

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. FREDLUND, JOSEPH A. MANICO,
MAUREEN E. CHURAN-KING, and WILLIAM T. MATTIAS

Appeal No. 2001-0052
Application No. 09/229,216

ON BRIEF

Before THOMAS, KRASS, and BARRY, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claim 2, the only claim on appeal.

The invention pertains to one-time use cameras. In particular, the flash in such a camera has a film identifying

indicia which cannot be removed without destroying the flash.

Claim 2 is reproduced as follows:

2. A one-time-use camera which comprises a filmstrip, and an electronic flash with a concave-shaped flash reflector having a front open end and an inner side, a flash illumination-producing flash tube inside said flash reflector, and a light-transmitting flash cover-lens over said front open end of the flash reflector, is characterized in that:

said flash reflector has integral depressed portions at least some of which are differently shaped than the others to form a readable message of different spatial forms that constitute film identifying indicia visible from outside said camera through said flash cover-lens to identify said filmstrip, which are depressed beginning at said inner side, and all of which are light-reflecting to the same extent as the remainder of said flash reflector in order to reflect flash illumination produced by said flash tube in concert with the remainder of the flash reflector, and

said flash reflector is adhered to said flash tube to prevent said flash reflector from being separated from said flash tube to gain access to said depressed portions at said inner side without breaking said flash tube.

The examiner relies on the following references:

Schmidt	3,484,597	Dec. 16, 1969
English et al. (English)	4,239,369	Dec. 16, 1980
Morisawa	5,651,601	Jul. 29, 1997

"Kodak Fun Saver 35" Camera, Manufacturer Serial Numbers KP 100904, P/N 3B0464, and ST 50.93. June, 1995.

Claim 2 stands rejected under 35 U.S.C. 101 as being

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directed to non-statutory subject matter, viz., printed matter.

Claim 2 stands further rejected under 35 U.S.C. 102(b) as anticipated by English.¹

Claim 2 stands even further rejected under 35 U.S.C. 103 as unpatentable over either one of Morisawa or Schmidt in view of "Kodak Fun Saver 35".

A previous rejection of claim 2 under 35 U.S.C. 112, second paragraph, has been explicitly withdrawn by the examiner in the answer (page 3).

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

We REVERSE.

¹Rejections under 35 U.S.C. 102(b) based on either Blinow or Van Allen have apparently been withdrawn since they have not been repeated in the answer.

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We turn, first, to the rejection of claim 2 under 35 U.S.C. 101.

The examiner's rationale, in toto, is that "[t]he only subject matter which applicant regards as new and seeks to patent, 'film identifying indicia' on a well known 'flash reflector,' is deemed to be printed matter which 'is rejected as not being within the statutory classes.' See M.P.E.P. 706.03."

The examiner's rejection is clearly misplaced since two of the statutory classes of invention under 35 U.S.C. 101 are machines and articles of manufacture. The instant claim is directed to a "one-time-use camera..." which is clearly a machine and/or an article of manufacture. Thus, we will reverse the rejection of claim 2 under 35 U.S.C. 101 as being directed to non-statutory subject matter.

It appears that the examiner's rejection is based on "printed matter." However, the examiner's rationale dissects the alleged printed matter from the remainder of the claimed subject matter and holds that since the printed matter belongs to a non-statutory class of invention, then so too must the claimed subject matter. Such a rationale is contrary to law.

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By looking at the differences between the instant claimed subject matter and the prior art, the examiner may actually be basing the rejection on 35 U.S.C. 103. To the extent that this may be the case, it is clear that the differences between an invention and the prior art cited against it (in this case, a "well known flash reflector") cannot be ignored merely because those differences reside in the content of the printed matter. Thus, one cannot dissect a claim, excise the printed matter (in this case, the "film identifying indicia") from it, and declare the remaining portion of the mutilated claim to be unpatentable. In re Gulack, 217 USPQ 401, 403 (Fed. Cir. 1983). The claim must be read as a whole.

In this case, reading the claim as a whole discloses that the claim is directed to a one-time-use camera which comprises, inter alia, a filmstrip and an electronic flash with a flash reflector wherein the flash reflector is further defined as having certain depressed portions to form a readable message that constitutes film identifying indicia.

