

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte DONALD R. CRAWFORD

Appeal No. 2003-0790
Application No. 09/138,063

ON BRIEF

Before ABRAMS, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1-14, 21, 22 and 35-41, which are all of the claims pending in this application.

We REVERSE AND REMAND.

BACKGROUND

The appellant's invention relates to a kit for making small disposable signs (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

| | | |
|--------------------------|-----------|---------------|
| Levy | 3,686,783 | Aug. 29, 1972 |
| Bishopp et al. (Bishopp) | 4,090,464 | May 23, 1978 |
| Hoebel | 4,947,566 | Aug. 14, 1990 |

The following rejections are before us for review.

Claims 14 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoebel.

Claims 1, 2, 4, 5, 7-13, 21, 22, 35, 36 and 38-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoebel in view of Bishopp.

Claims 3 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoebel in view of Bishopp and Levy.

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. 21) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 20) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claims 14 and 37

Claim 14 reads as follows:

A sign kit, comprising:

a stiff backing;

a sheet of paper suitable for printing with a computer printer, which sheet of paper is lined on a rear face thereof with an adhesive suitable for attaching the paper to the backing and has a glossy finish on a front face thereof, which front is also suited for receiving printed images from a computer printer; and

means for mounting a sign.

Hoebel, the sole reference relied upon by the examiner in rejecting claims 14 and 37, discloses a photograph mailing unit comprising a rigid panel 12 or 112 having an adhesive coating 14 or 114 on a front face thereof and a releasable backing material 16 or 116. According to Hoebel (column 1, lines 8-9), Hoebel's invention "relates in general to a unit to which a photograph can be affixed." Hoebel (column 3, lines 13-43) teaches that:

To utilize the unit 10, the backing sheet 16 is initially removed from the unit 10. The backing sheet 16 is simply

peeled from the adhesive coating 14 by separating a corner of the sheet 16 from the coating 14 and pulling the corner there across. The photograph is then centered over the panel 12 and placed in contact with the adhesive coating 14 so that the photograph suitably adheres to the unit 10. The panel side 20 is then addressed and stamped for mailing. Of course, an optional message can be applied to the panel region indicated 24.

If, after receiving the mounted photograph, the addressee desires to display it, he can either frame the photograph and unit 10 within the suitable frame or convert the unit panel 10 to an easel. . . .

An embodiment of the method of this invention includes the steps of constructing the unit 10. The relatively rigid panel 12, a suitable adhesive, and the releasable backing sheet 16 are initially provided. The adhesive is then layered over the panel marginal portion 32. The releasable backing sheet 16 is then substantially centered with the panel side 22 and placed into contact with the adhesive coating 14. The backing sheet 16 is thereby positioned in such relationship with the panel 22 that its boundary edges are substantially even with those of the panel 22.

The examiner concedes that the photograph, which the examiner apparently considers to be a sheet suitable for printing with a computer printer and having a glossy front face as recited in claim 14, lacks an adhesive lined on a rear face thereof as also called for in the claim. The examiner simply dismisses this difference as “an equivalent alternative to placing the adhesive on the front of the backing material” (answer, page 3) or “a mere reversal of the essential working parts of a device [involving] only routine skill in the art” (answer, page 6).

Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In

re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). Further, rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In this instance, the examiner has supplied no evidence that the placement of an adhesive layer on the rear of the photograph is an alternate equivalent to the placement of an adhesive layer on the rigid panel 14 or 114 of Hoebel. While it appears that the use of adhesive on the rear of the photograph would work as well as the placement of the adhesive on the front face of the rigid panel for mounting of the photograph on the backing panel, it is not apparent to us why one of ordinary skill in the art would resort to such an arrangement when the placement of the adhesive on the front face of the rigid panel, rather than on the sheet (photograph) which must be processed, whether by traditional photograph processing or passage through a computer printer, appears to be

the simpler arrangement. We thus conclude that the examiner's rejection stems from impermissible hindsight reconstruction and are therefore constrained to reverse it.

Claims 1, 2, 4, 5, 7-13, 21, 22, 35, 36 and 38-41

The examiner's rejection relies in part on the examiner's determination that it would have been obvious, in view of the teachings of Bishopp, to provide a transparent cover sheet on the unit of Hoebel so as to prevent defacing of the display sheet (answer, page 4). Appellant (brief, page 9) argues, *inter alia*, that the examiner has not established a proper basis for combining Hoebel and Bishopp and, in particular, there is no suggestion in Hoebel that the photograph, once mounted, needs the further protection of a plastic cover sheet.

