

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(2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES P. PETERSON

Appeal No. 1998-0566
Application 08/396,005¹

HEARD: Oct. 20, 1999

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

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner
finally rejecting claims 1-8 and 11-13. Claims 9, 10, 14 and
15 have been allowed. The appellant's invention is directed

¹Application for patent filed February 28, 1995.

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to a badge. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

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

Rader <i>et al.</i> (Rader) 1994	5,283,966	Feb. 8,
Kanzelberger 1994	5,305,538	Apr. 26,
Fan 1995	5,406,726	Apr. 18,
		(filed Jun. 24, 1994)
Smith 1995	5,410,827	May 2,
		(filed Jan. 28, 1993)

THE REJECTIONS²

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kanzelberger.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kanzelberger.

²In response to five rejections under the judicially created doctrine of obviousness-type double patenting based upon Kanzelberger U.S. Patent No. 5,305,538, entered by the examiner in Paper No. 14, the appellant filed a terminal disclaimer (Paper No. 16). In view of the examiner's comments (Paper No. 17), we consider these rejections to have been withdrawn, leaving before us only the rejections under Sections 102 and 103.

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Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kanzelberger in view of Smith.

Claims 6, 7 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kanzelberger in view of Rader.

Claims 8, 12 and 13 stand rejected as being unpatentable over Kanzelberger in view of Rader and Fan.

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 rejection, we make reference to the Answers (Paper Nos. 12 and 14) for the reasoning in support of the rejections, and to the Briefs (Paper Nos. 10, 13 and 15) for the arguments thereagainst.

OPINION

The Rejection Under 35 U.S.C. § 102(e)

Claims 1 and 4 stand rejected as being anticipated by Kanzelberger. Anticipation under 35 U.S.C. 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See ***In re Paulsen***, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed.

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Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Kanzelberger discloses a device that can be used as a name badge, desk plate, or the like. As shown in Figure 3, it comprises a metal backing plate (22), a plastic plate (24) bonded to the surface of the metal backing plate and having a textured strip (26) formed across its front surface, and a thin tape (28) affixed by adhesive along the textured strip. The tape has graphics (such as a name) imprinted on its back side, so that when it is installed upon the textured strip the graphics are visible from the front. The texture on the strip allows air to exit from beneath the tape when it is pressed into place, thus causing the tape to appear as if it were a part of the plastic plate.

It is the examiner's position that all of the subject matter recited in claim 1 reads on plastic strip portion 24 of the Kanzelberger device. The appellant sets out several arguments why he believes this not to be the case. We find ourselves in agreement with the appellant because the claim requires that there be an all-plastic plate having front and back surfaces with the "back surface . . . being exposed to

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view." Clearly, this is not the case in the Kanzelberger device, for the back surface of plastic plate 24 is bonded to the front surface of metal plate 22, and thus is hidden from view in the assembled device. We are not persuaded otherwise by the examiner's assertion that the exploded view in the patent drawings is sufficient to teach this feature of the appellant's claimed structure.

The rejection of claim 1 and of claim 4, which depends from claim 1, is not sustained.

The Rejections 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 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

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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).

All of the rejections under Section 103 utilize Kanzelberger as the primary reference. As a preliminary matter, the appellant has argued that Kanzelberger is not a proper reference under 35 U.S.C. § 103 (Brief, pages 6 and 7). As we understand this argument, it is grounded in the premise that Kanzelberger does not qualify as a reference under 35 U.S.C. § 102(b), and therefore should have been cited under subsections 102(f) or 102(g), in which case it would have fallen under the exemption for commonly owned patents and applications set forth in 35 U.S.C. § 103(c). We have carefully considered this argument, and the materials filed in support thereof. However, the fact remains that, from our perspective, Kanzelberger constitutes "an application for patent by another filed in the United States before the invention thereof by the applicant for patent," and thus clearly qualifies as prior art under subsection 102(e).

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Whether or not the rejection could have been made under subsections 102(f) or 102(g) is not relevant. The language of subsection 103(c) is clear; it applies to "[s]ubject matter developed by another person, which qualifies as prior art **only** under subsection (f) or (g) of section 102" (emphasis added). That is not the case in the situation before us, and we therefore are unpersuaded by the appellant's argument on this point.

The first rejection under Section 103 posed by the examiner is that claims 2 and 3 are unpatentable over Kanzelberger. Claim 2 depends from claim 1, and claim 3 from claim 2. As we stated above, it is our view that Kanzelberger fails to disclose or teach the limitation of claim 1 regarding the back surface of the all-plastic plate being exposed to view. This shortcoming in the showing of Kanzelberger is not alleviated by considering the reference in the light of Section 103. Since claims 2 and 3 incorporate the structure of claim 1, it therefore is our conclusion that the teachings of Kanzelberger fail to establish a *prima facie* case of obviousness with regard to the subject matter of claims 2 and 3, and we will not sustain this rejection.

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We reach the same conclusion, for the same reasons, with regard to the rejection of claim 5 as being unpatentable over Kanzelberger in view of Smith. Claim 5 is dependent from claim 1 through claim 4. The teaching in claim 1 that is missing from Kanzelberger is not found in Smith, which was cited for teaching depressing the channel in which the transparent tape containing the graphics is positioned. The rejection of claim 5 is not sustained for lack of a *prima facie* case of obviousness.

