

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THEO VAN DEN BERGH

Appeal No. 2003-0485
Application 08/767,249

ON BRIEF

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

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 18 through 26, all of the claims remaining in this application. Claims 1 through 17 have been canceled.

Appellant's invention is directed to a form for use in non-impact printers (e.g., laser or ink jet printers). Independent

Appeal No. 2003-0485
Application 08/767,249

claim 18 is representative of the subject matter on appeal and reads as follows:

18. A form for non-impact printers, comprising: an upper section; a lower section; two subsequent sections located between the upper section and the lower section; and a coating located on the back of at least one of said upper section and said lower section, wherein

each section is separated from the next section by a fold line formed as a perforation;

said upper section having a surface area equal to that of said two subsequent sections;

said upper section and the next one of said two subsequent sections have a surface equal to that of the other of said two subsequent sections and said lower section; and

said upper section is located relative to said two subsequent sections so that said upper section is folded onto said two subsequent sections and is thus adapted for printing on said upper section in a non-impact printer.

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

Frease	645,900	Mar. 20, 1900
Linden et al. (Linden)	5,393,265	Feb. 28, 1995
Fabel	6,173,888 B1	Jan. 16, 2001

Claims 18 and 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Fabel.

Appeal No. 2003-0485
Application 08/767,249

Claims 20 through 22, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fabel in view of Linden.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fabel in view of Frease.

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fabel in view of Linden and Frease.

Rather than reiterate the examiner's full statement regarding the above-noted rejections and the conflicting viewpoints advanced by appellant and the examiner with respect to those rejections, we make reference to the examiner's answer (Paper No. 34, mailed August 13, 2002) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 33, filed June 18, 2002) for appellant's arguments thereagainst.

Appeal No. 2003-0485
Application 08/767,249

OPINION

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

In maintaining the rejection of claims 18 and 26 under 35 U.S.C. § 102(e) as being anticipated by Fabel, the examiner has urged (answer, pages 3-5) that the mailing form (10) of Fabel for use in a non-impact printer includes an upper section (80), a lower section (78), and two subsequent sections (70, 72) located between the upper and lower sections. The examiner further notes that "[a]s seen in Figure 7, each section is separated from the next section by fold lines formed as perforations (18, 26, 36)", and contends that the various sections of the mailing form in Fabel are sized in the manner set forth in claims 18 and 26 on appeal.

We have reviewed the applied Fabel patent in its entirety and, like appellant, find that Fabel does not disclose, teach or

Appeal No. 2003-0485
Application 08/767,249

suggest a form having four sections as recited in claim 18 on appeal and sized in the particular manner required in claims 18 and 26. When the mailing form of Fabel is viewed as a whole from a consideration of all of the figures of the patent drawings and based on the description in the patent's specification, it is clear that the various sections of the form therein referred to by the examiner are not sized as required in claim 18 on appeal. For example, it is clear from viewing Figures 1, 5, 6 and 7 of Fabel that the upper section (80) and first subsequent section (70) together do not have a surface or surface area equal to that of the other of the subsequent sections (72) and the lower section (78).

When upper section (80) is separated from lower section (78) along perforated line (36) as described in the Fabel patent it is readily apparent that the upper section (80) is somewhat smaller in area than the lower section (78). Note in this regard, that it is scored line (38) that is described in the Fabel patent as being located at the midway point between the ends (39, 40) of lower sheet (14), and thus midway of the form (10) as a whole (col. 4, lines 63-66). Moreover, it is readily apparent from Figures 1, 5 and 6 of Fabel that the two subsequent sections (70,

Appeal No. 2003-0485
Application 08/767,249

72) differ considerably in size, i.e., with section (72) being much larger in area than section (70). Thus, when the surface areas of sections (70) and (80) are added together and the surface areas of sections (72) and (78) are added together, it is clear that (70, 80) has a smaller surface area than (72, 78).

As for the requirement in claim 18 that the upper section have a surface area equal to that of the two subsequent sections, we agree with appellant that it is rank speculation on the examiner's part to conclude that upper section (80) of Fabel has a surface area equal to that of sections (70, 72). Given the sizing of these portions of the mailing form (10) of Fabel as seen in Figures 1, 5 and 6 of the patent, it is highly unlikely that such a relationship exists.

In light of the foregoing, it is clear to us that the examiner's assertions (findings) in the last paragraph on page 4 of the answer are entirely without foundation and contrary to the teachings of Fabel. Accordingly, we will not sustain the examiner's rejection of claims 18 and 26 under 35 U.S.C. § 102(e) as being anticipated by Fabel.

Appeal No. 2003-0485
Application 08/767,249

Given our above-noted determination regarding the shortcomings of Fabel, and the lack of any further teaching or suggestion in either Frease or Linden supplying such deficiencies, it follows that the examiner's rejections of dependent claims 20 through 22, 24 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Fabel in view of Linden, of claim 19 under 35 U.S.C. § 103(a) based on Fabel and Frease, and the rejection of claim 23 under 35 U.S.C. § 103(a) based on Fabel, Linden and Frease, also will not be sustained.

Appeal No. 2003-0485
Application 08/767,249

Since we have refused to sustain any of the rejections
posited by the examiner, the decision of the examiner rejecting
claims 18 through 26 of the present application is reversed.

REVERSED

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

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Appeal No. 2003-0485
Application 08/767,249

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