Bishopp's invention relates to protective sign shields (column 1, line 4). Bishopp teaches that vandalism of street signs, particularly with spray paint cans, has become a very difficult problem and discloses clear plastic or vinyl vandal guard sheets 10 coated entirely on one side with a clear adhesive 11. The sheets are made in a same size and shape of the sign they are designed to protect so that scrawling by vandals defaces the sheet instead of the sign face, so that, after the sign information is excessively obliterated, a highway or street sign maintenance crew can quickly and easily simply peel off the defaced sheet and replace it with a fresh sheet. Bishopp also teaches additional inclusion of a frame 16 that fits over the sign so as to enclose the edges of the sheet, thereby preventing easy access by vandals to grasp the sheet edge and peel it off. Additionally, Bishopp discloses an embodiment in Figure 6 wherein several

sheets can be installed at one time on a sign panel so that, when the outermost sheet becomes defaced, it can be peeled off by a service person.

Bishopp is directed specifically to solving the problem of vandalism of street signs and provides no teaching or suggestion that photographs mounted on postcard units of the type taught by Hoebel are typically subject to such vandalism. Hoebel, likewise, lacks any recognition that protection of the photographs from defacement is necessary. From our perspective, the only suggestion for modifying Hoebel in the manner proposed by the examiner is found in the luxury of hindsight accorded one who first viewed appellant's disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). We are thus constrained to reverse the examiner's rejection of claims 1, 2, 4, 5, 7-13, 21, 22, 35, 36 and 38-41 as being unpatentable over Hoebel in view of Bishopp.

Claims 3 and 6

The rejection of claims 3 and 6 relies in part on the same combination of Hoebel and Bishopp that we found deficient for the reasons discussed above. In that the teachings of Levy do not remedy this deficiency, it follows that we are also constrained to reverse the examiner's rejection of claims 3 and 6 as being unpatentable over Hoebel in view of Bishopp and Levy.

REMAND TO THE EXAMINER

This application is remanded to the examiner, pursuant to 37 CFR § 1.196(a), to consider whether the subject matter of claim 9 or any of the claims depending therefrom is unpatentable over Bishopp. We note, at the outset, that claim 9 simply recites a kit comprising a plurality of stiff backings, a plurality of transparent cover sheets and a plurality of means for mounting a sign in an upright position.

Bishopp (note Figure 1) discloses two signs (relatively stiff backings) and a transparent vandal guard sheet (transparent cover sheet) for use on each of the signs, each of the vandal guard sheets being coated on one side with a clear adhesive. Additionally, each of the signs is mounted in an upright position on a post having a plurality of mounting holes thereon, presumably for the passage of mounting hardware, such as screws or bolts. The signs, vandal guard sheets and fastening hardware appear to us to be a “kit”¹ as that term is ordinarily understood.²

CONCLUSION

¹ The term “kit” is defined as a set of tools or implements; equipment for some activity, sport, etc.; or a set containing a number of parts to be assembled. Webster’s New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

² While claims directed to a kit of parts to be assembled were found in In re Venezia, 189 USPQ 149 (CCPA 1976), we find nothing in this decision which defines the term “kit” itself as denoting any particular type of association of the enumerated elements of the kit.

To summarize, the decision of the examiner to reject claims 1-14, 21, 22 and 35-41 under 35 U.S.C. § 103 is reversed. The application is remanded to the examiner for the reason discussed above.

REVERSED AND REMANDED

| | | |
|-----------------------------|---|-----------------|
| NEAL E. ABRAMS |) | |
| Administrative Patent Judge |) | |
| |) | |
| |) | |
| |) | |
| |) | BOARD OF PATENT |
| LAWRENCE J. STAAB |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
| |) | |
| |) | |
| |) | |
| JENNIFER D. BAHR |) | |
| Administrative Patent Judge |) | |

JDB/lbg

Appeal No. 2003-0790
Application No. 09/138,063

Page 10

Philip G. Meyers Intellectual Property Law, P.C.
1009 Long Prairie Road, Suite 302
Flower Mound, TX 75022