

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS E. DEMAIO and RUBEN A. JIMENEZ

Appeal 2006-3408
Application 10/885,524
Technology Center 3600

Decided: August 16, 2007

Before LINDA E. HORNER, ANTON W. FETTING, and DAVID B. WALKER,
Administrative Patent Judges.

WALKER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 10-14. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

THE INVENTION

Appellants claim a motorcycle disk lock reminder adapted to be received and held in the ignition switch of a motorcycle and incapable of operating the ignition switch, which serves as a reminder that a disk lock with locking pin is locked into place on one of the wheels and is adapted to carry a loop for receiving the locking pin (Specification 2). Claims 10 and 13, reproduced below, are representative of the subject matter on appeal.

10. The combination of

(a) A motorcycle disc lock reminder comprising

a key having a head portion and a key blank portion, said key blank portion being adapted to be received and held in the ignition switch of a motorcycle and being incapable of operating said ignition switch,

said disc lock reminder being adapted to serve to provide a reminder that a disc lock with locking pin is locked into place on one of the wheels of a motorcycle; and

(b) a motorcycle disc lock with locking pin;

said locking pin being locked into place;

said motorcycle disc lock reminder and said motorcycle disc lock being held together by a key ring which passes through said head portion and over said locking pin.

13. A motorcycle disc lock reminder comprising

a key having a head portion and a key blank portion,

said key blank portion being adapted to be

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received and held in the ignition switch of a motorcycle and being incapable of operating said ignition switch,

said disc lock reminder serving to provide a reminder that a motorcycle disc lock with locking pin is locked into place on one of the wheels of a motorcycle,

wherein said head portion includes a warning light or LED, and

wherein said head portion further includes an off-center key ring passing through said head portion for attachment to a disc lock when the disc lock reminder and disc lock are in a storage- ready state and

wherein said key ring is in the form of a loop large enough to receive said locking pin.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

De Forrest, Sr.	US 4,559,796	Dec. 24, 1985
Fields	US 4,683,741	Aug. 4, 1987
Montano	US 5,205,144	Apr. 27, 1993
Titterton	US 6,178,787	Jan. 30, 2001

The following rejections are before us for review.

1. Claims 10-12¹ are rejected under 35 U.S.C. § 103(a) as unpatentable over Titterton in view of Montano.
2. Claim 13-14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Titterton in view of Montano and further in view of Fields or De Forrest.²

ISSUE

The issue before us is whether Appellants have shown that the Examiner erred in rejecting the following claims under 35 U.S.C. 103(a): (1) claims 10-12 as unpatentable over Titterton in view of Montano; and (2) claims 13-14 as unpatentable over Titterton in view of Montano and further in view of Fields or De Forrest. The correctness of the above rejections turns on whether the secondary references may properly be combined with Titterton to provide (1) a motorcycle disc lock reminder and a motorcycle disc lock held together by a key ring which passes through said head portion and over said locking pin; and (2) a warning light or LED.

Rather than repeat the arguments of Appellants and the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision.

¹ The Examiner originally rejected claims 10-12 and 14 as unpatentable over Titterton in view of Montano. In the Answer, he corrected the rejections to group claim 14 with claim 13, from which it depends (Answer 4).

² The Examiner listed this rejection as over Titterton in view of Fields or De Forrest, but it is clear from his findings in support of the rejection that he also relied on Montano (Answer 8). Accordingly, we review this rejection over the combination of Titterton, Montano, and Fields or De Forrest.

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Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Titterton teaches a motorcycle wheel disk lock reminder system with a disk lock adapted for attachment to a wheel of a motorcycle. The reminder system also includes a reminder unit with an insertion tab outwardly extending from an inner face of the reminder unit. The insertion tab can be inserted into (1) a slot in the disk lock; or (2) an ignition keyhole of the motorcycle after removal from the slot in the disk lock to prevent insertion of an ignition key without prior removal of the reminder unit. (Titterton, col. 4, ll. 3-13).
2. The reminder unit of Titterton includes a head portion 21 (referred to as dome-shaped arcuate outer face), an offset loop portion 24 (referred to as a rectangular side tab) having a circular hole 25, and a key blank portion 22 (referred to as an insertion tab). The offset loop portion is designed for extending a flexible elongate element such as a string, cord, strap, or small chain therethrough to permit attachment of the reminder unit to an

- object such as a user's belt loop or key chain. (Titterton, col. 4, ll. 28-32 and 46-56).
3. Montano teaches a message board 20 joined by a message board attachment ring 22 to a holder head 10, which is adapted to be securely attached to a key-operated door lock (Montano, col. 1, ll. 19-26, col. 2, ll. 34-41).
 4. Fields teaches a door knob and lock assembly with a LED visible from the exterior of the door to provide a flashing display actuated by locking the lock assembly (Fields, col. 1, l. 60 – col. 2, l. 20).
 5. De Forrest discloses a status indicator for a door lock in which two LEDs are alternately lit to show either a locked or unlocked state of the lock to which the status indicator is attached (De Forrest, col. 5, ll. 23-44).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented 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 to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations.

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Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

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Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate this doctrine.” *Id.* at 1739, 82 USPQ2d at 1395. “In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* at 1739-40, 82 USPQ2d at 1395. “*Sakraida and Anderson’s-Black Rock* are illustrative – a court must ask whether the improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 1740, 82 USPQ2d at 1395.

The Supreme Court stated that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate review, this analysis should be made explicit.”

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Id. (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

A. Rejection of claims 10-12 under 35 U.S.C. § 103(a) as unpatentable over Titterton in view of Montano.

The Examiner correctly found that Titterton teaches each of the elements of claim 10 except said motorcycle disc lock reminder and said motorcycle disc lock being held together by a key ring which passes through said head portion and over said locking pin (Answer 3-4, Findings of Fact 1-2). The Examiner found that:

Since the loop portion is clearly an attachment means (col. 4, lines 46-56), it is capable of receiving the lock pin and attaching or joining to the disc lock in that manner. Titterton fails to teach the use of a key ring instead of the flexible elongate chain, strap, string or cord to permit attachment.

(Answer 3). The Examiner further found that “Montano teaches the well known feature of providing a key ring 22 on a loop portion of a key reminder device,” and concluded that

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It would have been obvious to modify the attachment means of Titterton with a well known storage means by providing the device of Titterton with a key ring attached to the loop portion 25, as taught by Montano, as an obvious matter of design choice to provide further attachment means as desired.

(Answer 3-4).

Appellants argue that Titterton requires a disk lock customized to contain slot 18 and thus teaches away from the claimed arrangement, which dispenses with the need of customization of the disk lock (Revised Br. 11-12). We disagree. In fact, Titterton teaches that its “offset loop portion is designed for extending a flexible elongate element such as a string, cord, strap, or small chain therethrough to permit attachment of the reminder unit to an object such as a user’s belt loop or key chain.” (Finding of Fact 2). Titterton thus teaches that the disk lock reminder unit can be attached to a variety of objects, including a key chain, not just placed in a slot in the disk lock. Accordingly, we find Appellants’ teaching away argument unpersuasive.

One of ordinary skill in the art would have been able to replace the flexible elongate chain, strap, string or cord in the motorcycle wheel disk lock reminder system of Titterton with the key ring of Montano using methods known in the art at the time the invention was made. Moreover, each of the elements of Titterton and Montano combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. *See Sakraida*, 425 U.S. at 282, 189 USPQ at 453.

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Claim 10 is a combination which only unites old elements with no change in their respective functions and which yields predictable results. Thus, the claimed subject matter likely would have been obvious under *KSR*. In addition, neither Appellants' Specification nor Appellants' arguments present any evidence that the addition of a key ring to a motorcycle wheel disk lock reminder system is uniquely challenging or difficult for one of ordinary skill in the art. Moreover, the key ring of Montano is a technique that has been used to improve one device (the door lock message holder of Montano), and one of skill in the art would recognize that it would improve similar devices in the same manner.

Because Appellants have not shown that the application of the Montano key ring to the motorcycle wheel disk lock reminder system of Titterton would have been beyond the skill of one of skill in the art, we find using the technique would have been obvious. Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the flexible elongate chain, strap, string or cord in the motorcycle wheel disk lock reminder system of Titterton with the key ring of Montano as an obvious matter of design choice to provide further attachment means as desired (Answer 3-4). Because this is a case where the improvement is no more than the predictable use of prior art elements according to their established functions, no further analysis was required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Claims 11 and 12 were not argued separately, and fall with claim 10. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

B. Rejection of claims 13-14 under 35 U.S.C. § 103(a) as unpatentable over Titterton in view of Montano and further in view of Fields or De Forrest.

In response to this rejection, Appellants argue that “[n]othing in Fields and/or De Forrest suggests modifying Titterton in a way which would result in joining a motorcycle disk lock via its locking pin to a disk lock reminder as defined in claims 10 and 13.” (Revised Br. 15). The Examiner responded that “contrary to Appellant[s’] arguments in the last two lines of page 15, the Fields and DeForrest patents are not used to teach the disk lock and reminder structure, this is clearly taught by the combination of Titterton and Montano.” (Answer 8). For the same reasons as stated for the preceding rejection, we find no error in the Examiner’s reliance on the combination of Titterton and Montano for the limitation of an off-center key ring passing through the head portion of the disk lock reminder for attachment to a disc lock when the disc lock reminder and disc lock are in a storage-ready state as required by claim 13.

In its pre-*KSR* brief, Appellants further argue there is no teaching, suggestion, or motivation to combine Titterton with any of the secondary references (Revised Br. 12, 15-16). *KSR* forecloses Appellants’ argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Moreover, one of skill in the art would have been able to modify the combination of Titterton and Montano to include an LED lock status indicator as taught by Fields or De Forrest using methods known in the art at the time the

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invention was made. Each of the elements of Titterton, Montano, and Fields or De Forrest combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. *See Sakraida*, 425 U.S. at 282, 189 USPQ at 453.

Claim 13 is a combination which only unites old elements with no change in their respective functions and which yields predictable results. Thus, the claimed subject matter likely would have been obvious under *KSR*. In addition, neither Appellants' Specification nor Appellants' arguments present any evidence that the addition of an LED lock status indicator to a motorcycle wheel disk lock reminder system is uniquely challenging or difficult for one of ordinary skill in the art. Moreover, the LED lock status indicators of Fields or De Forrest are techniques that have been used to improve certain devices (the door locks of Fields or De Forrest), and one of skill in the art would recognize that they would improve similar devices in the same manner.

Because Appellants have not shown that the application of the LED lock status indicator of Fields or De Forrest to the motorcycle wheel disk lock reminder system of the combination of Titterton and Montano would have been beyond the skill of one of skill in the art, we find using the techniques would have been obvious. Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a conventional LED lock status indicator as taught by Fields or De Forrest to the motorcycle wheel disk lock reminder system of the combination of Titterton and Montano in order to facilitate use of the lock by

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providing information on the lock status (Answer 8). Because this is a case where the improvement is no more than the predictable use of prior art elements according to their established functions, no further analysis was required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Claim 14 was not argued separately, and falls with claim 13. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

CONCLUSIONS

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 10-14 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 10-14 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 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

JRG

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