

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERENCE G. MORGAN

Appeal No. 2003-1234
Application 09/755,519¹

ON BRIEF

Before BARRETT, BLANKENSHIP, and MacDONALD, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claim 1.

We affirm.

¹ Application for patent filed January 18, 2001, entitled "Lecture Note-Taking Method."

BACKGROUND

The invention relates to a method of note taking in a chemistry lecture in which the note taker uses a stamp containing the structure of a benzene ring instead of drawing the ring.

Claim 1 is reproduced below.

1. In note taking by a student attendee at a lecture in the field of chemistry during which there is frequent mention of a benzene ring of known molecular-illustrated structure and an inscribing of said molecular-illustrated structure during said note taking at selected mentions of said benzene ring, an improved method of making inscriptions of said molecular-illustrated structure of said benzene ring in conjunction with note taking commentary comprising the steps of:

- A. using on a support a paper substrate having a writing surface in facing relation to a student lecture attendee;
- B. listening of said student lecture attendee to commentary of a lecturer for mention of a benzene ring;
- C. impressing in response to such mention with one hand by said student lecture attendee using a stamp of a transferred circular circumferentially spaced apart arrangement of carbon atoms identified by the letter "C" and in the spaces between the letters "C" having bond lines indicating electron sharing which consists of alternating double and single lines onto said paper substrate writing surface; and
- D. handwriting lecture commentary onto said paper substrate writing surface with the other hand by said student lecture attendee adjacent a said benzene ring transferred molecular-illustrated structure;

whereby note taking is facilitated by the coordinated use of the stamping and handwriting occupied hands of said student lecture attendee.

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THE REFERENCES

The examiner relies on the following references:

Bissonet	3,839,960	October 8, 1974
Eckels	4,452,142	June 5, 1984

THE REJECTION

We refer to the final rejection (Paper No. 7) (pages referred to as "FR__") and the examiner's answer (Paper No. 10) (pages referred to as "EA__") for a statement of the rejection, and to the appeal brief (Paper No. 9) (pages referred to as "Br__") and reply brief (Paper No. 11) (pages referred to as "RBr__") for a statement of appellant's arguments thereagainst.

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bissonet and Eckels. The examiner finds that "Bissonet teaches a method of taking notes in which a student attending a lecture in which there are numerous occasions in which one has to write down and print the same data repeatedly can use a stamp to easily print that data. See column 1, lines 6-47 and Figures 1-2 and 16-17 in particular" (FR2). The examiner finds that is inherent in the process of taking notes to listen and make notes and concludes that "it would have been obvious to one of ordinary skill in the art to stamp those data/symbols in response to the lecturer's comments using a hand stamp as taught by Bissonet in their notes to facilitate quick and neat note-taking" (FR2). The examiner finds that Bissonet

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does not teach a benzene ring stamp, but concludes that it would have been obvious "to use any desired stamp design that pertains to any desired topic of lectures in which the student attends, as it involves simply an obvious matter of design choice" (FR3).

The examiner finds that Eckels teaches that the use of a stamp of a benzene ring for repeatedly stamping the symbol was well known in the art. "Therefore, it would have been obvious to one of ordinary skill in the art for a student in a chemistry class to use a chemical stamp as claimed to facilitate taking notes."

(FR3.) The examiner finds that although Bissonet is silent with respect to holding the stamp in one hand while holding a writing instrument in the other, Eckels teaches using one hand to perform one function (pointing to a location) while the other hand is used to stamp the indicia and concludes that it would have been obvious "to use the hand stamp in one hand while taking notes with the other hand to more quickly and efficiently record notes from the lecture" (FR3).

Appellant filed a declaration of commercial success under 35 U.S.C. § 132 (attachment to Paper No. 4), which contains sample notes using the stamp, and a page of endorsements and quotes from professors, teachers, and students. The examiner found the declaration to be unpersuasive because: (1) the evidence is opinion evidence and lacks factual support, citing In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992),

and does not necessarily outweigh the evidence of obviousness (FR4); and (2) appellant has failed to establish a nexus between the merits of the claimed invention and the objective evidence because "the quotes and endorsements ... are predominantly directed to benefits of the hand stamp per se and not necessarily the particular note taking method (i.e., stamping with one hand while writing with the other)" (FR4).

DISCUSSION

The claim is to a use of a known manufacture

Initially, we note that appellant acknowledges that Eckels was known prior art (specification, page 1). Eckels teaches a benzene ring stamp in the shape of hexagon (Figs. 7 and 8; col. 3, lines 28-30). The benzene ring in claim 1 is more specific than the hexagon shape benzene ring in Figs. 7 and 8 of Eckels because it recites the letter "C" at each point and alternating double and single bond lines. However, appellant does not contest that it would have been obvious to represent the benzene ring in Eckels with a more detailed ring.² Since the benzene stamp itself would have been obvious, appellant seeks to patent a "new use of a known ... manufacture" as a "process"

² The structural formula of benzene is often represented as a circle drawn inside a hexagon, where the hexagon represents the six C-C bonds and the circle represents the three decentralized electron pairs.

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under 35 U.S.C. § 100(b). The claim can only be infringed by practicing the method. The issue is whether the claimed method of using a known stamp would have been obvious.

Appellant's arguments

Appellant argues that Bissonet does not teach a method of note taking during a lecture during which there are numerous occasions when it would be advantageous to use a stamp, as found by the examiner, but teaches that the printing stamp and pad are normally held inoperatively in a cavity to provide a flat writing surface (Br4). It is argued that "the combined activity of writing and stamping is not contemplated by Bissonet since while the paper sheet is being used for writing thereon, the printing stamp and pad are in their storage cavity" (Br4). It is also argued that the examiner has not considered claim limitations B, C, and D (Br4-5). Appellant notes that Bissonet discloses a stamp for identification or approval, quoting from column 1, lines 8, 9-12, 19, and 20, and argues that "[n]one of the foregoing text is in response to the lecturer's comments nor does it have anything whatsoever to do with record[ing] notes from the lecture" (RBr2). Appellant refers to steps B, C, and D (RBr2).

Appellant argues that the examiner improperly failed to consider the declaration. It is argued that the majority in Beattie did not fault the declaration because it was based on

"opinion," but, because weighed against a very strong prima facie case of obviousness, it did not carry the day (RBr2). It is also argued (RBr2) that there is no commentary in praise of the stamp per se, but only praise of the note-taking method using the stamp, such as the comments "[a] handy way to take notes . . .," "a timesaver," "... efficiency, neatness and ingenuity to the classroom," and "[c]lever and useful indeed--I'm surprised my colleagues or myself never thought of it!"

Analysis

Bissonet recognizes that "[t]here are numerous occasions in which one has to repeatedly write down or print the same data, such as his or her own identification" (col. 1, lines 6-8) and provides a printing stamp and inking pad to be carried along and used to readily stamp predetermined data (col. 1, lines 16-20). We agree with appellant that Bissonet does not disclose or suggest the combined action of writing and stamping during a lecture, as found by the examiner. Although the detachable stamp in Figs. 16 and 17 could be used during a lecture, there is no teaching or suggestion of doing so. Thus, the statement of the rejection is based on incorrect findings of the content of Bissonet. The basic teaching of Bissonet is that a stamp may be used in place of repeatedly writing down or printing the same data, which is, of course, the well known purpose of stamps.

Nevertheless, we conclude that claim 1 would have been obvious over Eckels. Although we have no documentary evidence, we find that the examiner is correct "that it is inherent in the process of taking notes for a student to listen to the lecturer and make notes of the lecturer's comments" (FR2). More specifically, we find that the steps of a student listening for mention of a benzene ring in a lecture in the field of chemistry, drawing a benzene ring by hand, and writing lecture commentary adjacent the benzene ring were well known in the prior art of note taking by chemistry students. Eckels discloses that "[i]n many businesses, recording various data on a map, chart, graph or the like requires repetative [sic] actions of the physical activity of adding one or more signs, symbols or indicia to the record being kept" (col. 1, lines 12-15). Eckels further discloses that "[c]hemists may use a number of symbols in the many types of writings required of them" (col. 1, lines 25-27) and "[f]or the chemical industries of art, each writer may have specialized symbols, and such symbols may be secured to the end of the different lengths of arms" (col. 3, lines 25-28) where one such symbol is benzene (Figs. 7 and 8; col. 3, lines 28-30). Thus, Eckels teaches that chemical writers may use symbol stamps to take the place of repetitively drawing the symbols. One of ordinary skill in the art would have known to use the symbol stamps in Eckels in any kind of writing, including writing by a

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student at a lecture, where the student would use the benzene stamp for its intended purpose of avoiding repetitive drawing of the symbol. That is, the use of the symbol stamp in Eckels instead of manual drawings is the normal and intended use of the stamp and the use of the symbol stamp in Eckels for note taking at a chemistry lecture is not a new or nonobvious use. As to the limitation of stamping with one hand while handwriting notes with the other, we agree with the examiner that it would have been obvious to one skilled in the art "to use the hand stamp in one hand while taking notes with the other hand to more quickly and efficiently record notes from the lecture" (FR3) and that such technique would occur naturally so the writer does not have to keep changing back and forth between the stamp and the pen. The examiner notes that Eckels teaches an example of using one hand to perform one function (pointing to a location) while the other hand is used to stamp the indicia.

Appellant's page of endorsements and quotes in the declaration have been considered. Although the endorsements and quotes are not evidence of "commercial success" because commercial success deals with evidence of sales and taking the place of other devices in the marketplace, they are objective evidence of nonobviousness as evidence of professional approval.

By going to the trouble to prepare and submit such evidence, appellant has done all he can to argue and support his case. We

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agree with appellant that opinion evidence is entitled to weight in an obviousness determination. Opinions by persons in the chemistry field, as in the declaration, are entitled to more weight than those of a lay person in this case. Nevertheless, on balance, the evidence does not persuade us of nonobviousness.

Objective evidence of nonobviousness (also called "secondary considerations") must always be considered in making an obviousness decision, Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538-39, 218 USPQ 871, 879 (Fed. Cir. 1983), although it need not be necessarily conclusive. Ashland Oil, Inc. v. Delta Resins & Refrac., Inc., 776 F.2d 281, 306, 227 USPQ 657, 674 (Fed. Cir. 1985). A "nexus" is required between the merits of the claimed invention and the evidence of secondary considerations in order for the evidence to be given substantial weight in an obviousness decision. Stratoflex, 713 F.2d at 1539, 218 USPQ at 879. "Nexus" is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in the determination of nonobviousness. Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 1392, 7 USPQ2d 1222. 126 (Fed. Cir. 1988). The burden of showing nexus is on the applicant. Ex parte Remark, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Inter. 1990).

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We agree with the examiner that there is no nexus between the statements and the merits of the claimed subject matter and that "the quotes and endorsements submitted by applicant ... are predominantly directed to the benefits of the hand stamp per se and not necessarily the particular note taking method requiring all of the specific steps as recited by applicant in the claim (for example, stamping with one hand while writing with the other)" (EA9). The statements relate to the general benefits of using the benzene stamp in note taking, but none of the comments discuss that the particular claimed steps of taking notes with a benzene stamp are unique or nonobvious, as required to establish a nexus. We also find that the statements are not persuasive because they do not indicate any familiarity with the most pertinent prior art to Eckels. That is, the persons may not have had the same praise if they were aware of the benzene stamp in Eckels for use in chemical writing. Lastly, we agree with the examiner that the evidence of obviousness is strong and is not overcome by the objective evidence.

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