

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KURT MONIGLE, CHARLES A. HAHN and THOMAS WILSON

Appeal No. 2004-0366
Application No. 09/848,044

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 7, mailed November 25, 2002) of claims 1, 2, 7 to 9 and 15 to 25. Claims 4 to 6, 11 to 14, 26 and 27, the only other claims pending in this application, have been allowed.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to signs and support structures for suspending a plurality of signs. In one embodiment of the appellants' invention, the invention relates to suspending a plurality of signs which are disposed adjacent to corresponding parking places of a parking lot (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Ferguson et al. (Ferguson)	580,682	Apr. 13, 1897
Mudd	831,973	Sept. 25, 1906
Barnes	2,364,419	Dec. 5, 1944
Steenhoudt	3,508,741	Apr. 28, 1970
Luikkonen	5,355,603	Oct. 18, 1994
Meuse	GB 878,550	Oct. 4, 1961
Zachner	CH 389,004 ¹	June 30, 1965

Claims 20, 22 and 23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

¹ In determining the teachings of Zachner, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellants' convenience.

Claims 1, 2, 7, 15 to 21, 24 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mudd.

Claims 1, 2, 15, 18 to 21, 24 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Zachner.

Claims 22 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mudd in view of Meuse or Luikkonen.

Claims 22 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zachner in view of Meuse or Luikkonen.

Claims 1, 2, 7 to 9, 15 to 21, 24 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ferguson in view of Steenhoudt or Barnes.

Claims 22 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ferguson in view of Steenhoudt or Barnes as applied to claim 21 above, and further in view of Meuse or Luikkonen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 15, mailed August 12, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 11, filed May 27, 2003) for the appellants' arguments thereagainst.

OPINION

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

The indefiniteness rejection

We sustain the rejection of claims 20, 22 and 23 under 35 U.S.C. § 112, second paragraph.

In the final rejection (p. 2) and the answer (p. 3), the examiner set forth his rationale as to why claims 20, 22 and 23 were indefinite.

The appellants have not specifically contested this rejection in the brief. Accordingly, we summarily sustain the rejection of claims 20, 22 and 23 under 35 U.S.C. § 112, second paragraph.

The anticipation rejection based on Mudd

We will not sustain the rejection of claims 1, 2, 7, 15 to 21, 24 and 25 under 35 U.S.C. § 102(b) as being anticipated by Mudd.

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. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claims 1, 18 and 21, the independent claims under appeal, read as follows:

1. A sign system adapted for use with a parking lot, the parking lot including a plurality of parking spaces, said sign system comprising:
 - (a) at least first and second monuments;
 - (b) a plurality of signs, each being disposed adjacent to and bearing indicia identifying a corresponding one of the plurality of parking spaces;
 - (c) at least first and second cable segments suspended between said first and second monuments in a spaced relationship to each other, each of said plurality of signs being affixed to both of said first and second cable segments in a steadying relationship; and
 - (d) said first monument includes first and second weights, each of said first and second weights coupled respectively to a corresponding one of said first and second cable segments, whereby tension is applied to each of said first and second cable segments.

18. A sign system for use with an area divided into a plurality of spaces, said sign system comprising:
 - (a) at least first and second monuments;
 - (b) a plurality of signs bearing indicia identifying a corresponding one of the plurality of spaces;
 - (c) at least one cable segment suspended between said first and second monuments and affixed to each of said plurality of signs, whereby each of said plurality of signs is disposed adjacent to and bearing indicia identifying a corresponding one of the plurality of spaces; and
 - (d) at least one of said first and second monuments including a weight affixed to said cable segment, whereby tension is applied to said cable segment.

21. A wind resistant sign system comprising:
 - (a) at least one cable segment suspended under tension along an axis;and
 - (b) a sign suspended from said one cable segment, said sign having first and second edges oriented substantially perpendicular to said axis and being configured such that the wind primarily spills around said first and second edges, whereby the wind tends to rotate said sign about said axis and said at least one cable segment tends to constrain such rotational motion.

Mudd discloses an advertising device designed to extend across a street or thoroughfare and to exhibit moving advertising signs, bulletins, and the like. Mudd teaches, as shown in Figure 1, a system for suspending a plurality of the advertising signs 6 by a cable 5 and guide cables 16. The cable 5 and guide cables 16 are suspended in a parallel relationship to each other to extend over the street between a pair of sheds 3 and 4 situated on top of houses or buildings 1 and 2. The cable 5 is continuous and passes over a pair of pulleys 7 (disposed in shed 4) and a grooved pulley 8 (disposed in shed 3). The grooved pulley 8 is connected to a drive shaft 9, which may be rotated by a crank-handle 22 or by a motor. The guide cables 16 are attached in any desired manner to a pair of stop boards or plates 13 mounted to the sheds 3 and 4.

