

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte RANDY B. REYNOLDS

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Appeal No. 2005-2174  
Application No. 10/060,614

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ON BRIEF

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Before FRANKFORT, McQUADE, and DELMENDO, Administrative Patent Judges.  
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Randy B. Reynolds originally took this appeal from the final rejection (mailed April 2, 2003) of claims 61-71, all of the claims pending in the application. The application is back before this Board for review of the merits of the final rejection following a remand to the examiner (mailed February 24, 2004) for clarification of certain issues.

THE INVENTION

The invention relates to “lighted merchandising display devices for advertising purposes . . . in mercantile establishments such as grocery stores, supermarkets, discount centers, and the like” (specification, page 1). Representative claim 61 reads as follows:

61. An assembly comprising:

a proximal portion adapted to be connected to a shelf along an aisle in a retail store;

a distal cantilevered portion carrying illumination and extending into the aisle;

an intermediate portion allowing the distal portion to deflect in respect to the proximal portion;

promotional printed matter pertaining to one or more products removably carried by the distal cantilevered portion.

THE EVIDENCE

The items relied on by the examiner as evidence of obviousness are:

Sernovitz	4,317,303	Mar. 02, 1982
Bogges et al. (Bogges)	4,805,331	Feb. 21, 1989

The items relied on by the appellant as evidence of non-obviousness are:

The 37 CFR § 1.132 Declaration of Randy B. Reynolds filed January 29, 2002  
(Reynolds I)

The updated 37 CFR § 1.132 Declaration of Randy B. Reynolds filed January 29, 2002  
(Reynolds II)

Appeal No. 2005-2174  
Application No. 10/060,614

The 37 CFR § 1.132 Declaration of Paul Roumpos filed January 29, 2002

The 37 CFR § 1.132 Declaration of Dennis R. Gibson filed January 29, 2002

The 37 CFR § 1.132 Declaration of Stephen A. Morin filed January 29, 2002

The 37 CFR § 1.132 Declaration of Bruce H. Porter filed January 29, 2002

### THE REJECTION

Claims 61-71 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boggess in view of Sernovitz.

Attention is directed to the main, reply and supplemental reply briefs (filed June 10, 2003, August 19, 2003 and May 5, 2004) and the main and supplemental answers (mailed August 8, 2003 and April 20, 2004) for the respective positions of the appellant and examiner regarding the merits of this rejection.<sup>1</sup>

### DISCUSSION

#### I. Preliminary matter

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<sup>1</sup> Contrary to statements made on page 7 in the main brief, the final rejection did not present any 35 U.S.C. § 112, second paragraph, or obviousness-type double patenting issues. The examiner entered rejections on these grounds in an earlier Office action (mailed June 7, 2002) but did not restate them in the final

Appeal No. 2005-2174  
Application No. 10/060,614

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rejection, presumably because they had been overcome.

Appeal No. 2005-2174  
Application No. 10/060,614

In the main and reply briefs, the appellant contends that the law of issue preclusion (whether viewed as res judicata, law of the case or collateral estoppel) mandates a reversal of the rejection on appeal in light of a decision by this Board in an earlier appeal (Appeal No. 1998-0234) involving Application No. 08/406,752, filed March 6, 1995, now U.S. Patent No. 6,438,882. A review of the decision in the earlier appeal (copy appended to the main brief) shows that the § 103 rejections at issue involved claimed subject matter and a prior art combination different from those in the present appeal. Thus, the appellant's position that the decision (a reversal) in the earlier appeal is binding in this case under the doctrine of issue preclusion is without merit.

#### II. The examiner's 35 U.S.C. § 103(a) rejection

The ultimate determination as to whether or not an invention is obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); In re Huang, 100 F.3d 135, 138, 40 USPQ2d 1685, 1687-88 (Fed. Cir. 1996). These fundamental principles form the basis for the following analysis of the appealed rejection.

Boggess, the examiner's primary reference, discloses "an apparatus for displaying and/or dispensing sales materials in a manner which attracts customers' attention to a featured item in the store as customers approach the area of a shelf on

which the item can be found" (column 1, lines 13-17). The apparatus achieves this objective by projecting from the shelf into the adjacent aisle so as to be in the direct view of customers approaching from either direction (see column 1, lines 33-53; column 2, lines 12-21; and column 3, lines 47-66). According to Boggess, this orientation of the display is more effective than one in which the display lies across the front of a shelf (see column 1, lines 33-36).

