

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PETER RASMUSSEN

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Appeal No. 1998-2240  
Application No. 08/443,058

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ON BRIEF

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Before ABRAMS, FRANKFORT, and GONZALES, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 5, 7, 8, and 10-18, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a covering for a sphere or hemisphere. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief (Paper No. 15).

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wigal	3,055,123	Sep. 25, 1962
Dukes	3,063,163	Nov. 13, 1962

Claims 1, 5, 7, 8, and 10-18 stand rejected under 35 U.S.C.

§ 112, second paragraph, as being indefinite.<sup>1</sup>

Claims 1, 5, 7, 8, and 10-18 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Wigal in view of Dukes.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 16) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 15) for the appellant's arguments thereagainst.

OPINION

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<sup>1</sup>Claims 10-18 were omitted from the statement of this rejection in the Answer. However, since claim 13 was mentioned in the explanation of the rejection, this omission appears to have been inadvertent.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, the applied prior art references, the respective positions articulated by the appellant and the examiner, and the guidance provided by our reviewing court. As a consequence of our review, we make the determinations which follow.

The appellant's invention is directed to a covering for a sphere or hemisphere, with particular application to a globe such as those upon which geographic features are presented. The invention comprises a flexible sheet that is cut so as to provide a plurality of polyconic gores extending from a central hub. The sheet can lie flat or can be placed upon a sphere and will conform to the surface thereof. An important feature of the invention is that the flexible sheet is readily removable from the globe so that it can be exchanged for sheets having other representations thereon. The invention further comprises a removable hemispherical cover that is shaped to closely overlay the sheet when the sheet is positioned on a globe.

*The Rejection Under 35 U.S.C. § 112, Second Paragraph*

It is the examiner's position that independent claims 1 and 13 are indefinite because the phrase "shaped to closely overlay" does not "require that the cover is overlaid [sic] the sheet," and because the phrase "readily removable" is unclear. We do not agree.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. We do not understand the reasoning behind the examiner's problem with the phrase "shaped to closely overlay." This is only a part of the language describing the cover which, in full, reads "shaped to closely overlay said sheet when said sheet is positioned upon said sphere or hemisphere." From our perspective, the language of the claim,

especially when considered in the light of the explanation of the invention provided in the specification, very clearly describes the globe and its relationship to the other components of the claimed invention.

With regard to the requirement that the flexible sheet be "readily" removable, we first note that the common definition of "readily" is "without much difficulty; easily."<sup>2</sup> Looking to the specification, we find that the cover is described as "holding" the sheet in place on the globe or, when a cover is not used, the sheet is held in place by electrostatic forces or through the use of "tacky, but readily removable, adhesives" (page 5). In our opinion, one of ordinary skill in the art clearly would have understood that "readily removable" means easy to remove, such as by using no attachment means at all (when a cover is used), or other means that are easily overcome by the user (when the cover is not used). Thus, we find this phrase to be in conformance with the second paragraph of Section 112.

This rejection is not sustained.

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<sup>2</sup>See, for example, Merriam Webster's Collegiate Dictionary, Tenth Edition, 1996, page 972.

*The Rejection 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 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, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

Independent claim 1 stands rejected as being unpatentable over Wigal in view of Duke. This claim requires, inter alia,

that the flexible sheet be "readily removable" from the sphere or hemisphere which it overlies. As we explained in preceding paragraphs, we consider this to mean that it be easily removable, that is, not permanently attached or attached in a manner that would require the use of tools, solvents, or the like to remove it. The examiner's position with regard to this limitation (Answer, page 5) is that because Wigal does not state whether the adhesive used to attach the sheet to the globe is permanent or removable, using a removable adhesive is included in the teachings that one of ordinary skill in the art would derive from it. The examiner further opines that "[i]t should be noted that all adhesive become[s] removable with time as it loses [sic, loses] its adhesivity," a statement that not only begs the question of whether a sheet attached therewith would be "readily removable" but, in the absence of supporting evidence, is untenable on its face.

We agree with the appellant that Wigal does not support the examiner's position. Wigal has among the objects of his invention providing a device that is "durable and stable, being resistant to breakdown through the normal, expected hard

usage on the part of young users" (column 1, lines 30-33). In furtherance of this aim, Wigal utilizes hard setting adhesives such as epoxy resin to attach together the sections of the globe (column 3, lines 10-14), and teaches that the covering sheet is provided with "a pressure sensitive adhesive coating" (column 3, line 28) and is "secured"<sup>3</sup> to the globe (column 4, lines 21, 22-32 and 49). Nowhere does Wigal explicitly teach that the sheet can be removed from the globe, nor in our opinion is this implicit in the disclosure. In this regard, Wigal does not recognize the problem to which the appellant has directed his inventive energies, namely, providing a system wherein the covering sheet can easily be removed and exchanged for another. In sum, there would seem to be no reason for Wigal's covering sheet to be removable.

Neither the examiner's presentation of the rejection nor our own analysis of the reference lead us to the conclusion that one of ordinary skill in the art would have been taught by Wigal that the covering sheet disclosed therein is "readily

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<sup>3</sup>The common definition of "to secure" is "to make fast." Merriam Webster's Collegiate Dictionary, Tenth Edition, 1996, page 972.

removable" from the underlying globe. In addition, we fail to perceive any teaching, suggestion or incentive which would have led the artisan to utilize adhesive having such properties as to allow the sheet to be "readily removable" from the globe in the Wigal device, other than that which is obtained through the hindsight afforded one who first viewed the appellant's disclosure.<sup>4</sup> Consideration of the teachings of Duke fails to alleviate this shortcoming.

For the reasons expressed above, it is our conclusion that the teachings of the applied references fail to establish a prima facie case of obviousness with regard to the subject matter of independent claims 1 and 13, and we therefore will not sustain the rejection of these claims or claims 5, 7, 8, 10-12 and 14-18, which depend therefrom.

#### CONCLUSION

Neither rejection is sustained.

The decision of the examiner is reversed.

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<sup>4</sup>The mere fact that the prior art structure 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).

Appeal No. 1998-2240  
Application No. 08/443,058

Page 10

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

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

NEA:hh

Appeal No. 1998-2240  
Application No. 08/443,058

Page 12

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