PRECEDENTIAL OPINION

Pursuant to the Board of Patent Appeals and Interference's Standard Operating Procedure 2, the opinion below has been designated a precedential opinion.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARY SMITH

Appeal 2007-1925
Application 09/391,869
Technology Center 3700

Decided: June 25, 2007

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge,* and WILLIAM F. PATE, III, JENNIFER D. BAHR, LINDA E. HORNER, and DAVID B. WALKER, *Administrative Patent Judges*.

PER CURIAM

DECISION ON APPEAL

STATEMENT OF THE CASE

Mary Smith ("Appellant") seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-21 and 32-36. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.[1]

THE INVENTION

Appellant claims a pocket insert for a bound book, which includes at least one pocket adapted to receive and retain supplemental material that cannot easily be bound directly to the book binding, such as a diskette or CD-ROM (Specification 1:3-7). Claims 1, 10, and 35, reproduced below, are representative of the subject matter on appeal.

> 1. A book comprising multiple pages and a pocket insert bound along a binding, wherein the pocket insert comprises:
>
> (a) a base sheet of paper material having a length and width comparable to the length and width of a book page, the base sheet comprising a binding edge bound to the binding, the base sheet being one ply and having a planar first surface and a planar second surface; and
>
> (b) a pocket sheet of paper material being one ply, the pocket sheet having a planar inner surface, a planar outer surface, and a perimeter defined by an attached edge section on the inner surface and a free edge section on the inner surface, at least a portion of the attached edge section being one of chemically bonded, fused or

[1] Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

glued to the first surface of the base sheet to form continuous two ply seams defining a closed pocket and the free edge section being unattached to the base sheet to form a pocket opening along the free edge section between the first surface and the inner surface of the pocket sheet, wherein the base sheet and the pocket sheet are arranged such that the pocket opening faces the binding.

10. The book of claim 9 [which depends ultimately from claim 1], wherein the base sheet and the pocket sheet are further adhered to one another along a strip parallel to the third and fourth edges of the sheets, so as to separate two pockets formed between the sheets.

35. An improved pocket insert for operably passing through a printer or a copier in sequence with a single sheet of paper having a given width and a given length, the improvement comprising:

(a) a base sheet having a single thickness and a binding edge located at an end of the sheet, the base sheet having a width equal to the given width and a length equal to the given length;

(b) a pocket sheet having a single sheet thickness;

(c) an adhesive between the base sheet and the pocket sheet to bond the base sheet to the pocket sheet to form a pocket with an opening facing the binding edge, the pocket insert having a thickness rendering the insert passable through a copier or printer in sequence with a sheet of paper having the given width and length, the thickness of the pocket insert being at its maximum equal to a combined thickness of the base sheet single

thickness, the pocket sheet single sheet thickness and the adhesive.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Dick	US 1,495,953	May 27, 1924
Ruebens	US 4,965,948	Oct. 30, 1990
Michlin	US 5,141,252	Aug. 25, 1992
Wyant	US 5,540,513	Jul. 30, 1996

The following rejections are before us for review.

1. Claim 35 is rejected under 35 U.S.C. § 102(b) as anticipated by Michlin.
2. Claims 1-9, 11-13, 16-18, and 32-24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wyant in view of Dick.
3. Claims 10, 14, 15, 19-21, and 36 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wyant in view of Dick, and further in view of Ruebens.

ANTICIPATION UNDER § 102(b)

The § 102(b) Issue

The anticipation issue before us is whether Appellant has shown that the Examiner erred in rejecting claim 35 under 35 U.S.C. § 102(b) as anticipated by Michlin. The anticipation issue turns on whether Michlin expressly or inherently discloses a pocket insert that has "a thickness rendering the insert passable through a copier or printer in sequence with a sheet of paper."

Findings of Fact Relating to Anticipation

1. Michlin discloses a pocketed insert with a front ply having a single thickness secured to a back ply having a single thickness to form a pocket (Michlin, col. 2, ll. 37-46, Figs. 1 and 2).
2. Michlin discloses that the pocketed insert is "of multi-ply construction with a back ply, a front ply disposed over the back ply to define a pocket and at least one insert ply in the pocket" (Michlin, col. 1, ll. 32-35).
3. "In other cases, one or more inserts may be provided within the pocket and may extend slightly out of the pocket in order to be manually grasped and removed." (Michlin, col. 1, ll. 48-51). Thus, Michlin teaches that one or more insert plies optionally may be inserted in, but are separate from, the pocket.
4. The pocket of Michlin is shown and described as having an opening facing toward the binding (Michlin, col. 2, ll. 53-55, Figs. 1 and 2).
5. Michlin also teaches that the back surface of the back ply can be preprinted with reply address information and postal indicia so as to be conveniently mailed (Michlin, col. 3, ll. 15-18). Michlin does not specify whether the back ply can be preprinted before assembly of the pocket insert or after assembly into the pocket insert but before binding into the book (Michlin *passim)*.

6. The Specification discusses that the pocket insert may be automatically collated along with the pages:

> For example, the pages may be collated automatically as they are copied on a copier. Some copiers provide a supplemental tray to collate a supplement page along with the copied pages, i.e., a supplemental page onto which no information is being applied to the page. The pocket insert of this invention is suitable for such copying environments, thereby permitting the insert to be collated automatically with the various pages while the pages are being photocopied. For this embodiment, the pocket insert should be assembled of standard weight paper, and it is important that the insert is arranged in the collator tray such that edge 12 (this edge having a single-sheet thickness) is pushed by the copier roller during collation.

(Specification 6:31 – 7:10). The Specification thus provides no detailed description of what thickness is required to render the insert passable through a copier or printer in sequence with a sheet of paper other than to say that "the pocket insert should be assembled of standard weight paper." *Id.*

Principles of Law Relating to Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631,

2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

"It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *In re Cruciferous Sprout Litig.,* 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002) (citations and internal quotation marks omitted). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson,* 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (citations and internal quotation marks omitted).

"[A] prima facie case of anticipation [may be] based on inherency." *In re King,* 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently

possess the characteristics of the claimed product. *In re Best,* 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product."). *See also In re Spada,* 911 F.2d 705, 708-09, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990).

Analysis of Anticipation Issue

Appellant argues that Michlin does not disclose that the pocket insert of the invention has "a thickness rendering the insert passable through a copier or printer in sequence with a sheet of paper" (Substitute Br. 6-8). Appellant asserts that the teaching of Michlin that "the back surface of the back ply can be preprinted with reply address information and postal indicia so as to be conveniently mailed," (Finding of Fact 5), "does not equate to a disclosure or a suggestion that the pocket insert itself and as a whole is of a thickness passable through a printer or copier in sequence with a sheet of paper having the same size as the base sheet." (Substitute Br. 6) (emphasis in original).

The Examiner found that "if the pocket sheet and base can be one ply, wherein the pocket sheet is folded and attached to the base sheet to form the insert (as stated in Col. 2, lines 40-46), then the insert is capable of being passed through a printer as a whole." (Answer 4). There is nothing in the Specification to indicate that the thickness necessary to render the insert passable through a copier or printer

is anything more than the inherent result of constructing the insert of standard materials in accordance with claim 35's other limitations, which are expressly disclosed in Michlin (Finding of Fact 6). We thus agree with the Examiner that a prima facie case of anticipation is established by Michlin. Because the Appellant presented no evidence to overcome the Examiner's finding of the inherent ability of Michlin's insert to pass through a copier or printer, she failed to meet her burden to overcome that prima facie case. We therefore find that claim 35 is anticipated by Michlin.

OBVIOUSNESS

The § 103(a) Issues

There are two obviousness issues before us. The first is whether Appellant has shown that the Examiner erred in rejecting claims 1-9, 11-13, 16-18, and 32-24 under 35 U.S.C. § 103(a) as unpatentable over Wyant in view of Dick. The first issue turns on whether it would have been obvious to glue two separate sheets to form a continuous two-ply seam, as taught by Dick, rather than folding one sheet to create a seam along the folded edge, as taught by Wyant.

The second obviousness issue is whether Appellant has shown that the Examiner erred in rejecting claims 10, 14, 15, 19-21, and 36 under 35 U.S.C. § 103(a) as unpatentable over Wyant in view of Dick, and further in view of Ruebens. This issue turns on whether it would have been obvious to improve a pocket insert by creating two pockets from a single pocket using an additional line of adhesive.

Findings of Fact Relating to Obviousness

7. Wyant discloses at least one pocket formed between a card and a tab yielding panel (Wyant, col. 3, ll. 28-29).
8. Wyant teaches that the card may be of any convenient size or shape (Wyant, col. 2, ll. 16-20).
9. Wyant also discloses that the indexing member may be formed from any conventional stationary paper including card stock and paper stock (Wyant, col. 2, ll. 21-25).
10. Wyant teaches that the tab yielding panel can be folded inwardly to secure the panel to the card with an adhesive along the inside margins of the tab yielding panel, which results in two-ply seams (Wyant, col. 2, ll. 49-53).
11. In an alternate embodiment, Wyant teaches securing the tab yielding panel to the card by top and bottom marginal panels which overlap the tab yielding panel, resulting in three plies along its top and bottom edges (Wyant, col. 2, ll. 53-61).
12. The pocket is shown and described as facing toward the apertures used to retain the card in a three ring binder (Wyant, col. 2, ll. 53-55, col. 3, ll. 9-13, Figure 1).
13. Any convenient bonding method including adhesive can be used to secure the tab yielding panel to the card (Wyant, col. 2, ll. 50-53).
14. Dick discloses that it has been a common practice to have portfolios in which leaves are permanently attached to a binder element of the book

and teaches an arrangement for loose leaf pockets (Dick, p. 1, ll. 16-25).

15. Dick teaches and displays a pocket that is stitched or otherwise suitably secured to a fly leaf along three of its four edges to define a closed pocket with an opening along its fourth edge (Dick, p. 1, ll. 54-60, Fig. 1).

16. Dick acknowledges that the pocket may be secured by any suitable means (Dick, p. 1, l. 90).

17. Ruebens describes an improved photo album in which a transparent cover is attached to three edges of each display page to form one or more pockets (Ruebens, col. 2, ll. 52-54, col. 3, ll. 40-42, Fig. 1).

18. The transparent cover is attached to the display page by lines of attachment by any convenient means such as various well-known adhesives (Ruebens, col. 3, ll. 53-55).

19. Figure 1 of Ruebens shows that the transparent cover is attached to the display page by lines of attachment along its upper and lower edges and also via an additional line of attachment parallel to the upper and lower edges to separate two pockets formed between the transparent cover and the display page (Ruebens, Fig. 1, col. 4, ll. 39-46).

20. The prior art differs from the disputed claim limitations only in its failure to explicitly state a pocket insert construction "rendering the insert passable through a copier or printer in sequence with a sheet of paper."

21. Because Wyant discloses that the indexing member may be formed from any conventional stationary paper (Finding of Fact 9), the two-ply embodiment of Wyant, or the two-ply seams of Dick combined with the single pocket arrangement of Wyant, would inherently be capable of passing through a copier or printer in sequence with a sheet of paper (Finding of Fact 6).

Principles of Law Relating to Obviousness

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc*., 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, 82

USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR,* 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court explained:

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*

The Supreme Court stated that there are "[t]hree cases decided after *Graham* [that] illustrate this doctrine." *Id.* at 1739, 82 USPQ2d at 1395. "In *United States v. Adams*, … [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable

result." *Id.* at 1739-40, 82 USPQ2d at 1395. "*Sakraida and Anderson's-Black Rock* are illustrative – a court must ask whether the improvement is more that the predictable use of prior art elements according to their established function." *Id.* at 1740, 82 USPQ2d at 1395.

The Supreme Court stated that "[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." *Id.* The Court explained, "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that "[t]o facilitate review, this analysis should be made explicit." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

The Federal Circuit recently concluded that it would have been obvious to combine (1) a mechanical device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) an electronic, processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1690-91 (Fed. Cir. 2007) ("[a]ccommodating a prior art mechanical device that accomplishes [a desired] goal to modern electronics would have been reasonably obvious to one of ordinary skill in designing children's learning devices"). In reaching that conclusion, the Federal Circuit recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Id.* at 1161, 82 USPQ2d at 1687 (citing *KSR,* 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007) ("The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* (citing *KSR*, 127 S.Ct. at 1740-41, 82 USPQ2d at 1396).

Analysis of Obviousness Issues

A. Rejection of claims 1-9, 11-13, 16-18, and 32-34 under 35 U.S.C. § 103(a) as unpatentable over Wyant in view of Dick.

Appellant separately argues claims 1, 8 and 32. For claim 5, Appellant repeats the same argument made for claim 1. We will therefore treat claims 2-7, 9, 11-13 and 16-18 as standing or falling with claim 1. Claim 8 will be addressed separately. Because Appellant repeats the same arguments for claims 32-34, we will treat claims 33 and 34 as standing or falling with claim 32 *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young,* 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

Appellant disputes that the prior art teaches "at least a portion of the attached edge section being one of chemically bonded, fused or glued to the first surface of the base sheet" as recited in Appellant's claim 1. In particular, Appellant argues that Dick does not disclose chemical bonding, fused or glued construction (Substitute Br. 11). Dick teaches that the pocket may be secured by any suitable means (Finding of Fact 16). Moreover, Wyant teaches that any convenient bonding method including adhesive can be used to secure the tab yielding panel to the card (Finding of Fact 13). From these teachings, we find that the combination of Wyant and Dick would have taught one of ordinary skill in the art to use the Wyant teaching of bonding method to secure the Dick pocket. Therefore, the prior art teaches "at least a portion of the attached edge section being one of chemically

bonded, fused or glued to the first surface of the base sheet" as recited in Appellant's claim 1.

Appellant argues that Wyant fails to disclose a pocket nor does it teach "continuous two-ply seams" as recited in Appellant's claim 1 (Substitute Br. 9-10). We find that Wyant discloses embodiments alternately using two-ply (Finding of Fact 10) and three-ply seams (Finding of Fact 11) to form a pocket. Also, Wyant discloses a single pocket for each base sheet (Finding of Fact 7). However, Wyant teaches forming the pocket by folding a single sheet, rather than gluing two separate sheets together. This results in a pocket insert with two glued, two-ply seams separated by a folded edge, not a continuous, two-ply seam. Thus, Wyant teaches all of the limitations set forth in Appellant's claim 1 except "continuous two ply seams." We find that Dick teaches a pocket made with a continuous two-ply seam. Dick teaches forming a pocket from two single sheets by stitching or otherwise suitably securing three of the four edges. (Finding of Facts 15 and 16). Thus, Dick teaches another way of making a pocket. Instead of Wyant's two-ply pocket made by folding a single sheet and securing the two opposite edges, Dick teaches forming a two-ply pocket by securing three edges of two sheets. Furthermore, Wyant and Dick together teach that a pocket can made by either method and yield a predictable result.

The question is whether one of ordinary skill in the art starting with Wyant's two-ply pocket would have found it obvious at the time the invention was made to modify Wyant's pocket insert to include a continuous two-ply seam as taught by Dick for providing a more secure pocket. In considering the teaching of Wyant

and Dick, we have found that (1) each of the claimed elements is found within the scope and content of the prior art; (2) one of ordinary skill in the art could have combined the elements as claimed by methods known at the time the invention was made; and (3) one of ordinary skill in the art would have recognized at the time the invention was made that the capabilities or functions of the combination were predictable. Furthermore, neither Appellant's Specification nor Appellant's arguments present any evidence that cutting the folded edge of Wyant and gluing the resulting separate pocket sheet and base sheet along the cut edge to form a continuous two-ply seam as taught by Dick was uniquely challenging or difficult for one of ordinary skill in the art. The substitution of the continuous, two-ply seam of Dick for the folded seam of Wyant thus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement." *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Therefore, it would have been obvious at the time the invention was made to modify Wyant's pocket insert to attach a separate pocket sheet to a base sheet to form a pocket insert with continuous two-ply seams as taught by Dick.

This conclusion is consistent with the line of case from the Federal Circuit and its predecessor court. *See, e.g., In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 8-9 (CCPA 1975) (holding that the claimed manner in which an electrical contact was made, i.e. by "metallic wrapping," that provided no novel or unexpected result over the metallic connections used in the applied references was an obvious choice within the skill of the art) (cited with approval in *In re Chu,* 66 F.3d 292, 299, 36

USPQ2d 1089, 1094 (Fed. Cir. 1995)). In the present case, the disputed claim limitation of "continuous two-ply seams" and the function it performs—to create a pocket—are identical between the claimed invention and the prior art. Thus, the selection of the continuous two-ply seam of Dick over the folded seam of Wyant represents an obvious choice within the skill of the art, *i.e.*, a choice between known viable alternatives.

Appellant argues that Wyant and Dick teach away from each other (Substitute Br. 14-18). The Examiner believed otherwise, finding that Wyant and Dick do not teach away from each other, and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wyant's pocket insert with a separate pocket sheet attached to a base sheet to form a pocket insert as taught by Dick (Answer 5-6).

In particular, Appellant argues that Wyant and Dick teach away from each other because combining Dick with Wyant would render Wyant inoperable for its primary purpose—namely providing tabs that selectively can be folded outward of the edge of the card (Substitute Br. 11). The Examiner correctly found that if the base sheet and pocket sheet were attached along the perimeter edge as disclosed in Dick, it would still be possible to fold back the tabs of Wyant near its attached perimeter edge (Answer 6). Appellant argues that the only way the tabs of Wyant can be formed is by forming the tab yielding sheet and the base sheet from a single piece of material to form a folded line (Substitute Br. 11). Although this method is consistent with an embodiment disclosed in Wyant, there is nothing in Wyant that requires or suggests that this is the only way to attach tabs that can be selectively

folded outward, much less to teach away from the use of a pocket constructed on one side surface of a base sheet, the element for which the Examiner relies on Dick (Answer 5). Where, as here, art is silent on the capabilities or function of any particular item, that is not teaching away from its use. Further, the Court in *KSR* noted that "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." 127 S.Ct. at 1742, 82 USPQ2d at 1397. It would take no more than ordinary creativity for a person of ordinary skill to adapt Wyant to form tabs with the base sheet and pocket sheet attached along the perimeter edge as disclosed in Dick. As noted by KSR:

> Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.

