner's decision that the printed matter was entitled to no patentable weight, the court pointed out that the endless band serves two functions, "it supports the sequence of digits and it presents the digits as an endless sequence with no discrete beginning or end" (703 F.2d at 1382, 217 USPQ at 402), "[t]hus, the digits exploit the endless

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<sup>4</sup> 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983).

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nature of the band" (703 F.2d at 1387, 217 USPQ at 405). Here again, the court believed a "functional relationship" was established between the indicia and the structure upon which it was placed, which allowed patentable weight to be given to the indicia.

The final case cited by the appellant is *In re Lowry*.<sup>5</sup> Here, the court was dealing with data objects, which the examiner urged were analogous to printed matter. The court did not agree, stating that the case was distinguishable from the printed matter cases (32 F.3d at 1583, 32 USPQ2d at 1034). While we do not quarrel with the quotation to which the appellant refers, we are of the view that to the extent it may be relevant it merely confirms the positions espoused by the court in the other two cases.

It is our view that the invention recited in claim 1 does not meet the test applied in *Miller* and *Gulack*. Unlike those situations, the only relationship between the elongated sheet and the indicia in claim 1 is the expected one - the indicia is supported by the sheet. The fact that the three indicia labels contain specific information and are arranged in a

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<sup>5</sup>32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

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specified order goes to the method of organizing the filing system and not to establishing a "functional relationship" between the indicia and the sheet. The fact of the matter is that Colavito teaches exactly what the appellant recites in claim 1, that is, placing colored labels containing specified indicia upon an elongated sheet in a particular order. The difference between the structure disclosed in the reference and that which is recited in claim 1 resides only in the content of the indicia which, in this case, is entitled to no patentable weight.

This conclusion is confirmed in the language of the claims themselves. The extent of the relationship between the elongated sheet and the indicia as recited in claim 1 is that the three areas of the sheet are "adapted for receiving" the indicia. From our perspective, claim 1 therefore requires merely that the sheet be capable of receiving the indicia in the manner specified in the final six lines of the claim. In our opinion, not only does this language fail to support the appellant's argument that the "functional relationship" between the structure and the indicia required to impart

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patentable weight to the indicia is established in the claim, but the elongated sheet disclosed by Colavito clearly meets this limitation, in that it is capable of receiving the indicia in the manner and in the order set forth in the "wherein" statement of claim 1.

It therefore is our view that the applied prior art establishes a *prima facie* case of obviousness with regard to the subject matter recited in independent claim 1. In view of the fact that the appellant has chosen not to challenge with any reasonable specificity before this Board the rejection of any of the claims depending from claim 1, they are grouped with claim 1, and fall therewith. See *In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

In reaching this conclusion, we have carefully considered all of the arguments presented by the appellant. However, they have not convinced us that these rejections were in error. Our position with respect to these arguments should be apparent from the foregoing explanation. In essence, we regard the appellant's interpretation of "functional relationship" not to fall within the definition of that phrase as established by the court in *Miller* and *Gulack*.

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**SUMMARY**

The rejection of claims 1, 3, 4 and 9 is sustained.

The rejection of claim 10 is sustained.

The rejection of claims 11 and 15-17 is not sustained.

The decision of the examiner is affirmed-in-part.

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

**AFFIRMED-IN-PART**

	Harrison E. McCandlish, Senior	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Neal E. Abrams	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	John F. Gonzales	)	
	Administrative Patent Judge	)	

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