The addition of Rader to Kanzelberger also falls short of establishing a *prima facie* case of obviousness with regard to the subject matter of claims 6 and 7, which depend from claim 1. Rader was applied for the purpose of demonstrating the obviousness of placing a finding on the badge (claim 6) or a finding in the form of a separate plate that fits over posts attached to the back of the badge (claim 7). Be that as it may, Rader does not cure the problem with Kanzelberger regarding the exposed rear face of the plastic plate.

Claim 8, which depends directly from claim 1, stands rejected on the basis of Kanzelberger and Rader, considered further with Fan, which teaches providing a name badge with

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slots to receive the material upon which the graphics are printed. As was the case above, Fan fails to cure the basic defect in the teachings of Kanzelberger, and thus these references fail to establish a *prima facie* case of obviousness with regard to the subject matter of claim 8, and we will not sustain the rejection. Claim 11 has been rejected as being unpatentable over Kanzelberger and Rader. This claim does not require that the back surface of the plastic plate be exposed to view, as was the case with claim 1, and therefore the deficiency in the teaching of Kanzelberger that resulted in reversing the rejections of claim 1 and the claims dependent therefrom is not an issue here. For the reasons set forth below, we find ourselves in agreement with the examiner that the combined teachings of Kanzelberger and Rader establish a *prima facie* case of obviousness with regard to the subject matter recited in claim 11, and we will sustain this rejection.

Claim 11 is directed to a system "for displaying graphic material on a solid and unitary badge size block of plastic." The system comprises a textured strip on the front of the block (36 of Kanzelberger), a thin strip of transparent self-

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adhesive tape which fits onto the textured strip (28 of Kanzelberger), and means for applying graphic material to the side of the transparent tape having the adhesive thereon (Kanzelberger, column 2, line 19 *et seq.*). Claim 11 also requires that there be means for applying a finding to the block. To the extent that this may not be taught by Kanzelberger, providing such a feature on the back surface of a badge is disclosed by Rader (11, 12), with explicit suggestion to do so for the purpose of attaching the badge to clothing being taught by Rader in column 2, line 10 *et seq.*

The only argument specifically directed to claim 11 is that the Rader pin "cannot be attached to the very thin plastic plate shown by Kanzelberger" (Brief, page 9). However, claim 11 does not require that the finding be attached directly to the plastic plate, but that there be "means for applying a finding to" the plate. From our perspective, element 22 of Kanzelberger and elements 11 and 12 of Rader constitute such a means, and suggestion for combining the references clearly is present in Rader. Moreover, it is our view that the fact that the Kanzelberger plastic plate is thin does not preclude mounting a finding upon it. We have

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considered the arguments regarding such matters as labor intensity, expense, and beauty, but find them also not to be persuasive.

The appellant also has argued throughout the Brief that Kanzelberger does not disclose a "solid and unitary badge size block of plastic," as is required by claim 11. This element is described on page 1 of the appellant's specification as "such as one which might be formed by injection molding." Other descriptive language that is applied in the specification is "name plate 26" and "plastic plate 26" (page 6, for example, emphasis added). No indication is provided of the thickness of the plate, except that it must be capable of having a depressed area (28). As shown in Figures 2 and 3, the Kanzelberger badge also utilizes a plastic element (24) that is thick enough to accommodate a depressed area (between edges 34 and 36 in Figure 2), which is provided with a textured area (Figure 3). As was the case in the appellant's specification, element 24 is described in Kanzelberger as a "plastic plate" (column 3, line 15, emphasis added). While this plate is "very thin" (column 3, line 20), it nevertheless is called a plate throughout the patent. Moreover, no

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evidence has been presented that would support a conclusion that the Kanzelberger plate cannot be manufactured by injection molding, as is described with regard to the present invention. It therefore is our opinion that Kanzelberger discloses "a solid and unitary badge size block of plastic" to the same extent that such is disclosed in the appellant's application. With regard to this conclusion, we point out that there is no factual basis to support the appellant's statement that the Kanzelberger plate is "too thin to support itself" and therefore a pin back cannot be attached to it (Brief, page 9), noting that it is not plastic plate 24 whose thickness is "little more than a thick piece of paper," but the combined thickness of items 28 and 32, which are bonded to the surface of plate 24 (column 5, line 5).

The combined teachings of Kanzelberger and Rader establish a *prima facie* case of obviousness with respect to the subject matter recited in claim 11, and we will sustain the rejection.

Claims 12 and 13, which depend from claim 11, stand rejected on the basis of Kanzelberger and Rader, taken further

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with Fan. Since the appellant has elected to group these two claims with claim 11 (Brief, page 3), they fall therewith.

SUMMARY

The rejection of claims 1 and 4 as being anticipated by Kanzelberger is not sustained.

The rejection of claims 2 and 3 as being unpatentable over Kanzelberger is not sustained.

The rejection of claim 5 as being unpatentable over Kanzelberger and Smith is not sustained.

The rejection of claims 6 and 7 as being unpatentable over Kanzelberger and Rader is not sustained.

The rejection of claim 8 as being unpatentable over Kanzelberger, Rader and Fan is not sustained.

The rejection of claim 11 as being unpatentable over Kanzelberger and Rader is sustained.

The rejection of claims 12 and 13 as being unpatentable over Kanzelberger in view of Rader and Fan is sustained.

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

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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-IN-PART

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