

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAN LORBER

Appeal No. 1998-3295
Application No. 08/054,223¹

ON BRIEF

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

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claim 2, as amended subsequent to the final rejection. Claim 2 constitutes the only claim pending in this application.

We REVERSE.

¹ Application for patent filed April 29, 1993.

BACKGROUND

The appellant's invention relates to a combined greeting card and record sleeve. An understanding of the invention can be derived from a reading of claim 2, which appears in the appendix to the appellant's brief.

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

Shore 1969	3,426,960	Feb. 11,
Rappaport 1935	783,277 ² (French)	July 10,

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Shore in view of Rappaport.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

² In determining the teachings of Rappaport, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

rejection, we make reference to the examiner's answer (Paper No. 27, mailed June 9, 1998) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 26, filed March 10, 1998) for the appellant's arguments thereagainst.³

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to claim 2. Accordingly, we will not sustain the examiner's rejection of claim 2 under 35 U.S.C. § 103. Our reasoning for this determination follows.

³ Since the other grounds of rejection set forth in the final rejection (paper No. 13, mailed December 30, 1994) were not set forth in the examiner's answer we assume that these other grounds of rejection have been withdrawn by the examiner. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues (brief, p. 14) that the rejection⁴ of claim 2 is improper since the references (i.e., Shore and Rappaport) fail to suggest a modification of the prior art that "would produce the claimed invention." We agree for the following reasons.

Claim 2 recites in part a **side-fold** greeting card design consisting of a front-sheet and a back-sheet. Claim 2 further

⁴ The rejection of claim 2 is set forth on pages 3-4 of the answer.

recites that a phonographic record-sleeve is incorporated in the front-sheet as a pocket having a **top** opening of sufficient length to receive an audio disc.

The above-noted limitations of claim 2 are not suggested by the combined teachings of the applied prior art. Specifically, both Shore and Rappaport teach the use of a **side-fold** jacket or pouch including a phonographic record-sleeve incorporated therein having a **side** opening of sufficient length to receive an audio disc. Thus, the teachings of Shore and Rappaport, even if combined as proposed by the examiner, would not have resulted in the claimed invention (i.e., a **side-fold** greeting card including a phonographic record-sleeve incorporated therein having a **top** opening of sufficient length to receive an audio disc).

For the reasons stated above, the decision of the examiner to reject claim 2 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 2 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	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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ALAN LORBER
414 EAST 52 ST.
NEW YORK, NY 10022

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APJ NASE

APJ STAAB

APJ ABRAMS

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 26 May 99

FINAL TYPED: