

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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Appeal No. 2006-1293  
Application No. 10/437,840

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ON BRIEF

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Before OWENS, CRAWFORD, and BAHR, Administrative Patent Judges.  
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 7, which are all of the claims pending in this application.

The appellant's invention relates to a divider incorporating changeable advertising messages (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art

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

Ray	D 3,444	Apr. 6, 1869
Langhorne et al. (Langhorne)	D 4,079	May 31, 1870
Fraser	5,450,926	Sep. 19, 1995
Misaresh	5,933,994	Aug. 10, 1999
Hoshi	4,934,079	June 19, 1990

The rejections

Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fraser in view of Langhorne or Ray.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Fraser in view of Langhorne or Ray and further in view of Hoshi.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fraser in view of Langhorne or Ray and further in view of Misaresh.

Claims 1 and 3 to 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Misaresh in view of Fraser.

Claims 1, 2, 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Misaresh in view of Hoshi.

Claims 3 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Misaresh in view of Hoshi and further in view of Fraser.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed June 17, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed March 30, 2005) 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. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claim 7 under 35 U.S.C. § 112, second paragraph. We note that the second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims 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 by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

With this as background, we analyze the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. The examiner states:

In claim 7, line 6, "a plurality of lamps" is indefinite since the applicant defines in claim 1 "at least one lamp" so it is not clear whether the applicant is trying to state that the at least one lamp includes a plurality of lamps or whether that applicant is defining a plurality of lamps in addition to that at least one lamp. In claim 7, line 5, "the panel" is indefinite since it is not clear which panel the applicant is referring to since the applicant defines a plurality of panels and the applicant should make it clear whether the four panels defined in line 2 are the same as the ones defined in claim 1 [answer at page 3].

The appellant argues:

An amendment is being submitted herewith to overcome the objections as to claim 7 under 35 U.S.C. § 112, second paragraph. However, with respect to the Examiner's requirement to change the claims to recite "the at least one,"

Appellant respectfully declines on the grounds that the same is unnecessary [brief at page 3].

We will sustain this rejection. We note that the amendment referred to by the appellant has not been entered (see answer at page 8). We agree with the examiner that as claim 1 recites "at least one lamp" and claim 7 recites "a plurality of lamps" it is not clear whether the plurality of lamps of claim 7 is a part of the at least one lamp or is a plurality of lamps in addition to the at least one lamp. Similarly, as claim 1 recites "at least one advertising panel" and claim 7 which is dependent on claim 1 recites "the four panels," it is not clear whether the four panels are included in the "at least one advertising panel" recited in claim 1.

In view of the foregoing, we will sustain this rejection.

We turn next to the examiner's rejection of claims 1, 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Fraser in view Langhorne or Ray.

It is the examiner's view that Fraser describes the invention as claimed except that Fraser does not describe that the advertising panel includes textual information. The examiner relies on Langhorne and Ray to supply the teaching of combining textual information along with graphical information.

We will not sustain this rejection because we agree with the appellant that Fraser does not describe a motion detector operative to activate a lamp *in response to motion detected outside the form*, as is required by claim 1. In contrast, Fraser discloses that

switch contacts within the device are closed when the form is shaken or tapped.

Therefore, the Fraser device detects motion *within* the form.

We have examined the disclosures of Langhorne and Ray and determined that neither of these references cures the deficiencies of Fraser. Therefore, we will not sustain this rejection as it is directed to claim 1 and claims 3 and 4 dependent thereon.

We turn next to the examiner's rejection of claim 2 under 35 U.S.C. § 103 as being unpatentable over Fraser in view of Langhorne or Ray and further in view of Hoshi.

In the examiner's view, Fraser in view of Langhorne and Ray describes the invention of claim 2 except that these references do not describe making the motion detector in the form of a light sensor. The examiner relies on Hoshi for disclosing a display device that includes and light sensor and concludes:

[I]t would have been obvious to one in the art to modify Fraser by making the motion sensor in the form of a light sensor since this would allow the light and sound to be activated in an easier, less expensive, and better manner [answer at pages 4 to 5].

