

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS F. FRANCIS

Appeal No. 2000-0791
Application No. 08/858,286

ON BRIEF

Before ABRAMS, NASE, and GONZALES, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-13, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a baggage tag. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears 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:

Breen <u>et al.</u> (Breen)	4,817,310	Apr. 4, 1989
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Claims 4, 8, 11 and 13 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1-4 and 9-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Breen.

Claims 5-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Breen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 14) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 13) and Reply Brief (Paper No. 15) 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, the applied prior art reference, the respective positions articulated by the appellant and the examiner, and the guidance provided by our reviewing court. As a consequence of our review, we make the determinations which follow.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

The appellant's inventive baggage tag comprises, *inter alia*, a liner that is described in the specification as being of tear-resistant material "such as VALERON®," which is the trademark of Van Leer Corporation "for a tear resistant material, constructed in such a manner that its fibers are oriented perpendicular to one another to resist tearing" (page 7). Dependent claims 4, 8, 11 and 13 contain the limitation that the liner first recited in the claims from which they depend "is comprised of a tear-resistant material sold under the trademark VALERON®." It is the examiner's position that this renders the claim scope uncertain since a trademark does not identify the goods upon which it is used, but the source of the goods. The appellant argues in response that the use of a trademark in the fashion here used is proper, citing Section 608.01(v) of the Manual of Patent Examining Procedure (MPEP). We find ourselves in agreement with the examiner on this issue, and we therefore will sustain the rejection.

The section of the MPEP referred to by the appellant focuses upon the use of trademarks in the specification; trademark use in claims is not specifically mentioned. The question that arises when a trademark is used in a claim is whether the claim particularly points out and distinctly claims the invention such that those who would approach the area circumscribed by the claim may readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). It is our view that since a trademark does not identify the goods but identifies the source of the goods, and since the formula or the characteristics of the product to which the trademark is applied may be changed from time to time and yet the product may continue to be sold under the same trademark, the use of a trademark as a limitation in a claim obscures the metes and bounds of a claim, causing it to be indefinite.

The Rejection Under 35 U.S.C. § 102(b)

Claims 1-4 and 9-13 stand rejected as being anticipated by Breen. Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Independent claims 1 and 9 each require that both the base ply and the tear-resistant liner have “exposed and underside faces” (emphasis added). We begin our analysis of this issue by pointing out that the common definition of “exposed” is “open to view.”¹ Breen discloses a baggage tag in which the liner (30) clearly has a face that is open to view. However, that is not the case with element designated by the examiner to correspond to the base ply (sheet 20), in which both faces are in engagement with other layers of the tag. Therefore, the base ply does not have an “exposed” face, that is, a face open to view, as is required by these two claims. In fact, Breen appears to be exactly the type of luggage tag over which the appellant believes his invention to be an improvement, in that it has one layer more than the appellant’s tag (see appellant’s Figures 3 and 4 and Breen’s Figure 3).

All of the elements recited in the claim thus are not disclosed in Breen, and the rejection under Section 102 of independent claims 1 and 9 and dependent claims 2-4 and 10-13 cannot be sustained.

The Rejection Under 35 U.S.C. § 103

Claims 5-8 stand rejected under this section of the statute. The test for obviousness is what the combined teachings of the prior art would have suggested to one

¹See, for example, Merriam Webster’s Collegiate Dictionary, Tenth Edition, 1996, page 410.

of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

While the examiner has focused upon the U-shaped cut recited in independent claim 5, this claim also contains the limitation that the first and second plies of material which comprise the luggage tag have “exposed and underside faces.” As we explained above with regard to the section 102 rejection, in the Breen arrangement one of the plies of material does not have an exposed face. Even considering Breen in the light of Section 103, this deficiency is not overcome. Thus, the teachings of Breen fail to establish a prima facie case of obviousness with regard to the subject matter of independent claim 5 and dependent claims 6-8, and we will not sustain this rejection.

SUMMARY

The rejection of claims 4, 8, 11 and 13 under 35 U.S.C. § 112, second paragraph, is sustained.

The rejection of claims 1-4 and 9-13 under 35 U.S.C. § 102(b) as being anticipated by Breen is not sustained.

The rejection of claims 5-8 under 35 U.S.C. § 103 as being unpatentable over Breen is not sustained.

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).

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JOHN F. GONZALES)	
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APPLICATION NO. 08/858,286

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APJ NASE

APJ GONZALES

DECISION: AFFIRMED-IN-PART

Prepared By:

DRAFT TYPED: 03 Jan 02

FINAL TYPED: