

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY D. BERGER

Appeal No. 95-4134
Application 08/099,090¹

ON BRIEF

Before MEISTER, ABRAMS and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 16, all of the claims remaining in the application. Claim 17 has been canceled.

Appellant's invention relates to "inserts for pad holders

¹Application for patent filed July 7, 1993.

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and the like, and in particular to inserts which can be placed in a standard pad holder designed to hold a cardboard-backed pad of paper without interfering with use of the pad and other standard features of the pad holder" (specification, page 1). More specifically, on page 2 of the specification, it is noted that

"[t]here is a need for a pad holder insert which can provide additional storage in a typical pad holder so as to enable the user to store and carry additional items in the pad holder without the need to resort to a portfolio or briefcase. Such an insert should preferably be available in a number of different configurations to hold a variety of different items, such as computer diskettes, a calculator, keys and coins, and so forth. It is desirable that such an insert be easily inserted and that it not interfere with the use of the pad of paper, inside flap pocket, and other standard features of the pad holder. It is also desirable that such an insert be easily removable for those times when it is not needed, or so that it can be replaced with a different insert adapted to hold different items as the user may desire.

Claim 1 is representative of the subject matter on appeal and a copy of that claim may be found in the Appendix to appellant's brief.

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

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Loudon	2,732,842	Jan. 31, 1956
Bisberg	3,913,740	Oct. 21, 1975
Garnier	Des. 241,381	Sep. 07, 1976
Ciarcia et al. (Ciarcia)	4,932,520	Jun. 12,
1990		
Woodruff	5,031,772	Jul. 16, 1991

Claims 1 through 16 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as his invention.

In addition to the foregoing rejection, the appealed claims stand rejected under 35 U.S.C. § 102 and § 103 as follows:

a) claims 1, 3 and 4 under § 102(b) as being anticipated by Bisberg;

b) claims 13 through 16 under § 103 as being unpatentable over Bisberg;

c) claims 1, 2, 11 and 12 as being unpatentable over Garnier in view of Ciarcia;

d) claims 1, 5 through 10 and 13 as being unpatentable

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over Woodruff in view of Ciarcia; and

e) claims 1, 2 and 14 through 16 as being unpatentable over Loudon in view of Ciarcia.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by

the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 9, mailed March 8, 1995) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 8, filed January 30, 1995) and reply brief (Paper No. 11, filed May 1, 1995) for appellant's arguments thereagainst.

OPINION

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

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We turn first to the examiner's rejection of appealed claims 1 through 16 under 35 U.S.C. § 112, second paragraph. After reviewing appellant's specification and independent claim 1 in light thereof, and also in light of appellant's arguments on pages 5 through 8 of the brief, it is our opinion that the scope and content of the subject matter embraced by appellant's claims on appeal is reasonably clear and definite, and fulfills the requirement of 35 U.S.C. § 112, second paragraph, that they provide those who would endeavor, in future enterprise, to

approach the area circumscribed by the claims, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. See, In re Hammack, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). These claims are clearly directed to an insert (e.g., as seen at 10 in Figures 1 and 8 of the application drawings), which insert is, at least in part, defined by having its tongue portion (42) dimensioned so

as to be received in said conventional pad holder's horizontally-oriented slit and by the capability of the insert's holder means to conformably lie between the pad holder's front and back covers when the pad holder is in its closed position (e.g., as seen in Figures 2-6). Thus, the claimed insert is defined by its ability to cooperate with another structure, which other structure is not positively recited in the claim, but is defined in the preamble of the claim and inferentially set forth in the body of the claim. In this regard, we note that there is nothing intrinsically wrong in defining something by what it does rather than by what it is. See, for example, In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981).

In our opinion, the examiner's criticism of appellant's claim 1 goes to the breadth of the claim, which we view as broadly defining the configuration and dimensions of the insert, its tongue and its holder means in terms of their capability of functioning in combination with a conventional pad holder like that set forth in the preamble of appellant's claim 1 and as described in appellant's specification at page

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4. It is well settled, however, that breadth alone is not to be equated with indefiniteness and that in determining whether a claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977). When this standard of evaluation is applied to the language employed in claim 1 on appeal, we are of the opinion that this claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. Given the

foregoing, we will not sustain the examiner's rejection of appellant's claims 1 through 16 under 35 U.S.C. § 112, second paragraph.

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We next look to the examiner's prior art rejections of the appealed claims, turning first to the rejection of claims 1, 3 and 4 under 35 U.S.C. § 102(b) as being anticipated by Bisberg. After a careful assessment of appellant's claims 1, 3 and 4 and of the Bisberg reference, we must agree with appellant that the protective sheet (44a), the partial opaque mask (50) and the full opaque mask (52) pointed to by the examiner in Bisberg are not the same as or equivalent to the "holder means" required in appellant's claim 1 on appeal. In accordance with 35 U.S.C. § 112, sixth paragraph, the "holder means" in appellant's claim 1 is understood to be a structure like that seen, for example, at (50) in appellant's drawing Figures 7 through 14 and equivalents thereof. The one common characteristic that each of the holder means seen in appellant's above-noted drawing figures share is that they include some form of pocket to accommodate, hold and store articles. See file-cut flap pockets (52), zippered pocket (56) and the pockets defined by the slits (54) of Figures 7 and 8; pockets (60, 62 and 64) of Figures 9 and 10; pockets (66, 68)

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of Figures 11 and 12; and pockets (76, 78) of Figures 13 and 14.

Moreover, as indicated in the above-quoted portion of appellant's originally filed specification (page 2), the purpose of the insert of the present invention is to "provide additional storage in a typical pad holder so as to enable the user to store and carry additional items in the pad holder without the need to resort to a portfolio or briefcase." In this regard, it is further indicated on page 2 of the specification, that the insert should be available in a number of different configurations to hold a variety of different items, such as computer diskettes, a calculator, keys and coins, and so forth. Thus, we understand the "holder means" set forth in appellant's independent claim 1 to require some form of pocket or other structure which permits holding, storing and carrying of an item (such as those noted above) in the insert and in the pad holder when such insert is placed therein.

Like appellant, we find no "holder means," as defined above, in those portions of Bisberg's folder pointed to by the

examiner. While it is true that one might place a sheet of paper in between

the protective sheet (44a) and the opaque masks (50b, 52b) of Bisberg, assuming that the folder therein is then used in a pad holder in the manner urged by the examiner, there is no pocket or other structure to hold the paper in the insert as is required in appellant's "holder means" of claim 1 on appeal. Furthermore, while it is certainly possible, as urged by the examiner, to staple or paper clip a sheet of paper to the elements (44a, 50b, 52b) of Bisberg, such extraneous means for holding a paper in place is not part of the structure of the folder in Bisberg, nor of the "holding means" as required in appellant's claim 1 on appeal. Thus, for these reasons, the examiner's rejection of independent claim 1 and dependent claims 3 and 4 under 35 U.S.C. § 102(b) based on Bisberg will not be sustained.²

² With respect to appellant's arguments in the brief and reply brief concerning the issue of non-analogous art in a rejection based on anticipation under 35 U.S.C. § 102(b), we direct appellant's attention to the somewhat more current precedent of the Court of Appeals for the Federal Circuit, the Court

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As for the examiner's rejection of claims 13 through 16 under § 103 as being unpatentable over Bisberg, we note that these claims each ultimately depend from independent claim 1, and

thus include all the limitations thereof. Accordingly, it follows from our determinations above that these dependent claims would not have been obvious to one of ordinary skill in the art based on the teachings of Bisberg alone, since Bisberg has no "holder means" like that required in independent claim 1 on appeal, and certainly no teaching or suggestion of such a "holder means" that also includes a book as set forth in dependent claim 13 and the claims which depend therefrom. Accordingly, we will not sustain the examiner's rejection of dependent claims 13 through 16 under 35 U.S.C. § 103.

We next consider the examiner's rejections under § 103 wherein Garnier, Woodriff and Loudon are the primary

of Customs and Patent Appeals, and the U.S. Claims Court as noted below. See, In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997), Twin Disc, Inc. v. U.S., 231 USPQ 417, 424 (Cl. Ct. 1986); and In re Self, 671 F.2d 1344, 1350, 213 USPQ 1, 7 (CCPA 1982).

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references that are each then combined with Ciarcia. Like appellant, we are of the view that Garnier, Woodriff and Loudon are not properly combinable with Ciarcia in the manner urged by the examiner. In our opinion, the only possible reason that one of ordinary skill in the art would have considered the combination of Garnier, Woodriff or Loudon with Ciarcia as posited by the examiner is based on hindsight derived from appellant's own disclosure and not from any teachings or suggestions found in the applied references themselves. Like appellant (brief, pages 13-20),

absent the disclosure of the present application, we do not consider that one of ordinary skill in the art would have been motivated to modify the combined checkbook wallet and electronic calculator of Garnier, the computer disk housing device of Woodriff, or the binder of Loudon so as to provide these separate and distinct items with a horizontally hinged tongue positioned and related to a vertically-oriented hinged holder means therein in the manner required in appellant's claims on appeal, based on the teachings of Ciarcia. For this reason, the examiner's rejections under 35 U.S.C. § 103

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(identified above as rejections c), d) and e)) will not be sustained.

To summarize our decision, we note that 1) the examiner's rejection of claims 1 through 16 under 35 U.S.C. § 112, second paragraph, has not been sustained, 2) the examiner's rejection of claims 1, 3 and 4 under 35 U.S.C. § 102(b) relying on Bisberg has not been sustained, 3) the rejection of appealed claims 13 through 16 under 35 U.S.C. §103 relying on Bisberg alone has not been sustained, 4) the rejection of claims 1, 2, 11 and 12 under 35 U.S.C. §103 relying on Garnier and Ciarcia has not been sustained, 5) the rejection of claims 1, 5 through 10 and 13 under 35 U.S.C. § 103 based on Woodriff and Ciarcia has not been sustained, and 6) the rejection of claims 1, 2 and 14 through 16 under 35 U.S.C. § 103 relying on Loudon and Ciarcia has also not been sustained.

As should be apparent from the foregoing, the decision of

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the examiner rejecting the claims of the present application
is, accordingly, reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
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CHARLES E. FRANKFORT)	
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