

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 KATHERINE C. HORTON
and
MARK C. ROGERS

Appeal No. 1998-0999
Application 08/452,737

ON BRIEF

Before KIMLIN, PAK, and JEFFREY T. SMITH, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 13 and 21 through 23, which are all of the claims pending in the above-identified application. Claim 1 was amended subsequent

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to the final Office action dated December 3, 1996.

APPEALED SUBJECT MATTER

The subject matter on appeal is directed to a placemat suitable for dining establishments for sanitary and entertainment purposes. Claim 1 is representative of the subject matter on appeal and reads as follows:

1. A placemat having at least one integrated adhesive sticker or label, comprising:

a bond paper sheet having a front surface and a rear surface, said bond paper sheet having a drawing portion and an integrated adhesive sticker or label portion;

a liner adhered by an adhesive to at least a portion of said rear surface of said adhesive sticker or label portion of said bond paper sheet; and

a die cut through said bond paper sheet to form said at least one integrated adhesive sticker or label, said at least one integrated adhesive sticker or label being positioned over said liner adhered by an adhesive to at least a portion of said rear surface of said integrated adhesive sticker or label portion of said bond sheet;

wherein said drawing portion has indicia printed thereon to represent a scene and said sticker or label portion has at least one preprinted label associated with the scene represented in said drawing portion and wherein said drawing portion and said sticker or label portion are preprinted to provide entertainment and educational activities for children or other interested patrons.

We interpret the phrase "drawing portion has indicia

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printed thereon to represent a scene" recited in claim 1 as requiring a drawing setting forth a scenery or place where action or event takes place. See *Webster's II New Riverside University Dictionary*, Houghton Mifflin Company (1994), page 1043 (attached herewith). This interpretation is consistent with appellants' application disclosure, especially Figures 4 and 5 of the drawings in the application.

We interpret the phrase "sticker or label portion has at least one preprinted label associated with the scene" recited in claim 1 as requiring an image shown in at least one sticker or label be connected or related to a scenery or location where action takes place. See *Webster's II New Riverside University Dictionary*, Houghton Mifflin Company (1994), pages 132 and 1043 (attached herewith). This interpretation is also consistent with appellants' application disclosure, especially Figures 4 and 5 of the drawings in the application.

PRIOR ART

In support of her rejections, the examiner relies on the following prior art references:

Ashby	5,129,682	Jul. 14,
1992		

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Limina et al. (Limina) 1996	5,507,901	Apr. 16,
		(Filed Dec. 22, 1994)
Brown et al. (Brown) 1996	5,512,612	Apr. 30,
		(Filed Apr. 4, 1994)

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REJECTION

The appealed claims stand rejected as follows:

- 1) Claims 1, 3, 10, 21 and 23 under 35 U.S.C. § 102(e) as anticipated by the disclosure of Limina;
- 2) Claims 1 through 5, 10, 12 and 21 through 23 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Limina and Brown; and
- 3) Claims 1 through 13 and 21 through 23 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Ashby and Brown.

OPINION

Having carefully reviewed the claims, specification, drawings and applied prior art, including the arguments advanced by both the examiner and appellants in support of their respective positions, we determine that the aforementioned § § 102(e) and 103 rejections are not well founded.

Initially, we determine that the examiner has not properly considered the preambular limitation "placemat" recited in claim 1. Contrary to the examiner's position, we determine that it gives life and meaning to the invention

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claimed, thus excluding the business forms described in the applied prior art. See, e.g., *Corning Glass Works v. Sumitomo Elect. U.S.A.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).

Secondly, we determine that the examiner has not adequately considered the limitations "scene" and "preprinted label associated with the scene" recited in claim 1. When these limitations are interpreted consistent with the application disclosure as indicated *supra*, they do not embrace the business form designs described in the applied prior art.

In view of the foregoing, we reverse each of the foregoing §§ 102 and 103 rejections.

REMAND ORDER

We remand the application to the examiner for appropriate action as indicated below.

We observe that appellants acknowledge at page 5 of the specification that a preprinted placemat constructed from a rectangular sheet of bond paper with either one or two-sided printing is known. According to appellants (*Id.*), it was known that

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this type of construction allows for . . . the form of games to play, pictures to draw or [separate] adhesive stickers to adhere to the preprinted placemat.

The separate adhesive stickers include pressure sensitive adhesive stickers. *Id.* The admittedly known prior art placemat containing drawings and admittedly known stickers associated therewith are closest to the claimed placemat. The only distinction between the admittedly known prior art placemat containing drawings and separate stickers and the claimed placemat appears to be that the claimed placemat integrates conventional pressure sensitive adhesive stickers, such as those described in Ashby, Limina and Brown, with drawings associated therewith.

Upon return of this application, the examiner is to determine whether one of ordinary skill in the art would have been led or motivated to join or integrate conventional pressure adhesive stickers (such as those shown in Limina, Ashby and/or Brown), which are to be used with the drawings in a placemat, with the placemat itself either for convenience or for other practical reasons (such as connecting stickers to related drawings in a placemat to avoid misplacement or misuse

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of the stickers).

Any reliance on appellants' admission at page 5 of the specification, together with Limina, Ashby and/or Brown, for the first time in any of the examiner's rejections would require reopening of the prosecution of this application.

This application, by virtue of its "special" status, requires immediate action. See Manual of Patent Examining Procedure (MPEP) § 708.01 (7th ed., Rev. 1, Feb. 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case.

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

REVERSED AND REMANDED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JEFFREY T. SMITH)
Administrative Patent Judge)

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