The display apparatus 10 shown in Figures 1-6 comprises a bracket assembly 18 adapted to be removably connected via a mounting clip 82 to a strip of shelf tag molding 12 on the front margin of a shelf 14, a frame 16 extending outwardly from the bracket assembly into the aisle, advertising placards 22 removably held within the frame, and stub shafts 30 and 32 and coil springs 52 and 54 pivotably mounting the frame to the bracket assembly. The springs bias the frame to a position extending perpendicularly from the shelf into the aisle while allowing it to be temporarily deflected or pivoted if struck by a customer or shopping cart.

The display apparatus 210 illustrated in Figures 7-15 is similar in many respects to the display apparatus 10. In this regard, it includes a bracket assembly 18, a mounting clip 82, a frame 216, stub shafts 230 and 232 and a leaf spring 52a. One difference is that the frame 216 is constructed to hold sheets of promotional material that can be sequentially accessed and removed from the frame by customers (see column 8, line 66, through column 9, line 28).

It is not disputed that one or both of the display embodiments disclosed by

Boggess respond to all of the limitations in each appealed claim except for those limitations pertaining to illumination.<sup>2</sup> As indicated above, independent claim 61 requires the distal cantilevered portion (which reads on either of Boggess' frames 16 or 216) to carry illumination. Similarly, independent claim 66 recites the step of causing illumination to be associated with a distal cantilevered portion, independent claim 68 calls for an illuminated distal portion, independent claim 69 sets forth a distal cantilevered portion comprising illumination, independent claim 70 requires a cantilevering display segment with at least one source of illumination and independent claim 71 recites a distal segment with illumination. The distal cantilevered portions of the Boggess displays (frames 16 and 216) do not carry, and are not associated with, any sort of illumination. To account for this deficiency in Boggess, the examiner turns to Sernovitz.

Sernovitz discloses "an illuminated display device such as a price tag for use on display racks, shelving or the like for retail merchandise" (column 1, lines 6-8). The device 10 comprises a one-piece housing 11 having a rear wall 12 and side walls 13, a battery compartment 15 defined in the rear wall, a battery 26 in the compartment, a circuit board 20 lying within the housing and carrying light elements 25 and timing circuitry for blinking the light elements on and off, a display panel 30 overlying the circuit board and having holes 31 for passage of the light elements, a transparent cover 40

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<sup>2</sup> The appellant's observation that "[t]he [Boggess] frame carries a non-illuminated display placard 22, but no customer removable tickets or coupons" (main brief, page 9) applies only to frame 16. The frame 216 in Boggess' second embodiment does carry customer removable tickets or coupons.

Appeal No. 2005-2174  
Application No. 10/060,614

and an indicia tag 50 attached to the cover in the area bounded by the light elements. The device may also include a pair of tines 55 for insertion into material such a meat product or the like for mounting the device in a display orientation. Sernovitz adds, though, that “[i]t will be appreciated that alternative supporting means may be provided, such as adhesive mounting means on the rear of the housing 11, easel means, hanging means and the like” (column 3, lines 33-36).

Combining Boggess and Sernovitz to reject the appealed claims, the examiner submits that

[i]n view of the teachings of Sernovitz it would have been obvious to one [of ordinary skill] in the art to modify Boggess et al. by attaching a light source to the distal cantilevered portion [i.e., frame 16 or 216] since this would allow the distal cantilevered portion to emit a flashing, attention-grabbing visual display [answer, page 3].<sup>3</sup>

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Given this test, the combination of Boggess and Sernovitz proposed by the examiner is reasonable on its face. The requisite suggestion or motivation for the

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<sup>3</sup> A fair reading of the rejection in full (see page 3 in the answer) belies the appellant's contention (see, for example, pages 16, 17 and 21 in the main brief) that the examiner failed to compare the appealed claims to Boggess, determine the differences therebetween and advance any rationale for the proposed

combination stems from (1) Boggess' stated desire to provide a product display designed to attract the attention of customers and (2) Sernovitz's disclosure of a product display generally similar to that of Boggess comprising lighting or illumination having self-evident attention-drawing characteristics. One of ordinary skill in the art would have readily appreciated the Sernovitz illumination feature as entirely consistent with, and in furtherance of, the stated aims of Boggess.

The appellant's arguments (see, for example, pages 3, 4, 9, 10, 21 and 24 in the main brief) that Boggess and Sernovitz are incompatible and mutually exclusive and would not have suggested, and in fact teach away from, the examiner's combination have no factual basis in the fair teachings of these references. While the appellant's observation that neither reference teaches all of the limitations in the appealed claims is accurate, where the rejection is based upon the teachings of a combination of references, non-obviousness cannot be established by attacking the references individually (In re Merck & Co., Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986)).

The argument (see, for example, pages 18 and 19 in the main brief) that Boggess and Sernovitz do not address the problems solved by the claimed invention is also unpersuasive. According to the appellant, the key problems in this regard involve determining a way to "(a) construct and provide a point-of-purchase sign which is both

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combination of Boggess and Sernovitz.

deflective and illuminated, while avoiding damage and injury, and (b) attract the attention of a shopper to a specific one of many products from a substantial distance, and (c) to provide printed matter access to purchaser” (main brief, page 18). Boggess, however, pertains to a display that deflects to avoid damage and injury and provides printed matter access to purchaser, both Boggess and Sernovitz relate to displays designed to attract the attention of a shopper to a specific product from a distance, and Sernovitz attains this objective by employing illumination. Thus, here again the

appellant’s argument finds no factual support in the fair teachings of the references. Furthermore, it is well settled that as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). As explained above, Boggess and Sernovitz provide the requisite motivation or suggestion for the combination proposed by the examiner.

The contention that “the [e]xaminer made no factually-based determination as to the level of ordinary skill [in the art]” (main brief, pages 17-18), while true, is of no practical moment in this case. Although it is always preferable for a factfinder to specify the level of skill applied to an invention at issue, the absence of specific findings on this matter does not give rise to reversible error where the prior art itself reflects an appropriate level of skill and a need for such a determination is not shown. Okajima v.

Appeal No. 2005-2174  
Application No. 10/060,614

Bourdeau, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001). The appellant has failed to cogently explain, and it is not evident, why Boggess and Sernovitz do not reflect the appropriate level of ordinary skill in the art to be applied in the obviousness determination at hand.

The appellant also queries that “[i]f obvious, why did one of skill in the art not provide such a sign prior to the present invention since Boggess and Sernovitz have been available since 1989 and 1981, respectively” (main brief, page 13). The mere age of the references, however, is not persuasive of the unobviousness of the combination of their teachings absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem. In re Wright, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977). As explained more fully below, the record before us contains no such evidence.

From the appellant’s perspective (see pages 13-16 in the main brief), the proposed combination of Boggess and Sernovitz is additionally deficient because it would not produce the claimed invention. To illustrate this point, the appellant offers five drawings (see pages 14 and 15 in the main brief) showing devices that might result if Boggess and Sernovitz were combined. These drawings, however, depict unrealistic bodily incorporations of the Sernovitz device into the Boggess display. Such renditions conflict with the relatively simple and straightforward modification of Boggess in view of Sernovitz proposed by the examiner. They also improperly presume a lack of skill on the part of the artisan (see In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed.

Cir. 1985)).

Considered in light of the foregoing, the combined teachings of Boggess and Sernovitz provide an evidentiary basis sufficient to establish a prima facie case of obviousness with respect to the subject matter recited in claims 61-71.

After a prima facie case of obviousness is established, the burden of going forward shifts to the applicant. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When prima facie obviousness is established and evidence is submitted in rebuttal, the decision-maker must start over and evaluate the facts established by the rebuttal evidence along with the facts on which the earlier conclusion was reached. In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Patentability is then determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)

In the present case, the appellant relies on the above listed 37 CFR § 1.132 declarations as objective evidence of non-obviousness which purportedly demonstrates that the claimed invention has enjoyed commercial success, solved a long felt need in the art and been copied by a competitor.

The Reynolds I declaration focuses, as do all of the declarations, on a product marketed by Impulse Promotional Products, Inc. as the "Impulse 220," which product allegedly embodies the claimed invention (see paragraphs 2-5 and Exhibits A and B). The declarant (see paragraphs 6-23) states gross revenues for the Impulse 220 of

Appeal No. 2005-2174  
Application No. 10/060,614

about 2.6 million dollars from June 1995 through 1996, projects gross revenues of 2.3 million dollars or higher for 1997, alleges increased sales in store brand products and food items from the use of the Impulse 220 (see Exhibit C), attributes the commercial success of the product based on feedback from customers to the unique combination of a deflectable display sign and illumination, reports interest in the product from several companies, charges copying of the product by at least one competitor (see Exhibit D), and submits that the product solves long-standing problems in the art of retail marketing relating to specific product differentiation and identification from a distance (see Exhibit E). The declarant (see paragraphs 24-54) also weighs in on the legal and factual issues raised during the prosecution of Application Nos. 08/406,752 (which is discussed above in conjunction with the matter of issue preclusion) and 08/058,197.

