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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JON PHILLIP VAN WAGONER

Appeal 2018-009233
Application 14/322,870
Technology Center 3600

Before CYNTHIA L. MURPHY, KENNETH G. SCHOPFER, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant¹ appeals from the Examiner's rejections of claims 1–8, 11–16, 18–22, and 24–33 under 35 U.S.C. §§ 102 and 103. We REVERSE.²

¹ The Appellant is the “applicant” as defined by 37 C.F.R. § 1.42 (e.g., “the inventor or all of the joint inventors”). “The real parties in interest are Jon P. Van Wagoner, the inventor, and Matthew C Phillips.” (Appeal Br. 1.)

² We have jurisdiction under 35 U.S.C. §§ 6(b) and 134(a). A hearing was held on June 22, 2020.

STATEMENT OF THE CASE

The Appellant's invention "relates generally to business cards and more particularly to a business card with a selectively exposable and re-exposable adhesive flap designed for removably attaching the business card to other objects." (Spec. ¶ 3.)

Independent Claims on Appeal

1. A business card comprising:
 - a front side;
 - a back side opposite the front side;
 - four edges; and
 - a non-removable flap permanently attached to the business card along substantially the entire length of one of the four edges, the flap comprising:
 - a front side;
 - a back side opposite the front side of the flap; and
 - an adhesive on at least a portion of the back side of the flap, wherein the adhesive is capable of removably and reusably adhering to objects, the flap being foldable with respect to the business card such that the flap can be alternately and repeatedly placed in the following two configurations:
 - a first configuration wherein the adhesive on the back side of the flap adheres to a portion of the back side of the business card, and
 - a second configuration wherein the flap aligns at least approximately with the business card such that the front of the business card and the front of the flap face the same general forward direction, and the back of the business card and the back of the flap face the same general direction that is generally opposite the forward direction, thereby presenting the flap's adhesive to be able to adhere to another object such that the front side of the business card faces outward from said another object,

wherein the back side of the flap has a lengthwise central area in which there is no adhesive anywhere along the height of the flap.

21. A business card changeable between an adhesive configuration and non-adhesive configuration, the business card comprising:

a generally flat paper business card body having opposing front and back sides; and

a non-removable plastic flap permanently attached to the generally flat paper business card body, the plastic flap having an adhesive side and an opposing non-adhesive side, the adhesive side of the plastic flap having an adhesive area that is adherable to, removable from, and re-adherable to another object, the plastic flap being moveable from a first position to a second position, wherein the plastic flap in the first position is folded against the paper business card body such that the adhesive side of the plastic flap adheres to the back side of the paper business card body, and wherein the plastic flap in the second position exposes the adhesive area to permit the business card to adhere to another object, and

wherein the plastic flap can be placed in a third position wherein the plastic flap's adhesive is able to adhere to said another object, and the third position is further characterized in that the paper business card body is further able to pivot with respect to the plastic flap such that the back side of the paper business card body is exposed outward from said another object, and wherein the paper business card body lies flat against said another object.

32. A card comprising:

indicia of business information on at least one side of the card; and

a means for enabling the card to be converted from an adhesive configuration to a non-adhesive configuration and vice versa.

33. A method of using a selectively adhesive business card, the method comprising:

storing the business card in a non-adhesive form such that an adhesive flap of the business card is folded down against and adheres to a portion of the business card;

unsticking the flap from the portion of the business card; sticking the adhesive flap to another object to thereby adhere the business card to said another object so as to reveal indicia on a front side of the business card;

turning the business card over 180° while the adhesive flap remains adhered to said another object so that the business card lies flat against said another object to reveal indicia on a back side of the business card;

removing the adhesive flap from said another object; and re-sticking the adhesive flap to the portion of the business card to thereby return the business card to the non-adhesive form.

Evidence

Drexler	US 4,711,347	Dec. 8, 1987
Meetze	US 5,980,676	Nov. 9, 1999
Mertens	US 5,575,574	Nov. 19, 1996
Dobbins	US 5,887,899	Mar. 30, 1999
Laurence	US 6,120,184	Sept. 19, 2000
Bay	US 6,146,728	Nov. 14, 2000
Hsu	US 2005/0191455 A1	Sept. 1, 2005
Von Ohsen	US 2007/0180746 A1	Aug. 9, 2007
Declaration of Jon P. Van Wagoner		Dec. 21, 2016

Rejections

I. The Examiner rejects claims 1–8, 11, 12, 15, 16, 18, 21, and 22 under 35 U.S.C. § 103 as unpatentable over Dobbins and Laurence. (Final Action 3.)

II. The Examiner rejects claims 13 and 24 under 35 U.S.C. § 103 as unpatentable over Dobbins, Laurence, and Bay. (Final Action 5.)

III. The Examiner rejects claim 14 under 35 U.S.C. § 103 as unpatentable over Dobbins, Laurence, Bay, and Drexler. (Final Action 7.)

IV. The Examiner rejects claim 19 under 35 U.S.C. § 103 as unpatentable over Dobbins, Laurence, and Mertens. (Final Action 8.)

V. The Examiner rejects claim 20 under 35 U.S.C. § 103 as unpatentable over Dobbins, Laurence, Bay, Mertens, Van Ohlsen, and Meetze. (Final Action 8.)

VI. The Examiner rejects claims 21–23 and 25–31 under 35 U.S.C. § 103 as unpatentable over Dobbins and Bay. (Final Action 6.)

VII. The Examiner rejects claim 32 under 35 U.S.C. § 102 as anticipated by Dobbins. (Final Action 2.)

VIII. The Examiner rejects claim 33 under 35 U.S.C. § 103 as unpatentable over Dobbins and Hsu. (Final Action 10.)

ANALYSIS

Claims 1, 21, 32, and 33 are the independent claims on appeal, with the rest of the claims on appeal (i.e., claims 2–8, 11–16, 18–20, 22, and 24–31) depending directly or ultimately from either independent claim 1 or independent claim 21. (*See* Appeal Br., Claims App.)

Each of the claims on appeal recites a card (e.g., a “business card”) comprising a card portion, a flap structure, and adhesive associated with the flap structure. (Appeal Br., Claims App.)³

³ Independent claim 1 recites “four edges,” a “flap” attached along “one of the four edges,” and “adhesive” on the flap (Appeal Br., Claims App.); independent claim 21 recites a “business card body,” and a “flap” attached to the business card body that has “an adhesive area” (*id.*); independent claim 32 recites “business information on at least one side of the card,” a “means for enabling the card” to be converted” between two configurations, including an “adhesive configuration” (*id.*); and independent claim 33 recites “a portion of the business card” and an “adhesive flap” (*id.*).

Independent Claim 1

Independent claim 1 requires the flap to be “foldable with respect to the business card such that the flap can be alternately and repeatedly placed” in a “first configuration” and a “second configuration.” (Appeal Br., Claims App.) The Examiner finds that Dobbins discloses such a flap. (*See* Final Action 3.)

Dobbins discloses three embodiments of a business card 10, each having a card portion 12, a flap 13, and an adhesive 17. (*See* Dobbins, Figs. 1–10.) In the first embodiment, the flap 13 converts between a first configuration (*see id.*, Figs. 3–4) and a second configuration (*see id.*, Figs. 1–2) “as a cycle, repeatedly.” (*Id.* 5:9–15.)

Independent claim 1 requires the adhesive to be “on at least a portion of the back side of the flap.” (Appeal Br., Claims App.) In Dobbins’s first embodiment (in which the flap 13 is repeatedly folded and unfolded), the adhesive 17 is on the card portion 12, not the flap 13. (*See* Dobbins Fig. 2.) Dobbins discloses that the adhesive 17 can be located on the flap 13, rather than the card portion 12, in the second and third embodiments. (*See id.* 5:23–25, 5:65–67.) However, neither the second nor third embodiments involve repeated conversions between the first configuration and the second configuration. (*See id.* 5:16–23, 50–53.)

The Examiner determines that “[i]t would have been obvious to one of ordinary skill in the art to locate the adhesive on the flap, since it is the result of merely choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success.” (Final Action 3.) The Appellant argues that the record contains un rebutted evidence that the Examiner’s proposed modification would not have been obvious to one of ordinary skill

in the art. (*See e.g.*, Appeal Br. 19–23.) We are persuaded by the Appellant’s position.

Insofar as the Examiner is saying that, absent evidence to the contrary, one of ordinary skill in the art would infer from Dobbins’s teachings that the adhesive in the first embodiment could be re-located on the flap 13 (*see e.g.*, Final Action 11), we do not necessarily disagree. Here, however, the record includes a Declaration containing evidence that one of ordinary skill in the art would not make this inference. The Declaration explains why one of ordinary skill in the art would not modify Dobbins’s first embodiment in the proposed manner because there would be no reasonable expectation of success. (*See* Declaration ¶¶ 11–13.)⁴ And, as pointed out by the Appellant, “[t]he Examiner has presented no evidence or reasoning to counter” this explanation. (Appeal Br. 31.)

Thus, we do not sustain the Examiner’s rejection of independent claim 1 under 35 U.S.C. § 103 (Rejection I).

Dependent Claims 2–8, 11–16, and 18–20

The Examiner’s further findings and determinations with respect to these dependent claims do not compensate for the shortcomings in the rejection of independent claim 1, from which they depend. (*See* Final

⁴ Specifically, for example, the Declaration explains that, “[w]hen a person grabs the [card] portion 12 of the business card 10 to unstick the adhesive 17 from another object,” the fold line 14 will be subjected to force,” and, “[a]fter repeated cycles of that happening,” this force will “cause a tear along the fold line.” (Declaration ¶ 12.) In other words, the Declaration explains why a person of ordinary skill in the art would “quickly realize[]” that fold line 14 “would weaken and tear after just a few uses.” (Appeal Br. 16.)

Action 3–5, 7–10.) Thus, we do not sustain the Examiner’s rejections of dependent claims 2–8, 11–16, and 18–20 under 35 U.S.C. § 103 (Rejections I–V).

Independent Claim 21

Independent claim 21 requires the flap to be placeable in a “third position” which is “characterized” in that the card portion is “able to pivot” with respect to the flap “such that the back side of the [card portion] is exposed outward from [an] object.” (Appeal Br., Claims App.) The Examiner finds that “[t]he card taught by Dobbins can be placed” in such a third position. (Final Action 6.)

Independent claim 21 requires the card portion to “lie[] flat against” the object when the flap is in the third position. (Appeal Br., Claims App.) The Examiner finds that, when Dobbins’s business card 10 is placed in the third position, “[t]he Dobbins fold line would lay flat within the broadest reasonable interpretation of the claim.” (Final Action 13.) The Appellant argues that the record contains un rebutted evidence that Dobbins’s business card 10 is “incapable of lying flat” when it is in the third position. (*See* Appeal Br. 35.) We are persuaded by the Appellant’s position.

Here, the record establishes that Dobbins’s disclosed business card 10 has a simple fold line 14. (*See e.g.*, Dobbins 3:2–14, 3:40–46, Figs. 1–4.) The record also establishes, per the Declaration, that a “shortcoming of a simple fold line hinge is that it takes considerable effort to crease the paper to try to create a flexible hinge to make the note lay upside down to reveal the back side of note.” (Declaration ¶ 9.) Specifically, for example, the Declaration explains that “no matter how many times or how hard you press the fold line, it is impossible to make the note lay flat upside down.” (*Id.*)

The Examiner does not seem to dispute the explanation provided in the Declaration. Rather, the Examiner maintains that the Declaration is “not convincing” because, per the Specification, the card portion need only be “substantially or generally flat.” (Answer 6.) However, the Examiner provides no discussion, much less evidence, that Dobbins’s card portion 12 would be capable of lying substantially or generally flat in the third position as required by independent claim 21.

Independent claim 21 requires the flap to be a “plastic flap” (Appeal Br., Claims App.), and the Examiner determines that it would have been obvious to form Dobbins’s flap 13 from plastic in view of the teachings of Bay. (Final Action 6). To the extent that such a plastic flap 13 would facilitate Dobbins’s capability to lie flat in the third position, the Examiner does not discuss why this would happen. (*See id.* at 6–7; Answer 5.) And, as pointed out by the Appellant, the Examiner seems to “rel[y] exclusively on Dobbins to teach the third configuration.” (Appeal Br. 35.)

Thus, we do not sustain the Examiner’s rejections of independent claim 21 under 35 U.S.C. § 103 (Rejections I and VI).

Dependent Claims 22, and 24–31

The Examiner’s further findings and determinations with respect to these dependent claims do not compensate for the shortcomings in the rejection of independent claim 21, from which they depend. (*See* Final Action 5–7.) Thus, we do not sustain the Examiner’s rejections of dependent claims 22, and 24–31 under 35 U.S.C. § 103 (Rejections I, II, and VI).

Independent Claim 32

Independent claim 32 recites a card comprising “a means for enabling the card to be converted from an adhesive configuration to a non-adhesive configuration and vice versa.” (Appeal Br., Claims App.) The Examiner finds that Dobbins discloses, in its first embodiment (Figs. 1–4), a “flap that is placeable” into the “configurations claimed.” (Final Action 2.)

In Dobbins’s first embodiment of its business card 10, the flap 13 converts repeatedly between a first configuration and a second configuration. (*See* Dobbins 5:9–15, Figs. 1–4.) The Appellant does not appear to dispute that Dobbins’s flap 13 enables its business card 10 to be converted from an adhesive configuration to a non-configuration and vice versa. (*See* Appeal Br. 40–41.) However, the Appellant argues that the structure of Dobbins’s flap 13 is not the same as or equivalent to the structure of the flap described in the Specification. (*See id.* at 41.) We are persuaded by the Appellant’s position.

As discussed above, in Dobbins’s disclosed first embodiment of its business card 10, the adhesive 17 is located on the card portion 12, not the flap 13. (*See* Dobbins Fig. 2.) This structurally differs from the Appellant’s described flap, in which the adhesive is located on the flap. (*See* Spec. ¶¶ 43, 44, 48, 50, Figs. 1–7.) And, as pointed out by the Appellant, the Examiner does not explain why, despite this different location of the adhesive, Dobbins’s flap 13 can be considered structurally equivalent to the flap disclosed in the Specification. (*See* Appeal Br. 41.)⁵

⁵ As for the second and third embodiments of Dobbins’s business cards, the adhesive 17 is located on the flap 13. (*See* Dobbins, 5:23–25, 65–67.) However, the flaps 13 in the second and third embodiments do not perform the function recited in independent claim 32. In the second embodiment,

Thus, we do not sustain the Examiner's rejection of independent claim 32 under 35 U.S.C. § 102 (Rejection VII).

Independent Claim 33

Independent claim 33 requires the step of “turning the business card over 180° while the adhesive remains adhered to [an] object so that the business card lies flat against [the object] to reveal indicia on the back side of the business card.” (Appeal Br., Claims App.) The Examiner finds that Dobbins does not teach this turning step. (Final Action 10.) However, the Examiner determines that “[i]t would have been obvious to one of ordinary skill in the art to use the Dobbins card with the additional step of turning 180 degrees to view the back as taught by Hsu, in order to make use of more area for notetaking.” (Final Action 10.)

Independent claim 33 requires the 180° turned business card to “lie[] flat against” the object to which the adhesive is adhered. (Appeal Br., Claims App.) As with independent claim 21, the Examiner finds that “[t]he Dobbins fold line would lay flat” (Answer 6); and the Appellant argues that the Declaration evidences otherwise. For the same reasons as discussed above in connection with independent claim 21, we are persuaded by the Appellant's position.

Thus, we do not sustain the Examiner's rejection of independent claim 33 under 35 U.S.C. § 103 (Rejection VIII).

when the business card 10 is in the adhesive configuration, the flap 12 is separated from the portion 12, and the business card 10 can no longer be converted to a non-adhesive configuration. (*See id.* 5:20–21). In the third embodiment, when the business card 10 is in the adhesive configuration, the flap 13 can be moved to enable the business card 10 to return a non-adhesive configuration, but not vice versa. (*See id.* 5:53–59.)

CONCLUSION

Claims Rejected	Basis	Affirmed	Reversed
1–8, 11, 12, 15, 16, 18, 21, 22	§ 103 Dobbins, Laurence		1–8, 11, 12, 15, 16, 18, 21, 22
13, 24	§ 103 Dobbins, Laurence, Bay		13, 24
14	§ 103 Dobbins, Laurence, Bay, Drexler		14
19	§ 103 Dobbins, Laurence, and Mertens		19
20	§ 103 Dobbins, Laurence, Bay, Mertens, Van Ohsen, Meetze		20
21–23, 25–31	§ 103 Dobbins, Bay		21–23, 25–31
32	§ 102 Dobbins		32
33	§ 103 Dobbins, Hsu		33
Overall Outcome			1–8, 11–16, 18–22, 24–31–33

REVERSED