

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDY B. REYNOLDS

Appeal No. 2004-0356
Application 09/811,993

ON BRIEF

Before COHEN, FRANKFORT, and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 61 through 67, 69 through 72 and 74. Claims 68 and 73, the only other claims remaining in the application, stand objected to as being dependent upon a rejected base claim, but have been indicated by the examiner to be allowable if rewritten in independent form including all of the limitations of

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the base claim and any intervening claims. Claims 1 through 60 have been canceled.

As seen in Figures 1 and 11, appellant's invention generally relates to a cantilevered, deflectable, merchandising/advertising display assembly (10) having illumination means (52) provided thereon. The merchandising display assembly is designed for placement so as to extend transversely into a shopping aisle from a merchandise storage site. It is important to appellant that advertising materials carried by the display assembly be viewable from both sides of the display as customers are approaching the display from either end of the shopping aisle, and that the display allow for temporary deflections should passersby inadvertently bump the display and thus deflect it from its usual orthogonal position relative to the shopping aisle (specification, page 5). As noted on page 16 of the specification,

what the present invention offers is an at-or-proximate shelf merchandising display device which is illuminated, battery powered, and which serves to draw attention to a variety of store goods.

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The invention also addresses a method of advertising products (i.e., point-of-purchase advertising) utilizing a deflectable, lighted merchandising display like that described above.

Independent claims 61 and 74 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellants' brief (Paper No. 19).

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Sernovitz	4,317,303	Mar. 2, 1982
Boggess et al. (Boggess)	4,805,331	Feb. 21, 1989

Claims 61 through 67, 69 through 72 and 74 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boggess in view of Sernovitz.

Rather than reiterate the examiner's full statement of the above-noted obviousness rejection and the conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the examiner's answer (Paper No. 20, mailed

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April 16, 2003) for the examiner's reasoning in support of the rejection, and to appellant's brief (Paper No. 19, filed January 21, 2003) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination which follows.

In considering the examiner's rejection of claims 61 through 67, 69 through 72 and 74 under § 103(a), we note that Boggess discloses a cantilevered, deflectable, point-of-purchase merchandising display apparatus (10) for placement so as to extend transversely into a shopping aisle from a merchandise storage site. Like appellant, it is important to Boggess that advertising materials carried by the display assembly be in direct view, from both sides of the display, as customers are approaching the display from either direction along the store aisle (col. 3, lines 47-50), and that the display allow for

temporary deflections should passersby inadvertently strike the display with a shopping cart and thus deflect it from its usual orthogonal position relative to the shopping aisle (col. 3, lines 54-66). A principal objective of the display apparatus in Boggess is to attract a customer's attention to a featured item at a location on a shelf as the customer approaches the area of the shelf where the item can be found and thereby focus attention on the featured item in an attempt to influence the customer's purchase decision at the earliest possible time. Like appellant, Boggess discusses the fact that advertising signage mounted across the front of a store shelf (i.e. parallel to the shopping aisle) is out of direct view of approaching customers and thus is less effective than an advertising display apparatus like that described in Boggess extending perpendicular to the shopping aisle which is visible from the time a customer enters the aisle (col. 1, lines 33-36).

The advertising display apparatus of Boggess includes a clamp or mounting clip (82) by which the apparatus is releasibly attached to a shelf tag molding (12) at a merchandise storage site along a shopping aisle; an advertising carrier or frame (16) disposed at a distal portion of the apparatus; advertising

information (22) disposed in the carrier frame; and a support bracket (18) interposed between the clamp (82) and the carrier frame (16), the support bracket removably and deflectably holding the carrier frame so that the frame normally cantilevers transversely into the shopping aisle. As recognized by the examiner, what the advertising display apparatus of Boggess lacks relative to appellant's claimed advertising display assembly is any teaching of or reference to providing a source of illumination (i.e., lights) on the display apparatus.

To account for this difference, the examiner looks to Sernovitz, noting that this patent shows an illuminated display device that includes a plurality of lights (25) thereon surrounding a display area and a source of power (e.g., battery 26) carried by the display device. Sernovitz indicates (col. 1, lines 5-8) that the display device therein is for use on "display racks, shelving or the like for retail merchandise." While Sernovitz shows one possible mounting means for the display apparatus as a pair of tines (55), it is expressly indicated in column 3, lines 34-36, that alternative supporting means may be provided, "such as adhesive mounting means . . . , easel means, hanging means and the like." Sernovitz notes that the lights

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(25) on the display device may be any suitable light source, but are preferably low-voltage lamps which produce negligible heat, and further indicates that the circuit components for the lights may include timing circuitry for blinking the light elements on and off (col. 2, lines 39-43).

Based on the collective teachings of Boggess and Sernovitz, the examiner has concluded that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to modify the apparatus of Boggess by including lights and a source of electrical power on the carrier frame (16) of the display apparatus therein, as generally taught by Sernovitz, since this would allow the display apparatus of Boggess to emit a flashing, attention-grabbing visual display and thereby better attract customer attention to a featured item located along a store aisle as the customer approaches the area of a shelf on which the featured item is stored.