The appellants argue (brief, pp. 7-10) that (1) claim 1 is not anticipated by Mudd since Mudd lacks the first and second weights (i.e., "each of said first and second weights coupled respectively to a corresponding one of said first and second cable segments, whereby tension is applied to each of said first and second cable segments"); (2) claim 18 is not anticipated by Mudd since Mudd lacks "a weight affixed to said cable segment, whereby tension is applied to said cable segment;" (3) claim 21 is not anticipated by Mudd since Mudd lacks a sign suspended from one cable segment

having an axis, wherein the sign has first and second edges oriented substantially perpendicular to the axis and the sign "being configured such that the wind primarily spills around said first and second edges, whereby the wind tends to rotate said sign about said axis and said at least one cable segment tends to constrain such rotational motion." We agree.

The examiner's position (answer, pp. 4 and 8-12) with respect to claims 1 and 18 that the claimed weights are readable on Mudd's grooved pulley 8 and the eye fastener shown in Figure 1 which attaches the guide cable 16 to shed 3 is totally without merit for the reasons set forth in the brief. In that regard, Mudd's grooved pulley 8 is not a weight which applies tension to the cable 5. Likewise, Mudd's eye fastener is not a weight which applies tension to the guide cable 16.

The examiner's position (answer, pp. 4 and 11-12) with respect to claim 21 is that the claimed sign configured such that the wind primarily spills around "said first and second edges, whereby the wind tends to rotate said sign about said axis and said at least one cable segment tends to constrain such rotational motion" is readable on Mudd's sign 6. We do not agree. In that regard, the appellants' sign is configured as shown in Figures 6A-6C to cause the wind to primarily spill off of the vertical edges

64a and 64b of the sign faces 50a and 50b, respectively as explained on pages 14-15 of the specification. The examiner's position that Mudd's sign 6 is inherently configured as claimed is sheer speculation.² As such, the examiner has not established the claim 21 is anticipated by Mudd.

Since all the limitations of claims 1, 18 and 21 are not disclosed in Mudd for the reasons set forth above, the decision of the examiner to reject claims 1, 18 and 21, and claims 2, 7, 15 to 17, 19, 20, 24 and 25 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Mudd is reversed.

The anticipation rejection based on Zachner

We will not sustain the rejection of claims 1, 2, 15, 18 to 21, 24 and 25 under 35 U.S.C. § 102(b) as being anticipated by Zachner.

² It is well-settled that under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

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. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Zachner's invention relates to a device equipped with advertisements designed to reserve spaces or block streets or in exhibits. The device includes a pair of cables 1 extending between posts 5 and 6 to suspend signs 8 (plane facings containing advertisements), as shown in Figure 1. A first end of each of the cables 1 is connected directly to the post 5 by a loop 3. The upper cable 1 extends from the post 5 to the left as shown in Figure 1 and is secured to the top of each of the signs 8. In a similar fashion, the lower cable 1 extends from the post 5 to the left in a manner that engages the lower edge of each of the signs 8. The other end of each of the cables 1 is connected to a tension spring 7, which in turn, is connected by a hang-up hook 4 to the post 6.

The appellants argue (brief, pp. 11-13) that (1) claim 1 is not anticipated by Zachner since Zachner lacks the first and second weights (i.e., "each of said first and second weights coupled respectively to a corresponding one of said first and second cable segments, whereby tension is applied to each of said first and second cable segments"); (2) claim 18 is not anticipated by Zachner since Zachner lacks "a weight affixed to said cable segment, whereby tension is applied to said cable segment;" (3) claim 21 is not anticipated by Zachner since Zachner lacks a sign suspended from one cable segment having an axis, wherein the sign has first and second edges oriented substantially perpendicular to the axis and the sign "being configured such that

the wind primarily spills around said first and second edges, whereby the wind tends to rotate said sign about said axis and said at least one cable segment tends to constrain such rotational motion." We agree.

The examiner's position (answer, pp. 4-5 and 12-15) with respect to claims 1 and 18 that the claimed weights are readable on Zachner's springs 7 is totally without merit for the reasons set forth in the brief. In that regard, Zachner's spring 7 is not a weight which applies tension to the cable 1.

The examiner's position (answer, pp. 4-5 and 15) with respect to claim 21 is that the claimed sign configured such that the wind primarily spills around "said first and second edges, whereby the wind tends to rotate said sign about said axis and said at least one cable segment tends to constrain such rotational motion" is readable on Zachner's sign 8. We do not agree. In that regard, the appellants' sign is configured as shown in Figures 6A-6C to cause the wind to primarily spill off of the vertical edges 64a and 64b of the sign faces 50a and 50b, respectively as explained on pages 14-15 of the specification. The examiner's position that Zachner's sign 6 is inherently configured as claimed is sheer speculation. As such, the examiner has not established the claim 21 is anticipated by Zachner.

Since all the limitations of claims 1, 18 and 21 are not disclosed in Zachner for the reasons set forth above, the decision of the examiner to reject claims 1, 18 and 21, and claims 2, 15, 19, 20, 24 and 25 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Zachner is reversed.

The obviousness rejection based on Ferguson in view of Steenhoudt or Barnes

We will not sustain the rejection of claims 1, 2, 7 to 9, 15 to 21, 24 and 25 under 35 U.S.C. § 103 as being unpatentable over Ferguson in view of Steenhoudt or Barnes.

Ferguson's invention relates to a sign that is particularly adapted to be mounted upon a wire fence. Referring to Figure 1, there is shown first and second unnumbered posts for suspending therebetween a plurality of wires A that are disposed horizontally and essentially parallel with respect to each other. The wires A are shown as being secured to the posts by a fastener, which is not described or mentioned in the written specification. Ferguson teaches that an advertising sign B is secured to the wires A by a wire or ribbon C, which passes through two perforations b that are disposed at the opposite edges of the sign B. The sign B is secured to the horizontal wires A by wrapping the ends of each ribbon C about its wire A. As the ribbon C passes through the perforations b, it is bent, as indicated at d, so that when the bent d is turned into the

plane of the sign B, a torsion or twist is given a transverse arm whereby the bent d bears against and holds the sign B under tension (see lines 46-53).

Steenhoudt relates to a corner device B, best shown in Figures 2-4, for tensioning a plurality of horizontally disposed wires 1, which comprise a fence as shown in Figure 1. The corner device B comprises a tubular post 3 and a pair of shafts 7 and 7'. The tubular post 3 has two vertical lines or rows of holes 5 and 5'. The holes 5 and 5' are spaced from each other by a distance equal to the vertical spacing between adjacent wires 1 and 1' of the fence. Each of the shafts 7 and 7' has a line of holes 6 and 6', which are aligned with the holes 5 and 5' through the tubular post 3. In use, the horizontally disposed wires 1 of a first section or panel A of the fence are aligned with and inserted through a line of the holes 5 in the tubular post 3 and into the corresponding holes 5 of the shaft 7. The opposing ends 10 of each shaft 7 are rotatably mounted in corresponding bores 11 of a lower post enclosing plate 9 and bores 16 of an upper post enclosing plate 15. The ends of each of the shafts 7 and 7' are of polygonal shapes 17 and 17', whereby a standard wrench may engage and rotate the shafts 7 and 7', and the fence is tensioned. In particular, the wires 1 and 1' are wrapped around their respective shafts 7 and 7'. To lock the position of the shafts 7 and 7' with respect to the tubular post 3, a pin or like member 18 is inserted through an opening 19 within the tubular post 3 and into a hole 20 of the shaft 7 and 7', thereby

locking the shaft 7 or 7' in a position that maintains the wires 1 of the fence under tension.

Barnes relates to a fence post 10, as shown in Figures 1-3, for suspending thereto a plurality of horizontally disposed wires 17, which are disposed parallel to each other. A plurality of pairs of tongues (18-19, 20-21, 22-23 etc.) are disposed along the vertical length of the fence post 10. As best shown in Figures 2 and 3, the tongues of each pair are bent in opposite directions, e.g., the tongue 14 is turned downwardly while the other tongue 15 of the pair is turned upwardly. Adjacent wires 17 engage respectively first and second pairs of tongues, whereby corresponding tongues of the first and second pairs are bent in opposite directions; for example, tongue 18 is bent upward and tongue 14 is bent downward. The wires 17 are mounted upon the fence post 10 by slipping a wire 17 under one tongue and then the other tongue of its pair. The tongues are not bent to clamp or engage their wires 17 as would prevent movement of the wires 17 due to changes in temperature, wind pressure or damage suffered by one climbing on the fence. As a result, all of the wires 17 mounted by the fence post 10 tend to remain under the same tension that was created by the original stretching of the fence. Further as a result of the use of these tongues, each of the plurality of wires 17 suspended from a single fence post 10 is connected thereto with the same degree of tightness.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Ferguson and claim 1, it is our opinion that one difference is the limitation that the first and second weights are "coupled respectively to a corresponding one of said first and second cable segments, whereby tension is applied to each of said first and second cable segments." Based on our analysis and review of Ferguson and claim 18, it is our opinion that one difference is the limitation that a weight is "affixed to said cable segment, whereby tension is applied to said cable segment." Based on our analysis and review of Ferguson and claim 21, it is our opinion that one difference is the limitation that the sign "being configured such that the wind primarily spills around said first and second edges, whereby the wind tends to rotate said sign about said axis and said at least one cable segment tends to constrain such rotational motion."

The examiner's position (answer, pp. 6 and 17-21) with respect to claims 1 and 18 that the claimed weights are readable on Ferguson's fasteners which secure the wires A to the posts is totally without merit for the reasons set forth in the brief (pp. 20-

23). In that regard, Ferguson's fastener is not a weight which applies tension to the wire A.

The examiner's position (answer, pp. 6-7 and 20) with respect to claim 21 is that the claimed sign configured such that the wind primarily spills around "said first and second edges, whereby the wind tends to rotate said sign about said axis and said at least one cable segment tends to constrain such rotational motion" is readable on Ferguson's sign B. We do not agree. As set forth above, the appellants' sign is configured to cause the wind to primarily spill off of the vertical edges 64a and 64b of the sign faces 50a and 50b. The examiner's position that Ferguson's sign B is inherently configured as claimed is sheer speculation.

Since the teachings of Steenhoudt or Barnes would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified Ferguson to make up for the above-noted deficiencies of Ferguson discussed above regarding claims 1, 18 and 21, the decision of the examiner to reject claims 1, 18 and 21, and claims 2, 7 to 9, 15 to 17, 19, 20, 24 and 25 dependent thereon, under 35 U.S.C. § 103 as being unpatentable over Ferguson in view of Steenhoudt or Barnes is reversed.

The obviousness rejections of claims 22 and 23

We will not sustain the rejection of claims 22 and 23 under 35 U.S.C. § 103 as being unpatentable over Mudd in view of Meuse or Luikkonen. We likewise will not sustain the rejection of claims 22 and 23 under 35 U.S.C. § 103 as being unpatentable over Zachner in view of Meuse or Luikkonen. We will also not sustain the rejection of claims 22 and 23 under 35 U.S.C. § 103 as being unpatentable over Ferguson in view of Steenhoudt or Barnes, and further in view of Meuse or Luikkonen.

We have reviewed the references to Meuse and Luikkonen additionally applied in the rejection of claims 22 and 23 (indirectly or directly dependent on claim 21) but find nothing therein which would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified either Mudd, Zachner or Ferguson to make up for the deficiencies of those references as discussed above regarding claim 21. Accordingly, the decision of the examiner to reject claims 22 and 23 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 20, 22 and 23 under 35 U.S.C. § 112, second paragraph, is affirmed; the decision of the examiner to reject claims 1, 2, 7, 15 to 21, 24 and 25 under 35 U.S.C. § 102(b) as being anticipated by

Mudd is reversed; the decision of the examiner to reject claims 1, 2, 15, 18 to 21, 24 and 25 under 35 U.S.C. § 102(b) as being anticipated by Zachner is reversed; the decision of the examiner to reject claims 22 and 23 under 35 U.S.C. § 103 as being unpatentable over Mudd in view of Meuse or Luikkonen is reversed; the decision of the examiner to reject claims 22 and 23 under 35 U.S.C. § 103 as being unpatentable over Zachner in view of Meuse or Luikkonen is reversed; the decision of the examiner to reject claims 1, 2, 7 to 9, 15 to 21, 24 and 25 under 35 U.S.C. § 103 as being unpatentable over Ferguson in view of Steenhoudt or Barnes is reversed; and the decision of the examiner to reject claims 22 and 23 under 35 U.S.C. § 103 as being unpatentable over Ferguson in view of Steenhoudt or Barnes, and further in view of Meuse or Luikkonen is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	APPEALS
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

JVN/jg