This rejection relies on Fraser for disclosing a motion sensor for detecting motion outside of the form which we found lacking in the preceding rejection. In addition, a motion sensor in the form of light which would be activated when the sensor senses any object as taught by Hoshi, would defeat the purpose of the Fraser divider as the sensor would be activated when a person was detected in the vicinity of the sensor and not

when a person indicated in some way that it was desired to purchase the items in the divider.

For the foregoing reasons, we will not sustain this rejection.

We turn next to the examiner's rejection of claims 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Fraser, Langhorne or Ray and Misaresh. The examiner's reasoning in regard to the rejection can be found on page 5 of the answer.

We will not sustain this rejection for the reasons given above for the rejection of claim 1, from which claims 5 and 6 depend as neither Langhorne nor Misaresh cures the deficiencies noted above for Fraser.

We turn next to the examiner's rejection of claims 1 and 3 to 6 as being unpatentable over Misaresh in view of Fraser. The examiner's rationale regarding this rejection can be found on page 6 of the answer. The examiner relies on Fraser for teaching a motion detector operative to activate a lamp in response to motion detected outside the form. We will not sustain this rejection because as we have discussed above, the motion detector described in Fraser does not detect motion outside the form.

We turn next to the examiner's rejection of claims 1, 2, 5 and 6 as being unpatentable under 35 U.S.C. § 103 over Misaresh in view of Hoshi. The examiner's rationale regarding this rejection can be found on page 7 of the answer. Recognizing that Misaresh does not describe a motion sensor, the examiner relies on Hoshi and concludes:

. . . it would have been obvious to one in the art to modify Misaresh by attaching a light sensor to the divider bar since this would allow the lamps to be turned on automatically which would help to create a more amusing eye-catching display [answer at page 7].

Appellant argues that there is no mention in either Misaresh or Hoshi of creating a more eye-catching display.

We do not find this argument persuasive because Misaresh teaches that translucent material that is backlit, for example is used to produce a more striking appearance (col. 3, lines 57 to 63). As such Misaresh does contemplate a more eye catching display.

In view of the foregoing, we will sustain this rejection as it is directed to claim 1. We will also sustain this rejection as it is directed to claims 2, 5 and 6 because the appellant has not argued the separate patentability of these claims. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

We turn lastly to the examiner's rejection of claims 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Misaresh, Hoshi and Fraser. The examiner's rationale regarding this rejection can be found on pages 7 to 8 of the answer. Recognizing that Misaresh does not describe having the lamp operate for 30 seconds, the examiner relies on Fraser for teaching the idea of having the lamp off after a predetermined time. The examiner reasons that a person of ordinary skill in the art would have been motivated to combine this teaching of Fraser with the teachings of

Misaresh and Hoshi to create a more attention attracting display and to allow the battery to last longer.

The appellant argues that the prior art does not mention the need for a more attention attracting display or the need to reduce the power required or heat generated by the lamps.

We will sustain this rejection because, as we discussed above, Misaresh describes a desire to form a more attractive display and this teaching, in our view, would have motivated a person or ordinary skill in the art to combine the teachings of Misaresh with the teachings of Hoshi and Frazier.

To summarize:

The following rejections of the examiner are not sustained;

The rejection of claims 1, 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Fraser in view of Langhorne and Ray.

The rejection of claim 2 under 35 U.S.C. § 103 as being unpatentable over Fraser in view of Langhorne or Ray and further in view of Hoshi.

The rejection of claims 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Fraser in view of Langhorne or Ray and further in view of Misaresh.

The rejection of claims 1 and 3 to 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Misaresh in view of Fraser.

The following rejections of the examiner are sustained:

The rejection of claim 7 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

The rejection of claims 1, 2, 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Misaresh in view of Hoshi.

The rejection of claims 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Misaresh in view of Hoshi and further in view of Fraser.



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

I join my colleagues in the affirmance of the rejections of claim 7 under 35 U.S.C. § 112, second paragraph, claims 1, 2, 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Misaresh in view of Hoshi and claims 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Misaresh in view of Hoshi and Fraser. For the reasons that follow, I cannot join my colleagues in the reversal of the rejections of claims 1, 3 and 4 as being unpatentable over Fraser in view of Langhorne or Ray, claim 2 as being unpatentable over Fraser in view of Langhorne or Ray and further in view of Hoshi, claims 5 and 6 as being unpatentable over Fraser in view of Langhorne or Ray and further in view of Misaresh, and claims 1 and 3-6 as being unpatentable over Misaresh in view of Fraser.

