

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte EDWARD A. JANOUSEK

Appeal No. 2001-2199
Application No. 08/754,462

ON BRIEF

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 18, 19 and 21 to 37, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to packaging for fiber glass rovings (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

PPG Industries, Inc. Packing Specification No. 972.0 & 972.1; Nov. 19, 1992 & Dec. 3, 1992 (PPG '972)

PPG Industries, Inc. Packing Specification No. 913.0 and five photos; Sept. 2, 1993 (PPG '913)

French Patent No. 2,446,238; Aug. 8, 1980¹ (French '238)

Claims 18, 19, 21 to 30 and 33 to 37 stand rejected under 35 U.S.C. § 103 as being unpatentable over PPG '913 in view of French '238.

Claims 31 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over PPG '913 in view of French '238 as applied to claim 18, and further in view of PPG '972.

¹ In determining the teachings of this reference, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellant's convenience.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 41, mailed March 26, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 40, filed January 25, 2001) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the declaration under 37 CFR § 1.131 of Edward A. Janousek² (the Janousek declaration) and to the respective positions articulated by the appellant and the examiner. Upon evaluation of the Janousek declaration, it is our conclusion that the Janousek declaration establishes a reduction to practice prior to the effective date of PPG '913 (i.e., September 2, 1993). Accordingly, we will not sustain the examiner's rejection of claims 18, 19 and 21 to 37 under 35 U.S.C. § 103. Our reasoning for this determination follows.

The Janousek declaration in paragraphs 3 to 10 sets forth the evidence relied upon to establish a reduction to practice of the claimed invention in the United States prior to the effective date of PPG '913 (i.e., September 2, 1993). Page 4 of the Certaineed

² Filed August 16, 1999, Paper No. 28.

Corporation Invention Disclosure (Attachment A of the Janousek declaration) sets forth most of the details of the claimed invention.³ Pages 5 and 6 of the Certainfeed Corporation Invention Disclosure contain copies of seven photographs showing a completed package assembly.⁴ Page 4 of the Certainfeed Corporation Invention Disclosure sets forth that the invention has been tested and that three pallets (i.e., package assemblies) were sent to PAC-FAB. Lastly, paragraph 10 of the Janousek declaration states that the reduction to practice occurred in the United States. From this evidence, it is our view that the Janousek declaration establishes a reduction to practice of the claimed invention in the United States prior to the effective date of PPG '913 (i.e., September 2, 1993).

The examiner considered the Janousek declaration to be ineffective for two reasons (answer, pp. 3-4). The first reason was because PPG '913 was "successfully tested in July 1993 by Paul E. Sowa from SIGNODE PACKAGING SYSTEMS (see the report)."⁵ However, the rejections under 35 U.S.C. § 103 are based on the PPG '913 reference which is dated September 2, 1993, not the report from Paul E. Sowa or the

³ This page does not appear to include the claimed securing means.

⁴ These photographs appear to include the claimed securing means.

⁵ The report was cited by the examiner on page 2 of the Notice of References Cited in Paper No. 25, mailed March 16, 1999.

testing done July 1993. As such, the date for a 37 CFR § 1.131 declaration to overcome is September 2, 1993. The second reason was that the seven photographs on pages 5 and 6 of the Certainited Corporation Invention Disclosure were "so vague that it in no way appears to lead one to conclude that one in possession of the drawing [the seven photographs] prior to the reference date was in possession of all of the subject matter of the claims." However, the examiner did not identify any specific claim limitation that would not be apparent from the seven photographs. Moreover, it is our view that when all the evidence contained in the Janousek declaration is considered, the Janousek declaration is sufficient to establish a reduction to practice of the claimed invention in the United States prior to the effective date of PPG '913 (i.e., September 2, 1993) for the reasons set forth above.

Since the Janousek declaration establishes a reduction to practice of the claimed invention in the United States prior to the effective date of PPG '913 (i.e., September 2, 1993), PPG '913 is not available as prior art in a rejection under 35 U.S.C. § 103. Since all of the rejections before us in this appeal rely upon PPG '913, we reverse the decision of the examiner to reject claims 18, 19 and 21 to 37 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 18, 19 and 21 to 37 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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DUANE MORRIS, LLP
ATTN: WILLIAM H. MURRAY
ONE LIBERTY PLACE
1650 MARKET STREET
PHILADELPHIA, PA 19103-7396

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