

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDY B. REYNOLDS

Appeal No. 1998-0234
Application No. 08/406,752

HEARD: November 7, 2001

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 1 through 3, 6, 8, 9, 12 through 16, 18, 28 through 30 and 38 through 60, all of the claims remaining in this application. Claims 4, 5, 7, 10, 11, 17, 19 through 27 and 31 through 37 have been canceled. Minor amendments to claims 3, 38, 42, 43 and 60 were made subsequent to the final rejection in a paper filed May 19, 1997 (Paper No. 16).

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As seen best in Figure 1 of the application, appellant's invention relates to a deflectable, illuminated advertising display assembly for placement so as to extend from a mounting site, comprising a shelf location, generally perpendicularly into a shopping aisle when in its neutral position. The invention also addresses a method of advertising products (i.e., point-of-purchase advertising) utilizing a deflectable, illuminated sign-carrying display assembly like that generally described above. Independent claims 1, 28, 29, 30, 38, 42, 43, 44, 49, 54 and 56 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief (Paper No. 19).

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

Slavsky	3,041,760	Jul. 3, 1962
Boggess et al. 1989 (Boggess)	4,805,331	Feb. 21,
Kornelson 1990	4,924,363	May 8,
Potter	DE 497,867	Apr. 24, 1930

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(German Patent)¹

Claims 38 through 41, 43 and 60 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as his invention. According to the examiner (answer, page 4), the areas of indefiniteness are as follows:

[i]n claims 38 and 43, line 12, "based" should be "base." In claim 43, line 1, "assemble" should be "assembly." In claim 60, line 4, there is no antecedent basis for "the shelf area."

In addition to the foregoing rejection, the appealed claims stand rejected under 35 U.S.C. § 103 as follows:

a) claims 1 through 3, 6, 8, 9, 12 through 16, 28 through 30, 38 through 54 and 56 through 60 under § 103 as being unpatentable over Boggess in view of Kornelson;

¹ Our understanding of this foreign language document is based on a translation prepared for the U.S. Patent and Trademark Office. A copy of that translation is appended to this decision.

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b) claims 18, 44 through 53 and 56 through 60 under § 103 as being unpatentable over Boggess in view of Kornelson as applied above, and further in view of Slavsky;

c) claim 55 under § 103 as being unpatentable over Boggess in view of Kornelson as applied to claim 54 above, and further in view of Potter (the German Patent).

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 21, mailed August 21, 1997) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 19, filed June 9, 1997) 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

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positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the examiner's rejection of claims 38 through 41, 43 and 60 under 35 U.S.C. § 112, second paragraph. After reviewing appellant's specification and the above enumerated claims in light thereof, it is our opinion that the scope and content of the subject matter embraced by appellant's claims on appeal is reasonably clear and definite, and fulfills the requirements of 35 U.S.C. § 112, second paragraph. In our view, the defective language in appellant's claims on appeal criticized by the examiner, in each instance, is of such a minor nature that it does not create confusion or uncertainty which rises to the level of indefiniteness. It is well settled that in determining whether a claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted

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by one possessing the ordinary level of skill in the pertinent art. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977). When that standard of evaluation is applied to the language employed in the claims before us on appeal, we are of the opinion that those claims set out and circumscribe a particular area with a reasonable degree of precision and particularity.

Given the foregoing, we will not sustain the examiner's rejection of appellant's claims 38 through 41, 43 and 60 under 35 U.S.C. § 112, second paragraph. We do however strongly encourage appellant to correct the minor errors noted by the examiner during any further prosecution of the application.

We next look to the examiner's prior art rejections of the appealed claims, turning first to the rejection of claims 1 through 3, 6, 8, 9, 12 through 16, 28 through 30, 38 through 54 and 56 through 60 under § 103 as being unpatentable over Boggess in view of Kornelson. After a careful assessment of appellant's independent claims 1, 28, 29, 30, 38, 42, 43, 44, 49, 54 and 56, and of the patents to Boggess and Kornelson, we

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must agree with appellant that the examiner has failed to establish a *prima facie* case of obviousness and has engaged in a hindsight reconstruction of appellant's claimed subject matter. While Kornelson discloses an attention-attracting, lighted price-ticket holder and display device for mounting beneath a supermarket display shelf, we do not see that the mere existence of lights used on a display device of the particular type shown in Kornelson would have provided any suggestion or motivation to one of ordinary skill in the art to modify the very different deflectable, pivotally mounted display apparatus of Boggess in the manner urged by the examiner so as to provide lights on the frame (16) therein, a source of power carried adjacent to the bracket assembly (18) and electrical conductors somehow spanning the deflection joint or yieldable coupling between the bracket assembly and the frame.

Like appellant, we view the examiner's position regarding the combination of Boggess and Kornelson as being based on an improper "obvious to try" rationale relying on the general concept of lighting a display of one kind or another for the

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purpose of attracting attention, but without any guidance or suggestion in the applied references as to the particular forms of lighted deflectable sign displays covered by the claimed invention or how to achieve them. In that regard, we do not agree with the examiner's assertion (answer, page 8) that the mere fact that illumination on signs is well known in the art makes it within the skill of one skilled in the art to place illumination on any type of sign. Nor do we find that the examiner has in any way established that the reason there are no patents showing deflectable signs having illumination is that the idea of attaching lights on deflectable signs is obvious.

Lacking any credible teachings in the applied prior art itself which would appear to have fairly suggested the claimed subject matter as a whole to a person of ordinary skill in the art, or any viable line of reasoning as to why such artisan would have otherwise found the claimed subject matter to have been obvious in light of the teachings of the applied Boggess and Kornelson patents, we must refuse to sustain the examiner's rejection of claims 1 through 3, 6, 8, 9, 12

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through 16, 28 through 30, 38 through 54 and 56 through 60
under 35 U.S.C.

§ 103.

Having also reviewed the patent to Potter applied by the examiner along with Boggess and Kornelson against dependent claim 55 on appeal, we find nothing therein which would overcome or provide for the deficiencies noted above in the teachings and/or suggestions of the basic combination of Boggess and Kornelson. Moreover we agree with appellant's arguments as set forth on pages 21-23 of the brief that the examiner has again engaged in an improper hindsight reconstruction of the claimed subject matter. For those reasons, we will not sustain the examiner's rejection of claim 55 under 35 U.S.C. § 103.

The last of the examiner's rejections for our review is that of claims 18, 44 through 53 and 56 through 60 under § 103 as being unpatentable over Boggess in view of Kornelson as applied above, and further in view of Slavsky. In this instance, the examiner is of the view that it would have been

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obvious to one of ordinary skill in the art to modify the display assembly resulting from the combination of Boggess and Kornelson by using a spring (presumably like that of Slavsky) to attach the frame portion (16) to the mounting bracket (18) since this would allow the frame portion to move in side-to-side as well as up-and-down directions which would provide greater flexibility in the frame portion and would reduce the likelihood of the display being damaged. Like appellant, we see nothing in the disclosure of the Slavsky patent which provides for or otherwise resolves the significant deficiencies in the examiner's proposed combination of Boggess and Kornelson as discussed above. Moreover, we again perceive the examiner's combination of the applied references to be an effort to create the claimed subject matter by hindsight reconstruction, and therefore remind the examiner that it is impermissible to use appellant's claims as a frame or template and the prior art references as a mosaic to piece together a facsimile of the claimed invention. Thus, the examiner's rejection of claims 18, 44 through 53 and 56 through 60 under § 103 as being unpatentable over Boggess in view of Kornelson and Slavsky will not be sustained.

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Since we have determined that the examiner has failed to establish a prima facie case of obviousness with regard to the claimed subject matter before us on appeal, we find it unnecessary to comment on appellant's evidence of secondary considerations relating to commercial success, long felt need and copying by others.

To summarize our decision, we note that 1) the examiner's rejection of claims 38 through 41, 43 and 60 under 35 U.S.C. § 112, second paragraph, has not been sustained, 2) the examiner's rejection of claims 1 through 3, 6, 8, 9, 12 through 16, 28 through 30, 38 through 54 and 56 through 60 under § 103 as being unpatentable over Boggess in view of Kornelson has not been sustained; 3) the examiner's rejection of claims 18, 44 through 53 and 56 through 60 under § 103 as being unpatentable over Boggess in view of Kornelson and Slavsky has not been sustained; and 4) the examiner's rejection of claim 55 under § 103 as being unpatentable over Boggess in view of Kornelson and Potter (the German Patent) has not been sustained.

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As should be apparent from the foregoing, the decision of the examiner rejecting claims 1 through 3, 6, 8, 9, 12 through 16, 18, 28 through 30 and 38 through 60 of the present application is reversed.

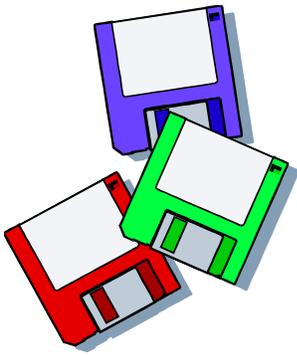
REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JOHN P. MCQUADE)	
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DECISION: REVERSED

Prepared: September 20, 2002

Draft Final

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