

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THERESA G. TALBOTT and ALEX F. TALBOTT

Appeal No. 96-0811
Application No. 08/023,955¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS and FRANKFORT, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 10 and 15 through 17 under 35 U.S.C. § 103. The only other claims still pending in the application, namely claims 12 through 14, have been allowed.

¹ Application for patent filed February 26, 1993.

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As stated on page 1 of appellants' specification, their invention relates to "a system and method including a shopping map for aiding shoppers in the selection and location of articles displayed for sale at various aisle locations in a store." In the illustrated embodiment, the store is described as being a grocery store (e.g., a supermarket).

Claim 1 is illustrative of the subject matter at issue. A copy of this claim, as it appears in the appendix to appellants' brief, is appended to this decision.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Krebs et al. (Krebs) 1989	4,858,353	Aug. 22,
Haynes 1992	5,154,330	Oct. 13,

Bigg's, "Your dollar is bigger at bigg's," True Minimum Price information brochure, Louisville, Kentucky.

Winn-Dixie Marketplace brochure and map.

The grounds of rejection are as follows:

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1. Claims 1 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Bigg's publication in view of the Winn-Dixie publication.

2. Claims 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over the references applied in the rejection of claims 1-10 above and further in view of the Krebs patent.

3. Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over the references applied in the rejection of claims 1-10 above and further in view of the Haynes patent.

Reference is made to the final office action (Paper No. 9, mailed September 30, 1994) for details of these rejections.

As noted from the examiner's answer, the examiner has not supplied us with the publication dates for the Bigg's and Winn-Dixie publications. These references were furnished to the examiner by appellants during prosecution of this application. Appellants stated during prosecution that the publication dates for these references were not known to them. As a result, we issued an order under 37 CFR § 1.196(d), to obtain further information regarding the status of these

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references. Appellants' response to this order was filed on August 6, 1998 (see Paper No. 24).

Contrary to the examiner's statement in the paper mailed September 11, 1998 (Paper No. 25), appellants did not concede in their response to our order that the Bigg's and Winn-Dixie publications constituted prior art. Instead, appellants stated in that response that the publications were discovered after the application was filed and that they had no knowledge that the publications pre-dated the filing date of the application. Accordingly, it has not been established that the Bigg's and Winn-Dixie publications constitute prior art. We must therefore reverse the rejections of claims 1 through 10 and 15 through 17.

We are not unmindful of appellants' request in Paper No. 24 to provisionally treat the Bigg's and Winn-Dixie publications as prior art subject to the conditions set forth in Paper No. 24. To decide the patentability issue on such a basis would be tantamount to an advisory opinion. However, we have no authority under the statute (Title 35) or the code of federal regulations (Title 37) to render advisory opinions on

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the patentability of inventions. Appellants' request is therefore denied.

Under the provisions of 37 CFR 1.196(b), the following new grounds of rejection are entered against claims 1 through 10 and 12 through 14:

Claims 1 through 10 and 12 through 14 are rejected under 35 U.S.C. § 112 ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention. The preamble in each of the independent claims 1, 12 and 14 calls for a system for aiding shoppers in a store so that in this sense the system is defined as being exclusive of the store. In contrast, the body of each of these independent claims recites the store as a positive element of the combination. As a consequence, the scope of the body of each of these independent claims is inconsistent with the scope of the preamble of each of these claims. For this reason alone claims 1 through 10 and 12 through 14 are indefinite.

Furthermore, it is well settled that a claim in an application must accurately define the applicant's invention in order to satisfy the provisions in the second paragraph of

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§ 112. See In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). In the present case, it is inaccurate to state that the system to be used in a store includes the store itself.

In summary, the examiner's decision rejecting claims 1 through 10 and 15 through 17 is reversed, and a new ground of rejection has been entered against claims 1 through 10 and claims 12 through 14 under the provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

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ground of rejection to avoid termination of proceedings

(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

REVERSED, 37 CFR 1.196(b)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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Daniel J. Lueders
Woodward, Emhardt, Naughton,
Moriarty & McNett
Bank One Center Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

APPENDIX

1. A system for aiding shoppers in the selection and location of articles displayed for sale at various aisle locations in a store, comprising:

a store having a plurality of aisles therein, said store including numerous discrete articles displayed at various display locations along said plurality of aisles;

a portable map including a display surface bearing store specific indicia arranged in a pictorial representation of said plurality of aisles;

said store specific indicia comprising first written identifications sufficiently detailed in descriptiveness to correspond to said discrete articles, said identifications showing said discrete articles arranged at locations in said pictorial representation corresponding to the display locations of said articles along said plurality of aisles; and

wherein said portable map is usable as a shopping list for selecting discrete articles for purchase from said store and as an in-store map for locating said selected discrete articles in said store.