

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID F. LAURASH and GEORGE T. TAYLOR

Appeal No. 1999-2063
Application No. 08/744,432

HEARD: February 22, 2000

Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of newly presented claims 21-26 in this broadening reissue application based on appellants' U.S. Patent 5,413,383. Claims 1-20, which correspond to the claims of the original patent, have been allowed. No other claims are

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currently pending. We reverse and enter a new ground of rejection pursuant to 37 CFR § 1.196(b).

Appellants' invention pertains to "a multipurpose label or business form, and more particularly to a tuck label adapted to be adhered to a substrate such as an envelope or package" (specification, page 1, lines 5-8). Newly presented independent claim 21 is representative of the appealed subject matter and reads as follows:¹

21. A multipurpose tuck label/form in combination with an article comprising:

an article, and

a tuck label/form secured to a surface of said article, said tuck label/form comprising a label ply having a top edge and a bottom edge and first and second sides, said label ply including a first panel, a second panel, and a pair of side panels, said first and second panels being connected along a transverse perforated fold line, along which fold line said second side of said first panel is folded to be in contact with said second side of said second panel, said second panel extending from a top edge of said second panel at said transverse perforated fold line to a bottom edge of said second panel at said bottom edge of said label ply and being connected to respective side panels along generally vertical lines of perforation extending substantially from said

¹In accordance with 37 CFR 1.121(b)(2)(i)(C), claim 21 is presented in underlined form to indicate that it is a claim not found in the patent.

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transverse perforated fold line between said first and second panels to said bottom edge of said second panel at said bottom edge of said label ply, said side panels including an adhesive on the respective second sides thereof securing said label to said article.

The references relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:

| | | |
|----------------------------------|-----------|---------------|
| Rogers | 202,874 | Apr. 23, 1878 |
| Ehret et al. (Ehret) | 4,927,179 | May. 22, 1990 |
| Webendorfer et al. (Webendorfer) | 5,031,939 | Jul. 16, 1991 |
| O'Brien | 5,071,167 | Dec. 10, 1991 |

Claims 21-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over O'Brien in view of Rogers.

Claims 21-26 stand further rejected under 35 U.S.C. § 103 as being unpatentable over Ehret and Webendorfer in view of O'Brien and Rogers.

The examiner considers that O'Brien, Ehret and Webendorfer each disclose a tuck label/form generally as claimed, including a first panel (card 14 of O'Brien, flap 14, 16, 30 of Ehret, price tag sheet 50 of Webendorfer), and a second panel (shipping labels 12, 12, and 42 of O'Brien,

Ehret, and Webendorfer, respectively) connected together along a transverse perforated fold line. The examiner further considers that O'Brien, Ehret and Webendorfer each include adhesive backed side panels (adhesive portions 24, 28 of O'Brien's U-shaped adhesive area, leg elements of Ehert's U-shaped adhesive area 26, opposed portions of Webendorfer's unnumbered U-shaped adhesive area bounding shipping label 42) connected to respective sides of the second panels along vertical lines of perforation.² The examiner concedes that none of the primary references discloses vertical lines of perforation between the second panel and the side panels that extend all the way to the bottom edge of the second panel, as called for in each of the independent claims on appeal. However, the examiner cites Rogers for a teaching of this feature. In particular, the examiner considers that Rogers

²In that appellants do not dispute the examiner's implicit finding to the effect that Ehert's adhesive area 26 is connected to the second panel by a U-shaped line of perforation, we will accept the examiner's finding in this respect at face value. We note for completeness sake, however, that the U-shaped dotted line 60 seen in Ehret's Figure 5 merely indicates where the top portion of the release liner 16 of the first panel 14 will overlies the adhesive 26 when the first panel is folded under the second panel. See column 4, lines 15-22.

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shows a structure that is similar to that of the primary references in that the letter sheet envelope of Rogers has at least two panels A and B, and side panels a¹, b¹ and a², b² connected to the panels along generally vertical lines of perforations that extend all the way to the bottom edge of the letter sheet envelope. Based on these reference teachings, the examiner concludes that

[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the vertical perforations of O'Brien [Ehret and Webendorfer] to extend to the bottom edge of the label ply as shown in Rogers to ensure straight tearing. [Answer, page 3.]