The decision of the majority to reverse the rejections of claims 1, 3 and 4 as being unpatentable over Fraser in view of Langhorne or Ray, claim 2 as being unpatentable over Fraser in view of Langhorne or Ray and further in view of Hoshi, claims 5 and 6 as being unpatentable over Fraser in view of Langhorne or Ray and further in view of Misaresh, and claims 1 and 3-6 as being unpatentable over Misaresh in view of Fraser is grounded on their agreement with appellant that Fraser does not describe a motion detector operative to activate a lamp in response to motion detected **outside** the form, as required by claim 1. Initially, I find no such argument in appellant's brief. Secondly, and more importantly, I note that Fraser (col. 6, last full para.)

describes a motion responsive signaling device including a pair of switch contacts that “can be closed by shaking or tapping housing 11.” The described shaking or tapping of housing 11, which is signaled by closing of switch contacts in response thereto, is, in my opinion, motion outside the form (housing 11). Moreover, motion such as shaking of a shelf, conveyor or other support on which the housing 11 is supported, which is certainly motion outside the housing, would be signaled by the described motion responsive signaling device, as such motion would be translated to the housing 11. Additionally, pressure responsive switch 32 described in the last paragraph of column 5 of Fraser detects pushing motion outside the housing 11 that is translated through indicia bearing strip 34 to flexible plate 36 to close contacts 38 to energize light emitting diode 30.

The argument actually made by appellant (brief, pp. 3-4) with respect to the rejection of claims 1, 3 and 4 as being unpatentable over Fraser in view of Langhorne or Ray is that Fraser does not disclose any backlit textual information and that neither Langhorne nor Ray provides any suggestion to do so. This argument likewise fails to persuade me that these claims are patentable over the applied references as the feature of backlighting of textual information is taught or suggested by Fraser. Specifically, Fraser discloses forming the three side walls 15 of the housing 11 of a hard transparent plastic material (col. 4, ll. 6-9), embedding a circuit including a light source 30 in one of the side walls in combination with pressure responsive switch 32 and providing an indicia bearing strip 34 immediately above the pressure responsive switch

32 bearing textual information such as "PRESS HERE TO TAKE ME HOME." In light of the disclosed transparency of the side walls, for the purpose of permitting merchandise items located within the housing 11 to be seen by a person checking out at a checkout counter, one of ordinary skill in the art would have expected the textual information on indicia bearing strip 34 to be, at least to some extent, backlit by the light source 30 in response to pushing motion imparted to the strip 34, plate 36 and switch 32, or other motion responsive signaling device.

In light of the above, in my opinion, based on the argument by appellant, the rejection of claims 1, 3 and 4 as being unpatentable over Fraser in view of Langhorne or Ray should be sustained.

With respect to the second reason cited by the majority for reversal of the rejection of claim 2 as being unpatentable over Fraser in view of Langhorne or Ray and further in view of Hoshi, while appellant and the majority may be correct that the type of light sensor disclosed by Hoshi would be unsuitable for use in the Fraser divider because such a sensor could activate the switch 32 to signal interest of the customer in purchasing items in the divider without any deliberate and knowing action by the customer, such as pulling a tab, pushing a button or tapping or shaking the housing, I note that a motion responsive signaling device comprising a phototransistor that is exposed to ambient light when a tab 42 is pulled upwardly is disclosed by Fraser in column 7, first full paragraph. Accordingly, appellant's argument does not persuade me

that the rejection of claim 2 should be reversed.

As for the rejections of claims 5 and 6 as being unpatentable over Fraser in view of Langhorne or Ray and further in view of Misaresh and claims 1 and 3-6 as being unpatentable over Misaresh in view of Fraser, appellant's arguments appear to be directed solely to the disclosure of Fraser and Misaresh, respectively, without consideration of the teachings of the additional references applied. It is well established that nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). Such argument does not persuade me that either of these rejections should be reversed.

JENNIFER D. BAHR	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS
	)	AND
	)	INTERFERENCES

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