

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY J. STEELEY

Appeal No. 99-0633
Application No. 08/880,247¹

ON BRIEF

Before COHEN, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 through 19, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

¹ Application for patent filed June 23, 1997. According to the appellant, the application is a continuation of Application No. 08/613,505, filed March 11, 1996, now abandoned; which is a continuation-in-part of Application No. 08/337,730, filed November 14, 1994, now U.S. Pat. No. 5,577,403; which is a continuation-in-part of Application No. 29/006,161, filed March 22, 1993, now U.S. Pat. No. Des. 352,600.

The appellant's invention relates to an identification system comprising a plastic housing for holding a key and an insert having identification indicia thereon or for holding coins and an insert having emergency contact information thereon. An understanding of the invention can be derived from a reading of exemplary claims 1, 6 and 12, which appear 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:

Corwin et al. (Corwin)	2,566,118	Aug. 28, 1951
Hines	3,094,799	Jun. 25, 1963
Sawyer et al. (Sawyer)	5,038,590	Aug. 13, 1991
Levine et al. (Levine)	5,113,602	May 19, 1992
Steeley (Steeley '600)	Des. 352,600	Nov. 22, 1994
Steeley (Steeley '403)	5,577,403	Nov. 26, 1996

The following rejections are before us for review.

(1) Claims 1 and 3 through 19 stand rejected under the judicially created doctrine of double patenting over claims 1 through 3 of Steeley '403 since, according to the examiner, the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

(2) Claims 1, 3 through 5, 15 and 16 stand rejected under the judicially created doctrine of obviousness-type double

patenting as being unpatentable over the claim of the design patent Steeley '600 in view of Sawyer, Corwin and Hines.

(3) Claims 1 and 3 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Levine in view of Corwin and Hines.

The complete text of the examiner's rejections and response to the argument presented by the appellant appears in the answer (Paper No. 19, mailed September 14, 1998), while the complete statement of the appellant's argument can be found in the brief (Paper No. 18, filed August 27, 1998).

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. As a consequence of our review, we make the determinations which follow.

Double Patenting Rejections

Regarding rejections (1) and (2), the appellant has not contested the examiner's position that claims 1 and 3 through

19, if allowed in this application without a proper terminal disclaimer, would improperly extend the protection afforded by appellant's earlier patent (Steeley '403) or the examiner's position that claims 1, 3 through 5, 15 and 16, if allowed in this application without a proper terminal disclaimer, would improperly extend the protection afforded by appellant's earlier design patent (Steeley '600). Rather, the appellant has filed two terminal disclaimers on August 5, 1998 and August 10, 1998 and argues, in effect, that the filing of these terminal disclaimers is sufficient to overcome the double patenting rejections (brief, pages 5 through 7). The examiner has stated that these terminal disclaimers are not acceptable and has given reasons in support thereof (answer, page 6). Since the terminal disclaimers were determined to be unacceptable, and appellants have not otherwise contested the merits of the rejection, we are constrained to summarily sustain rejections (1) and (2).²

² A copy of a proper format for a terminal disclaimer to obviate a double patenting rejection over a prior patent may be found on page 1400-62 of the Manual of Patent Examining Procedure (MPEP § 1490 (7th ed., July 1988)). We encourage the examiner and appellant to work together to get proper terminal disclaimers filed and entered in this application to overcome the standing double patenting rejections.

The Obviousness Rejection

We shall not sustain the standing rejection of claims 1 and 3 through 13 under 35 U.S.C. § 103 as being unpatentable over Levine in view of Corwin and Hines.

Levine discloses a snap-on key cover comprising a pliable plastic frame (100) including two halves (120,140) bent or folded at hinges (160). The hinges are separated with an opening (170) between them for receiving a key blade (420). A projecting locking rim (240) and a locking recess (260) cooperate to hold the frame halves in a closed position. Each frame half (120,140) comprises an insignia-receiving opening (200) for tightly holding an insignia plate (300) (see Figures 8 through 12 and column 3, line 43 through column 4, line 40). Levine discloses that the plate faces (320) of the insignia plates "may be embossed, printed or otherwise marked with a word, symbol or the like identification" (column 3, lines 45 through 51).

According to the examiner, Levine discloses all features of the appellant's claimed invention "except for an insert means comprising a length of foldable material having a medial slot formed therein for alignment with the slot of the

housing" (answer, page 5). It is the examiner's position, however, that it would have been obvious to replace the two separate indicia plates (300) of Levine with a single foldable material as disclosed by Corwin (answer, page 5). The foldable material of Corwin relied upon by the examiner, clip (21), best seen in Figures 4 and 5, comprises a foldable material which, when folded about the head of a key, has an opening (22) to receive the shank of a key. Further, according to the examiner, it would have been obvious to form the insert of Levine as modified by Corwin from a non-metallic material in view of the teaching of an identification tag of non-metallic material by Hines.

Turning first to independent claim 1, we, like the appellant (brief, page 12), do not agree with the examiner's statement that Levine discloses all of the features recited in claim 1 aside from the foldable insert. Specifically, we find that one of the frame halves (120 or 140) of Levine must be considered to correspond to the "closure" and the other half to correspond to the housing of claim 1 so as to meet the limitation that the closure be "affixed to said housing by a living hinge."

As the slot or opening (170) for receiving the key blade is located between the hinges affixing one frame half (a closure) to the other frame half (a housing), the opening (170) is not formed in an endwall, with planar sidewalls extending between the endwall and the closure, as required by claim 1.

Further, as conceded by the examiner, Levine lacks an insert comprising foldable material "having a medial slot formed therein for cooperative alignment with said slot of said endwall" as required in claim 1. We have reviewed the disclosure of Corwin and do not find therein any suggestion to provide such an insert in the Levine device in place of the two indicia plates.

Corwin discloses a carrying case for carrying keys, the keys being retained in a retracted position inside the carrying case by means of a deflectable bar (44) having a dog (49) which cooperates with a slot (28) in a key-carrying clip (21) folded about a key. To release a key to an extended position as shown in the center of Figure 1, the user depresses the end (48) of the bar (44), thereby forcing the dog (49) out of the slot (28). The

clip (21) and key are then forced to the extended position by pressure exerted from springs (39) (column 3, line 69 through column 4, line 22). Corwin does not disclose provision of any indicia on the clip (21).

As seen from the above discussion, the clip (21) of Corwin is disclosed for use in combination with a spring-biased mechanism for selectively retaining a key in a retracted position within a carrying case or releasing a key to an extended position. There is nothing in Corwin which would suggest the use of such a clip purely for application of identification indicia, as a replacement for the indicia plates of Levine, for example, or in combination with a housing and closure as claimed.

The examiner submits that "one of ordinary skill in the art would have found it obvious to cover the head of the key [of Levine] with a single piece of foldable material so as to provide a key identification system with fewer parts thus reducing the likeliness [*sic*] of missing parts" (answer, page 7). However, it appears to us that this conclusion stems from speculation, unfounded assumptions or hindsight reconstruction, as we can find no factual basis for this

conclusion. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

We have reviewed the teachings of Hines and we find that, although Hines does disclose a folded mailing tag for use in an identification device for attachment to a key ring, Hines does not disclose or suggest provision of a slot in the folded material "for cooperative alignment with said slot of said endwall" as required by claim 1.

For the above reasons, we cannot sustain the examiner's rejection of independent claim 1, or of claims 3 through 5 which depend therefrom, under 35 U.S.C. § 103.

As independent claim 12 also recites an identification system comprising a housing including an endwall having an aperture therethrough and a foldable sheet "including a second portion having an aperture therein aligned with said aperture

in said endwall" and as we can find no teaching or suggestion in the evidence before us in this appeal to provide such an insert as a replacement for the indicia plates of Levine or in combination with a housing and closure as claimed, as discussed above with regard to claim 1, it follows that we cannot sustain the rejection of claim 12, or of claim 13 which depends therefrom, under 35 U.S.C. § 103 as being unpatentable over Levine in view of Corwin and Hines.

Turning finally to the rejection of independent claim 6, we, like the appellant (brief, page 14), note that neither Levine, Corwin nor Hines discloses a transparent frame or housing, as required by the claim. Further, we note that Levine lacks a length of foldable material confined within the housing "having a length and width commensurate with said interior volume such that when folded said material is coextensive with the dimensions of said volume" as required by claim 6. As for the Corwin reference, the disclosure of which is discussed above, we find no teaching therein which would suggest use of the folded key-carrying clips (21) in

combination with a transparent housing as claimed or as a replacement for the two indicia plates (300) of Levine.

While Hines does disclose a foldable (and folded) length of material (16), confined within a chamber formed by a closure member (14) and a casing member (11) having a base (12) and peripheral walls (13), having at least one face on which indicia (a mailing address) is applied, neither the closure member (14) nor the casing member (11) is disclosed as being transparent. In

fact, the outer surface of the closure member (14) is inscribed with instructions to pry the chamber or tag apart (column 2, lines 40 through 42). The mailing tag (16) can then be withdrawn from the chamber as shown in Figure 4 and the entire assembly, with the mailing tag still attached to the key chain, can be mailed to the address on the tag (column 2, lines 45 through 47). As the mailing tag is intended to be withdrawn from the enclosed chamber, there is no apparent reason to make the casing member or closure member transparent. Further, even if the teachings of Hines were combined with Levine to provide a foldable or folded mailing

tag within the frame (100) of Levine, to conclude that the resulting arrangement would be such that the length and width of the mailing label would be commensurate with the interior volume of the frame "such that when folded said material is coextensive with the dimensions of said volume" as required by claim 6 would require speculation and/or unfounded assumptions. See Id.

For the reasons discussed above, we find that the combined teachings of Levine, Corwin and Hines do not render obvious the invention recited in claim 6. Accordingly, we cannot sustain the standing rejection of claim 6, or of claims 7 through 11 which depend therefrom, under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 3 through 19 under the judicially created doctrine of double patenting over claims 1 through 3 of Steeley '403 and claims 1, 3 through 5, 15 and 16 under the judicially created doctrine of obviousness-type double patenting over the claim of Steeley '600 in view of Sawyer,

Corwin and Hines is affirmed and the decision of the examiner to reject claims 1 and 3 through 13 under 35 U.S.C. § 103 as being unpatentable over Levine in view of Corwin and Hines is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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