The flaws in the examiner's rejections begin with the basic combination of Rogers with any of the primary references (O'Brien, Ehret and/or Webendorfer). Rogers relates to a letter sheet envelope wherein the various panels and lines of perforation are for the purpose of creating a letter sheet that can be folded and sealed to create a mailing envelope. As such, the adhesive portions of the side panels of Rogers engage each other to close off the sides of the folded panels. In contrast, both appellants' invention and each of the cited primary references are directed to a tuck label/form wherein the various panels and lines of perforation are for the

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purpose of creating a label that is folded and then secured to an article such as a carton. Accordingly, the adhesively backed side panels of O'Brien, Ehret and Webendorfer are utilized to secure the tuck label/form to the article. Given the disparate way in which the side panels of the envelope of Rogers are utilized as compared to the side panels of the tuck label/forms of O'Brien, Ehret and Webendorfer, there is no suggestion in either Rogers or any of O'Brien, Ehret and Webendorfer, or need in view of the divergent objectives of these references, for their combination.

The examiner's rationale that the proposed modification of O'Brien, Ehret and Webendorfer would have been obvious "to ensure straight tearing" (answer, page 3) of the second panel from the side panels is noted. The examiner's "reuse" argument on pages 5 and 6 of the answer is also noted. Assuming for the sake of argument that the proposed modification of the primary references would result in straighter tearing of the second panel from the side panels and/or facilitate reuse of the article to which the tuck label/form is adhered, nothing in O'Brien, Ehret and/or

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Webendorfer indicates that straight tearing or reuse of the article are of any particular concern in any of the primary references. The examiner's implication that the proposed modification would have been obvious because of the structural similarities between Rogers and the primary references also is not well taken. From our perspective, the many rationalizations offered in support of the rejections on appeal demonstrate that the examiner has impermissibly employed appellants' claims as a template to selectively piece together isolated disclosures in the prior art in an effort to construct a facsimile of appellants' claimed invention.

In any event, even if the references were combined in the manner proposed by the examiner, it is questionable whether the resulting structure would meet the limitations in the independent claims on appeal. Each of appellants' independent claims calls for a second panel that extends from the transverse fold line to the bottom edge of the label ply. In O'Brien, Ehret and Webendorfer, the second panels do not extend to the bottom of the label because of the presence of the bight portion of the U-shaped adhesive area. Likewise,

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the presence of sealing flap a³ prevents the panel A of Rogers from extending to the bottom of the letter sheet envelope. Since the references do not individually teach a second panel extending from a perforated fold line to the bottom of the label or letter sheet, it is not seen how this claimed feature would have been obvious from a consideration of their combined teachings.

For these reasons, we will not sustain the standing § 103 rejections of the appealed claims.

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 21-26 are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification that does not provide descriptive support for the invention as now claimed.

The test for determining compliance with the written description requirement found in the first paragraph of 35 U.S.C. § 112,

is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the

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specification for the claim language. The content of the drawings may also be considered in determining compliance with the written description requirement.

In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citations omitted).

A first embodiment of the multipurpose tuck label of the present invention (see Figure 1) comprises a label ply that includes an upper panel 16, a center panel 18, a lower panel 20, and a pair of side panels 22, 24, with the upper and center panels being connected along a transverse perforated fold line 26. Column 2, lines 7-11. In use, the upper panel is folded along fold line 26 so as to lie beneath the center panel. Figures 3, 4 and 5 illustrate other "versions" of the Figure 1 embodiment (column 4, lines 17-25), with each version of the first embodiment having an upper panel, a center panel, and a lower panel. Patent claims 1-7 are drawn to this first embodiment in that they are expressly limited to a multipurpose tuck label/form including an upper panel, a center panel, a lower panel, and a pair of side panels. Thus, the specification as a whole consistently indicates that the

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first embodiment includes an upper panel, a center panel, and a lower panel.

A second embodiment of the multipurpose tuck label of the present invention (see Figure 6) comprises a label ply that includes an upper panel 160, a center panel 180 having an upper portion 190 and a lower portion 195 connected along a transverse perforated fold line 270, a lower panel 200, and a pair of side panels 220, 240. Column 2, line 66 through column 3, line 6. In use, the upper panel and the upper portion of the center panel are folded along fold line 270 so as to lie beneath the lower panel and the lower portion of the center panel, respectively. Figures 8 and 9 illustrate other "versions" of the Figure 6 embodiment (column 4, lines 31-36), with each version of the second embodiment having an upper panel, a center panel having upper and lower portions, a lower panel, and a pair of side panels. Patent claims 8-20 are drawn to this second embodiment in that they are expressly limited to a multipurpose tuck label/form including an upper panel, a center panel having upper and lower portions connected along a transverse line of perforations, a lower panel, and a pair of side panels. Thus, the specification as

a whole consistently indicates that the second embodiment includes an upper panel, a center panel having upper and lower portions, and a lower panel.

