

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BART G. CUDERMAN

Appeal 2007-2606
Application 10/903,376¹
Technology Center 3600

Decided: August 15, 2007

Before TEDDY S. GRON, CAROL A. SPIEGEL, and MARK NAGUMO,
Administrative Patent Judges.

SPIEGEL, *Administrative Patent Judge*.

DECISION ON APPEAL

I. Introduction

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejections of claims 1, 2, 4 and 9 as anticipated under 35

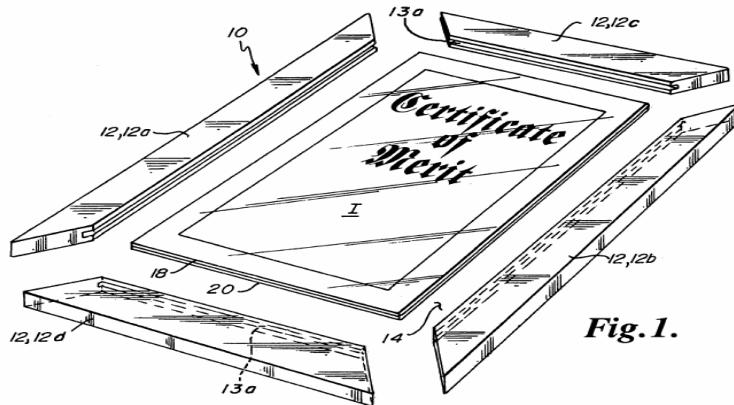
¹ Application 10/903,376 was filed 30 July 2004. The real party-in-interest is said to be Bart G. Cuderman (Amended Appeal Brief, filed August 22, 2006, "Appeal Br.," 2).

U.S.C. § 102(b) and claims 1-8 as obvious under 35 U.S.C. § 103(a). We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

The claimed subject matter relates to a reusable picture frame. Claim 1 is illustrative of the subject matter on appeal and may be understood with reference to the particular embodiment shown in Figure 1:

1. A reusable picture frame [10] for easily and quickly mounting therein a certificate, diploma, license, picture, art piece, or memorabilia, comprising:
 - (a) four frame molding sections [12a-12d] each with two ends, the molding sections joined at their ends for forming a rectangle;
 - (b) an opposing pair of the molding sections having opposing grooves [13a] therein; and
 - (c) a clear flexible sheet [18] adapted to mount the item [I] thereon flexibly pressed into the opposing grooves to secure the item within the picture frame. [Answer² Appendix A, bracketed text added.]

Specification Figure 1 is reproduced below:



² Examiner's Answer ("Answer") mailed November 16, 2006.

{Specification Fig. 1 is said to depict an exploded perspective general assembly view of the claimed invention.}³

The Examiner has relied on the following references as evidence of unpatentability:

Hull	US 1,448,664	Mar. 13, 1923
Wiener	US 3,877,572	Apr. 15, 1975
Wenkman	US 5,075,991	Dec. 31, 1991

Hull, Wiener, and Wenkman qualify as prior art under 35 U.S.C. § 102(b). The Examiner has rejected claims 1, 2, 4, and 9 under 35 U.S.C. § 102(b) as anticipated by Wiener and claims 1-8 under 35 U.S.C. § 103(a) as obvious over Hull in view of either Wiener or Wenkman.

II. Findings of Fact (FF)

The following findings of fact are supported by a preponderance of the evidence of record. To the extent any "finding of fact" is a conclusion of law, it should be so treated.

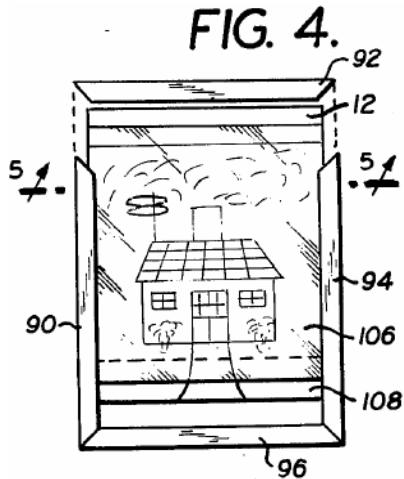
A. Appellant's Specification

- [1] Figure 1 of the Specification appears to depict opposing grooves **13a** as slots within molding sections **12c, 12d**.
- [2] According to the specification, opposing grooves may also be round or convex grooves **13b**, v-notched grooves **13c** or concave grooves **13d** (Specification 5:21-23; Figs. 3-5).

