

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT DUHAMEL

Appeal No. 2000-0206
Application No. 08/699,328

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, NASE and
BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5, 6, 11 to 13, 15 and 16, which are all of the claims pending in this application.

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a traffic sign. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Like 1,517,439 Dec. 2, 1924
Lectric Lites Co. Catalog, page 6, item W3-1 (Lectric Lites)

Claims 5, 6, 11 to 13, 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lectric Lites in view of Like.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 13, mailed June 22, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 10, filed October 19, 1998) and supplemental brief (Paper No. 12, filed April 5, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 5, 6, 11 to 13, 15 and 16 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)

and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Lectric Lites discloses a diamond-shaped traffic sign. A first symbol in the shape of an octagon representing a stop sign is located in the bottom portion of the traffic sign. A second symbol in the shape of an arrow pointing straight ahead is located in the upper portion of the traffic sign. We find that together these two symbols represent to a driver viewing the traffic sign that a stop sign is up ahead.

Like discloses a direction indicator. The direction indicator includes a plate 3 (i.e., a sign), a post 1, and bolts 4 to secure the plate 3 to the post 1. Direction indicators in the form of arrow-shaped members 5 are secured to the plate 3.

The examiner ascertained (answer, p. 3) as to all the claims under appeal that Lectric Lites lacks only a post and the plate being mounted on the post. The examiner then determined that it would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the traffic sign of

Lectric Lites to a post as taught by Like to provide a means to display the traffic sign.

The appellant has not contested the obviousness determination made by the examiner. The appellant has challenged the correctness of the examiner's ascertainment as to the differences between the Lectric Lites and the independent claims on appeal (i.e., claims 15 and 16). In that regard, the appellant argues (brief, pp. 3-4; supplemental brief, pp. 2-3) that an additional difference is the limitation that the secondary traffic symbol provides secondary traffic information unrelated to the first traffic symbol and to the first traffic information provided by the first traffic symbol. We agree. In our view, the two symbols on the Lectric Lites' traffic sign (i.e., the octagon symbol and the arrow) are clearly **related** since the two symbols when taken together inform a driver that the driver is approaching a stop sign up ahead. In fact, a warning sign designated W17 in the 1990 Uniform Sign Chart of the California Department of Transportation¹ (which is nearly

¹ A copy of the warnings signs and regulatory signs contained in the 1990 Uniform Sign Chart of the California Department of Transportation is attached hereto.

identical to the applied Lectric Lites' traffic sign) is designated a "Stop Ahead (Symbol)" warning sign. Thus, the octagon symbol on the Lectric Lites' traffic sign does not provide the same traffic information as a typical "STOP" sign (i.e., the regulatory sign designated R1 in the 1990 Uniform Sign Chart of the California Department of Transportation) since the typical "STOP" sign provides the traffic information to stop where the sign is located. In the embodiment of the appellant's invention shown, for example, in Figure 3, the traffic information conveyed by the secondary traffic symbol (16') provides secondary traffic information **unrelated** to the first traffic symbol (not identified in Figure 3 but identified as symbol 13 in Figure 1) and to the first traffic information provided by the first traffic symbol. In that regard, the appellant's first traffic symbol of Figure 3 informs a driver that the driver must stop where the sign is located (as with a typical "STOP" sign) while the appellant's second traffic symbol of Figure 3 informs the driver that a vehicle approaching from the driver's left has a typical "STOP" sign. Thus, it is our view that the information conveyed to the driver by the appellant's secondary traffic symbol is unrelated to the

information conveyed to the driver by the appellant's first traffic symbol.

For the reasons set forth above, the examiner has not established that the claimed subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Thus, the decision of the examiner to reject claims 5, 6, 11 to 13, 15 and 16 under 35 U.S.C. § 103 is reversed.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 6, 15 and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over either the regulatory sign designated R67 in the 1990 Uniform Sign Chart of the California Department of Transportation (hereinafter "the R67 sign) or the regulatory sign designated R61-36 in the 1990 Uniform Sign Chart of the California Department of Transportation (hereinafter "the R61-36 sign) .

In our view, both the R67 sign and the R61-36 sign are inherently mounted on a post and thus each anticipate claims 6, 15 and 16. To the extent that the R67 sign and the R61-36 sign are not inherently mounted on a post, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to mount either the R67 sign or the R61-36 sign to a post since it was old and well known in the art to mount regulatory traffic signs on posts.

