

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 YU ZHENG

Appeal No. 2004-1439
Application No. 10/044,142

ON BRIEF

Before WARREN, TIMM, and JEFFREY T. SMITH, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 25-29, 31, 32, 34, and 36-38 which are all the claims pending in the application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

Claim 25 is illustrative:

25. A collapsible structure comprising:
a panel having a foldable frame member having a folded and an unfolded orientation, and a fabric material covering selected portions of the frame member; and
a pair of flotation devices connected to the panel;
wherein the fabric material extends in a flat planar configuration when the frame member is in its unfolded orientation.

As evidence of unpatentability, the Examiner relies upon the following prior art references:

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|------------------------------|-----------|---------------|
| Ivanovich et al. (Ivanovich) | 5,163,461 | Nov. 17, 1992 |
| Price | 5,676,168 | Oct. 14, 1997 |

Claims 25-27, 29, 31, 32, 34, 36-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ivanovich.¹ Price is added to reject claim 28.²

The claims stand or fall together (Brief, p. 3). We select claim 25 to represent the issues on appeal with respect to the rejection over Ivanovich. Claim 28 will reviewed separately as it is rejected separately and argued separately.

Because Appellant has not convinced us of reversible error on the part of the Examiner, we affirm. Our reasons follow.

¹The inclusion of claim 35, a cancelled claim, in the Examiner's statement of the rejection (Answer, p. 3) is harmless error. Appellant correctly lists the claims subject to rejection in the Brief (Brief, pp. 1 and 3).

²The listing of Price twice in the Examiner's statement of rejection is harmless error. Only one Price reference was applied and Appellant correctly states the rejection in the Brief.

OPINION

The Rejection over Ivanovich as Applied to Claim 25

Ivanovich describes a number of self-erecting shelters in a variety of shapes and configurations. As pointed out by the Examiner, Figure 1 shows one particular shelter, a tent, with an elliptical floor 10. As found by the Examiner, floor 10 of the tent meets the requirements of the panel of claim 25 (Answer, p. 3). The Examiner acknowledges that the tent of Figure 1 is not disclosed by Ivanovich as including flotation devices, but points out that the floating boat shelter of Figure 11 described by Ivanovich is disclosed as including such flotation devices, i.e., buoyant elements 63 (Answer, p. 4; see also Ivanovich, col. 3, ll. 31-34). The Examiner concludes that modifying a Figure 1 type shelter by adding the type of flotation devices depicted in Figure 11 would have been obvious to one of ordinary skill in the art (Answer, p. 4).

Appellant argues that the prior art provides no motivation or suggestion for making the combination and that the suggested combination would be inoperative and would destroy the function of the structure (Brief, pp. 3-9). In making these arguments Appellant focuses on the literal disclosure of the embodiments of Figures 1 and 11 of Ivanovich without taking into account the broader teachings of Ivanovich or the general knowledge in the prior art as shown by the evidence of record as a whole. This not the correct approach. In making a determination of obviousness, one must take into account the level of ordinary skill in the field of the invention as well as the full scope and content of the prior art, the differences

between the claimed invention and the prior art, and any objective evidence of non-obviousness such as unexpected results, long-felt need, and commercial success. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). “On the issue of obviousness, the combined teachings of the prior art *as a whole* must be considered.” *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 907, 225 USPQ 20, 25 (Fed. Cir.), *cert. denied*, 474 U.S. 843 (1985)(emphasis added).

Here, the evidence shows that collapsible structures such as those of Ivanovich were known to come in all sorts of sizes for various purposes including tents, car shelters, boat shelters, hot houses for plants, beach shelters, display booths, playpens, and animal pens (Ivanovich, col. 3, ll. 23-44). Appellant’s specification provides further evidence of the breadth and extent of this knowledge within the prior art and offers further examples of what was known including smaller versions used as dollhouses and action figure play houses (specification, p. 1, l. 18 to p. 2, l. 3). Attaching the flotation devices suggested by Ivanovich to a tent-type shelter such as that suggested by Ivanovich, Figure 1 for any of the known purposes, including use with dolls in water play, would have been obvious to one of ordinary skill in the art.

With regard to the inoperability argument (Brief, pp. 7-9), we note that in the proposed combination, the flotation devices would serve the function described in Ivanovich: To allow flotation. It would have been reasonably expected that a smaller tent-type shelter would float given that Ivanovich discloses that a larger boat shelter will float.

This reasonable expectation of success is enough to support a *prima facie* case of obviousness in the context of the present case given the various uses for such structures known in the prior art. *See In re O'Farrell*, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988)(“For obviousness under § 103, all that is required is a reasonable expectation of success.”).

As a final point, we note that Appellant bases no arguments upon objective evidence of non-obviousness. We conclude that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 25-27, 29, 31, 32, 34, and 36-38 which has not been sufficiently rebutted by Appellant.

The Rejection of Claim 28 over Ivanovich in view of Price

Claim 28 requires that the panel of claim 25 be a single panel. The Examiner has interpreted this language as excluding the unitary configuration of the tent of Ivanovich. It is not clear to us that the claim is so limited. By the ordinary meaning of the words, the claim merely requires that the panel described in claim 25 be one panel. In other words, that described panel cannot itself be made up of a plurality of panels. The claim is silent with regard to any other panels and how they are attached. Nothing in the specification is inconsistent with the ordinary meaning of the terms “single panel.” Ivanovich describes a floor 10 meeting the requirements of the panel of claim 25. Floor 10 is but one panel.

Even assuming that the claim has a more limited meaning which excludes the floor structure of Ivanovich, we cannot agree with Appellant that there was reversible error by the

Examiner. Appellant argues that the Examiner has identified no reason or motivation for modifying the Ivanovich structure to include a single panel (Brief, p. 11). But the reason or motivation is expressly articulated in Price. Price describes a collapsible tent with a separate loop and panel for the base. The tent is described as an improvement over the continuous loop tents such as those of Ivanovich (Price, col. 1, l. 24 to col. 2, l. 6). Price expressly articulates reasons for forming the base using a separate loop, rather than forming the entire tent from a continuous loop: To reduce manufacturing cost and to allow the inclusion of loops of different materials and diameters (Price, col. 2, ll. 2-26). There is ample motivation within the prior art for making the combination.

Appellant also argues that Ivanovich teaches away from the modification suggested by the Examiner (Brief, p. 12). The problem with this argument is that Ivanovich does not indicate that the multiple loop configuration will not work and Price expressly discloses the tent configuration described therein as an improvement over the configuration of Ivanovich. Price expressly leads one of ordinary skill in the art to the modification.

As a final point, we note that Appellant bases no arguments upon objective evidence of non-obviousness such as unexpected results. We conclude that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claim 28 which has not been sufficiently rebutted by Appellant.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 25-29, 31, 32, 34, and 36-38 under 35 U.S.C. § 103(a) is affirmed.

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

AFFIRMED

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| CHARLES F. WARREN |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CATHERINE TIMM |) | APPEALS |
| Administrative Patent Judge |) | AND |
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