

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR G. CASTILLO, NORMAN YAMAMOTO,
CHITTO R. SARKAR, CHRISTINE KAY LANDIS,
FRANK YEN-JER SHIH, and ZHISONG HUANG

Appeal No. 2003-0156
Application No. 09/607,996

ON BRIEF

Before ABRAMS, MCQUADE and NASE, Administrative Patent Judges.

By the Board

DECISION ON APPEAL

Arthur G. Castillo, et al. appeal from the final rejection (Paper No. 9) of claims 1 through 26, all of the claims pending in the application.¹

THE INVENTION

The invention relates to personalized, paper-holding binders. Representative claims 1 and 10 read as follows:

1. A binder having a drawable/traceable cover comprising: front and back covers hingedly coupled together and including arrangements for holding papers between said covers;

¹ Claim 26 has been amended subsequent to final rejection.

a transparent plastic sheet extending over a substantial area of and being secured to said front cover;

said transparent plastic sheet being provided with an ink receptive layer, said layer comprising a porous pigment dispersed in or mixed with a binder including a water soluble polymer, said layer being at least semi-transparent; and

a pocket formed between the transparent sheet and said front cover;

whereby a visual image may be inserted into said pocket and traced by writing with a pen onto said ink receptive layer.

10. A method of forming a personalized binder comprising:
forming a binder with a plastic sheet on a cover thereof, with a pocket between said cover and said plastic sheet, said plastic sheet being provided with a layer which is receptive to water based inks, solvent based inks and gel inks, said layer also being substantially water-fast following drying of said ink;
inserting a visual image into said pocket;

tracing said at least a part of said visual image onto the transparent plastic sheet using a pen utilizing water based ink, solvent based ink, or gel ink; and
drying said ink;

whereby said traced visual image is permanently fixed into said coating and is substantially water-fast.

THE EVIDENCE

The examiner relies on the following items as evidence of obviousness:

Bachrach, et al. (Bachrach)	5,030,027	Jul. 09, 1991
Wyant	Des. 343,862	Feb. 01, 1994
Brault, et al. (Brault)	6,165,593	Dec. 26, 2000
Miyazaki, et al. (Miyazaki)	6,176,910	Jan. 23, 2001

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The appellants rely on the following items as evidence of non-obviousness:

The 37 CFR § 1.132 declarations of Arthur G. Castillo filed August 13, 2001 (Paper No. 8) and January 23, 2002 (Paper No. 10).

THE REJECTIONS

Claims 1 through 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bachrach in view of Brault.

Claims 10 through 20, 22 through 24 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bachrach in view of Brault and Miyazaki.

Claims 21 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bachrach in view of Brault, Miyazaki and Wyant.

Attention is directed to the appellants' main and reply briefs (Paper Nos. 13 and 15) and to the examiner's answer (Paper No. 14) for the respective positions of the appellants and the examiner regarding the merits of these rejections.²

² In the final rejection (Paper No. 9), claim 26 also stood rejected under 35 U.S.C. § 112, first paragraph. The examiner has since withdrawn this rejection in view of the amendment of claim 26 subsequent to final rejection (see the advisory action dated January 31, 2002, Paper No. 11).

DISCUSSION

Bachrach, the examiner's primary reference, discloses a notebook binder 36 comprising front and back covers 34 and 25, a ring binder 28, 30 for holding papers between the covers, a clear vinyl sheet 44 sealed on three peripheral sides to the front cover and open at the top to define a pocket, and a series of graphically imprinted sheets 48, 50 sized for insertion into the pocket. According to Bachrach, the user may write on the clear vinyl sheet 44 with a marker (see column 3, lines 60 through 62).

As conceded by the examiner (see page 3 in the answer), Bachrach does not respond to the limitations in the appellants' independent claims calling for an ink receptive layer. As indicated above, independent claim 1 requires the transparent plastic sheet to be provided with an ink receptive layer comprising a porous pigment dispersed in or mixed with a binder including a water soluble polymer, and independent claim 10 requires the plastic sheet to be provided with a layer which is receptive to water based inks, solvent based inks and gel inks and substantially water-fast after drying of the ink. Similarly, independent claim 5 requires a transparent sheet provided with a layer which is receptive to water based inks, solvent based inks and gel based inks and substantially water-fast after drying of the ink, independent claim 12 requires a cover bearing an ink

receptive layer which comprises a porous pigment dispersed in or mixed with a binder including a water soluble polymer and is substantially water-fast after drying of the ink, independent claim 16 requires a cover provided with a layer which is receptive to water based inks, solvent based inks and gel based inks and substantially water-fast after drying of the ink, and independent claims 22 and 26 require the step of coating a cover with a layer which is receptive to water based inks, solvent based inks and gel inks and substantially water-fast after drying of the ink. To overcome these shortcomings in Bachrach vis-a-vis the appellants' claims, the examiner turns to Brault.

Brault discloses an ink receptor element 10 designed to be bonded to a substrate element 20 to form a large format poster, billboard or like article. The ink receptor element comprises an adhesive ink receptive layer 16, an image transparent protective layer 14 permanently adhered to the ink receptive layer, and a temporary carrier layer 12 releasably adhered to the protective layer. The ink receptive layer 16 has adhesive characteristics (see column 7, line 37, through column 8, line 2) which allow it to be bonded to the substrate element after an imaged layer 18 is deposited thereon by an ink jet device 11 (see column 8, line 62, through column 9, line 50), whereupon the temporary carrier layer 12 is removed from the protective layer 14 (see column 9, line

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51, through column 10, line 27) to produce a substrate having a protected ink image thereon.

In proposing to combine Bachrach and Brault, the examiner concludes that it would have been obvious "to modify Bachrach's invention to include an . . . ink receptive layer for the transparent sheet, as taught by Brault et al., to enable the user to have a writing surface that may be written on and erased repeatedly providing a customizable cover for the binder" (answer, page 4).

The appellants' argument that this proposed reference combination stems from impermissible hindsight is persuasive. Under § 103(a), the teachings of references can be combined only if there is some suggestion or incentive to do so. In re Fritch, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The mere fact that the prior art might be modified in a manner advanced by an examiner would not have made the modification obvious absent some suggestion in the prior art of the desirability of the modification. Id. In the present case, there is nothing in the combined teachings of Bachrach and Brault which would have suggested culling the adhesive ink receptive layer from the laminated ink receptor element disclosed by Brault and adding it to the clear vinyl sheet on the notebook binder disclosed by Bachrach. This proposed modification springs from

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an impermissible hindsight reconstruction of the appellants' invention wherein the examiner has used the claims as a blueprint to selectively piece together isolated disclosures in the prior art. Furthermore, these flaws in the Bachrach and Brault combination find no cure in Miyazaki and/or Wyant.³

Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1 through 9 as being unpatentable over Bachrach in view of Brault, the standing 35 U.S.C. § 103(a) rejection of claims 10 through 20, 22 through 24 and 26 as being unpatentable over Bachrach in view of Brault and Miyazaki, or the standing 35 U.S.C. § 103(a) rejection of claims 21 and 25 as being unpatentable over Bachrach in view of Brault, Miyazaki and Wyant.

SUMMARY

The decision of the examiner to reject claims 1 through 26 is reversed.

³ As the references relied on by the examiner fail to establish a prima facie case of obviousness with respect to the subject matter recited in the appealed claims, there is no need to delve into the merits of the appellants' declaration evidence of non-obviousness.

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REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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