The limitation that the secondary traffic symbol provides secondary traffic information unrelated to the first traffic symbol and to the first traffic information provided by the first traffic symbol is met, in our view, by both the R67 sign and the R61-36 sign. In that regard, the bottom turn arrow in the R67 sign provides traffic information that a car in that lane must turn left while the upper turn arrow in the R67 sign provides the unrelated traffic information that a car in the lane approaching the sign from the opposite direction must turn left, much like the unrelated information provided in the embodiment of the appellant's invention shown in Figure 2. Likewise, the symbol on the right in the R61-36 sign provides traffic information that a car in the right lane must turn right while the symbol on the

left in the R61-36 sign provides the unrelated traffic information that a car in the left lane must either turn left or go straight.

The limitation of claim 16 that the secondary traffic symbol is "at least one of a sign shape or object used solely for a regulatory or warning traffic sign" and the limitation of claim 6 that "the pictograph is an object used solely for a regulatory or warning traffic sign" are, in our view, readable on both the R67 sign and the R61-36 sign. Examples of suitable objects given by the appellant (specification, page 5) include a bicycle, a car, a bump, a letter, a number, and an arrow head. Since both the R67 sign and the R61-36 sign include a secondary traffic symbol, as pointed out above, being a pictograph of an arrow having an arrow head, the secondary traffic symbol in both the R67 sign and the R61-36 sign is an object used solely for a regulatory or warning traffic sign.

CONCLUSION

To summarize, the decision of the examiner to reject claims 5, 6, 11 to 13, 15 and 16 under 35 U.S.C. § 103 is reversed and a

new rejection of claims 5, 6, 15 and 16 under 35 U.S.C. § 102 or under 35 U.S.C. § 103 has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 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 appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new 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. . . .

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

REVERSED; 37 CFR § 1.196(b)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
)	BOARD OF PATENT
)	APPEALS
)	AND
)	INTERFERENCES
JEFFREY V. NASE)	
Administrative Patent Judge)	

BAHR, Administrative Patent Judge, concurring-in-part and dissenting-in-part:

Having reviewed appellant's specification and claims and the arguments advanced by both appellant and the examiner, I conclude, for the reasons set forth herein, that the examiner's rejection of claims 11-13 and 15 is sustainable and that the examiner's rejection of claims 5, 6 and 16 is not sustainable. Therefore, I cannot join in the portion of the opinion of my colleagues addressing the rejections set forth by the examiner. I do join in the decision to enter a new ground of rejection of claim 15. Although I concur with the decision to enter a new rejection of claims 6 and 16, my reasons for that decision differ somewhat from those of my colleagues, as explained infra.

As acknowledged by my colleagues, appellant has not contested the examiner's determination that it would have been obvious to one skilled in the art at the time of appellant's invention to attach the traffic sign of Lectric Lites to a post as taught by Like. Rather, appellant argues that such modification would not result in the claimed invention for the following reasons.

With respect to claim 15, appellant (brief, pp. 3-4) argues that the Lectric Lites sign does not disclose:

- 1) the secondary traffic symbol providing "traffic information unrelated to the first traffic information" and
- 2) "the secondary symbol being a pictograph of at least a part of a regulatory or warning traffic sign."

Appellant's first argument, which my colleagues found persuasive, appears to be based on an interpretation of "unrelated" which, in my opinion, is unduly restrictive, especially when read in light of appellant's specification.² From my perspective, it is often the case that two objects or items of information may be at the same time considered unrelated in some contexts and related in other contexts. Merely by way of example, the information provided by one regulatory or warning symbol is by its very nature related to other regulatory or warning symbols and the information they provide, in that they are all regulatory or warning symbols. On the other hand, if

² In proceedings before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

these same symbols are different from one another and provide different information, they may also be fairly viewed as unrelated.

Using appellant's disclosed embodiments, for example, the octagon symbols provide traffic information (i.e., that the driver of a vehicle coming toward the viewer of the sign from a particular direction has a stop sign) which is related to the "STOP" symbol and the information provided by the "STOP" symbol, in that the octagon and "STOP" symbols convey the message "STOP" and in that the octagon and "STOP" symbols provide information as to what all drivers of vehicles are directed to do at the upcoming intersection. Indeed, all symbols on appellant's disclosed sign provide information which is related to the intersection and, hence, to the other symbols and to the information provided by the other symbols.

On the other hand, appellant and my colleagues have found a context in which to view the secondary symbols (the octagons) of appellant's sign as providing information which is unrelated to the "STOP" symbol and to the information ("stop") provided by the "STOP" symbol. Specifically, the "STOP" symbol informs a driver

what he or she must do at the intersection while the octagons inform the driver that a driver of another vehicle approaching the intersection from a particular direction has a stop sign.³ Apparently, the fact that the octagons and "STOP" symbol provide information as to the obligations of different drivers makes them unrelated. Thus, it is clear to me that the octagons and "STOP" symbol, as well as the information they provide, may at once be viewed as unrelated to one another in one context and as related to one another in another context.

Likewise, the arrow of the Electric Lites sign provides information (designation of a direction - straight ahead) which is unrelated to the octagon symbol, in that it means something different than "stop" or stop sign (the accepted meaning of an octagon on a warning or regulatory sign). Moreover, the information provided by the arrow is unrelated to the information provided by the octagon, in that the octagon informs the driver what he or she is to do (stop) whereas the arrow provides directional or positional information (the direction in which the

³ As I see it, the information as to what other drivers must do also provides the driver information as to what he or she must do at the intersection.

driver should travel to reach the stop sign). The arrow by itself would not denote "stop" or stop sign and thus is unrelated to both the octagon symbol and the information provided by the octagon symbol.

While it may be true that the arrow on the Lectric Lites sign can be viewed as providing information which is construed as related to the octagon and the stop or stop sign information conveyed by the octagon, in that the arrow provides the driver with information as to the direction the driver should travel to reach the stop sign, this does not change the fact that, for the reasons discussed supra, the information provided by the arrow is also unrelated to the octagon and information provided thereby, when viewed in a different context.⁴ From my perspective, the term "unrelated" cannot reasonably be interpreted, consistently with appellant's specification, as requiring more than this. Thus, unlike my colleagues, I am not persuaded that Lectric Lites

⁴ Indeed, I cannot discern a meaningful distinction between the relationship of the symbols in appellant's disclosed embodiment and that in Lectric Lites within the context of the claimed invention. In this regard, the examiner's observations on page 4 of the answer are well taken. The determination of whether any two items are related or unrelated is, as evidenced herein, a matter of interpretation.

lacks a secondary traffic symbol "providing secondary traffic information unrelated to the first traffic symbol and to the first traffic information provided by the first traffic symbol."

Appellant's second argument (brief, p. 4) to the effect that the secondary traffic symbol (the arrow) of Lectric Lites is not a pictograph of at least a part of a regulatory or warning sign because "[a]n arrow on its own obviously is not a warning or regulatory sign" is not well founded. Claim 15 does not require that the secondary symbol constitutes a regulatory or warning traffic sign by itself. The traffic sign of Lectric Lites is a regulatory or warning sign and the arrow is a pictograph⁵ which is a part of that sign, thereby responding fully to the claim limitation addressed in appellant's second argument.

For the above reasons, neither appellant's brief nor the decision of my colleagues has persuaded me that the examiner's rejection of claim 15 is in error. Accordingly, it is my opinion that the examiner's rejection of claim 15, as well as claims 11-

⁵ A picture or picturelike symbol representing an idea (Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)).

13 which appellant has grouped therewith (brief, p. 2), should be sustained.

I agree with my colleagues that the examiner's rejection of claims 5, 6 and 16 is not sustainable, but not for the reasons cited above in the majority's decision.

Appellant argues that the applied references do not establish a prima facie case of obviousness of the subject matter of claim 16 because Lectric Lites lacks:

- 1) the secondary traffic symbol providing traffic information unrelated to the first traffic information and
- 2) the secondary traffic symbol being "at least one sign shape or object used solely for a regulatory or warning traffic sign" (emphasis mine).

For the same reasons cited supra with regard to claim 15, I do not find appellant's first argument persuasive with respect to claim 16. However, I do share appellant's view that the arrow of Lectric Lites is not a sign shape or object used solely for a

regulatory or warning traffic sign.⁶ While appellant's specification (p. 5) indicates that secondary symbols representing shapes of objects such as an arrow head may be used, the language of claims 5, 6 and 16 is more limited than that disclosure. In my view, the claim language precludes sign shapes and objects used in applications other than regulatory or warning traffic signs, even if those shapes or objects are also used in warning or regulatory traffic signs. By way of example, appellant points out that arrows are used in guide signs. For this reason, and not for the reason cited by my colleagues, I concur in the decision of my colleagues not to sustain the examiner's rejection of claim 16. As claims 5 and 6 contain similar limitations, the rejection of these claims also should not be sustained, notwithstanding appellant's grouping of these claims with claim 15 (brief, p. 2).

I concur with my colleagues' decision to enter a new rejection of claims 6 and 16 because the turn arrows of the R67 and R61-36 signs are used on regulatory signs and there is no

⁶ In this regard, however, I do note that the octagon symbols in appellant's disclosed embodiments would not appear to meet the very strict requirement set forth in claim 16.

evidence of record to indicate that such symbols or objects are used other than on regulatory or warning signs.

In summary, I dissent from my colleagues' decision not to sustain the examiner's rejection of claims 11-13 and 15 and concur in the decision not to sustain the examiner's rejection of claims 5, 6 and 16. I join in the majority's new rejection of claim 15 and concur with the decision to enter a new rejection of claims 6 and 16.

JENNIFER D. BAHR
Administrative Patent Judge

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