

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT W. CRUM

Appeal No. 97-4083
Application 08/422,933¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Robert W. Crum originally took this appeal from the final rejection of claims 1 through 23, all of the claims pending in the application. In the main brief (Paper No. 9), the appellant states that “[a]ppel of claims 2 to 6 and 11 to 15 is waived” (page 1).

¹ Application for patent filed April 17, 1995.

Thus, the appeal as to claims 2 through 6 and 11 through 15 is hereby dismissed, leaving for review the standing rejections of claims 1, 7 through 10 and 16 through 23.

The invention relates to the “framed display of artwork, especially via backlighting of translucent artwork” (specification, page 1). Claims 1 and 16 are illustrative and read as follows:

1. Artwork display means for wall-supportable translucent laminar artwork, comprising shallow back-lighting means to underlie and back-light such an artwork, transparent cover means to overlie and protect the artwork supported wall-parallel, and decorative frame means to outline the artwork.

16. Display method for wall-supported artwork, comprising the steps of back-lighting a laminar wall-parallel location for translucent artwork, diffusing light reaching that back-lighted location, locating a laminar translucent artwork at that location, locating an opaque border peripherally about that location, and outlining the artwork with multiple decorative frame means.

The references relied upon by the examiner as evidence of obviousness are:

Lawrence	2,588,545	March 11, 1952
Green	4,850,125	July 25, 1989
Bianchi	4,976,057	Dec. 11, 1990

The claims remaining on appeal stand rejected as follows:

a) claim 9 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention;

b) claims 1, 7, 8 and 16 through 23 under 35 U.S.C. § 103 as being unpatentable over Bianchi in view of Lawrence; and

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c) claims 9 and 10 under 35 U.S.C. § 103 as being unpatentable over Bianchi in view of Lawrence, and further in view of Green.

Reference is made to the appellant's main and reply briefs (Paper Nos. 9 and 11) and to the examiner's answer (Paper No. 10) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

As a preliminary matter, it is noted that the appellant has raised as an issue in this appeal the refusal of the examiner to enter the amendment filed subsequent to final rejection on December 24, 1996 (see, for example, pages 1 through 5, 11 and 12 in the main brief). It is well established, however, that the refusal of an examiner to enter an amendment after final rejection is a matter of discretion which is reviewable by petition to the Commissioner rather than by appeal to this Board. In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). Accordingly, we shall not review or further discuss the examiner's refusal to enter the appellant's amendment.

Turning now to the standing 35 U.S.C. § 112, second paragraph, rejection, the examiner considers claim 9 to be indefinite because "[c]laim 9 recites a decorative frame, however, claim 9 depends from claim 7 which also recites a decorative frame. It is not clear if there are one or two decorative frames in the device" (answer, page 3). The appellant has not specifically disputed the examiner's reasoning that claim 9 is indefinite. Instead, the appellant appears to contend that any problem with the claim is

overcome by the amendment filed subsequent to final rejection (see page 5 in the main brief). As indicated above, however, this amendment has not been entered. In this light, we shall sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claim 9.

We shall not sustain, however, any of the standing 35 U.S.C. § 103 rejections of claims 1, 7 through 10 and 16 through 23.

Bianchi, the examiner's primary reference, discloses a simulated neon sign. The sign includes hollow plastic tubing 10 formed, for example, in the shape of the letters "EAT," an opaque plastic backing sheet 11 having clear areas 12 co-extensive with the tubing, a light diffuser 14, a pair of fluorescent tubes 16 and a housing 18, these elements being arranged and assembled as illustrated in Figures 2 and 3a. As conceded by the examiner, Bianchi's sign does not meet the limitations in independent claims 1 and 21 relating to the transparent means or the limitations in independent claims 1, 16 and 23 relating to the frame/frame means.

Lawrence discloses a display device for illuminated transparencies. The device includes a casing 1, portions 4, 5, 6 and 7 on the front of the casing giving the effect of a picture or mirror frame, feet 15 for supporting the casing on an underlying surface, a clear plate 16 closing the front of the casing, an opaque plate 17 having an opening therein disposed immediately behind the clear plate, a photographic or ornamental

transparency 25 framed by the opening in the opaque plate, and a diffusion plate 27 and electric bulb 29 disposed behind the transparency for illuminating same with back-light.

According to the examiner, it would have been obvious to a person having ordinary skill in the art “to utilize [Lawrence’s] cover plate in the device of Bianchi to protect the display” (answer, page 4) and “to include [Lawrence’s] decorative frame in the device of Bianchi to give the frame a more decorative effect” (answer, page 4).

The appellant’s position that this proposed modification of Bianchi in view of Lawrence is based on impermissible hindsight is persuasive. The disparities between the simulated neon sign disclosed by Bianchi and the photograph/ornamental display disclosed by Lawrence make it evident that the particular modifications of the Bianchi sign proposed by the examiner rest on an improper use of the appellant’s claims as a template to selectively pick and choose from among isolated disclosures in the prior art. Green, the third reference relied upon by the examiner, discloses a picture unit having a transparent plastic frame whose appearance can be altered via the use of mat board inserts. This disclosure does not cure the foregoing fundamental flaw in the basic Bianchi-Lawrence combination.

The following new rejections are entered pursuant to 37 CFR § 1.196(b).

Claims 7 through 10 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Claims 7 through 10 contain various references to an opaque border which are completely lacking in proper antecedent basis. As a result, the scope of these claims is indefinite. Claim 9 is additionally indefinite in that the recitation therein that the larger decorative frame is along the perimeter of the “inner” edge of the opaque border is inconsistent with preceding claim language and the underlying specification which indicate that a different decorative frame is along the perimeter of the inner edge of the border.²

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Lawrence.

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the

² The comment on page 1 of Appendix A to the main brief demonstrates that the appellant already is aware of the above noted inconsistency in claim 9.

reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

In the present case, Lawrence's casing 1 and electric bulb 29 meet the recitation in claim 1 of the shallow back-lighting means, Lawrence's clear plate 16 meets the recitation in claim 1 of the transparent cover means, and Lawrence's frame portions 4, 5, 6 and 7 meet the recitation in claim 1 of the decorative frame means. In addition, although Lawrence's display device is disclosed as being supportable on an underlying surface via feet 15, it is not evident why such device is not inherently capable of being wall supportable in the broad sense set forth in claim 1. Thus, Lawrence discloses, expressly or under principles of inherency, each and every element of the invention recited in claim 1.³

Claim 16, and claims 17, 19 and 20 which depend therefrom, are rejected under 35 U.S.C. § 103 as being unpatentable over Lawrence in view of Green.

Lawrence teaches, or would have suggested, a display method and artwork meeting all of the limitations in these claims except for those relating to the "wall-parallel location" (independent claim 16). Green teaches framed artwork that is conventionally known to be wall mountable for display purposes. It would have been

³ Due to the indefinite scope of claims 7 through 10, which depend from claim 1, the subject matter recited in these claims cannot at this time be evaluated for patentability over the prior art since to do so would require undue speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962).

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obvious to a person having ordinary skill in the art at the time the invention was made to suitably modify the Lawrence display device and support it on a wall as is known to be conventional, thereby arriving at the subject matter recited in claims 16, 17, 19 and 20, in order to expand the display range of the device. In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

In summary:

a) the decision of the examiner to reject claim 9 under 35 U.S.C. § 112, second paragraph, is affirmed;

b) the decision of the examiner to reject claims 1, 7 through 10 and 16 through 23 under 35 U.S.C. § 103 is reversed; and

c) new rejections of claims 1, 7 through 10, 16, 17, 19 and 20 are entered pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains new grounds 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, "A new ground of rejection shall not be considered final for purposes of judicial review."

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Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

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 grounds of rejection to avoid termination of proceedings (37 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. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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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; 37 CFR § 1.196(b)

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Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
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