Now, if the printed matter, i.e., film identifying indicia, is not functionally related to the substrate, it is true that the printed matter will not distinguish the

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invention from the prior art in terms of patentability. Gulack, 217 USPQ 401, at 404. However, in the instant case, it is very clear that the film identifying indicia is functionally related to the flash reflector on which it resides. The "film identifying indicia," which is the printed matter to which the examiner refers, is so functionally related to the other claimed elements that such indicia is formed by "integral depressed portions" of the flash reflector such that the indicia is visible from outside the camera and such that access to said film identifying indicia cannot be had without breaking the flash tube to which the flash reflector is adhered. Because the film identifying indicia, or "printed matter," in this case is so functionally intertwined with the flash reflector of the camera, by being formed of "integral depressed portions at least some of which are differently shaped than the others to form a readable message of different spatial forms," visible from outside the camera and being "light-reflecting to the same extent as the remainder of said flash reflector in order to reflect flash illumination produced by said flash tube in concert with the remainder of the flash reflector," and wherein the flash

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reflector is adhered to said flash tube to "prevent said flash reflector from being separated from said flash tube to gain access to said depressed portions at said inner side without breaking said flash tube," we find no reason for ignoring the "printed matter" in this case or for casting the instant claimed subject matter into the netherworld of non-statutory subject matter.

Regarding the rejection of claim 2 under 35 U.S.C. 102(b) as anticipated by English, we also will not sustain this rejection. We agree with appellants that the concave groove members 47 of English do not meet the specific claim language of depressed portions being "differently shaped than the others to form a readable message of different spatial forms that constitute film identifying indicia." While the grooves 47 of English may, indeed, be of different sizes, they are not of different "shapes," as required by instant claim 2. Moreover, the diffusing region formed by these grooves 47 of English clearly do not "form a readable message" and certainly do not identify any particular film, i.e., the grooves do not constitute "film identifying indicia."

Since each and every claim limitation is not disclosed by

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English, the rejection of claim 2 under 35 U.S.C. 102(b) is reversed.

Finally, we turn to the rejection of claim 2 under 35 U.S.C. 103.

The examiner contends that the instant claimed subject matter would have been obvious over either one of Morisawa or Schmidt, either one allegedly disclosing the claimed subject matter but for "film identifying indicia visible from outside [the] said camera through [the] flash cover-lens" in the form of "integral depressed portions" of the flash reflector, over the Kodak Fun Saver 35 camera, alleged to provide for the deficiencies of the two primary references.

Appellants present no arguments disputing the teachings of either Morisawa or Schmidt. Instead, appellants focus on the Kodak Fun Saver 35 camera. They contend that any number portions on the body of the Kodak Fun Saver 35 camera are not "light-reflecting," as required by claim 2, since these number portions must be black-colored, like the body. Appellants also state that they believe these number portions to be "raised" rather than "depressed," as claimed. Appellants

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state that the examiner has not specifically identified what, in the Kodak Fun Saver 35 camera reference, is considered to be the "depressed portions which identify [the] filmstrip" [brief-page 5].

We have reviewed the Kodak Fun Saver 35 camera reference and we agree with appellants that it is not clear from the reference what would constitute the claimed "integral depressed portions...that constitute film identifying indicia..."

The examiner takes the position that "irrespective of whether the body is 'light-reflecting,' the reference clearly teaches...' integral [ly formed] depressed portions' on the body of the camera." However, the claim calls for these depressed portions to be on the flash reflector, not the "body" of the camera so it is very relevant, in accordance with the instant

claim language, as to where, exactly, the depressed portions are located.

The examiner also contends that the integral depressed portions of the Kodak Fun Saver 35 camera do identify the

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filmstrip contained in the camera because the Kodak tradename is imprinted on 4 of the 6 sides of the camera and that the Kodak name imprinted on at least the front of the camera are "depressed portions" which are "light-reflecting to the same extent as the remainder of" the camera body. The examiner appears to be referring to imprinting located on the cardboard surrounding the body of the camera, but, in any event, it would be pure speculation to find that the Kodak name is a "depressed portion" of the body, or the cardboard, since the reference is not clear on this matter. Moreover, inter alia, even if the Kodak name was a depressed portion of the camera body or cardboard cover, this does not provide for the claim limitation of having the depressed portions on the flash reflector, as claimed.

Since the examiner's case depends on speculation, at best, anent the disclosure of the Kodak Fun Saver 35 camera reference, we will not sustain the rejection of claim 2 under 35 U.S.C. 103.

Since we have not sustained the rejection of claim 2

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under

35 U.S.C. 101, 102(b) or 103, the examiner's decision is
reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
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ERROL A. KRASS)BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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LANCE LEONARD BARRY)
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