KSR, 127 S.Ct. at 1742, 82 USPQ2d at 1397.

Appellant's claim 8 recites "the base sheet and the pocket sheet are adhered to one another along their respective first edges, third edges and fourth edges." With respect to claim 8, Appellant argues that there is no specific suggestion in either of the references to modify Wyant to adhere the pocket sheet to the base sheet along their respective first, third, and fourth edges. *KSR* forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

With respect to claim 32, Appellant reasserts the above arguments and asserts that the combination of Wyant with Dick would not meet the limitation of "rendering the insert passable through a copier or printer in sequence with a sheet

of paper." Wyant discloses that the indexing member may be formed from any conventional stationary paper including card stock and paper stock (Finding of Fact 9). As such, the two-ply embodiment of Wyant, or the two-ply seams of Dick combined with the single pocket arrangement of Wyant, would inherently be capable of passing through a copier or printer in sequence with a sheet of paper (Finding of Fact 20). Accordingly, the argument fails as to claims 32-34 for the same reasons as it did for claim 35.

Appellant's claims 1-9, 11-13, 16-18, and 32-34 were combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under *KSR*. In addition, neither Appellant's Specification nor Appellant's arguments present any evidence that the modifications necessary to effect the combination are uniquely challenging or difficult for one of ordinary skill in the art. Because this is a case where the improvement is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396, no further analysis was required by the Examiner. *KSR,* 127 S.Ct. at 1740, 82 USPQ2d at 1396. Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wyant's pocket insert with a separate pocket sheet attached to a base sheet to form a pocket insert as taught by Dick for providing a more secured pocket.

B. Rejection of claims 10, 14, 15, 19-21, and 36 under 35 U.S.C. § 103(a) as unpatentable over Wyant in view of Dick, and further in view of Ruebens.

With respect to the combination of Wyant, Dick, and Ruebens, Appellant reasserts the arguments made against the combination of Wyant and Dick, and argues that Ruebens does not cure the deficiencies of that combination (Substitute Br. 19-21). Appellant separately argues the allowability of claim 36. The remaining claims stand or fall together. With respect to claim 36, Appellant essentially reasserts the "thickness" argument asserted against the rejection of claims 32-34. The argument fails as to claim 36 for the same reasons as it did for claims 32-34.

The Examiner relies on Ruebens to show a pocket sheet that is adhered to a base sheet along the base sheet's perimeter edge and along a strip or inner portion, which separates the pocket sheet into two pockets (Answer 5). One of skill in the art would have been able to combine the adhesive strip of Ruebens with the combination of Wyant and Dick asserted by the Examiner in the preceding rejection using methods known at the time the invention was made in the bookbinding art. Moreover, each of the elements of Wyant, Dick, and Ruebens combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. *See Sakraida,* 425 U.S. at 282, 189 USPQ at 453.

Claims 10, 14, 15, 19-21, and 36 were combinations which only unite old elements with no change in their respective functions and which yield predictable

results. Thus, the claimed subject matter likely would have been obvious under *KSR*. In addition, neither Appellant's Specification nor Appellant's arguments present any evidence that the separation of one pocket into two pockets using an additional line of adhesive is uniquely challenging or difficult for one of ordinary skill in the art. Moreover, the separation of one pocket into two pockets using an additional line of adhesive is a technique that has been used to improve one device (the photo album of Ruebens), and one of skill in the art would recognize that it would improve similar devices in the same manner. Because Appellant has not shown that the application of the Ruebens technique to the combination of Wyant and Dick would have been beyond the skill of one of skill in the art, we find using the technique would have been obvious. Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wyant's and Dick's pocket insert with an adhesive strip, as taught by Ruebens, for the purpose of defining a plurality of pockets to hold numerous articles. Because this is a case where the improvement is no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. *KSR,* 127 S.Ct. at 1740, 82 USPQ2d at 1396.

CONCLUSIONS

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-21 and 32-36.

DECISION

The decision of the Examiner to reject claims 1-21 and 32-36 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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