³ The captions in curly braces following the Figures are provided so the publication of this Decision on the USPTO website complies with Section 508 of the U.S. Rehabilitation Act and are *not* part of the Decision.

B. Wiener

- [3] Wiener describes a modular picture frame comprising frame members **90, 92, 94, 96** which are joined together to form a rectangular frame **98** for displaying a picture (Wiener col. 4, ll. 31-36; Figs. 4-8).
- [4] Wiener further describes sandwiching a picture **108** between a flexible backing board **12** and a protective clear flexible plastic sheet **106** (Wiener col. 4, l. 57 to col. 5, l. 1).
- [5] The sandwiched picture assembly **12/108/106** is received into a slot **112** which forms an interior channel in the frame which will completely surround the sandwich picture assembly in the completely assembled frame (Wiener col. 5, ll. 5-14; Figures 4-8).
- [6] Figure 4 is said to depict an exploded embodiment of a picture frame assembly of Wiener and is reproduced below:



{Weiner Figure 4 is said to be an exploded diagrammatic illustration of assembly of a picture frame embodiment according to Wiener.}

- [7] The Examiner found that

Wiener teaches a picture frame for easily and quickly mounting a picture therein comprising: four frames molding sections (90, 92, 94, 96), a

picture 108, a flexible transparent sheet 106, and a backing member 12. The frame sections each have two ends and a slot. The frame sections are joined at their ends for forming a rectangular frame. (See column 4, lines 29-52). [Answer 5, ¶ 3.]

- [8] The Examiner found that claims 1, 2, 4 and 9 are anticipated by Wiener (Answer 5, ¶ 2).
- [9] Appellant argues that the "flexibly pressed ... into the opposing grooves to secure the item within the picture frame" claim language imparts a distinctive structure to the opposing grooves recited in the claimed invention, which distinguishes over the opposing slots disclosed by Wiener (Appeal Br. 4; Reply Br. 2-3).
- [10] In particular, Appellant argues that Wiener discloses sliding flexible sheet **106** into a slot at the top of the frame rather than flexibly pressing it into opposing grooves (Appeal Br. 4; Reply Br. 3).
- [11] Appellant does not otherwise articulate how the opposing slots recited in the claims differ structurally from the opposing slots described by Wiener.

Other findings of fact follow below.

III. Anticipation

Claims 1, 2, 4 and 9 stand rejected under § 102(b) as anticipated by Wiener. Appellant has not argued the separate patentability of claims 1, 2, 4 or 9. Therefore, we decide the issue of anticipation on the basis of claim 1. 37 CFR § 41.37(c)(1)(v).

Anticipation requires disclosure of each and every claim limitation in a single prior art reference, either explicitly or inherently. *MEHL/Biophile Int'l Corp. v. Milgram*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed.

Cir. 1999). Here, we agree with the Examiner that Wiener explicitly discloses each and every limitation of claim 1 (FF 3-8). Appellant contends, but does not explain how, the opposing grooves recited in claim 1 differ structurally from the opposing slots disclosed by Wiener. Indeed, according to Appellant's specification, the claimed opposing grooves may take a variety of shapes (FF 2). Instead, the claim language relied upon by Appellant, i.e., the clear flexible sheet is "flexibly pressed ... into the opposing grooves to secure the item within the picture frame," apparently relates to the recited flexible sheet, specifically to its degree of structural rigidity. Secondly, to the extent the "flexibly pressed" claim language recites a method step, the recited method is a method of using the claimed product that does not distinguish the structure of the claimed product from the prior art, not a method of manufacturing it. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962).

Therefore, based on the foregoing, we will affirm the rejection of claims 1, 2, 4, and 9 under § 102(b) as anticipated by Wiener.

IV. Obviousness

Claims 1-8 stand rejected under § 103(a) as obvious over Hull in view of either Wiener or Wenkman. Appellant has not provided separate patentability arguments for any of claims 2-8 and, therefore, they stand or fall together with claim 1. 37 CFR § 41.37(c)(1)(v). Hence, we decide the issue of obviousness on the basis of claim 1.

A claimed invention is not patentable if its subject matter would have been obvious to a person of ordinary skill in the art. 35 U.S.C. § 103(a); *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d at 1385 (2007); *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966). Facts relevant to a determination of obviousness include: (1) the scope and content of the prior art, (2) any differences between the claimed invention and the prior art, (3) the level of ordinary skill in the art and (4) relevant objective evidence of nonobviousness. *KSR*, 127 S.Ct. at 1734, 82 USPQ2d 1389; *Graham*, 383 U.S. at 17-18. All claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). It is well settled that "anticipation is the epitome of obviousness." *Cornell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983) (quoting *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982)).

A. Rejection based on Hull in view of Wiener

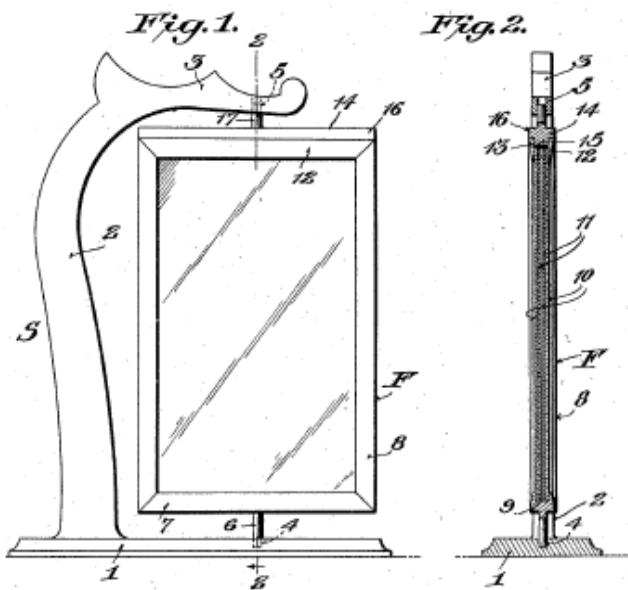
The obviousness rejection of claims 1-8 under § 103(a) is sustained insofar as it is based on the anticipatory disclosure of Wiener for the reasons given above. *Cornell*, 722 F.2d at 1548, 220 USPQ at 198; *Fracalossi*, 681 F.2d at 794, 215 USPQ at 571.

B. Rejection based on Hull in view of Wenkman

1. Hull

- [12] Hull describes a picture frame **F** having a bottom bar **7** and side members **8** which are rabbeted or grooved, as indicated at **9**, to accommodate a transparent element **10** and items, e.g., pictures, etc. (Hull 1:60-68).

- [13] An upper bar **12** is slotted **13** to provide an opening for inserting and removing the items to be displayed (Hull 1:69-73).
- [14] A keeper bar **14** is used to open or lock the items and transparent elements in place (Hull 1:73-76).
- [15] Figures 1 and 2 are said to depict an elevation and vertical sectional view, respectively, of a frame according to Hull and are reproduced below:



{Hull Figure 1 is said to depict an elevation of a preferred embodiment of a display device according to Hull. Hull Figure 2 is said to depict a vertical sectional view of a side of the device shown in Hull Figure 1.}

2. Wenkman

- [16] Wenkman describes a rectangular picture frame **10** having an integral outer margin **24** comprising members **16, 18, 20, 22** and back plate **26** (Wenkman col. 1, ll. 47-49; col. 2, l. 66 - col. 3, l. 4; Fig. 1).
- [17] The front of the frame **10** has four corners **48** that are each slotted **50** to receive a picture or document corner (Wenkman col. 1, ll. 49-51; col. 3, ll. 28-34; Fig. 1).

- [18] A transparent flexible acetate cover sheet **30** fits over the top of the picture or document (Wenkman col. 1, ll. 57-60; col. 3, ll. 46-52; Fig. 1).