Reynold's statement of gross revenues for the Impulse 220 of about 2.6 million dollars from June 1995 through 1996 does not, in and of itself, establish commercial success of this product. Bald sales figures such as these that are not presented in any meaningful context, e.g., share of a definable market or profitability per unit, show little in the way of commercial success. See Cable Elec. Prods. v. Genmark, Inc., 770 F.2d 1015, 1026-27, 226 USPQ 881, 888 (Fed. Cir. 1985). The projected gross revenues for 1997 suffer the same flaw and are unduly speculative. The one month increase in store brand products and food items shown in Exhibit C also lacks any meaningful background or context.

Moreover, a nexus is required between the merits of the claimed invention and

Appeal No. 2005-2174  
Application No. 10/060,614

the evidence of commercial success proffered. Id. Considered together, Exhibits A and B indicate that one of the major features of the Impulse 220 is sequential or pulsing lighting which “acts like a magnet to draw attention” (Exhibit B). As the claims on appeal do not call for such sequential or pulsing lighting or illumination, the nexus between any commercial success enjoyed by the Impulse 220 and the claimed invention is somewhat suspect.

The Reynolds I declaration also lacks any corroboration for the alleged feedback from customers attributing the commercial success of the Impulse 220 broadly to the combination of a deflectable display sign and illumination or for the purported interest in the product from several companies.

Exhibit D, which relates to a computerized display sign controlled by wireless technology, simply does not establish copying of the claimed invention by a competitor.

As for the assertion of long-felt need in the art and the solution thereto by the claimed invention, the relevant consideration is a long-felt but unsolved need in the art. Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 7139 F.3d 877, 45 USPQ2d 1977, 1983 (Fed. Cir. 1998). In short, the Reynolds I declaration does not provide any evidence corroborating the asserted existence of a long-felt need in the art, the failure of others to solve the problem (see Vandenberg v. Dairy Equip. Co., 740 F.2d 1560, 1567, 224 USPQ 195, 199 (Fed. Cir. 1984)) or that the claimed invention did solve the problem (see In re Cavanaugh, 436 F.2d 491, 168 USPQ 466 (CCPA 1971)).

Finally, the declarant's opinions as to the legal and factual issues raised during the prosecution of Application Nos. 08/406,752 and 08/058,197 have little, if any, relevance to the issues of obviousness presented in the instant case.

The Reynolds II declaration updates the Reynolds I declaration by asserting that the Impulse 220 had gross revenues of "\$841,275.00" for the first five months of 1997, that orders already received will bring the gross revenues for calendar year 1997 to "\$1,549,288.00," that expected additional orders would bring the year's total to "\$2.5 million" and that total gross revenues for the Impulse 220 will be "\$5.1 million." These bald sales figures suffer the same defects as those presented in the Reynolds I declaration.

The Roumpos and Gibson declarations make broad and sweeping assertions of commercial success for the Impulse 220 that purportedly stem from its combination of deflectability and illumination, but fail to provide any corroborating evidence for such assertions.

The Roumpos, Morin and Porter declarations praise the Impulse 220 due to features which allow it to fit easily into shelf channels, provide high visibility to customers from both ends of an aisle, permit deflection out of the way when struck by a customer or shopping cart to prevent damage and injury, allow easy relocation and variation of content, provide a lighted billboard effect and embody a self-contained power source. To the extent that these features are recited in the appealed claims,

Appeal No. 2005-2174  
Application No. 10/060,614

those relating to the mechanical aspects are taught by Boggess and those pertaining to the illumination aspects are disclosed by Sernovitz.

For these reasons, the appellant's declaration evidence of non-obviousness is seriously flawed and, considering the totality of the record, is far outweighed by the examiner's evidence of obviousness. The preponderance of all of the evidence justifies the examiner's conclusion that the differences between the subject matter recited in claims 61-71 and the prior art are such that the 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.

Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claims 61-71 as being unpatentable over Boggess in view of Sernovitz.

#### SUMMARY

The decision of the examiner to reject claims 61-71 is affirmed.

Appeal No. 2005-2174  
Application No. 10/060,614

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

AFFIRMED

CHARLES E. FRANKFORT  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

ROMULO H. DELMENDO  
Administrative Patent Judge

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Appeal No. 2005-2174  
Application No. 10/060,614

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APPEAL NO. 2005-2174  
APPLICATION NO. 10/060,614

APJ McQUADE  
APJ FRANKFORT  
APJ DELMENDO

DECISION: **AFFIRMED**

**PREPARED:** May 22, 2006

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT