

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BRYCE C. WAGGONER and KEVIN R. KEYS

Appeal No. 2005-2727
Application No. 10/164,211

ON BRIEF

Before FRANKFORT, CRAWFORD, and BAHR, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 7, 12 to 21 and 26 to 39. Claims 8 to 11 and 22 to 25, the only other claims pending in this application, have been objected to by the examiner as being dependent on a rejected claim.

The appellants' invention relates to a foldable information card (specification, p.

1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The Prior Art

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

Bryden et al. (Bryden)	4,852,783	Aug. 1, 1989
Blanchard	5,621,990	Apr. 22, 1997
Cieplak	5,845,772	Dec. 8, 1998
Mirza	6,347,471	Feb. 19, 2002

The Rejections

Claims 1, 2, 5 to 7, 14 to 16, 19 to 21 and 28 to 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bryden in view of Cieplak.

Claims 3 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bryden in view of Cieplak and Mirza.

Claims 4, 12, 13, 18, 26 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bryden in view of Cieplak and Blanchard

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed September 7, 2004) for the examiner's complete reasoning in support of the

rejections, and to the brief (filed June 1, 2004) 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. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 1, 2, 5 to 7, 14 to 16, 19 to 21 and 28 to 39 under 35 U.S.C. § 103 as being unpatentable over Bryden in view of Cieplak. We initially note that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

In the examiner's view, Bryden describes the invention as claimed except that Bryden describes a hook and loop fastener rather than repositionable adhesive

(answer at pages 3 and 4). The examiner relies on Cieplak for teaching securing a folded device with a repositionable adhesive.

We agree with the examiner that Bryden describes the invention except that Bryden describes hook and loop fasteners 38 and 40 to secure the folded sheet rather than repositionable adhesive as required by claim 1.

Cieplak describes a folded article which utilizes a fastener 30 to releasably secure a flap 18 to close the flap to the front wall 12. The fastener may be a hook and loop fastener or repositionable adhesive (col. 3, lines 52 to 55; col. 4, lines 37 to 43).

We agree with the examiner that it would have been obvious to a person of ordinary skill in the art to substitute the repositionable adhesive taught by Cieplak for the hook and loop fasteners of Bryden because repositionable adhesive is a known alternative to the hook and loop fasteners as evidenced by Cieplak. In that regard, it must be borne in mind that where two known alternatives are interchangeable for their desired function, an express suggestion of the desirability of the substitution of one for the other is not needed to render such substitution obvious. See In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 568, 152 USPQ 618, 619 (CCPA 1967).

In view of the above, we will sustain the examiner's rejection of claim 1. We will also sustain this rejection as it is directed to claims 2, 5 to 7, 14 to 16, 19 to 21 and 28 to 39 as these claims stand or fall with claim 1 (see brief at page 4).

We turn next to the examiner's rejection of claims 3 and 17 under 35 U.S.C. § 103 as being unpatentable over Bryden in view of Cieplak and Mirza. Claim 3 recites that the pocket panel secured to the first panel by a permanent adhesive.

The examiner, recognizing that neither Bryden nor Cieplak explicitly describes securing a pocket panel utilizing a permanent adhesive, relies on Mirza for this teaching.

We find that Bryden describes attaching panels 14 and 16 by forming a heat sealed seam and that Mirza describes attaching pocket panels 12 and 13 utilizing adhesive or heat sealing (col. 5, lines 24 to 26).

We agree with the examiner that it would have been obvious to utilize adhesive to attach the panels of Bryden instead of the heat seam as permanent adhesive is a known alternative to heat sealing as is evidenced by Mirza. Therefore, we will sustain the rejection as it is directed to claim 3. We will likewise sustain the rejection as it is directed to claim 17 as claim 17 stands or falls with claim 3 (brief at page 4).

We turn lastly to the examiner's rejection of claims 4, 12, 13, 18, 26 and 27 under 35 U.S.C. § 103 as being unpatentable over Bryden in view of Cieplak and Blanchard. The examiner, recognizing that neither Bryden nor Cieplak describes information printed by a variable printer, relies on Blanchard for this teaching.

The appellants argue that Blanchard does not describe information printed by a variable printer.

We will sustain this rejection, because in our view a card constructed in accordance with the combined teachings of Bryden, Cieplak is capable of having the indicia placed on the card with a variable printer and therefore, the method of placing the indicia on the card does not render patentability to the subject matter of claim 4. In addition, contrary to appellant's argument, it appears that the type printed on the Blanchard card was applied via a "variable printer" given the color and type variations.

We will also sustain the rejection as it is directed to claims 12, 13, 18, 26 and 27 because these claims stand or fall with claim 4 (brief at page 4).

In conclusion, the decision of the examiner is affirmed.

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

AFFIRMED

MEC/gjh

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