UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY L. HENGSBACH

Appeal 2007-2182
Application 10/408,997
Technology Center 3700

Decided: February 27, 2008

Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and DAVID B. WALKER, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant appeals from a rejection of claims 1-8, 10-31 and 54-57, which are all of the pending claims.

THE INVENTION

The Appellant claims a book cover comprising a substantially transparent sheet having wrong-reading indicia on its interior surface

configured for being read from its exterior surface. Claims 1 and 11 are illustrative:

> 1. A book cover comprising:
>
> a substantially transparent sheet, said substantially transparent sheet having opposite first and second surfaces and edges;
>
> cover indicia applied to said second surface of said substantially transparent sheet in a wrong-reading orientation;
>
> an adhesive layer applied to said second surface of said substantially transparent sheet; and
>
> a frontpiece, a backpiece, and a spine piece positioned between said frontpiece and backpiece, said pieces together defining a profile, each of said frontpiece, said backpiece, and said spine piece having a first surface and a second surface;
>
> wherein said first surfaces of said frontpiece, said backpiece, and said spine piece are adhered to said second surfaces of said substantially transparent sheet such that said edges of said substantially transparent sheet project beyond said profile of said frontpiece, said spine piece, and said backpiece are folded over onto said second surfaces of said frontpiece, said backpiece, and said spine piece and adhered thereto.
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> 11. A book cover as defined in Claim 1, further comprising first and second endsheets, wherein said first endsheet is adhered to said frontpiece on said second surface thereof and said second endsheet is adhered to said backpiece on said second surface thereof, wherein said endsheets cover said folded-over edges of said substantially transparent sheet.

THE REFERENCES[1]

Deschamps-Despe (FR '576) (as translated)	FR 2 328 576	May 21, 1977
Ranson	US 5,308,208	May 3, 1994
Bilbie	US 6,481,127 B1	Nov. 19, 2002

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-4, 7, 8, 10-17, 20-27, 30, 31 and 54-57 over Ranson in view of FR '576, and claims 5, 6, 18, 19, 28 and 29 over Ranson in view of FR '576 and Bilbie.

OPINION

The rejection over Ranson in view of FR '576 is affirmed as to claims 11-17, 20-23, 54 and 56, and reversed as to claims 1-4, 7, 8, 10, 24-27, 30, 31, 55 and 57. The rejection over Ranson in view of FR '576 and Bilbie is affirmed as to claims 18 and 19, and reversed as to claims 5, 6, 28 and 29.

Rejection over Ranson in view of FR '576

Claims 11-17, 20-23, 54 and 56

The Appellant addresses, in combination, only the independent claims among claims 11-17, 20-23, 54 and 56, i.e., claims 11, 54 and 56 (Br. 7-24; Reply Br. 2-9). We therefore limit our discussion of claims 11-17, 20-23, 54 and 56 to the argued limitations in independent claims 11, 54 and 56. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2007).

[1] The Examiner also relies upon US 3,572,767 to Learned (Ans. 7). Because that reference is not included in the statement of a rejection it is not properly before us and, therefore, has not been considered in reaching our decision. *See In re Hoch*, 428 F.2d 1341, 1342 n.3 (CCPA 1970).

Ranson discloses a book cover (54) made using an apparatus comprising "a base portion, an anvil member supported by the base portion and a forming bar, preferably heated, which is movably supported relative to the anvil member" (col. 2, ll. 6-9). "The forming bar is adapted to engage the anvil member whereby the cooperation of the forming bar and the anvil member defines the desired shape of the spine of the book cover" (col. 2, ll. 9-12). That shape is shown in Ranson's figure 6 (col. 5, ll. 38-42). Book cover 54 comprises cover sheet 60 bonded on its inner surface, preferably by adhesive, to support boards 66 and spine strip 68 (col. 4, ll. 39-45, 50-52, 61-63). "The cover sheet can comprise any suitable material such as cloth, buckram or a thermoplastic material including a laminated polyester film material" (col. 4, ll. 26-28), and "[t]he outer surface of cover sheet **60** will generally include printing or artwork to identify the book as desired" (col. 4, ll. 29-31). "The support boards **66** and the foldable spine strip **68** are preferably made of cardboard although other suitable materials could also be utilized" (col. 4, ll. 42-44).

