

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JERRY W. PEARCE and J. ROCKLAND PROFFIT

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Appeal No. 98-2034  
Application No. 08/571,276<sup>1</sup>

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ON BRIEF

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Before ABRAMS, STAAB and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 23, which are all of the claims in the application.

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<sup>1</sup> Application for patent filed December 12, 1995.

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We REVERSE.

The appellants' invention relates to a casing board for use as an information and storage device having a substrate formed from a rigid paper material, an opaque intermediate covering affixed to the substrate and a transparent outer layer attached to the substrate with a turned-edge corner. An understanding of the invention can be derived from a reading of exemplary claims 1 and 13 which appear in the "Appendix" to the brief (Paper No. 11).

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Boelema	2,318,192	May 04, 1943
Federbush et al. (Federbush)	2,801,115	Jul. 30, 1957
Bachrach et al. (Bachrach)	5,030,027	Jul. 09, 1991
Acker	5,069,568	Dec. 03, 1991

The following rejections are before us for review:

Claims 1, 8, 11 through 13, 18, 22 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bachrach in view of Federbush;

Claims 2 through 7, 14 through 17, 20 and 21 stand

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rejected under 35 U.S.C. § 103 as being unpatentable over Bachrach in view of Federbush, as applied to claims 1 and 13, and further in view of Acker; and

Claims 9, 10 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bachrach in view of Federbush and Acker, as applied to claims 2 and 14, and further in view of Boelema.

The full text of the examiner's rejections and the responses to the arguments presented by appellants appear in the answer (Paper No. 16), while the complete statement of appellants' arguments can be found in the brief.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

The rejection of claims 1, 8, 11-13, 18, 22 and 23  
under 35 U.S.C. § 103

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In rejecting claims under 35 U.S.C. § 103 the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. Id. If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In order to establish the prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Independent claim 1 is directed to a casing board for use as an information displaying and storage device comprising a generally rectangular rigid paper substrate having inner and outer surfaces, an opaque intermediate covering layer affixed to said substrate and covering at least the outer surface thereof, and a transparent outer layer formed with at least

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three transparent flaps formed along at least three edges thereof and affixed along at least three edges of the board to at least one of the substrate and opaque layer to define a pocket intermediate the transparent and opaque layers. The claim further requires that the transparent flaps be:

folded over onto said opaque covering layer and fixed thereto with end portions of each said transparent flap overlying end portions of adjacent, perpendicularly oriented transparent flaps with a remainder of said transparent flaps being fixed to at least one of said inner surface of said substrate and said opaque covering layer.

Claim 13, in addition to requiring a transparent outer layer formed with at least three transparent flaps secured in the manner quoted above, requires opaque flaps extending along each of the four sides of the opaque layer.

Bachrach discloses a cover for a notebook binder comprising a cardboard substrate [20], an opaque vinyl covering layer [40] heat sealed on all sides and a clear outer sheet [44] heat sealed on three sides, but open on the top edge [46] to form a pocket (col. 2, line 48-65).

Federbush discloses a cover or display panel for a catalog binder having a frame board [37] and an outer cover

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sheet [19, 23, 39] of leather, cloth, paper, buckram or the like. The cover sheet includes edge lapping portions [41] which are adhered to the frame board [37] as shown in Figure 3. See, col. 1, line 71 through col. 2, line 1 and col. 2, lines 53-60.

The examiner admits that Bachrach does not disclose a casing board having a transparent outer layer formed with at least three transparent flaps formed along at least three edges, but takes the position that

[i]t would have been obvious to one of ordinary skill in the art to modify the opaque covering layer and the transparent outer layer to be formed with at least three flaps formed along at least three edges as taught by Federbush et al in order to provide an alternative means to cover the casing board. (Answer, page 3).

Appellants argue (brief, page 6) that Federbush also does not teach the use of any flaps that are overlapping and secured in the specific manner quoted above from claim 1.

We agree. While Federbush arguably shows flaps, as broadly recited in appellants' claims, on an outer cover sheet [19, 23, 39], Federbush's Figure 3 does not show the flaps as overlaying end portions of adjacent, perpendicularly oriented flaps. Rather, Federbush shows the excess material at each

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corner of the frame board bunched and gathered.

Since all the claim limitations would not have been taught or suggested by the combined disclosures of Bachrach and Federbush, it follows that the examiner has not established the prima facie obviousness of the invention set forth in claims 1 and 13. See In re Royka, supra. Accordingly, we cannot support the examiner's rejection of independent claims 1 and 13 under 35 U.S.C. § 103.

Claims 8, 11 and 12, dependent on claim 1, and claims 18, 22 and 23, dependent on claim 13, contain all of the limitations of their respective independent claim. Therefore, we will also not sustain the standing 35 U.S.C. § 103 rejection of these claims.

The 35 U.S.C. § 103 rejections of claims  
2-7, 9, 10, 14-17 and 19-21

Our review of Acker, which is used in combination with Bachrach and Federbush to reject claims 2 through 7, 14 through 17, 20 and 21, and Boelema, which is used in combination with Bachrach, Federbush and Acker to reject claims 9, 10 and 19, reveals that these references fail to

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supply the deficiencies in

the Bachrach-Federbush combination discussed above. Since claims 2 through 7, 9, 10, 14 through 17 and 19 through 21 are dependent on either claim 1 or claim 13 and contain all of the limitations of the claim from which they depend, we will not sustain the standing 35 U.S.C. § 103 rejections of these claims.

In summary, all of the examiner's rejections of claims 1 through 23 are reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
LAWRENCE J. STAAB	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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