

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(2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MURRAY O. MEETZE

Appeal No. 95-4014
Application 08/128,929¹

ON BRIEF

Before SOFOCLEOUS, WARREN and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 36 through 53.²

We have carefully considered the record before us, and based thereon, find that we cannot sustain any of the grounds of rejection under 35 U.S.C. § 103 maintained on appeal by the

¹ Application for patent filed September 29, 1993. According to appellant, this application is a division of application 07/808,241, filed December 16, 1991, now abandoned.

² See the amendment of September 29, 1993 (Paper No. 2) and the amendment of April 29, 1994 (Paper No. 5).

examiner: claims 36 and 53³ are unpatentable over Doery in view of Ito et al.;⁴ claims 37 through 39 are unpatentable over Doery in view of Ito et al., further in view of Jones and Barber et al.; claims 41 through 51 are unpatentable over Doery in view of Ito et al., further in view of Jones and Barber et al., further in view of Leahy; and claims 40 and 52 are unpatentable over Doery in view of Ito et al., further in view of Jones and Barber et al., further in view of Leahy, further in view of Ojha or Rourke (answer, pages 3-6). It is well settled that the examiner must satisfy his burden of establishing a *prima facie* case of obviousness by showing some objective teaching or suggestion in the applied prior art taken as a whole or that knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention, including each and every limitation of the claims, without recourse to the teachings in appellant's disclosure. See generally *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Fine*, 837 F.2d 1071, 1074-1076, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988).

In the present case, the examiner has failed to make out a *prima facie* case of obviousness as to appealed claims 36 through 53 as a whole since he has not provided evidence and/or scientific reasoning in the record why one of ordinary skill in this art would have modified the method of thermally applying adhesive tape to the spine of a set of sheets in Doery by winding a binder tape completely around a paper bundle as taught by Ito et al. in order to arrive at the claimed methods of organizing multiple print job sets and printed documents of the appealed claims by applying a multiplicity of small thin strips of low-tack adhesive tape "only partially around each of two opposing sides of each of said neatly stacked job set, intermediately thereof, extending over only a minor portion of the dimensions of said job set, so that each said strip wraps around one edge of said stacked job set to removably adhere to only a minor portion of only said top and bottom sheets" as specified by claim 36 and by "applying a selectively removable adhesive tab on opposing side edges of said stacked plural printed documents"

³ See the supplemental examiner's answer (Paper No. 12).

⁴ The references relied on by the examiner with respect to the grounds of rejection are listed at page 3 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

as specified by claim 53. Indeed, the examiner has merely alleged that “[o]ne skilled in the art would have known to fold two small strips on opposite edges of the stacks, to reduce the amount of tape required by the process” without any evidence or scientific reasoning why this would be so. *See In re Horn*, 203 USPQ 969, 971 (CCPA 1979) (“[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness.”). We find nothing in the remaining references which would cure this deficiency in the combination of Doery and Ito et al. which is basic to each of the examiner’s ground of rejection. Accordingly, it is inescapable that the combined references applied by the examiner taken as a whole would not have resulted in the claimed methods. *See In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988); *cf. In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Thus, it is manifest that the only direction to appellant’s claimed invention as a whole on the record before us is supplied by appellant’s own specification.

The examiner’s decision is reversed.

Reversed

MICHAEL SOFOCLEOUS)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

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