

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD L. WOOD

Appeal No. 96-0405
Application No. 08/178,668¹

HEARD: December 10, 1998

Before CALVERT, COHEN, and STAAB, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 23

¹ Application for patent filed January 7, 1994. According to Appellant this application is a continuation of Application No. 07/975,217, filed November 12, 1992, now U.S. Patent No. 5,293,705, issued March 15, 1994; which is a continuation of Application No. 07/599,488, filed October 18, 1990, now abandoned; which is a continuation-in-part of Application No. 07/188,980, filed May 2, 1988, now U.S. Patent No. 4,794,712, issued January 3, 1989; which is a continuation of Application No. 06/800,663, filed November 22, 1985, now abandoned.

through 25 and 28 through 30, and from the refusal of the

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examiner to allow claims 26 and 27, as amended (Paper No. 19) subsequent to the final rejection. These claims constitute all of the claims remaining in the application.

Appellant's invention pertains to a portable display device. An understanding of the invention can be derived from a reading of exemplary claim 24, a copy of which appears in the "CLAIM APPENDIX" appended to the main brief (Paper No. 17).

As evidence of obviousness, the examiner has applied the documents listed below:

Anderson	2,142,547	Jan. 3, 1939
Kent, Jr.	3,973,341	Aug. 10,
1976		

The following rejection is before us for review.²

² A final rejection of claims 26 and 27 under 35 U.S.C. § 112, second paragraph, set forth on page 3 of the main answer (Paper No. 18), was overcome by an amendment after final, as acknowledged by the examiner on page 1 of the supplemental answer (Paper No. 22). Additionally, the main answer does not carry forward and is silent on the final rejection of claims 23 through 30 under the judicially created doctrine of obviousness-type double patenting. This latter rejection and the earlier filing of a terminal disclaimer (Paper No. 12) are discussed by appellant on page 3 of the main brief (Paper No. 17). Considering the absence of the double patenting rejection from the main answer and the

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Claims 23 through 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Anderson in view of Kent, Jr.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the main and supplemental answers (Paper Nos. 18 and 22), while the complete statement of appellant's argument can be found in the main and reply briefs (Paper Nos. 17 and 21).³

In the main brief (pages 2 and 3), appellant indicates that the rejection of "[c]laims 23, 24, and 26-30" is separately contested from the rejection of "claims 25 and 30." In error, the aforementioned groups each include claim 30, a claim not separately argued. It appears appropriate to consider claim 30 as grouped solely with claim 25, the claim

presence of a "DISCLAIMER LABEL" on the face of the application file, specifying that a terminal disclaimer has been entered and recorded under 35 U.S.C. § 253 in this file, it is apparent that the examiner has withdrawn the obviousness-type double patenting rejection.

³ An appeal brief supplement supplying requested additional information (Paper No. 24) was also submitted by appellant, pursuant to an order for compliance (Paper No. 23).

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from which it depends. In light of the above, and consistent with 37 CFR § 1.196(c)(7), we select claims 23 and 25 for review, with claims 24 and 26 through 29 and claim 30 respectively standing or falling therewith.

OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellant's specification and claims,⁴ the applied patents,⁵ and the respective viewpoints of appellant and the

⁴ Claims 23, 24, 25 and 26 specify a first corrugated "substantially parallel" rigid section. Because we are uncertain as to the meaning of the recitation "substantially parallel" in the context used in the claim, and in light of the underlying disclosure, we introduce a new indefiniteness rejection under 35 U.S.C. § 112, second paragraph, infra. Nevertheless, we understand the claimed subject matter to the extent that we can fairly evaluate the claims on appeal relative to the evidence of obviousness, as applied in the examiner's rejection under 35 U.S.C. § 103.

⁵ In our evaluation of the applied patents, we have considered all of the disclosure thereof for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which

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examiner. As a consequence of our review, we make the determination which follows.

We reverse the examiner's rejection of claims 23 through 30 under 35 U.S.C. § 103.

Claim 23 is drawn to a portable display device for displaying educational or informational material comprising, inter alia, three panels, each side panel separated from the center panel by a score line to permit relative movement between adjacent panels, each score line extends through an inner corrugated portion to form a flexible hinge between adjacent panels along the score lines, the width of each side panel being equal to one-half the width of the center panel to permit folding of the side panels in substantially co-planar relationship relative to each other and in substantial parallel relationship to the center panel to form a substantially flat, rigid, configuration such that adjacent

one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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panels may be folded for storage and transport, whereby the outer rigid surface of the first corrugated section of each panel forms a continuous, uninterrupted display surface.

Claim 25 addresses a portable device for displaying educational or information material comprising, inter alia, three panels including a center panel having side panels hingedly attached to opposite ends thereof, each side panel separated from the center panel by a score line to permit relative movement between adjacent panels, each score line extends through an inner corrugated portion to form a hinge between adjacent panels along the score lines, each side panel and center panel being a single rigid panel member, the width of each side panel being approximately equal to one-half the width of the center panel to permit folding of the side panels in substantially co-planar relationship relative to each other and in substantially parallel relationship to the center panel such that adjacent panels may be folded relative to each other for storage and transport.

The examiner is of the opinion that the subject matter of

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claims 23 and 25 would have been suggested by the combined teachings of Anderson in view of Kent, Jr. For reasons set forth, infra, we do not share the examiner's point of view.

When we set aside what appellant has taught us in the present application, and focus our attention upon the collective teachings of Anderson and Kent, Jr., we fail to perceive any suggestion that would have been derived by one of ordinary skill in the art for making the modification proposed.

The Anderson patent discloses a window display form formed from a single sheet of material, e.g., ordinary corrugated paper board or double corrugated board. As configured, the window display form was intended to be bent and configured into all sorts of positions and forms to give different effects without the necessity of providing a plurality of separate units. As depicted in Figures 2 and 7, for example, the corrugated fiber board is cut scored to cut the corrugations 3 and the outer surface 4, while leaving the inner surface or back surfaces 5 intact. As shown in Figure

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4, the back surface is presented in a more or less smooth condition (page 2, column 1, lines 5 and 6). According to the patentee (page 2, column 1, lines 40 through 46), a "decided advantage" of the material that may be bent to form all manner of columns is that it is "mailable in a flattened condition" and permits the receiver to create his own novel assembly of different units.

It is at once apparent to us that Anderson sought a window display form configured for great versatility to enable the effecting of a flattened condition (Figure 1), a smooth column or niche (Figure 4), a fluted column (Figure 5), and a corrugated back drop (Figure 6), but such that it can be mailable in a flattened condition.

The patent to Kent, Jr. teaches a display device for presenting indicia on one or more surfaces. As explained by the patentee (column 1, lines 51 through 54), with the present invention an integral display device is provided containing means which permits a portion of the device to be folded so as to provide a platform or base by which the major portion of

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the device can selectively be positioned. More specifically, the display device (Figure 1a) includes a line of weakening located approximately 3/4 of the way down from the top edge 6, while an additional line of weakening 3N is located about 3/4 of the way up from edge 7 and functions in a manner similar to line of weakening 3. Based upon the above locations of the lines of weakening, it is apparent that the display device of Kent, Jr. may fairly be said to include a major center section, with the width of minor sections 5,5N being about one-half the width of the center section. The line of weakening 3 above the portion 5 is achieved by scoring the rear and front surface of the device with conventional means (column 3, lines 29 through 32). Integrally mounted in the device (Figures 1a and 1b) and extending for its entire length is a centrally disposed malleable wire member 4 which serves to provide rigidity as well as strength to the device. As further explained in Kent, Jr., the invention may also be employed to display information in a horizontal plane. With portions 5,5N folded, the display device is caused to rest on an edge, whereby 5,5N aid in providing the requisite support for the device.

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This panel of the board does not discern, from a collective evaluation of the disclosures of Anderson and Kent, Jr., that one having ordinary skill in the art would have been motivated, in the absence of appellant's own teachings, to modify the Anderson window display form, as proposed by the examiner. Simply stated, the conversion of the Anderson window display form, as proposed by the examiner, to in effect produce a three panel configuration with relative panel widths as taught by Kent, Jr. would clearly have defeated a primary objective of Anderson, i.e., the provision of a display form which may be bent and configured into all sorts of positions and forms in order to give different effects. Thus, the evidence of obviousness alone would not have been suggestive of the now claimed invention.

Since the applied evidence does not establish a prima facie case of obviousness, we need not address appellant's evidence of nonobviousness.

New Ground of Rejection

Under the authority of 37 CFR § 1.196(b), this panel of

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the board enters the following new ground of rejection.

Claims 23 through 30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 22, line 5; claim 24, line 6; claim 25, line 6; and claim 25 line 6 "substantially parallel" is not understood relative to the "rigid section."

In summary, this panel of the board has reversed the rejection of claims 23 through 30 under 35 U.S.C. § 103 as being unpatentable over Anderson in view of Kent, Jr. Additionally, we have introduced a new ground of rejection.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37

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CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a).

The decision of the examiner is reversed.

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT)
Administrative Patent Judge)
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)
) BOARD OF PATENT)
IRWIN CHARLES COHEN)
Administrative Patent Judge) APPEALS AND)
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LAWRENCE J. STAAB)

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