FR '576 discloses, in a first embodiment, a book cover comprising sheet 1 glued over its entire external surface to transparent synthetic material sheet 2 (p. 2, ll. 18-19; fig. 1). In a second embodiment sheet 5 and sheet 6 are placed on opposite sides of cardboard 8, sheet 6 is covered by transparent synthetic material sheet 9, and sheets 5, 6 and 9 are welded together along their edges (p. 2, l. 25 – p. 3, l. 5; fig. 2). In both embodiments the transparent sheet (2 or 9) has, on its interior side, printing that is a mirror image of what is intended to be seen through the transparent sheet from its exterior side (p. 1, ll. 23-26; p. 2, ll. 19-22). Because the

printing is on the inner surface of the transparent sheet, it is sheltered from all friction and it appears with great clarity regardless of the presence of adhesive between transparent sheet 2 and sheet 1, or the tension imperfection of transparent sheet 9 resulting from edge-to-edge weld bonding (p. 2, ll. 3-9, 22-24; p. 3, ll. 4-5).

The Appellant argues that "[w]hile the Ranson reference does not indicate what the material laminated with polyester film is, those in the printing arts will readily comprehend it to be a polyester film laminated with paper, metal film, or ceramic, all of which are completely opaque" (Reply Br. 3-4). The Appellant argues that Ranson's laminated polyester film material must be opaque because the support to which it is applied is ugly, unbleached cardboard (Br. 14; Reply Br. 4).

Ranson does not state that the laminated polyester film material is opaque, the cardboard support boards are ugly or unbleached, or that the support boards must be cardboard. One of ordinary skill in the art who desired to protect Ranson's ink from friction and to provide print clarity by printing on the reverse side of a transparent sheet as taught by FR '576 (p. 2, ll. 3-9, 22-24) would have used, through no more than ordinary creativity, FR '576's transparent synthetic material sheet bonded either to Ranson's cover sheet 60 or to Ranson's support strips 66 and foldable spine strip 68 made of attractive cardboard or, as stated by Ranson, one of the "other suitable materials… as will be appreciated by those skilled in the art" (col. 4, ll. 44-45). *See KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (In making the obviousness determination one "can take account of the

inferences and creative steps that a person of ordinary skill in the art would employ”).

The Appellant argues that if Ranson’s laminated polyester film material were transparent, streaks of adhesive would show through it (Reply Br. 4).

Ranson does not state that the adhesive is applied in streaks (col. 4, ll. 50-52). To avoid the appearance of adhesive streaks argued by the Appellant, one of ordinary skill in the art would have applied the adhesive over the entire support surface as disclosed in FR ‘576 (p. 1, ll. 27-28).

The Appellant argues that one of ordinary skill in the art “might be lead [sic] by the ‘576 reference to add or laminate the Ranson opaque cover with a transparent sheet for the purposes [sic] of protecting the printing ink of the Ranson flatback cover -- but would not replace or substitute the Ranson cover sheet with a transparent sheet, because such modification would completely alter the structural durability, and thus, the principle operational purpose and intended function [of] the Ranson cover” (Br. 15-16).

It appears that what gives Ranson’s book cover the desired similarity to the durability of a hardcover book is the support boards and the shaped spine or channel into which the pages are secured, not the laminated polyester film cover material (col. 2, ll. 30-35). Moreover, the Appellant’s claims 11, 54 and 56 encompass a book cover having a transparent sheet laminated over an opaque cover.

The Appellant argues that there is no teaching or suggestion in Ranson to eliminate the support boards (Br. 16-17).

The Appellant's claims 11, 54 and 56 encompass a book cover having a transparent sheet laminated to support boards.

The Appellant argues that it cannot be assured that Ranson's heated anvil would not scorch, distort or damage the laminated polyester film material, crack the printing ink or cause the printing ink to come loose (Br. 17-18).

The Appellant has not provided evidence that the heating disclosed by Ranson would damage the FR '576 synthetic material sheet. The Appellant has merely provided attorney argument, and such argument cannot take the place of evidence. *See In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). Furthermore, the heating of Ranson's anvil is merely preferred, not required (col. 2, l. 8). Even if some heating were used, one of ordinary skill in the art, through no more than ordinary creativity, would use an amount of heat that is insufficient for damaging the components heated. *See KSR*, 127 S.Ct. at 1741.

The Appellant argues that if Ranson's cover sheet were laminated with the FR '576 transparent sheet, high volume use would cause the transparent sheet to peel away, crack or come loose (Br. 19).

