members involved in the private and commercial earth station business. See In re The Officers' Organization for Economic Benefits, Ltd., 221 USPQ 184 (TTAB 1983) (THE OFFICERS' ORGANIZATION FOR ECONOMIC BENEFITS held merely descriptive of applicant's services of providing personal financial and other services), In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held merely descriptive of the services of conducting and arranging trade shows in the hunting, shooting and outdoor sports products field), and Nationwide Consumer Testing Institute v. Consumer Testing Laboratories, 159 USPQ 304 (TTAB 1968) (CONSUMER TESTING LABORATORIES held merely descriptive of the services of conducting tests and analyses on fibers, fabrics, garments and other materials).

[2] With respect to the application to register the mark SPACE for the same services, the examining attorney contends variously that this term describes the fact that the industry which applicant promotes "involves (outer) space" and that the term refers to the fact that applicant's services involve space communications or communications outside of the earth's atmosphere. It seems to us, however, that while the term SPACE may have some general relationship to applicant's trade association services on behalf of its members because they make, sell or use earth stations which receive messages from satellites orbiting in space, it cannot be said that this term *immediately* describes applicant's services. Rather, the term SPACE only suggests the general field in which its members operate (space-related communications or technology) and some imagination, thought or perception is required to reach a conclusion concerning the nature of applicant's services. Accordingly, we agree with applicant that the term at most only suggests applicant's services and does not merely describe them.[4] See In re Recovery, Inc., 196 USPQ 830 (TTAB 1977).

[3] Finally, with respect to the application to register the composite mark reproduced above, we disagree with the Examining Attorney that the mark as a whole is merely descriptive. Rather, as we have held above, the word SPACE, the dominant literal portion of the mark, is only suggestive of applicant's services. Accordingly, we find that, as a whole, applicant's mark is not merely descriptive. However, in accordance with Office practice, registration is not allowed in the absence of disclaimers of the descriptive phrase SOCIETY FOR PRIVATE AND COMMERCIAL EARTH STATIONS and the representation of the earth station which forms part of applicant's mark. With respect to that design, we note that the Examining Attorney has argued that the design is of a non-fanciful representation of an earth station, the primary product made, sold and used by applicant's members, and applicant has offered no argument in rebuttal. Indeed, at the oral hearing, counsel for applicant, while arguing that the design was not merely descriptive, did not contend that the representation is fanciful. In view of these circumstances, we find that disclaimers of the representation and the words SOCIETY FOR PRIVATE AND COMMERCIAL EARTH STATIONS are warranted.

Under the circumstances, the refusal to register in Serial No. 403,886 is affirmed, but applicant is allowed until thirty days from the date of this decision in which to submit disclaimers of the representation of the earth station and the phrase SOCIETY FOR PRIVATE AND COMMERCIAL EARTH STATIONS. Trademark Rule 2.142(g). If applicant submits the required disclaimers during the time allowed, the refusal to register in this application will be set aside.

Decision:

The refusal to register in Serial No. 403,885 is affirmed; the refusal to register in Serial No. 403,887 is reversed; and the refusal to register in Serial No. 403,886 is affirmed except as indicated above.

[4] Applicant also points out that the term SPACE is an acronym for its former corporate name — *Society for Private And Commercial Earth Stations*. However, because it is not obvious to us that the term SPACE would be perceived as an acronym, this fact has been given little consider-

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Patent and Trademark Office
Board of Appeals

Ex parte Chicago Rawhide Manufacturing Company

Opinion dated Feb. 22, 1984

PATENTS

1. Reissue — In general (§58.1)

Examiner's mere reliance on reference, to evidence obviousness of particular feature of

claim pending during prosecution of application but cancelled prior to patent grant, is not sufficient to justify holding that "substantial new question of patentability affecting" claim has not been raised by citation of that patent during reexamination proceeding.

Particular patents — Stroke Molding

Christiansen and Anderson, No. 3,936,257, Closed Stroke Molding, rejection of claims 1-6 reversed.

Appeal from Art Unit 147.

Reexamination, No. 90/000,002, filed July 1, 1981, of No. 3,936,257, issued Feb. 3, 1976, application, Serial No. 155,469, filed June 22, 1971. From decision rejecting claims 1-6, patentee appeals (Appeal No. 552-52). Reversed.

James T. FitzGibbon, Chicago, Ill., for appellant.

Before Serota, Pellman, and Lovell, Examiners-in-Chief.

Serota, Examiner-in-Chief.

This appeal is from the Examiner's decision finally rejecting claims 1 through 6. Claims 1, 2 and 3 correspond to the claims of the here involved patent. Claims 4, 5 and 6 were added during the proceedings before the Examiner, which proceeding resulted from the granting of a request by a third party, Federal-Mogul Corp., that the appellant's patent be reexamined. The Examiner at page 4 of his answer, indicates that claim 6 is allowable and that claims 3 and 5 would be allowable if rewritten in independent form or made to depend from an allowed claim. Accordingly, this appeal is dismissed as to claims 3, 5 and 6, leaving for our consideration the Examiner's refusal to allow claims 1, 2 and 4.

Claim 1 is illustrative of the subject matter to which the claims on appeal are directed and reads as follows:

1. A mold assembly for forming an insert molded article comprised of a relatively rigid insert element and a flexible body portion, said mold assembly comprising a first, fixed mold part having surfaces thereon defining at least a portion of a molding cavity, and second and third relatively movable mold parts, at least one of which includes surfaces thereon defining the remainder of said molding cavity, insert-receiving surfaces forming a part respectively of each of said second and third mold parts, means confining said second and third mold parts to a predetermined extent of movement along a given axis relative to said first part, spring means providing resistance to movement of said third part during one portion of said predetermined movement extent when said second and third mold parts move toward said fixed mold part, means for moving said second part away from said third part along said axis to open said second and third parts and to permit positioning of an insert element between said insert-receiving surfaces, and means for moving said second and third parts along said axis against the resistance of said spring while said insert is received between said second and third parts against the resistance of said spring.

The sole reference now relied upon by the Examiner in support of his rejection is:

Baney et al. (hereafter Baney)	3,315,316	Apr. 25, 1967

The Examiner has rejected the claims on appeal under 35 USC § 103 as obvious from Baney.

The owner-appellant (hereinafter appellant) has traversed the Examiner's rejection, and in addition has questioned the propriety of this entire reexamination proceeding. In effect, the appellant has asserted that since the Baney reference was considered by the Patent and Trademark Office prior to the granting of the here involved patent, it is improper to subject the patent to a reexamination procedure based upon the Baney patent.

We will first consider the issue raised by the appellant regarding the propriety of this reexamination proceeding. In substance, the appellant contends that since prior to the issuance of the here involved patent, the Board of Appeals reversed the then outstanding rejections based upon the same evidence as now being relied upon in support of the current rejection, it is improper for the Examiner to maintain the rejection. The appellant based its position on an analogy to the legal doctrine of "resjudicata" or "law of the case". The appellant urges that the Examiner has no authority, in effect, to overrule the decision by the Board of Appeals, pursuant to

Ex parte Rawlinski 226 PQ 438

MOTIVATION TO MAKE CHANGES

[1] A review of the patent file reveals that in the first Office action on the merits, several of the claims then in the application were rejected under 35 USC § 103 as unpatentable over a Jackson patent in view of Baney, McKinven or Bush. In the response to that rejection, the claims elected for prosecution and which were rejected were cancelled and new claims were added. These new claims were subsequently rejected based solely on the Jackson reference. The Examiner did not maintain his rejection which included the Baney reference. The Examiner's rejection based solely upon Jackson was appealed to the Board of Appeals. The Baney reference was not discussed in the appeal brief, the Examiner's Answer, or the Board's decision. Thus, contrary to the appellant's assertions in his brief before this panel, the Board of Appeals has not previously overruled a rejection based upon Baney. As far as can be determined from the written record, the Board has not had an occasion to consider an Examiner's rejection based upon the Baney reference. In such circumstances, even assuming that the doctrine of "res judicata" or "law of the case" is here applicable, there is no question of "res judicata" or "law of the case" that would have precluded the Examiner in this proceeding from maintaining a rejection based upon the Baney reference. The mere reliance on a reference to evidence the obviousness of a particular feature of a claim pending during the prosecution of an application prior to the issuance of a patent, which claim is cancelled prior to the granting of the patent, is not sufficient to justify a holding that "a substantial new question of patentability affecting" a claim of a patent has not been raised by the citation of that patent. The public interest may demand a finding that "a substantial new question of patentability affecting" a patent claim has been raised where a reference cited during the prosecution of the patent is presented and viewed in a different light than it was considered during the prosecution of the application which issued as a patent. The public interest in valid patents intended to be served by the patent reexamination sections of the patent laws cannot be disregarded where a reasonable new interpretation of a reference disclosure is presented for the first time via a request for reexamination. This is especially true, where, as here, the reference had previously been considered in a secondary manner for a very limited purpose. Compare with In re Riddle, 58 CCPA 983, 438 F.2d 618, 169 USPQ 45, 47 (penultimate paragraph). Under the facts here present we find that there was no reason why the Examiner was here precluded from bottoming a

In our view the here claimed subject matter would not have been obvious within the meaning of 35 USC § 103 based solely on the Baney patent. As correctly urged by the appellant, and as apparently recognized by the Examiner, in order to meet the terms of the claims on appeal, the elements of the Baney device would have to be arranged in a manner different from that disclosed by Baney. The elements of the reference would also be required to coact differently from the way they coact in the arrangement disclosed by the reference. The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the Baney device to render the here claimed device unpatentable. We additionally note that the interrelationship and the relative movements of the various elements required by the claims on appeal would not be met by the Baney device even if reconstructed as suggested by the Examiner. The requirements of appealed claim 1, commencing with the phrase "spring means providing * * *" just are not met even if elements 31, 15 and 36 of Baney are designated respectively as first, second and third mold parts as suggested by the Examiner. The requirements of this portion of the claim cannot be ignored. The coaction of the elements required in the claims on appeal would not be present in the Baney device as modified by the Examiner.

Accordingly, the Examiner's rejection is not sustained. The decision of the Examiner is reversed.

REVERSED

Minnesota Court of Appeals

Aries Information Systems, Inc.
v. Pacific Management Systems Corporation et al.

No. C5-84-1301
Decided Apr. 23, 1985

UNFAIR COMPETITION

1. Trade secrets — In general (§68.901)

Computer program system that has inde-