We concur in the examiner's assessment of obviousness of the claimed subject matter under 35 U.S.C. § 103(a) based on the combined teachings of Boggess and Sernovitz. Unlike appellant, we are of the opinion that the examiner has clearly established a

prima facie case of obviousness and has not engaged in hindsight reconstruction based on appellant's disclosure and claims. While it is true that Boggess alone does not disclose an attention-attracting, lighted display device for mounting on a supermarket display shelf so that the display normally cantilevers transversely into the shopping aisle, we share the examiner's view that one of ordinary skill in the art would have derived ample suggestion and motivation from the collective teachings of the applied patents, and particularly the illuminated display apparatus seen in Sernovitz, for enhancing the attention grabbing ability of the advertising display apparatus of Boggess by providing the display apparatus of Boggess with lighting mounted on or in the carrier frame (16) which can be seen by customers approaching the display apparatus from either direction along the aisle and thereby focus attention on a featured item at an even earlier time, e.g., as the customer enters the shopping aisle, especially when the lighting on the display device is flashing or blinking on and off as suggested in Sernovitz. We consider that one of ordinary skill in the art would have immediately recognized that such a combination of features would more effectively fulfill the desires in Boggess of a) directing customer attention to a featured item at a location on a shelf

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where the item can be found (col. 2, lines 9-11) and b) having the advertising display apparatus and promotional material or advertisement message carried thereby "dominate at the moment of the customer's purchase decision" (col. 3, lines 55-56).

As for appellant's depictions on pages 14 and 15 of the brief showing different attempted bodily incorporations of the display device of Sernovitz wholly into, or attachment onto, the display apparatus of Boggess, we note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art at the time of appellant's invention. See, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In the present case, given the common goal in both Boggess and Sernovitz of attracting attention of potential customers to a particular product carried on a store shelf, and the self-evident advantage of lighting, particularly, flashing lighting as in Sernovitz, to attract such customer attention, we concur in the examiner's position that the combined

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teachings of the applied references would have reasonably suggested to one of ordinary skill in the art at the time of appellant's invention adding light sources and a battery power source to the frame of the advertising display apparatus of Boggess so as to achieve the advantage of improving the ability of that advertising display to attract customer attention to a particular product on a store shelf. In reaching this conclusion, we have presumed skill on the part of the artisan, rather than the converse. See In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir 1985).

In further response to appellant's arguments in the brief concerning combinability of the applied references, we also observe that where the issue is one of obviousness under 35 U.S.C. § 103, the proper inquiry should not be limited to the specific structure shown by a reference, but should be into the concepts fairly contained therein, with the overriding question to be determined being whether those concepts would have suggested to one skilled in the art the modification called for by the claims. See In re Bascom, 230 F.2d 612, 614, 109 USPQ 98, 100 (CCPA 1956). Furthermore, under 35 U.S.C. § 103, a reference must be considered not only for what it expressly teaches, but

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also for what it fairly suggests (In re Burckel, 592 F.2d 1175, 179, 201 USPQ 67, 70 (CCPA 1979); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976)), as well as the reasonable inferences which the artisan would logically draw from the reference. See In re Shepard, 219 F.2d 194, 197, 138 USPQ 148, 150 (CCPA 1963).

Contrary to appellant's assertion in the brief (page 9), we do not see that Boggess in any way "admits to being incompatible with the Sernovitz-type of point-of-purchase signs." Moreover, although the illuminated display device of Sernovitz may not be mounted so as to protrude into a store aisle like the display apparatus of Boggess, we find nothing in Sernovitz which in any way limits placement of the display device therein to an orientation parallel to a store aisle and across the front of a shelf, as appellant seems to imply in the argument spanning pages 9-10 of the brief. Nor do we perceive that Boggess and Sernovitz in any way "teach away" from the present invention.

As for appellant's contention that "the law of issue preclusion mandates reversal here based upon the results in the parent appeal as to claims very similar in limitations to the

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present claims" (brief, page 51), we do not share appellant's view that the claims now before us on appeal are in any way "very similar in limitations" to the claims addressed in prior Appeal No. 1998-0234 in parent Application No. 08/406,752 (now U.S. Patent No. 6,438,882). The claims before us in the present appeal are clearly much broader in scope than the claims of the parent application. In addition, we note that the examiner's current rejection under 35 U.S.C. § 103 relying on the collective teachings of Boggess and Sernovitz was not an issue in the earlier appeal. Thus, the doctrine of Issue Preclusion (whether viewed as *res judicata*, law of the case, or collateral estoppel) has no bearing on the present appeal.

With respect to the arguments presented on pages 27-50 of the brief addressing appellant's rebuttal evidence in the form of several declarations pertaining to secondary considerations filed on December 26, 2002 and January 13, 2003, we note that the examiner has refused entry of such evidence as being untimely filed (Paper No. 16, mailed January 29, 2003), and further observe that the decision of the examiner refusing entry and consideration of such evidence was upheld on petition (see Decision on Petition, Paper No. 22, mailed June 2, 2003).

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Accordingly, we have not considered any argument pertaining to such non-entered evidence in reaching our decision in the present appeal.

In light of the foregoing, the examiner's rejection of claims 61 through 67, 69 through 72 and 74 under 35 U.S.C. § 103(a) will be sustained.

Notwithstanding appellant's request on page 5 of the brief that the Board rule separately on the patentability of each appealed claim, we note that appellant has not presented arguments directed to any specific claim on appeal and failed to separately argue the patentability of each of the claims on appeal. Thus, we have concluded that claims 62 through 67, 69 through 72 and 74 will fall with representative independent claim 61. See, In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

The decision of the examiner rejecting claims 61 through 67, 69 through 72 and 74 under 35 U.S.C. § 103(a) is affirmed.

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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
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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