The Appellant's argument is not well taken because it is merely unsupported attorney argument, and arguments of counsel cannot take the place of evidence. *See De Blauwe*, 736 F.2d at 705.

The Appellant argues that because Ranson's printing is merely optional, one would not make the radical modification of laminating the cover sheet with the FR '576 transparent sheet and thereby increase the cost (Br. 22).

Ranson teaches that "[t]he outer surface of cover sheet **60** will generally include printing or artwork to identify the book as desired" (col. 4, ll. 29-31), and that the cost of substituting Ranson's book cover for the standard paperback cover must not exceed the cost of a hardcover version of the book (col. 1, ll. 64-67). The Appellant has not provided evidence that a book having Ranson's cover with the FR '576 transparent sheet bonded to or substituted for Ranson's cover sheet 60 would exceed the cost of a hardcover version of the book. The Appellant has provided mere attorney argument to that effect, and such argument cannot take the place of evidence. *See De Blauwe*, 736 F.2d at 705.

For the above reasons we are not convinced of reversible error in the Examiner's rejection of claims 11-17, 20-23, 54 and 56.

Rejection of claims 18 and 19 over
Ranson in view of FR '576 and Bilbie

Although an additional reference (Bilbie) is applied in the rejection of claims 18 and 19 that depend from claim 11, the Appellant does not separately argue those claims.

For the reasons given above with respect to claim 11, we are not persuaded us of reversible error in the rejection of claims 18 and 19.

Rejections of claims 1-4, 7, 8, 10, 24-27, 30, 31, 55 and 57
over Ranson in view of FR '576, and claims 5, 6, 28 and 29
over Ranson in view of FR '576 and Bilbie

We need to address only the independent claims among claims 1-8, 10, 24-31, 55 and 57, i.e., claims 1, 24, 55 and 57. Claim 1 requires a substantially transparent sheet having "a second, interior surface corresponding to an inside surface of the book cover". Claim 24 requires a rectangular, substantially transparent sheet having "a second planar surface corresponding to the planar interior face of the book cover". Claim 55 requires a substantially transparent sheet having "a second, opposing surface forming the interior surface of the book cover of the bound book". Claim 57 requires a substantially transparent sheet having "a second planar surface corresponding to a planar interior face of the book cover".

Ranson discloses cover sheet 60, the interior surface of which is bonded to support boards 66 and foldable spine strip 68 (col. 4, ll. 61-63). FR '576 discloses transparent synthetic material sheet 2 glued over its interior surface to sheet 1, and discloses transparent synthetic material sheet 9, the interior surface of which covers sheet 6 (p. 2, ll. 18-19, 32-33; figs. 1, 2). Cardboard 8 is placed between sheets 5 and 6, and sheets 5, 6 and 9 are welded together (p. 2, l. 25 – p. 3, l. 4; fig. 2). Thus, in both Ranson and FR '576, the interior surface of a sheet other than the transparent sheet corresponds to the interior surface of the book cover.[2]

The Examiner does not explain how the applied references would have rendered obvious to one of ordinary skill in the art a substantially transparent sheet having a surface corresponding to the interior surface of a book cover.

The Examiner states that "Ranson reference was cited for disclosing a book cover comprising a transparent sheet having an interior surface and an exterior surface wherein indicia can be placed on either the interior or exterior surface of the cover" (Ans. 5).

The Appellant's claims 1, 24, 55 and 57 do not merely require that the transparent sheet has an interior surface and an exterior surface and that indicia are placed on the interior surface of the book cover. Those claims also require that the interior surface of the transparent sheet corresponds to the interior surface of the book cover. Because the Examiner has not explained how the applied references would have rendered that claim requirement prima facie obvious to one of ordinary skill in the art, the Examiner has not established a prima facie case of obviousness of the inventions claimed in the Appellant's claims 1-8, 10, 24-31, 55 and 57.

DECISION

The rejection under 35 U.S.C. § 103 over Ranson in view of FR '576 is reversed as to claims 1-4, 7, 8, 10, 24-27, 30, 31, 55 and 57, and affirmed as to claims 11-17, 20-23, 54 and 56. The rejection under 35 U.S.C. § 103 over Ranson in view of FR '576 and Bilbie is reversed as to claims 5, 6, 28 and 29, and affirmed as to claims 18 and 19.

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[2] The Examiner does not rely upon Bilbie for any disclosure that remedies this deficiency in Ranson and FR '576 (Final Rejection mailed Aug. 25, 2005, p. 5).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

vsh

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