Claims 21-26 are newly presented in this reissue application and are drawn to a multipurpose tuck label/form comprising a label ply having a top edge and a bottom edge, said label ply including a first panel and a second panel connected along a transverse perforated fold line, and a pair of side panels. The second panel is further defined in independent claim 21 as "extending from a top edge of said second panel at said transverse perforated fold line to a bottom edge of said second panel at said bottom edge of said label ply."³ Thus, it is clear that claim 21, as well as similarly worded claims 22-26, preclude the existence of a third or lower panel adjacent the lower edge of the second panel.⁴

³Independent claims 24, 25 and 26 contain similar limitations.

⁴This, of course, is precisely what appellants intend. See paragraph 4 of the reissue declaration, wherein it is stated that the newly presented claims recite

inter alia, a label ply or a label including two

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Appellants' explanation of where descriptive support for newly presented claims 21-26 can be found in the original patent disclosure is found in paragraph 8 of the reissue declaration, which reads as follows:

8. The subject matter defined in new claims 21-23^[5] is the same general invention as that disclosed as being the invention in the original patent. Specifically, the specification of the '383 patent illustrates the optional nature of the third or lower panel. For example, the "Summary of the Invention" points out that the lower and side panels are used to adhere the form/label to a substrate but subsequently points out that the side panels alone would be sufficient to secure the form/label to the substrate (see column 2, lines 21-25, and column 3, lines 65-68, "adhesive carried on the side **and/or** lower panels.").

The passage at column 2, lines 21-25 of the specification reads as follows:

The lower and side panels include an adhesive on the respective second sides thereof which are used to adhere the form/label to a substrate after it has been peeled away from the liner ply.

panels, i.e., a first and a second panel, as opposed to three panels, i.e., an upper panel, a center panel, and a lower panel.

⁵When the present reissue application was filed, claims 21-23 were the only newly presented claims.

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The passage at column 3, lines 65-68 of the specification reads as follows:

In use, the label is peeled away from the liner ply and the adhesive carried on the side and/or lower panels is used to secure it to a surface of a package or envelope.

We do not think the artisan would have gleaned from these passages that the third or lower panel of appellants' first embodiment is optional. This is particularly so when these passages are read within the context of the specification in its entirety, which, as indicated above, consistently indicates that the third or lower panel of the first embodiment is an integral component of the first embodiment of the form/label.⁶ Concerning the term "and/or" found at column 3, line 66, of the patent specification, we think the artisan simply would have understood from this terminology that the adhesive found on the back of the lower panel and the adhesive found on the back of the side panels are each in and of themselves sufficient to secure the label to the package or

⁶Appellants do not contend, and it is not apparent to us, that the newly presented claims can be read on the second embodiment of the form/label.

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envelope. However, it does not necessarily and inevitably follow from this that the third or lower panel is optional and may be eliminated, as appellants would have us believe. In this regard, the term "and/or" at column 3, line 66, of the specification may just as readily be interpreted by the artisan as meaning that the placement of adhesive on the lower panel is optional.

In short, we do not believe the disclosure of the application as originally filed (i.e., the patent disclosure) reasonably conveys to the artisan that appellants had possession at that time of the subject matter set forth in claims 21-26.

In summary, the standing rejections of claims 21-26 under 35 U.S.C. § 103 are reversed, and a new rejection of claims 21-26 pursuant to 37 CFR § 1.196(b) has been entered.

The decision of the examiner is reversed.

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

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§ 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 appellants, 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 (37 CFR

§ 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 37 CFR § 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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| NEAL E. ABRAMS |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| LAWRENCE J. STAAB |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| |) | |
| |) | |
| JENNIFER BAHR |) | |
| Administrative Patent Judge |) | |

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KILWORTH GOTTMAN HAGAN & SCHAEFF
ONE DAYTON CENTER
ONE SOUTH MAIN STREET
SUITE 500
DAYTON, OH 45402

Leticia

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APJ STAAB

APJ BAHR

APJ ABRAMS

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: March 18, 2002

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT