

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MINORU INABA

Appeal No. 1999-0112
Application No. 08/693,614

HEARD: March 7, 2001

Before McCANDLISH, Senior Administrative Patent Judge,
FRANKFORT, and LAZARUS, Administrative Patent Judges.

LAZARUS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5 through 9, which are all of the claims pending in this application.¹

We reverse and add a new ground of rejection.

¹ Claims 1 through 4 have been canceled pursuant to applicant's amendment filed September 8, 1997 (Paper No. 10).

BACKGROUND

The appellant's invention relates to a slide mount onto which can be correctly fitted a film that is cut into individual screens (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

THE PRIOR ART

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

Staeble	2,184,007	Dec. 19, 1939
Roehrl	2,527,765	Oct. 31, 1950

THE REJECTION

Claims 5 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roehrl in view of Staeble.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 16, mailed August 17, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 15,

filed July 6, 1998) and reply brief (Paper No. 18, filed October 16, 1998) for the appellant's arguments thereagainst.

OPINION

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

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 as to claims 5 through 8.

Claims are considered to satisfy the requirements in the second paragraph of § 112 if they define the metes and bounds of the claimed subject matter with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

Claims 5 through 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

As set forth in the preamble of claim 5 the subject matter the appellant regards as his invention is "a slide mount". However, we note the body of claim 5 additionally sets forth

a rectangular film portion having first opposing lateral edges, a partial gap portion at each of said first opposing lateral edge, and a rectangular photographed screen between the first opposing lateral edges, each of the partial gap portions having therein a pair of holes being cut nearly in half forming open engaging holes in the opposing lateral edges... whereby said rectangular film portion is positioned securely in the slide mount when said cover is closed over said rectangular film portion having a convex portion causing said rectangular film to be extended forcing the open engaging holes against said four positioning pins and causing the photographed screen to be centered therein.

This recitation conveys the impression that the subject matter on appeal is something more than just a slide mount as set forth in the preamble of claim 5. That is, that the subject matter on appeal is an assembly of components apparently

including the film. At the oral hearing the appellant's counsel, when questioned about this, conceded that there is an inconsistency and that claim 5 should be amended by adding the word "assembly" to the preamble. Accordingly, we find claim 5, and dependent claims 6 through 8, to be indefinite because the subject matter defined in the body of claim 5 is inconsistent with the invention as set forth in the preamble of the claim.

Although we have rejected claims 5 through 8 as being indefinite, in the interest of avoiding piecemeal appellate review we will treat claim 5 as inclusive of the "rectangular film..." and thus as being directed to a slide mount assembly, and proceed to consider the § 103 rejection on that basis. Cf. Ex parte Saceman, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993).

--The obviousness rejection over Roehrl in view of Staehle--

Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness

with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 5 through 9 under 35 U.S.C. ' 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. ' 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. See In re Fine, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Claim 5 on appeal is directed to a slide mount and requires, in part, "a rectangular film portion... having a pair of holes being cut nearly in half forming open engaging

holes in the opposing lateral edges". Claim 5 concludes with the limitation that

said rectangular film portion is positioned securely in the slide mount when said cover is closed over said rectangular film portion having a convex portion causing said rectangular film to be extended forcing the open engaging holes against said four positioning pins and causing the photographed screen to be centered therein.

Claim 9, the only other independent claim, recites a method of mounting a slide film comprising

cutting the slide film having gap portions and a plurality of holes in both side portions such that the holes are cut nearly into one-half forming open engaging hole portions; [and]

inserting the slide film into a slide mount having positioning pins studded at four corners such that the open engaging hole portions are positioned to come into engagement with the positioning pins; and closing a cover contacting a convex portion of the slide film causing the slide film to be extended and forcing the open engaging holes into contact with the positioning pins studded at four corners....

The examiner determined that Roehrl's film "does not have open engaging holes" and that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the slide mount taught by Roehrl to display the film taught by Staehle as an alternate film

adapted to be displayed therein" (answer, pages 3-4). The examiner adds that "[i]f film taught by Staehle was mounted in the slide mount taught by Roehrl the open positioning holes would engage the positioning pin" (answer, page 5). The examiner's reasoning is that both Roehrl and Staehle teach conventional film having holes and both films are adapted to be mounted (answer, page 5).

The appellant argues that "[t]he Examiner has cited no reference suggesting the claimed combination, and has presented no convincing line of reasoning as to why the claimed invention would have been obvious in view of the cited references" (brief, pages 3 and 4).

It is our opinion that the examiner has not cogently explained, nor is it evident, why a person of ordinary skill in the art would have found it obvious to utilize Staehle's film in Roehrl's film mount. Indeed, it is not even clear that the open hole portions of Staehle's film would be usable in Roehrl's film mount. Roehrl's film is mounted using enclosed, not open, holes placed over the projections (17).

And Staehle's film does not use the holes at all for mounting, rather it is positioned within the shallow seat of central opening (18). Even if one used Staehle's film in Roehrl's mount, as suggested by the examiner, they would insert the film with the enclosed holes in registry with the projections (17) as suggested by Roehrl. In order that the Staehle's film cooperate with Roehrl's mount as recited in the appellant's claims 5 and 9 it would have to be cut to the right length so that there are holes with open ends which just fit against Roehrl's projections (17) when the film is extended and we find nothing in either prior art reference which would have suggested cutting Staehle's film to this length. Therefore, it is our view that the examiner has failed to provide an adequate explanation of what there is in the applied references that would have been suggestive of their combination.² Therefore, we do not see in either Roehrl or Staehle any basis for their combination in the manner

² The mere fact that the references can be combined or modified does not
(continued...)

(2 continued...)
render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990).

suggested by the examiner to arrive at the claimed subject matter and we can only conclude that the examiner's determination, in this regard, is based on impermissible hindsight.³

Accordingly, we will not sustain the examiner's rejection of claims 5 and 9 under 35 U.S.C. § 103 as being unpatentable over Roehrl in view of Staehle.

Claims 6 through 8 depend from claim 5 and the examiner's rejection of claims 6 through 8 will not be sustained for the same reasons as stated above with respect to claim 5.

CONCLUSION

³ Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. See Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ 2d 1237, 1239 (Fed. Cir. 1995) (citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

To summarize, the decision of the examiner to reject claims 5 through 9 under 35 U.S.C. § 103 is reversed and a new 35 U.S.C. § 112, second paragraph, rejection of claims 5 through 8 is entered pursuant to 37 CFR § 1.196(b).

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 (§ 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. . . .

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)

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Senior Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
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)	
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APPLICATION NO. 08/693,614

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DECISION: REVERSED; 37 CFR

1.196(b)

Prepared By:

DRAFT TYPED: 12 Sep 02

FINAL TYPED: