

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 98-1293
Application No. 08/418,833¹

ON BRIEF

Before COHEN, ABRAMS, and McQUADE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-12, 14, 15 and 17-28, which constitute all of the claims remaining of record in the application.

¹ Application for patent filed April 7, 1995.

The appellants' invention is directed to a system for decorating textile material (claims 1-12 and 23-27) and to a greeting card (claims 14, 15, 17-22 and 28). The claims before us on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

Baxter <i>et al.</i> (Baxter)	5,086,516	Feb. 11, 1992
Saetre	5,102,171	Apr. 7, 1992

THE REJECTIONS

The following rejections stand under 35 U.S.C. § 103:

- (1) Claims 1-12 and 23-27 on the basis of Baxter.
- (2) Claims 14, 15, 17-22 and 28 on the basis of Saetre.²

² We would be remiss if we did not point out that in the first office action (Paper No. 5), the Section 103 rejection based upon Baxter was not explained with sufficient precision to allow one to determine the examiner's rationale, and that the Section 102 rejection based upon Saetre was provided with no explanation at all. These shortcomings were magnified in the final rejection (Paper No. 9), wherein reference merely was made to Paper No. 5 for an explanation of the rejections, even though the Baxter rejection was inadequate in the first instance and even though the Saetre rejection was changed from Section 102 to Section 103 for several of the claims. Continuing down this path, in the Answer the examiner referred to Paper No. 9 for an explanation of both rejections, although none appeared therein. This conduct violates MPEP 1208, which

limits the examiner to referring back to only one document for the explanation of a rejection and requires that the Answer include a clear exposition of the rejection, and MPEP 707.07, which requires that an examiner's action be complete and clear.

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellants as set forth in the Answer and the Brief. Since the rejections are under 35 U.S.C. § 103, we have evaluated them on the basis that the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which 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, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

The Rejection Based Upon Baxter

Independent claims 1 and 26 are directed to a system for decorating textile material. Among the requirements of each is that there be an article of textile material "embellished with an ornamental design." Baxter discloses an article of textile material having on its back surface an outline of hook-and-loop

strips (18) that provides a means for detachably fastening a design or other pictorial representation (24). However, Baxter does not teach that the jacket is first embellished with a design, which is completed or augmented by a portion that later is attached, as in the appellant's invention, as required by claims 1 and 26. In view of this deficiency in Baxter, it is our view that the teachings of the reference do not establish a *prima facie* case of obviousness with regard to the subject matter of claims 1 and 26, and we will not sustain the rejection. It follows that we also will not sustain the rejection of claims 2-12 and 23-25, which depend from claim 1.

Independent claim 27 requires that there be a plurality of patches and that the article of textile material have

a marked area for indicating a plurality of locations for mounting said plurality of patches respectively and wherein said plurality of patches, when mounted on said article of textile material at said plurality of locations, together form at least a portion of an ornamental design.

Baxter discloses only one patch, and therefore explicitly has no such teaching. Moreover, the examiner has not stated, nor can we find, any rationale for concluding that this feature would have been obvious in view of the teachings of Baxter.

The reference thus fails to establish a *prima facie* case of obviousness with respect to the subject matter of Claim 27, and we will not sustain the rejection.

The Rejection Based Upon Saetre

Independent claim 14 is directed to a greeting card having a sticker removably attached to its face. The sticker must be "formed with first and second different adhesives" so that it can be adhered to the card and then removed and adhered to another surface. Like the appellant's invention, Saetre discloses a greeting card having a design that is attached to the face of the card, and can be removed from the card and attached to another surface. However, the Saetre design is on a thin sheet of static cling material so that it is electrostatically adhered to the various surfaces (column 1). This is not an adhesive, in either the commonly used definition of the term³ or in the manner in which it is used in the appellant's specification. The reference fails to teach the use of even a single adhesive, much less the required "first and second different adhesives," and therefore fails to establish a *prima facie* case of obviousness with regard to the subject matter of this claim. We will not sustain the

³ See, for example, Merriam Webster's Collegiate Dictionary, Tenth Edition, 1996, page 14.

rejection of claim 14 or of claims 15 and 17 through 22, which depend therefrom.

Independent claim 28 recites a greeting card having a sticker that includes a first mounting element whereby the sticker is removably mountable on the card and a second mounting element whereby it is mountable at another location. For reasons analogous to those explained immediately above, it is our view that Saetre does not render this language unpatentable either, and we will not sustain the rejection.

REMAND TO THE EXAMINER

Our inspection of the application file reveals that the appellant filed an Information Disclosure Statement (Paper No. 3, including copies of the cited references), which was received in Group 3500 some six months prior to the mailing of the first office action on the merits (Paper No. 5). However, the examiner's initials do not appear at the appropriate points on FORM PTO-1449, which indicates that the examiner apparently

did not consider any of the references that the appellant brought to the PTO's attention.⁴

This application is remanded to the examiner so that the references brought to the attention of the PTO by the appellant can be considered with regard to the pending claims. We note with interest U.S. Patent No. 4,860,387 (Williams), which would appear to be relevant to the claims directed to a system for decorating textile material.

SUMMARY

Neither rejection is sustained.

The decision of the examiner is reversed.

The application is remanded to the examiner for consideration of the references cited by the appellant in the Information Disclosure Statement.

⁴ 37 CFR 1.97(b)(3) provides that the examiner shall consider an information disclosure statement if it is received before the mailing date of a first office action on the merits.

This application, by virtue of its "special" status, requires an immediate action, MPEP 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED and REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

NEA/jlb

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