

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT CAMERON

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Appeal No. 1999-2088  
Application No. 08/782,243<sup>1</sup>

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ON BRIEF

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Before PATE, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3 to 8, 10 to 15 and 17 to 21, which are all of the claims pending in this application.

We REVERSE and REMAND.

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<sup>1</sup> Application for patent filed January 14, 1997.

BACKGROUND

The appellant's invention relates to rectangular-faced enclosures. An understanding of the invention can be derived from a reading of exemplary claims 1, 8 and 15 (the independent claims on appeal), which appear in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Landenberger	941,525	Nov. 30, 1909
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Claims 1, 3 to 8, 10 to 15 and 17 to 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Landenberger.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 5, mailed June 26, 1998) and the answer (Paper No. 12, mailed February 1, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 11,

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filed January 12, 1999) for the appellant's arguments  
thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 3 to 8, 10 to 15 and 17 to 21 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, 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). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references **to arrive at the claimed invention**. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d

1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the final rejection (p. 2), the examiner ascertained with respect to claims 1, 8 and 15 that Landenberger "discloses the invention as claimed except for the pair of right triangular tip portions  $a^2$ ,  $a^3$  being of equal size not more than the size of right triangular tip portions  $a^1$ ,  $a^4$ ." The examiner then determined that

it would have been an obvious matter of design choice to make the right triangular tip portions  $a^2$ ,  $a^3$  being of equal size not more than the size of right triangular tip portions  $a^1$ ,  $a^4$ , since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

It is our finding that the above-noted ascertainment by the examiner that Landenberger "discloses the invention as claimed except for the pair of right triangular tip portions  $a^2$ ,  $a^3$  being of equal size not more than the size of right triangular tip portions  $a^1$ ,  $a^4$ " is incorrect for the reasons that follow.

Initially, it is our opinion that the following relationships are inherent from the disclosure of Landenberger: (1) notches  $a^2$ ,  $a^3$  are of equal size; (2) notches  $a^1$ ,  $a^4$  are of equal size; and (3) notches  $a^2$ ,  $a^3$  are of a size not more than the size of notches  $a^1$ ,  $a^4$ . We reach this conclusion of inherency from the ensuing factors. First, Landenberger teaches that a rectangular envelope is formed from a rectangular sheet of paper. Second, Landenberger teaches the apex of the four triangular flaps  $b^1$ ,  $b^2$ ,  $b^3$  and  $b^4$  is a right angle and the opposite flaps of each pair (i.e., flaps  $b^1$  and  $b^3$  are one pair and flaps  $b^2$  and  $b^4$  are the second pair) being symmetrical and the triangles of one pair (i.e., flaps  $b^1$  and  $b^3$ ) being larger than those of the other pair (i.e., flaps  $b^2$  and  $b^4$ ). Lastly, the appellant admits (brief, pp. 15-16) that

[i]n fact no rectangular sheet can be formed into Landenberger's claimed envelope without sizing the tip portions [sic, notches] exactly as called for by applicant in element (d) of applicant's independent claims, and Landenberger evidently failed to understand this.<sup>[2]</sup>

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<sup>2</sup> We note that the discovery of a mathematic function or relationship does not entitle a person to a patent therefor.

(continued...)

Lastly, it is our opinion that the claimed "first and second pairs of opposed right triangular tip portions" are not readable on the notches a<sup>1</sup>, a<sup>2</sup>, a<sup>3</sup> and a<sup>4</sup> of Landenberger. In that regard, we view the independent claims on appeal as requiring the "first and second pairs of opposed right triangular tip portions" to be part of the rectangular sheet, not notches cut into a rectangular sheet. Additionally, due to the presence of the notches a<sup>1</sup>, a<sup>2</sup>, a<sup>3</sup> and a<sup>4</sup> in Landenberger, it is our determination that elements (a) and (b) of the independent claims are not met by Landenberger. Accordingly, the examiner has not established that it would have been obvious at the time the invention was made to a person having ordinary skill in the art **to have arrived at the claimed invention.**

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<sup>2</sup>(...continued)

Thus, the underlying relationships, such as those expressed in element (d) of appellant's independent claims, reveals relationships that, in our view, have always existed in the envelope of Landenberger and the envelope of the admitted prior art (specification, pp. 1-2) (e.g., U.S. Patent No. 2,021,620 to Weir).

For the reasons set forth above, the decision of the examiner to reject claims 1, 3 to 8, 10 to 15 and 17 to 21 under 35 U.S.C. § 103 is reversed.

#### REMAND

We remand the application to the examiner for his/her consideration of whether any of the claims under appeal are anticipated<sup>3</sup> by either the admitted prior art (specification, pp. 1-2) or U.S. Patent No. 2,021,620 to Weir. Additionally, we remand the application to the examiner for his/her consideration of whether any of the claims under appeal would have been obvious from the teachings of the admitted prior art (specification, pp. 1-2), Landenberger and U.S. Patent No. 2,021,620 to Weir.

#### CONCLUSION

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<sup>3</sup> To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art 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).

To summarize, the decision of the examiner to reject claims 1, 3 to 8, 10 to 15 and 17 to 21 under 35 U.S.C. § 103 is reversed. In addition, we have remanded the application to the examiner for consideration of prior art.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Seventh Edition, July 1998).

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

REVERSED; REMANDED

WILLIAM F. PATE, III	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPLICATION NO. 08/782,243

APJ NASE

APJ McQUADE

APJ PATE

DECISION: **REVERSED & REMANDED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 02 Dec 99

**FINAL TYPED:**