

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM KELLER and CHARLES BERGERON

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Appeal No. 1999-2368  
Application No. 08/771,018<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3 and 5 to 9. Claims 2, 10, 11 and 13 to 21 have been allowed. Claims 4 and 12 have been canceled.<sup>2</sup>

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<sup>1</sup> Application for patent filed December 20, 1996.

<sup>2</sup> The appellants cancellation of claims 4 and 12 was set forth in the amendment filed October 14, 1997 (Paper No. 4). We note that this cancellation of claims 4 and 12 has not been

(continued...)

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We REVERSE AND REMAND.

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<sup>2</sup>(...continued)  
clerically entered.

BACKGROUND

The appellants' invention relates to a hidden photographic storage and display device. An understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the opinion section below.

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

Colbow, Jr. 1924 (Colbow)	1,509,285	Sep. 23,
Clark 1937	2,086,472	July 6,
Spertus 1953	2,649,799	Aug. 25,
Donle 1963	3,079,771	March 5,
Newman 1966	3,286,382	Nov. 22,
Cornelius 29, 1971	3,589,049	June
Yang 3, 1989	4,794,713	Jan.
Curtis 1994	5,368,378	Nov. 29,
McClelland 1979	1,054,666	May 15,
	(Canada)	

Claims 1, 3 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Clark in view of McClelland.

Claims 1, 3, 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yang in view of Spertus, Donle and Cornelius.

Claims 6 to 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Clark in view of McClelland as applied to claim 1 above, and further in view of Spertus and Cornelius.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Clark in view of Colbow.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 8, mailed May 20, 1998) and the answer (Paper No. 12, mailed April 12, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 11,

filed January 11, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. 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 1 and 3 to 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 by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 1 reads as follows:

A hidden photographic storage and display device comprising:

a plurality of photographic storage panels, each of said panels having a plurality of photographic insert sleeve members disposed thereon, each of said photographic sleeve members capable of storing at least one photograph;

means for housing said photographic storage panels, said means for housing including a cover member, said means for housing concealing said plurality of photographic storage panels and any photographs disposed within an associated photographic insert sleeve member when said cover member is in a closed position, said means for housing attached to an outer surface of a wall member;

said cover member having an outer appearance of a decorative element;

wherein said device providing an outer appearance of a decorative element as well as providing a hidden storage area for the plurality of photographs when said cover member is in a closed position.

**The rejections utilizing Clark as the primary reference**

We will not sustain the following rejections under 35 U.S.C. § 103: (1) the rejection of claims 1, 3 and 5 as being unpatentable over Clark in view of McClelland; (2) the rejection of claims 6 to 8 as being unpatentable over Clark in view of McClelland as applied to claim 1 above, and further in view of Spertus and Cornelius; and (3) the rejection of claim 9 as being unpatentable over Clark in view of Colbow.

All of the above-noted rejections utilizing Clark as the primary reference are based on the examiner's determination (final rejection, p. 4) that the only difference between Clark and claim 1 was that Clark "does not teach that the housing means is attached to an outer surface of a wall member." The appellants have contested this determination of the examiner. Specifically, the appellants argue (brief, p. 5) that "the spring clips 33 of Clark are not the same or equivalent of Applicant's photographic insert sleeve members."

We find ourselves in agreement with the appellants' position in this matter. In that regard, it is clear to us

that the spring clips 33 are not readable on the claimed "plurality of photographic insert sleeve members" capable of storing at least one photograph disposed on a plurality of photographic storage panels as recited in claim 1.

Additionally, it is our view that this limitation is not taught or suggested by any of the applied prior art.

Furthermore, we agree with the appellants' argument (brief, p. 5) that there is no teaching or suggestion for modifying Clark by McClelland so that Clark's housing means is attached to an outer surface of a wall member. In that regard, we note that McClelland fails to teach or suggest attaching his housing means to **an outer surface** of a wall member (i.e., hung on the wall as in the first embodiment of the appellants' invention (see Figures 1-3), not disposed within an opening in the wall as in the second embodiment of the appellants' invention (see Figure 4)) since in our view McClelland only teaches and suggests attaching his housing means to a wall by disposing the housing means within an opening in the wall. Moreover, there is no apparent motivation, absent the use of impermissible hindsight, for one

skilled in the art to have mounted the filing cabinet of Clark to **an outer surface** of a wall member.

**The rejection utilizing Yang as the primary reference**

We will not sustain the rejection of claims 1, 3, 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Yang in view of Spertus, Donle and Cornelius.

This rejection utilizing Yang as the primary reference is based on the examiner's determination (final rejection, p. 4) that the only differences between Yang and claim 1 were that Yang "does not teach a plurality of photographic insert sleeve members disposed on the panels and that the device is attached to a wall." The appellants have contested this determination of the examiner. Specifically, the appellants argue (brief, p. 7) that "Yang fails to conceal the picture storage area and displays the top picture being stored."

We find ourselves in agreement with the appellants' position in this matter. In that regard, it is clear to us that Yang's leaves 2 (including the top leave) would be

considered to be the recited "plurality of photographic storage panels." Thus, Yang's cover 1 including front wall 11 with window 111 and rear wall 12 is not readable on the claimed "means for housing said photographic storage panels, said means for housing including a cover member, said means for housing concealing said plurality of photographic storage panels and any photographs disposed within an associated photographic insert sleeve member when said cover member is in a closed position," since the window 111 permits the pictures to be seen when the front wall 11 of the cover 1 is closed (see column 1, lines 54-60 of Yang). Accordingly, the examiner has failed to establish the obviousness of the claimed invention.

Furthermore, we note that the claimed "plurality of photographic insert sleeve members" capable of storing at least one photograph disposed on a plurality of photographic storage panels as recited in claim 1 is not suggested by any of the applied prior art.

REMAND

We remand this application to the examiner for further consideration of the patentability of the appealed claims under 35 U.S.C. § 103. With regard to claim 1, the examiner should assess available evidence in the photographic storage art to determine if it is known in that art to store photographs in a plurality of photographic storage panels wherein each of the panels has disposed thereon a plurality of photographic insert sleeve members each capable of storing at least one photograph. If this item is known in the photographic storage art, the examiner should cite that evidence (e.g., prior art) and then consider whether or not such evidence can be combined with the above-noted applied prior art (e.g., Spertus) to render any of the appealed claims unpatentable under 35 U.S.C. § 103.

We additionally remand this application to the examiner for consideration of the patentability of claims 7 and 8 under 35 U.S.C. § 112, second paragraph. In claim 7, the phrase "said means for pivoting" lacks proper antecedent basis. The examiner should determine if this lack of antecedent basis

renders claims 7 and 8 indefinite under 35 U.S.C. § 112,  
second paragraph.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3 and 5 to 9 under 35 U.S.C. § 103 is reversed. In addition, the application has been remanded to the examiner for further consideration of the pending claims.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Seventh Edition, July 1998).

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

REVERSED; REMANDED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

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APPEAL NO. 1999-2368 - JUDGE NASE  
APPLICATION NO. 08/771,018

APJ NASE

APJ FRANKFORT

APJ CRAWFORD

DECISION: **REVERSED; REMANDED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 20 Dec 99

**FINAL TYPED:**

**Gloria: Note change in panel order**