

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION<sup>8</sup>

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT GISH

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Appeal No. 1999-0931  
Application 08/772,861<sup>1</sup>

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ON BRIEF

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Before CALVERT, COHEN and ABRAMS, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This appeal involves claims 1, 3 through 11, and 13 through 20, all of the claims remaining in the application.

Appellant's invention pertains to an apparatus for sizing

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<sup>1</sup> Application for patent filed December 26, 1996. According to appellant, this application is a continuation of Application 08/450,015, filed May 25, 1995, now abandoned.

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sandpaper from bulk sheets into sander sized-sheets and to a method for sizing sandpaper from bulk sheets into sander-sized sheets. An understanding of the invention can be derived from a reading of exemplary claims 1 and 11, copies of which appear in the Appendix to the supplemental appeal brief (Paper No. 19).

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

|                                     |           |                                   |
|-------------------------------------|-----------|-----------------------------------|
| Freeman                             | 3,172,587 | Mar. 9, 1965                      |
| Fischer et al.<br>1996<br>(Fischer) | 5,511,316 | Apr. 30,<br>(filed Sep. 22, 1994) |

A reference of record in this application, relied upon by this panel of the board in a new ground of rejection, infra, is:

|             |           |               |
|-------------|-----------|---------------|
| Schell, Jr. | 2,642,674 | Jun. 23, 1953 |
|-------------|-----------|---------------|

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The following rejection is before us for review.

Claims 1, 3 through 11, and 13 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Freeman in view of Fischer.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the office action dated May 8, 1998 and the answer (Paper Nos. 18 and 20), while the complete statement of appellant's argument can be found in the supplemental appeal brief (Paper No. 19).

#### 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, the applied patents,<sup>2</sup> and the respective viewpoints of appellant and the

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<sup>2</sup> In our evaluation of the applied teachings, we have considered all of the disclosure of each teaching for what it would have fairly taught one of ordinary skill

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

We are constrained to reverse the rejection on appeal since the evidence does not support a conclusion of obviousness, as further explained, infra.

Claims 1 and 11 (apparatus and method for sizing sandpaper from bulk sheets) each expressly require, inter alia, a substantially flat planar member, and a plurality of indicia formed across and on a surface of the substantially flat planar member including a central portion thereof within a periphery of the member, with the planar member being used for tearing a bulk sheet of sandpaper.

The patent to Freeman addresses a sandpaper tearing guide (Fig. 1) which requires two coacting members, i.e., a cutter

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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 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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block 12 of wood (Fig. 4) slidably movable within a base element 11 (Fig. 2) between two limits of movement determined by the positioning of pins 32 on the cutter block that are movable within slots 22 in the opposite end walls of the base element.

In each of the two positions, sandpaper can be lifted and torn against the serrated edge 25 of the cutter block to obtain a selected size of sandpaper. On the other hand, the Fischer patent teaches a stencil for cutting sandpaper. The stencil 10 (Figs. 1 through 4) is formed from a sheet of plastic material having a planar top surface 12 and a planar bottom surface 14, with corner lips 16, 18, 20, and 22 extending downwardly from the bottom surface forming a recess within which sandpaper sheets 80 to be cut are placed (Figs. 3 and 4). Complete cuts of the sandpaper can be made through slots 60 or 62. Further, primary cuts of the sandpaper can be effected through the series of slots 64 and 66, followed by use of the straight edge 28 placed adjacent these primary cuts so that a cut can be made across the complete sheet of sandpaper.

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It is readily apparent to this panel of the board that appellant and the aforementioned patentees share a common objective, i.e., obtaining particularly sized sheets of sandpaper from larger sheets. However, it is also quite clear to us that appellant's claimed structure to obtain the objective differs from the respective teachings of the applied prior art. Simply stated, we have determined that neither the two component guide of Freeman nor the one piece stencil of Fischer, each considered alone and in combination with one another, teach or would have suggested the apparatus and method now claimed by appellant. When what appellant teaches in the present application is set aside, and the reference teachings alone are collectively considered, it is at once apparent that only reliance upon appellant's own teaching and impermissible hindsight would enable one to achieve the now claimed invention. For these reasons, we are constrained to reverse the examiner's rejection.

NEW GROUND OF REJECTION

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Under the authority of 37 CFR 1.196(b), this panel of the board introduces the following new grounds of rejection.<sup>3</sup>

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Schell, Jr.

Anticipation under 35 U.S.C. 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ

385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an

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<sup>3</sup> While we have been made aware by appellant (supplemental appeal brief, page 7) of a prolonged prosecution history (page 7), we nevertheless, but regrettably, have found it necessary to enter new grounds of rejection.

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appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

A review of the overall teaching of Schell, Jr. reveals to us that the apparatus broadly defined in appellant's claim 1 fairly reads upon the implement disclosed therein. More specifically, it is clear to this panel of the board that the implement of Schell, Jr. may reasonably be said to comprise a substantially flat planar member (plate 10), a handle on a top surface of the planar member (handle 11), a plurality of measuring indicia formed across and on a surface of the planar member including a central portion thereof within the periphery of the member (numerical indicia represented in units of length legends), and at least one edge on the planar member (edges A through F). In our opinion, the implement of Schell, Jr. is capable of being used to size sandpaper from bulk sheets into sander-sized sheets, with the edges of the

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planar member being capable of tearing a portion of a bulk sheet held beneath the planar member into a sander-sized sheet. Based upon this assessment of the Schell, Jr. disclosure, claim 1 is determined to be anticipated thereby.

Claims 3 through 8 are rejected under 35 U.S.C. 103 as being unpatentable over Schell, Jr. in view of Fischer.

In applying the test for obviousness,<sup>4</sup> we reach the conclusion that it would have been obvious to one having ordinary skill in the art, from a combined consideration of Schell, Jr. and Fischer to fabricate the plate 10 of Schell, Jr. from a transparent plastic material. As we see it, the incentive on the part of one having ordinary skill in the art for making this modification would have simply been to obtain the advantage of being able to see the underlying material

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<sup>4</sup> The test for obviousness is what the combined teachings of references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

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being worked on, a known advantage of transparent materials, as recognized by Fischer (column 2, lines 40 through 43). Thus, the content of claims 3 and 4 is seen to be fairly suggested by the combined teachings of the applied references. As to claims 5, 6, and 7, we are of the opinion that an artisan would have found it obvious to selectively provide indicia of some form (printed or integrally molded) on either the top or bottom of a transparent plastic material member. It is also our view that the selection of an appropriate attachment means (adhesive or nuts and bolts, for example) for the handle (claim 8) would have been an obvious matter of ordinary design choice. As to the aforementioned selection and positioning of indicia and the choice of attachment means, and considering the present application (specification, pages 7 and 9), these matters are appropriately viewed as obvious design choices since they have not been disclosed as, in and of themselves, solving any particular problems or yielding any unexpected results.

In summary, this panel of the board has reversed the rejection of claims 1, 3 through 11, and 13 through 20 under

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35 U.S.C. § 103 as being unpatentable over Freeman in view of Fischer.

Additionally, we have introduced new grounds of rejection for claims 1 and 3 through 8.

The decision of the examiner is reversed.

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 (§ 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

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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).

REVERSED  
37 CFR 1.196(b)

IAN A. CALVERT )  
Administrative Patent Judge )  
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)  
) BOARD OF PATENT

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|                             |   |               |
|-----------------------------|---|---------------|
| IRWIN CHARLES COHEN         | ) |               |
| Administrative Patent Judge | ) | APPEALS AND   |
|                             | ) |               |
|                             | ) | INTERFERENCES |
|                             | ) |               |
| NEAL E. ABRAMS              | ) |               |
| Administrative Patent Judge | ) |               |

ICC/kis  
Robert Platt Bell  
ROBERT P. BELL & ASSOCIATES  
917 Duke Street  
Alexandria, VA 22314

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