

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DEBORAH L. MCCOY and DAVID G. WAGNER

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Appeal No. 2000-1813  
Application No. 08/954,156

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge, STAAB and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's non-final rejection of claims 1 to 20, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a business form (claims 1 to 12) and a mailer type business form (claims 13 to 20). A copy of the claims under appeal is set forth in the appendix to the appellants' brief (Paper No. 8, filed August 5, 1999).

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

Whiteside 27, 1994	5,376,048	Dec.
Greenway 1935	GB 430,801	June 25,

Claims 1 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Whiteside in view of Greenway.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the third Office action (Paper No. 9, mailed October 13, 1999) and the answer (Paper No. 11,

mailed February 11, 2000) for the examiner's complete reasoning in support of the rejection, and to the request for reinstatement of the appeal (Paper No. 10, filed December 27, 1999) and reply brief (Paper No. 12, filed February 28, 2000) 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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 20 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of

obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require a sheet of paper having a first area having security indicia positively imaged in white ink thereon and a second area substantially covered by white ink with security indicia reverse imaged thereon. However, these limitations are not suggested by the applied prior art. The examiner correctly found (third Office action, page 3) that Whiteside does not disclose a sheet of paper having a first area having security indicia positively imaged in white ink thereon and a second area substantially covered

by white ink with security indicia reverse imaged thereon. Additionally, while Greenway does teach a sheet of paper having a first area having security indicia positively imaged in "fugitive water colour ink" thereon and a second area substantially covered by "fugitive water colour ink" with security indicia reverse imaged thereon, Greenway does not teach or suggest using white ink as the "fugitive water colour ink." Thus, the examiner's finding on page 3 of the third Office action that Greenway discloses documents comprising a first area having security indicia positively imaged in **white** ink thereon and a second area substantially covered by **white** ink with security indicia reverse imaged thereon is in error. Accordingly, the examiner's determination (third Office action, page 3) that the claimed invention would have been obvious to an artisan is not supported by any evidence that would have led an artisan to arrive at the claimed invention.

In our view, the only suggestion for modifying Whiteside by the teachings of Greenway to meet the above-noted limitations stems from hindsight knowledge derived from the

appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 to 20.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 20 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH	)	
Senior Administrative Patent Judge	)	
)	)	
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	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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