

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD SPECTOR

Appeal No. 98-1254
Application No. 08/579,588¹

ON BRIEF

Before McCANDLISH, *Senior Administrative Patent Judge*, MEISTER
and FRANKFORT, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed December 26, 1995.

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Donald Spector (the appellant) appeals from the final rejection of claims 1-15, the only claims present in the application.

We REVERSE.

The appellant's invention pertains to a greeting card having a detachable decal section that is formed therewith as a one-piece construction. The detachable decal section has an image printed in a transferable ink and the remaining section of the card has a message printed thereon in a non-transferable ink. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

Holoubek 1978	4,089,722	May 16,
Feuer 1980	4,200,222	Apr. 29,
Kennedy 1988	WO 88/01419	Feb. 25,

Claims 1-3, 5, 6 and 10-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Feuer in view of Holoubek.

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Claims 4 and 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Feuer in view of Holoubek and Kennedy.

Both of these rejections are bottomed on the examiner's view that:

Feuer discloses the claimed greeting card having a removable decal except that the decal is not printed with a transferable ink. Holoubek teaches a removable decal via perforations being printed with a transfer-able ink. Note that the decal is being transferred from one surface to another surface. It would have been obvious to one of ordinary skill in the art to modify the decal of Feuer to include a transferable ink and perforations as taught by Holoubek in order to transfer the image on the decal to another surface. [Answer, page 3.]

We will not support the examiner's position. It is well settled that it is the teachings of the prior art taken as a whole which must provide the motivation or suggestion to combine the references. ***See Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) and ***Interconnect Planning Corp. v. Feil***, 774 F.2d 1132, 1143, 227 USPQ 543, 550-51 (Fed. Cir. 1985). Here, we find no such suggestion.

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Feuer discloses a greeting card having removable display portion 20 releasably secured thereto by a "light" adhesive 22 so that the removable display portion may be removed from the card and attached to another surface for display purposes. Although Feuer styles the removable display portion as a "decal,"² this term is not used in its normal sense, or in the sense used by the appellant. In reality, Feuer's removable display portion is a sheet having an image such as a fish thereon and a "permanent" adhesive backing 32 which is covered by a removable backing sheet 28. There is no mention in Feuer of either a transferable ink or decalcomania. In an attempt to overcome this deficiency, the examiner relies on the teachings of Holoubek. Holoubek, however, teaches a method of affixing heat transferrable indicia to a fabric surface of a garment such as a T-shirt 37. To this end, Holoubek provides

² According to *Webster's Third New International Dictionary of the English Language, Unabridged*, G. & C. Merriam Co., Springfield, MA, 1971 "decal" is a shortened form of the word -- decalcomania --. "Decalcomania" is further defined therein as -- **1**: the art or process of transferring pictures and designs typically from specially prepared paper to china, glass, or marble and permanently fixing them thereto. **2a**: a picture or design prepared for transfer by decalcomania **b**: a paper on which designs are printed for transfer printing --.

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a carrier sheet containing a plurality of detachable subsections. Each subsection is provided with indicia 3 which may "include various letters and symbols" (column 4, lines 44 and 45). After a desired subsection is removed from the carrier sheet it is placed on the T-shirt and heated with an iron 41 in order to transfer the indica from the subsection to the T-shirt. Absent the appellant's own disclosure we can think of no cogent reason why one of ordinary skill in this art would have been motivated to single out the feature of transferable ink from the disparate teachings of Holoubek and incorporate it into the greeting card of Feuer in the manner proposed by the examiner. In our view, the examiner has impermissibly relied upon the appellant's own teachings in arriving at a conclusion of obviousness. As the court in **Uniroyal**, 837 F.2d at 1051, 5 USPQ2d at 1438 stated "it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

With respect to claims 4 and 7-9, we have carefully reviewed the teachings of Kennedy but find nothing therein

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which would overcome the deficiencies of Feuer and Holoubek
that we have noted above.

The decision of the examiner to reject claims 1-15 under
35 U.S.C. § 103(a) is reversed.

REVERSED

HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CHARLES E. FRANKFORT)	
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