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and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIMMY R. KENDRICK

Appeal No. 1999-2064
Application No. 08/619,853¹

ON BRIEF

Before CALVERT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final
rejection of claims 29 to 48, which are all of the claims
pending in this application.

We AFFIRM-IN-PART and REMAND.

¹ Application filed March 20, 1996. According to the
appellant, the application is a division of Application No.
07/817,894, filed January 8, 1992.

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BACKGROUND

1. The file record of this application indicates that in the final rejection (Paper No. 12, mailed November 9, 1998) claims 29-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,197,765² to Mowry, Jr. et al. (hereafter "Mowry"). This rejection was maintained in the Examiner's Answer (Paper No. 15, mailed January 11, 1999).

2. The file record of this application indicates that on pages 4-5 of the brief (Paper No. 14, filed November 30, 1998) the appellant argued that

[i]t appears in making this rejection that the Mowry reference was considered in its entirety as prior art, when in fact [it] is not. Attention is directed to the Declaration under 37 CFR 1.132 filed in the parent application (a copy, with attachments, was enclosed in this case).

The appellant then stated that only claim 12 of Mowry may be considered prior art and that the application of the entire Mowry reference as prior art is erroneous.

² Issued March 30, 1993 based upon Application No. 07/729,363, filed July 12, 1991.

3. The file record of parent Application No. 07/817,894 indicates that a Declaration under 37 CFR § 1.132 of Jimmy Ray Kendrick was executed on April 8, 1993 and filed on April 13, 1993 (Paper No. 13). This declaration avers that "[p]rior to July 12, 1991, I actually reduced the invention of claim 1 of the above-identified application to practice in the United States, by making actual operable specimens thereof."

4. The file record of parent Application No. 07/817,894 indicates that in the Advisory Action of November 2, 1993 (Paper No. 18) the examiner stated that the declaration was not effective for two reasons. First, the portion of 37 CFR which controls swearing back of a reference is 37 CFR § 1.131, not 37 CFR § 1.132. Second, the Mowry patent is clearly claiming the same invention as the appellant is claiming. The examiner then stated that "neither 37 CFR 1.131 or 37 CFR 1.132 are available to the Applicant regarding this rejection."

5. The file record of parent Application No. 07/817,894 indicates that in the Office action of February 10, 1997

(Paper No. 29) the examiner stated that the declaration "is considered irrelevant since applicant can not swear back of a patent where the same invention is being claimed."

6. The file record of this application indicates that this panel of the Board issued an order (Paper No. 18, mailed December 6, 1999) requiring the appellant to clarify the record by addressing the following issue:

Is the patent to Mowry available as prior art under 35 U.S.C. § 102(e) against claims 29-48 in Application No. 08/619,853?

In that order the Board required the appellant to either

- (1) provide an argument specifying in detail the reasons why Mowry is not prior art under 35 U.S.C. § 102(e), or
- (2) acknowledge that on the current record that Mowry is prior art under 35 U.S.C. § 102(e) and thus the entire Mowry reference is available as prior art.

7. The file record of this application indicates that in the response to the Board's order (Paper No. 19, filed February 4, 2000) the appellant provided an argument specifying in detail the reasons why Mowry is not prior art

under 35 U.S.C. § 102(e). Specifically, the appellant argues that Mowry is not claiming "the same patentable invention" as the claims under appeal.

8. The file record of this application indicates that this panel of the Board issued a remand (Paper No. 20, mailed March 7, 2000) requiring the examiner to specifically identify each provision of 35 U.S.C. § 102 that the examiner is applying Mowry as prior art. In addition, if the examiner was relying on 35 U.S.C. § 102(e) as a basis for applying Mowry as prior art, we required the examiner to set forth factual evidence establishing that Mowry is claiming "the same patentable invention" as the claims under appeal.

9. The file record of this application indicates that in the answer (Paper No. 21, mailed April 13, 2000) responding to the Board's remand the examiner states (p. 6) that Mowry is prior art under 35 U.S.C. § 102(e) and 35 U.S.C. § 102(g). In addition, the examiner asserts (p. 6) that the factual evidence to establish that Mowry is claiming "the same

patentable invention" as the claims under appeal is set forth in the rejection section of the answer.

10. The file record of this application indicates that the appellant filed a reply brief (Paper No. 22, filed April 17, 2000) responding to the examiner's answer of April 13, 2000.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 103 Rejection based upon Mowry being prior art under 35 U.S.C. § 102(g)³

³ The appellant has not disputed the examiner's reliance on claim 12 of Mowry being available as prior art under 35 U.S.C.

(continued...)

We sustain the rejection of claims 29, 37 and 39 under 35 U.S.C. § 103, but not the rejection of claims 30 to 36, 38 and 40 to 48.

Claims 30 and 40 to 45

We agree with the appellant's argument (brief, pp. 7-10) that the claimed linear bands positioned as set forth in independent claim 30 would not have been obvious at the time the invention was made to a person having ordinary skill in the art from the subject matter of Mowry's claim 12. In that regard, we note that Mowry's claim 12 fails to teach each band having "first and second substantially parallel substantially linear edges" and each of the bands engaging others of the

³(...continued)
§ 102(g). We note that in parent Application No. 07/817,894 the appellant did not copy claim 12 of Mowry for purposes of interference as suggested by the examiner. On these facts, the appellant's refusal to make the suggested claim constitutes a concession that the subject matter of that claim is prior art as to the appellant within the meaning of 35 U.S.C. § 102(g) and 35 U.S.C. § 103. Otherwise stated, the appellant's refusal to make the suggested claim constitutes a disclaimer of the invention covered by that claim and the appellant is not entitled to claims which do not define patentably over claim 12 of Mowry. See In re Ogiue, 517 F.2d 1382, 1391, 186 USPQ 227, 235 (CCPA 1975) and 37 CFR § 1.605(a).

bands "only along one or both of said substantially linear first and second edges thereof." The examiner has not cited any **evidence**⁴ that would have established the obviousness of these limitations.

Claims 31 to 36 and 46 to 48

We agree with the appellant's argument (brief, pp. 10-11) that the claimed sizes for the geometric elements as set forth in independent claim 31 and dependent claim 32 would not have been obvious at the time the invention was made to a person

⁴ Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

having ordinary skill in the art from the subject matter of Mowry's claim 12. The examiner has not cited any **evidence** that would have established the obviousness of these sizes.

Claim 38

We agree with the appellant's argument (brief, p. 12) that the subject matter of dependent claim 38 would not have been obvious at the time the invention was made to a person having ordinary skill in the art from the subject matter of Mowry's claim 12. The examiner has not cited any **evidence** that would have established the obviousness of the limitations of claim 38 (e.g., some of the geometric elements are of a color other than black, the claimed thickness of the geometric elements).

Claim 29

We agree with the examiner that the subject matter of independent claim 29 would have been obvious at the time the invention was made to a person having ordinary skill in the art from the subject matter of Mowry's claim 12.

The appellant argues (brief, pp. 5-6) only that the limitation that the substrate surface is "devoid of a camouflage pattern" is not obvious from Mowry's claim 12 since parent claim 11 of Mowry specifically recites "a camouflage pattern." We do not agree. In our view, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to omit Mowry's camouflage pattern and its associated function for the self evident advantages thereof (e.g., cheaper to manufacture). We reach this conclusion of obviousness based upon the basic principle that the question under 35 U.S.C. § 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). That is, the question of obviousness in this instance cannot be approached on the basis than an artisan having ordinary skill would have known only the subject matter of Mowry's claim 12, because such artisan is presumed to know something about the art apart

from what the reference discloses. See In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). A conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985).

Claims 37 and 39

We agree with the examiner that the subject matter of dependent claims 37 and 39 would have been obvious at the time the invention was made to a person having ordinary skill in the art from the subject matter of Mowry's claim 12.

The appellant argues (brief, p. 12) only that the examiner failed to establish the obviousness of the claimed features (i.e., the claimed densities). We find this argument to be unpersuasive since we find ourselves in agreement with the examiner's position (final rejection, pp. 3-4) that the

claimed densities would have been an obvious matter of design choice.

Synopsis

In view of the above-noted decisions with respect to claims 29 to 48, it is our determination that claims 29, 37 and 39 define the "same patentable invention" as claim 12 of Mowry and that claims 30 to 36, 38 and 40 to 48 define a "separate patentable invention" with respect to claim 12 of Mowry. 37 CFR § 1.601(n).

35 U.S.C. § 103 Rejection based upon Mowry being prior art under 35 U.S.C. § 102(e)

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). In addition, the initial burden of making a prima facie case of prior invention is also on the examiner. See In re Bass, 474 F.2d 1276, 1287, 177 USPQ 178, 186 (CCPA 1973).

In view of our determination above that claims 30 to 36, 38 and 40 to 48 define a "separate patentable invention" with respect to claim 12 of Mowry and not the "same patentable invention" as claim 12 of Mowry, 37 CFR § 1.131 requires that the merits of the Kendrick Declaration be evaluated by the examiner to determine if it is sufficient to overcome Mowry.⁵ Since the examiner has not provided any acceptable reason for not giving effect to the Kendrick Declaration, we are constrained to reverse the rejection of claims 30 to 36, 38 and 40 to 48 and remand this application to the examiner to consider on the record whether or not the Kendrick Declaration is sufficient to overcome Mowry and if not, whether these claims are patentable under 35 U.S.C. § 103 taking into consideration the views we expressed above. With respect to claims 29, 37 and 39, the examiner has established that Mowry is claiming the "same patentable invention" for the reasons set forth above. Thus, with respect to claims 29, 37 and 39,

⁵ The record is unclear whether or not the examiner considered the facts and evidence set forth in the Kendrick Declaration sufficient to overcome Mowry if Mowry was considered to not claim the "same patentable invention" as set forth in 37 CFR § 1.601(n).

the examiner's treatment of the Kendrick Declaration was appropriate.

For the reasons set forth above, the decision of the examiner to reject claims 29 to 48 under 35 U.S.C. § 103 is affirmed with respect to claims 29, 37 and 39 and reversed with respect to claims 30 to 36, 38 and 40 to 48.

CONCLUSION

To summarize, the decision of the examiner to reject claims 29 to 48 under 35 U.S.C. § 103 is affirmed with respect to claims 29, 37 and 39 and reversed with respect to claims 30 to 36, 38 and 40 to 48. In addition, the application has been remanded to the examiner to determine whether or not the Kendrick Declaration is sufficient to overcome Mowry and if not, whether claims 30 to 36, 38 and 40 to 48 are patentable under 35 U.S.C. § 103.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 1.196(e) provides that

[w]henever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the

affirmed rejections, including any timely request for rehearing thereof.

AFFIRMED-IN-PART; REMANDED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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