

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH G. JULIAN

Appeal No. 2000-0266
Application No.08/762,973

ON BRIEF

Before HAIRSTON, FLEMING, and LEVY, Administrative Patent Judges.
HAIRSTON, Administrative Patent Judge.

This is an appeal from the final rejection of claims 1 through 20.

The disclosed invention relates to a sanitary guard for covering a telephone handset.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. An article for covering a handset of a telephone, comprising:

a flexible sanitary guard covering for a telephone handset, said covering having a front sheet and a back sheet composed of flexible nonwoven fabric material bonded together to form a pocket covering for receiving said telephone handset,

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(a) wherein said front sheet and said back sheet are bonded together on a left side, a top, and right side by impact bonding to form said pocket covering;

(b) wherein said pocket covering has an insertion point wider than a narrower telephone handset holding zone width;

(c) wherein said pocket covering has a slit on at least one of said sides, said slit extending from said insertion point to said narrower telephone handset holding zone width; and

(d) further comprising printed indicia means on at least said front sheet for indicating the nature of the intended use and instructions for the method of use of said article.

The references relied on by the examiner are:

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| Lo et al. (Lo) | 5,054,063 | Oct. 1, 1991 |
| Vigal (European Patent Application) | 0 484 267 A1 | May 6, 1992 |

Claims 1 through 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vigal in view of Lo.

Reference is made to the briefs (paper numbers 11 and 13) and the answers (paper numbers 12 and 14) for the respective positions of the appellant and the examiner.

OPINION

In view of the examiner's reasoning (answer, pages 4 through 10; supplemental answer, page 2), we will sustain the obviousness rejection of claims 1, 2 and 13 through 15. On the other hand, we will reverse the obviousness rejection of claims 3 through 12 and 16 through 20 because we agree with the appellant's

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arguments (brief, pages 12 through 14; reply brief, page 2) that the applied references neither teach nor would have suggested the specifically claimed fabric material, thickness and weights set forth in these claims.

We agree with the examiner (answer, pages 4 and 5) that Vigal discloses all of the claimed subject matter set forth in claims 1, 2 and 13 through 15 except for the printed indicia. Appellant's contentions to the contrary notwithstanding, we likewise agree with the examiner (answer, page 5) that Lo teaches "printing indicia on the sanitation guard (col. 3, lines 28-35)," and that "it would have been obvious for one skilled in the art to modify '267 with printed indicia as taught by Lo" In response to appellant's arguments (brief, pages 10 and 11), the examiner correctly concluded (answer, pages 8 and 9) that:

[T]he concept here is the design or structure of the sanitary guard, and the use of such guard with the handset. The type of instruction printed on the guard can be varied as long as such printing would not interfere with the operation of the combination of the guard and the handset. This is also stated by Lo, see col. 3, lines 28-35

Appellants reliance (brief, page 11) on In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) is misplaced since a showing has not been made that the indicia is "functionally related" to the claimed sanitary article for a telephone handset.

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Appellant's argument (brief, page 6) that the paper protector disclosed by Vigal is not "flexible" is without merit since Vigal discloses that the paper is folded over onto itself during its manufacture (column 2, lines 20 through 26). No degree of flexibility is set forth in claims 1, 2 and 13 through 15.

Appellant's arguments (brief, page 14; reply brief, page 3) concerning noise are equally without merit because the claims on appeal are silent as to noise.

Appellant's arguments throughout the briefs concerning the individual shortcomings in each of the applied references are without merit because the examiner has relied on the combined teachings of the references to demonstrate the obviousness of the invention set forth in claims 1, 2 and 13 through 15.

In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Thus, the 35 U.S.C. § 103(a) rejection of claims 1, 2 and 13 through 15 is sustained because the examiner did not have to resort to impermissible hindsight to demonstrate the obviousness of these claims (brief, page 10; reply brief, pages 4 through 7).

The 35 U.S.C. § 103(a) rejection of claims 3 through 12 and 16 through 20 is reversed because the examiner has not come to grips with the fact that the applied references neither teach nor would have suggested the claimed subject matter.

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DECISION

The decision of the examiner rejecting claims 1 through 20 under 35 U.S.C. 103(a) is affirmed as to claims 1, 2 and 13 through 15, and is reversed as to claims 3 through 12 and 16 through 20. Accordingly, the decision of the examiner 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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| KENNETH W. HAIRSTON |) | |
| Administrative Patent Judge |) | |
| |) | |
| |) | BOARD OF PATENT |
| MICHAEL R. FLEMING |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
| |) | |
| |) | |
| STUART S. LEVY |) | |
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