

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(2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH A. MANICO
and JERRY CARMEN

Appeal No. 1996-2883
Application 08/172,466

ON BRIEF

Before THOMAS, JERRY SMITH and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

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DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-32, which constitute all the claims in the application. In response to the brief on appeal, the examiner withdrew the rejection of claims 4, 5, 15, 16, 19, 25, 26 and 32 [answer, page 2]. Therefore, this appeal is now directed to the rejection of claims 1-3, 6-14, 17, 18, 20-24 and 27-31.

The disclosed invention pertains to a flexible filmstrip holder which can secure filmstrips of a size smaller than the size of the filmstrip for which the holder was originally designed. At least two sheet members are secured together to form a pocket, and the filmstrips can be slid into and out of the pocket.

Representative claim 1 is reproduced as follows:

1. A flexible film holder designed to allow use of a filmstrip of a first size in a printing or scanning apparatus designed to receive filmstrips of a second size greater than said first size, said flexible film holder comprising a first sheet member and a second sheet member designed to be secured

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to said first sheet member and form a pocket therebetween for receiving and holding said filmstrip of a first size, said pocket having an opening through which said filmstrip can be slid into and out of said pocket.

The examiner relies on the following references:

Jones	2,252,632	Aug. 12, 1941
Reyniers	2,487,982	Nov. 15, 1949
Kogane et al. (Kogane)	4,286,869	Sep. 01, 1981
Roberg	4,629,070	Dec. 16, 1986
Kumanomido	4,804,989	Feb. 14, 1989

Claims 1-3, 6-14, 17, 18, 20 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Jones in view of Kumanomido, Roberg or Kogane. Claims 22-24 and 27-31 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Jones in view of Kumanomido, Roberg or Kogane and further in view of Reyniers.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answers for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken

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into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-3, 6, 9-11, 13, 14, 17, 20, 22-24, 27, 30 and 31. We reach the opposite conclusion with respect to claims 7, 8, 12, 18, 21, 28 and 29. Accordingly, we affirm-in-part.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references

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to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

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Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We consider first the rejection with respect to claims 1-3, 6, 9 and 10 which stand or fall together as a group [brief, page 2]. Independent claim 1 will serve as the representative claim for this group. With respect to claim 1, the examiner cites Jones as teaching a film holder designed to adapt to a smaller size film for use in larger scanning apparatus. The examiner cites Kumanomido, Roberg or Kogane as teaching a first and second sheet member forming a transparent pocket therebetween, and a filmstrip which can be slid into or out of the pocket. The examiner also notes several other features of these three secondary references [answer, pages 3-4].

Appellants basically present two arguments in support of the patentability of independent claim 1. First, appellants point to several deficiencies in Jones with respect to the recitations of claim 1. Second, appellants argue that there is no basis for combining the teachings of Jones with

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any of the applied secondary references [brief, pages 3-7]. Although we agree with many of appellants' arguments on the deficiencies of Jones and the lack of combinability of the applied references, we find that the examiner and appellants have failed to properly consider the scope of representative claim 1 and the teachings necessary to suggest the invention of claim 1.

In our view, the preamble of claim 1 in which it is noted what the flexible film holder is designed to do does not place any structural limitation on the film holder. The preamble simply represents a future, possible intended use for the film holder. Instead, claim 1 simply recites that the film holder is comprised of two sheets secured to each other to form a pocket therebetween and having an opening through which said filmstrip can be slid into and out of said pocket. In our view, each of the secondary references, by itself, fully meets the film holder as broadly recited in claim 1. As noted above, whether the film holder is designed to allow use of a filmstrip of a first size in printing or scanning apparatus designed to receive filmstrips of a second size is not a structurally distinguishing limitation of the invention.

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Kumanomido discloses a flexible film holder having an opening for receiving film [see Figure 9]. Roberg also discloses such a film holder [see Figure 3, for example]. Finally, Kogane also discloses such a film holder [see Figures 1 and 5]. It is our view that the film holders disclosed by Kumanomido, Roberg or Kogane are each sufficient to fully meet the film holder of claim 1 because the "designed" limitation adds nothing.

Since the teachings of Jones are unnecessary to meet the invention of claim 1, appellants' arguments regarding the deficiencies of Jones and the lack of motivation to combine the teachings of Jones with either Kumanomido, Roberg or Kogane are not relevant to the scope of invention as set forth in claim 1. Thus, we would sustain the obviousness rejection of claim 1 based on Kumanomido, Roberg or Kogane taken alone. Even though we sustain the examiner's rejection for different reasons than those advanced by the examiner, our position is still based upon the collective teachings of the references and does not constitute a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 267 (CCPA 1961); In re Boyer, 363 F.2d 455, 458 n.2, 150 USPQ 441, 442 n.2 (CCPA

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1966). Therefore, we sustain the rejection of claims 1-3, 6, 9 and 10 which are grouped together. We now consider the rejection with respect to claims 11, 13, 14, 17 and 20 which stand or fall together as a group [brief, page 2]. Independent claim 11 will serve as the representative claim for this group. With respect to claim 11, the examiner basically presents the same rationale we noted above with respect to claim 1. Claim 11 is similar to claim 1 except that it additionally recites a limitation that the pocket has a cross member defining at least one window through which direct exposure of the image on the filmstrip may be provided. Appellants make the same arguments we considered above with respect to claim 1. Appellants also argue that neither Kumanomido, Roberg or Kogane teaches the window of claim 11 [brief, pages 6-7].

For reasons fully discussed above, we do not find Jones necessary to meet the invention of claim 11. We also disagree with appellants that the examiner's secondary references do not suggest the "at least one cross member defining at least one window" of claim 11. Each of

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Kumanomido, Roberg and Kogane forms a window on the pocket by the presence of a cross member perpendicular to the direction of the opening at each end of the pocket to form a single window with the pocket. Since claim 11 only recites "at least one" cross member and window, the single window of the applied secondary references suggests the claimed invention. Therefore, we sustain the rejection of claims 11, 13, 14, 17 and 19 based on either Kumanomido, Roberg or Kogane taken alone.

We now consider the rejection with respect to claims 22-24, 27 and 31 which stand or fall together as a group [brief, page 2]. Independent claim 22 will serve as the representative claim for this group. With respect to claim 22, the examiner basically presents the same rationale we noted above with respect to claim 1. Claim 22 is similar to claim 1 except that it additionally recites a limitation that a third intermediate sheet member is used to form the pocket. The examiner additionally applies the teachings of Reyniers to claim 22 because Reyniers teaches the use of three sheet members to form a film holder. Appellants make the same arguments we considered above with respect to claim 1.

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Appellants also argue that Reyniers is not directed to a film holder designed in the manner recited in claim 22 [brief, pages 7-8].

As we discussed above with respect to claim 1, the "designed" limitation of claim 22 does not add a structural limitation to the film holder of claim 22. Since we agree with the examiner that Reyniers does teach a film holder comprised of three sheet members, we sustain the rejection of claims 22-24, 27 and 31 based on either of Kumanomido, Roberg or Kogane in view of Reyniers.

We now consider dependent claims 7 and 8, which stand or fall together [brief, page 2], dependent claims 12, 18 and 21, which stand or fall together [id.], and dependent claims 28-30, which stand or fall together [id.]. Each of these claims is argued to contain a limitation that the window has a leading edge which has a configuration designed to minimize catching of the leading edge of the filmstrip. We note that claim 30 depends from claim 27 which depends from independent claim 22. None of these claims recites the configuration of the window to minimize catching of the leading edge of the filmstrip. Therefore, claim 30 will stand or fall with claim

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27 which was grouped with independent claim 22. Accordingly, claim 30 falls with claims 22 and 27 from which it depends.

The other dependent claims do recite the feature that the leading edge of the window has a configuration designed to minimize catching of the leading edge of the filmstrip. Appellants argue that none of the references teach or suggest this feature [brief, page 9]. The examiner responds that Kogane, for example, teaches a device which performs this function [answer, pages 5-6]. Although Kogane does teach a feature which prevents the film from being caught upon insertion, the feature in Kogane has nothing to do with the configuration of the leading edge of a window. In other words, Kogane performs the function of these dependent claims but in an entirely different manner from that claimed. In fact, we can find no teaching in either Kumanomido, Roberg or Kogane which suggests the feature of the window as recited in these claims. Therefore, we do not sustain the rejection with respect to claims 7, 8, 12, 18, 21, 28 and 29. In summary, we have sustained the examiner's rejection of claims 1-3, 6, 9-11, 13, 14, 17, 20, 22-24, 27, 30 and 31, but we have not sustained the examiner's rejection with respect to

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claims 7, 8, 12, 18, 21, 28 and 29. Therefore, the decision
of

the examiner rejecting claims 1-3, 6-14, 17, 18, 20-24 and 27-
31 is affirmed-in-part.

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

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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