

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TERESA L. CARRAWAY

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Appeal No. 2001-0595  
Application No. 09/079,293

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ON BRIEF

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Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 6, all of the claims pending in this application.

As noted on page 1 of appellant's specification, the present invention relates to a method of preparing and

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conveying an intercessory prayer pledge and to a soft sculpture which is utilized in performing the method. Independent claims 1 and 6 are representative of the subject matter on appeal, and a copy of those claims can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Stevens	4,795,397	Jan. 3,
1989		
Friedel '201	5,324,201	Jun. 28,
1994		
Callahan	5,607,337	Mar. 4,
1997		

Claim 6 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, because the examiner finds a lack of antecedent basis for the "said signatures" set forth in the last two clauses of the claim. In addition, the examiner also now urges (answer, page 4) that there is no

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proper antecedent for "said messages" in the last two clauses of claim 6.

Claims 1 through 3, 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Callahan in view of Stevens.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Callahan in view of Stevens as applied to claim 1 above, taken further in view of Friedel '201.

Rather than reiterate the examiner's statement of the above-noted rejections and the conflicting viewpoints advanced by appellant and the examiner regarding those rejections, we refer to the answer (Paper No. 13, mailed August 1, 2000) for the examiner's reasoning in support of the rejections and to the brief (Paper No. 12, filed June 26, 2000) for appellant's views to the contrary.

OPINION

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Our evaluation of the issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art references, and the respective positions advanced by appellant and the examiner. As a consequence of our review, we have made the determination that the evidence relied upon by the examiner is sufficient to support a conclusion of obviousness under 35 U.S.C. § 103 with respect to appellant's claims 1 through 5, but not with respect to method claim 6. We have also concluded that claim 6 on appeal is reasonably definite and thus we will not sustain the examiner's rejection thereof under 35 U.S.C. § 112, second paragraph. Our reasoning for these determinations follows.

We turn first to the examiner's rejection of claim 6 under 35 U.S.C. § 112, second paragraph. After reviewing appellant's specification and the above enumerated claim in light thereof, it is our opinion that the scope and content of the subject matter embraced by appellant's claim 6 is reasonably clear and definite, and fulfills the requirements of 35 U.S.C. § 112, second paragraph. In our view, any

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defects in the language in appellant's claim 6 are of such a minor nature that they do not create confusion or uncertainty which rises to the level of indefiniteness. It is well settled that in determining whether a claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977). When that standard of evaluation is applied to the language employed in claim 6 on appeal, we are of the opinion that the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. Like appellant, we view the recitation in paragraph 2 of claim 6 as providing ample antecedent basis for the recitations of "said messages" and "said signatures" in paragraphs 5 and 6 of the claim.

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Given the foregoing, we will not sustain the examiner's rejection of appellant's claim 6 under 35 U.S.C. § 112, second paragraph.

We next look to the examiner's prior art rejections of the appealed claims under 35 U.S.C. § 103. In regard to the examiner's rejection of claims 1 through 3, 5 and 6 based on Callahan and Stevens, appellant indicates on page 4 of the brief that as to claim 1 on appeal Callahan discloses all recitations with the exception of a relevant preamble relating to providing tangible evidence of intercessory prayers offered on behalf of a recipient and the subject matter of paragraph 4 of the claim relating to the placard. We concur in appellant's evaluation of Callahan. However, we find that we are in agreement with the examiner's position that it would have been obvious to one of ordinary skill in the art in view of the teachings in Stevens to provide the soft sculpture of Callahan with a "placard," e.g., like that seen at (36) of Stevens, where certain pre-printed information relating to the soft sculpture is provided.

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While it is true that the apparatus resulting from the examiner's combination of Callahan and Stevens is not "for providing tangible evidence of intercessory prayers offered on behalf of a recipient" as set forth in the preamble of appellant's claim 1, we view the preamble recitation of claim 1 as being merely directed to the intended use of the apparatus and thus conclude that it is not effective to distinguish appellant's claimed apparatus from the apparatus resulting from the examiner's combination of Callahan and Stevens. See In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974); In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); and In re Sinex, 309 F.2d 488, 493, 135 USPQ 302, 306 (CCPA 1962). Moreover, we observe that, in our view, the apparatus resulting from the combined teachings of Callahan and Stevens structurally corresponds to the apparatus set forth in appellant's claim 1 on appeal and, although not disclosed for the use noted above, has the capability of being used in the manner claimed.

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The only difference between the apparatus in Callahan as modified by Stevens and the apparatus claimed by appellant resides in the arrangement and content of the printed matter that is set forth on the placard. The appropriate test for determining whether such printed matter is entitled to patentable weight is set forth in In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403 (Fed. Cir. 1983), which states at 217 USPQ 404

[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight.

\* \* \*

[w]hat is required is the existence of differences between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.

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In the present case, the mere arrangement and content of the printed matter on the placard does not appear to provide any new and unobvious functional relationship between the printed matter and the placard. The only functional relationship that we see between the above-noted printed matter and the placard of appellant's claimed apparatus is that the placard acts to support or carry the printed matter. This is of course the same relationship that exists between the printed matter and the placard in Callahan as modified by Stevens. The fact that the content or substance of the printed matter placed upon the placard in Callahan as modified may be different than that placed on appellant's placard does not alter the fact that the substrate merely supports the printed matter thereon. Since we discern no new and unobvious functional relationship between the printed matter claimed by appellant and the placard, we are led to the conclusion that such printed matter is not entitled to patentable weight when considered in light of the teachings of the applied prior art. Mere support by the substrate for the printed matter is simply not the kind of functional relationship necessary for patentability. See In re Gulack, supra.

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Since, for the reasons stated above, we decline to accord the preamble of claim 1 on appeal and the printed matter in paragraph four of claim 1 any patentable weight, it follows that we will sustain the examiner's rejection of independent claim 1 under 35 U.S.C. § 103. In accordance with appellant's grouping of the claims (brief, page 3), dependent claims 2 through 5 fall with claim 1.

As for method claim 6, we view this claim in a different light. The method recited is said to provide tangible evidence of intercessory prayers pledges on behalf of a recipient and sets forth steps which clearly accomplish that end result. Like appellant, we see nothing in Callahan or Stevens that relates in any way whatsoever to a method like that claimed by appellant. Moreover, in reviewing the final rejection and examiner's answer, we see no statements or comments from the examiner as to why or how the combined teachings in Callahan and Stevens render obvious appellant's claimed method. Since we have determined that the examiner has not established a *prima facie* case of obviousness

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regarding method claim 6, we are constrained to reverse the examiner's rejection of claim 6 under 35 U.S.C. § 103.

In summary:

The examiner's rejection of claim 6 under 35 U.S.C. § 112, second paragraph, has not been sustained.

The examiner's rejection of claims 1 through 3 and 5 under 35 U.S.C. § 103(a) as being unpatentable over the Callahan and Stevens has been sustained.

The examiner's rejection of method claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Callahan and Stevens has not been sustained.

The examiner's rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Callahan, Stevens and Friedel '201 has been sustained.

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As should be apparent from the foregoing, 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

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES

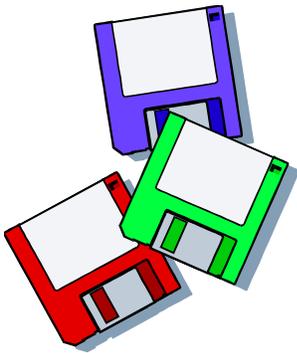
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JEFFREY V. NASE )  
Administrative Patent Judge )

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DECISION: AFFIRMED-IN-PART

Prepared: November 7, 2002

Draft            Final

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PALM / ACTS 2 / BOOK

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