3. The Examiner's findings and conclusions

- [19] The Examiner found that Hull disclosed a picture frame comprising (a) four frame molding sections (bottom **7**, sides **8** and top **12**), (b) opposing grooves **9** in opposing sides **8**, and (c) a pair of transparent panels **10** (Answer 6, ¶¶ 9 - 7 and 11; 8, ¶ 16).
- [20] With respect to claim 2, the Examiner expressly found that Hull discloses "each frame section has grooves or slots such that opposite top and bottom frame sections and opposing left and right side frame sections have grooves/slots" (Answer at 9, ¶ 20).
- [21] The Examiner further found that Hull failed to disclose the transparent panels **10** being made of a flexible material (Answer 8, ¶ 11).
- [22] The Examiner found that Wenkman discloses a picture frame having four frame molding sections **16, 18, 20, 22** mounted to form a rectangular frame adapted to receive a flexible transparent sheet **30** and a display sheet (Answer 8, ¶ 17).
- [23] The Examiner concluded that it would have been obvious to one of ordinary skill in the art "to construct the frame taught by Hull with flexible transparent sheets as taught by Wenkman to provide a protective transparent covering that can be easily inserted into the slotted or grooved frame members" (Answer 8-9, ¶ 18).
- [24] In particular, the Examiner stated that "[t]he advantage of using a flexible transparent material is that it is malleable, light weight, and

easier to manipulate to insert into the slot of the frame taught by Hull" (Answer 14-15, ¶ 27).

4. Appellant's arguments

- [25] Appellant argues a lack of motivation to combine Hull and Wenkman because "the ease of inserting a protective transparent covering in Hull would not be made greater by making the transparent covering flexible" (Appeal Br. 6).
- [26] Appellant further argues that the combination of Hull and Wenkman fails to disclose all the elements of claim 2 because Hull does not disclose a second pair of molding sections with opposing grooves therein (Appeal Br. at 6).

5. Discussion

The test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA). "Obviousness is not to be determined on the basis of purpose alone." *In re Graf*, 343 F.2d 774, 777, 145 USPQ 197, 199 (CCPA 1965). However, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

Here, the Examiner has provided a reason for making the combination, which we find credible and which Appellant has not materially challenged, i.e., to provide a protective transparent covering that is malleable, light weight and can be easily inserted into the slotted or grooved frame members (FFs 23 and 24). Instead, Appellant simply contends that

the "ease of inserting a protective transparent covering in Hull would not be greater by making the transparent covering flexible" (Reply Br. 6). First, Appellant's contention does not address the entirety of Examiner's reason for combining Hull and Wenkman. Second, Appellant has provided no evidentiary basis for concluding that the alleged relative ease of inserting a flexible transparent covering in Hull's frame compared to inserting a nonflexible transparent covering results in a structural difference that distinguishes the claimed frame from the prior art in a nonobvious way. Unsupported attorney argument is entitled to little, if any, weight.

As a final matter, we point out that a statement which merely points out what a claim recites is not considered an argument for separate patentability for the claim. 37 CFR § 41(c)(1)(vii). Thus, we do not consider Appellant's statement that "Hull does not disclose (claim 2) a second pair of molding sections with opposing grooves therein" to be an argument for the separate patentability of claim 2 (FF 26; Appeal Br. 6). Nonetheless, we agree with the Examiner's response to Appellant's counterargument (FF 26) that groove **9** in bottom bar **7** and groove **13** in upper bar **12** of Hull correspond to the second opposing grooves in claim 2 (Answer 15). We also note that Appellant did not contest this finding of the Examiner in his Reply Brief.

Therefore, based on the foregoing, we affirm the rejection of claims 1-8 under § 103(a) as obvious over Hull in view of Wenkman.

CONCLUSION

In summary, the decision of the Examiner to reject (i) claims 1, 2, 4 and 9 under 35 U.S.C. § 102(b) as anticipated by Wiener and (ii) claims 1-8

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under 35 U.S.C. § 103(a) as obvious over Hull in view of either Wiener or Wenkman 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

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