

L10

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

**MAILED**

MAR 30 1995

PAT.&T.M.OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JOACHIM UTSCH,  
GERHARD UTSCH and  
MANFRED UTSCH

Appeal No. 95-0747  
Application 07/808,768<sup>1</sup>

ON BRIEF

Before STONER, ABRAMS and FRANKFORT, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claim 7, which is the only claim remaining of

<sup>1</sup> Application for patent filed December 17, 1991.

Appeal No. 95-0747  
Application 07/808,768

record in the application. An amendment filed after the final rejection was entered by the examiner, but was not considered to overcome the final rejection.

The appellants' invention is directed to a process for the production of vehicle license plates. The claim on appeal reads as follows:

7. A process for the production of automotive vehicle license plates, comprising unreeling from a coil a continuous length of metal strip, applying to said length of metal strip a colored film that imparts to said strip a series of colored rims, severing said length of strip into individual license plate blanks bordered by said rims and embossing only said rims thereby to produce raised rims about the periphery of each severed blank, subsequently embossing on said blank individual characters identifying a particular automotive vehicle, and applying to said characters a paint of a color contrasting with the background of said characters by applying to said characters a strip bearing said paint and having a width substantially less than the distance between upper and lower said rims of said blank.

#### THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Adams	1,629,944	May 24, 1927
Husted	2,587,325	Feb. 26, 1952
Lawson	4,510,006	Apr. 9, 1985

Appeal No. 95-0747  
Application 07/808,768

#### *THE REJECTION*

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lawson in view of Husted and Adams.

The rejection is explained in the Examiner's Answer.

The opposing viewpoints of the appellants are set forth in the Appeal Brief and the Reply Brief.

#### *OPINION*

According to the appellants, their invention provides an improved process for producing vehicle license plates which includes two stages. In a first stage, which can be done at a remote location, a mass producer of license plates unreels a coil of continuous length license plate metal strip, applies to it a color film that imparts to the strip a continuous series of colored rims, severs the strip into individual license plates blanks bordered by the rims, and then embosses only the rims. At this point the license plate blanks with embossed rims can be sent to the field for the second stage in the manufacture, where the identifying characters are embossed upon the blanks and a

Appeal No. 95-0747  
Application 07/808,768

paint of contrasting color is applied to the embossed characters by means of a strip bearing the paint. This process provides a number of advantages, including easier coloring of the embossed rims and the use of a paint-bearing strip for coloring the subsequently embossed characters which is narrower than the full width of the license plate, thus reducing its cost (Brief, pages 2 and 3).

We understand the claimed process to comprise the following steps:

- (1) Unreeling a continuous length of metal strip from a coil.
- (2) Applying to the strip a colored film that imparts a series of colored rims.
- (3) Severing the length of strip into individual license plate blanks bordered by the rims.
- (4) Embossing only the rims to produce raised rims about the periphery of each severed blank.
- (5) Subsequently embossing on the severed blanks individual characters identifying a particular vehicle.
- (6) Applying to the characters a paint of contrasting color by the use of a strip bearing the paint and having a width substantially less than the distance between the upper and lower rims of the blank.

Appeal No. 95-0747  
Application 07/808,768

This claim stands rejected as being unpatentable over the combined teachings of Lawson, Husted and Adams. We are provided by our reviewing court with the following guidance in our evaluation of a rejection under 35 U.S.C. § 103: 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, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *Cable*

Appeal No. 95-0747  
Application 07/808,768

*Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983); *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The Lawson patent is directed to the manufacture of personalized laminated displays, which include "bicycle license plates with a child's name" (column 2, line 64). Lawson teaches providing to a merchandiser a blank with a pre-printed border, which is then completed at this site by adhesively applying personalized indicia such as names and photographs. The material recited in the reference is "any suitable sheet material" (column 4, line 20), but the examples given all are paper stock. Lawson does not teach printing the borders upon a continuous sheet of material and then severing them into blanks, nor is there mention of embossing any portion of the blank. The final step in the Lawson process is to laminate the blank.

The examiner looks to Husted for a teaching of embossing the rim of a vehicle license plate. In the Husted process, the first step is to stamp out a flat license plate blank, after which a coating is applied to the entire surface.

Appeal No. 95-0747  
Application 07/808,768

The sign characters "with or without a border" then are painted on (column 3, line 60 et seq.) and the entire blank is stamped to provide the small diamond-shaped protuberances over the entire surface. A further stamping operation raises the characters above the protuberances (column 5, lines 27 through 31).

The Adams reference also is directed to the manufacture of license plates, which it teaches making in sheets (Figure 5). After each sheet is painted, characters are embossed therein and the embossed portions painted. The final step is to cut the sheets into individual license plates.

The examiner has pointed out where some of the steps of the claim may individually be found in the three references. However, from our perspective, this case appears to fall into the category about which the court spoke in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), to wit:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" (citations omitted).

Appeal No. 95-0747  
Application 07/808,768

We first note in support of our supposition here that none of the references teach the step of unreeling a continuous length of metal from a coil, much less doing so along with applying a colored film to the strip to impart thereto a series of colored rims. The examiner disposes of the continuous coil step by concluding, without presenting evidence in support, that such is a well-known technique. Be that as it may, the relationship between the continuous coil step, that of applying the colored rims to the continuous coil, and the subsequent embossing of the rims only, to which the appellants have attached much importance, essentially has been ignored by the examiner. This is true also of the claimed width of the paint bearing strip in the last step of the process.

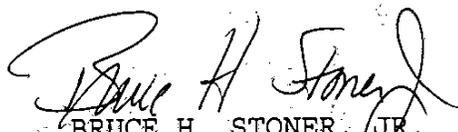
From our perspective, the only suggestion to select particular teachings from each of the three references and then combine them together in the manner proposed by the examiner is found via the hindsight accorded one who first viewed the appellants' disclosure. This, of course, is improper.

It therefore is our conclusion that the teachings of the three references applied against claim 7 fail to establish a *prima facie* case of obviousness with respect to the subject matter recited therein. This being the case, we are constrained not to sustain the rejection.

Appeal No. 95-0747  
Application 07/808,768

The decision of the examiner is reversed.

REVERSED



BRUCE H. STONER, JR. )  
Administrative Patent Judge )



NEAL E. ABRAMS )  
Administrative Patent Judge )

) BOARD OF PATENT  
) APPEALS  
) AND  
) INTERFERENCES



CHARLES E. FRANKFORT )  
Administrative Patent Judge )

Appeal No. 95-0747  
Application 07/808,768

Robert J. Patch  
YOUNG & THOMPSON  
745 South 23rd Street  
Suite 200  
Arlington, VA 22202