

UNITED STATES PATENT AND TRADEMARK OFFICE

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

*Ex parte JANET STOLLE, BELINDA NEMETH and
DAN KOPSAK*

Appeal 2007-2976
Application 11/073,107
Technology Center 3600

Decided: March 26, 2008

Before TONI R. SCHEINER, ERIC GRIMES, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a gift wrap display device. The Examiner has rejected the claims as indefinite, anticipated, and obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse the rejection for indefiniteness but affirm the rejections based on the prior art.

DISCUSSION

1. CLAIMS

Claims 1-20 and 22-26 are pending and on appeal. The claims have not been argued separately with respect to the prior art rejections. The claims rejected under §§ 102(b) and 103(a) therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Claims 1 and 5 are representative and read as follows:

1. A consolidated and coordinated gift wrap display module supporting different types of gift wrap products, the gift wrap display module comprising:

a generally vertically disposed panel having a plurality of fixtures for supporting different types of gift wrap products, the gift wrap products including

gift wrap sheets, gift bags, bows and ribbons;

each of the different types of gift wrap products arranged in groups upon the panel, and colors or themes of the gift wrap products being coordinated.

5. The gift wrap display module of claim 1 wherein the gift bags comprise gift bags of at least two different sizes.

2. DEFINITENESS

Claims 1-20 and 22-26 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The Examiner presented separate bases for rejecting claims 1, 2, 4-7 and 25 (as a group), and 10 (Ans. 4-5).¹

¹ The Examiner also stated that claim 3 is indefinite because the limitation “within the groups” has insufficient antecedent basis (Ans. 5). The version of claim 3 in the Claims Appendix to the Appeal Brief, which the Examiner has indicated is correct (Ans. 3), does not contain the phrase “within the groups.” In any event, claim 1 recites “different types of gift wrap products

A. Claim 1

The Examiner reasons that claim 1’s “recitation ‘for supporting different types of gift wrap products’ . . . conflicts with the positive recitations ‘including gift wrap sheets’” in claim 1 and similar recitations in dependent claims. (Ans. 4.) The Examiner concludes that the claims are indefinite because “it is thus unclear whether applicant is intending to positively claim such articles” (*id.*).

Appellants argue that they filed an after-final amendment to delete the word “for” from line 3 of claim 1, but the Examiner refused to enter the amendment (Reply Br. 2). Appellants assert that the “claims on appeal are directed to the combination of a gift wrap product display and the gift wrap products which are on the display” (*id.* at 1) and request that the claims be interpreted as such during this appeal (*id.* at 2).

We do not completely agree with either the Examiner’s rejection or Appellants’ interpretation of the claim language. Instead, we agree with the Examiner’s response to Appellants’ argument: As written, the claim language “places the gift wrap products as being a non-claimed item of the device, and not a requirement of the claim. As a result the claims are directed solely to the device, i.e. the vertical panel with the plurality of fixtures, and not to the combination of the device with gift wrap products on it” (Ans. 8).

arranged in groups,” so even if the correct version of claim 3 refers to “different types of gift wrap products within the groups” (as it read earlier in prosecution), that limitation has adequate antecedent support.

“The definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification.” *Union Pacific Resources Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692 (Fed. Cir. 2001). “During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000).

Claim 1 states that the claimed gift wrap display module comprises “a generally vertically disposed panel having a plurality of fixtures *for supporting different types of gift wrap products . . . including gift wrap sheets, gift bags, bows and ribbons; each of the different types of gift wrap products arranged in groups upon the panel, and colors or themes of the gift wrap products being coordinated.*” The emphasized limitation states the purpose or intended use of the fixtures on the vertical panel but it does not require that the display module actually comprise gift wrap products in order to come within the scope of the claim. Thus, while the claim requires that the fixtures be *capable of* supporting different types of gift wrap products, arranged in a certain way, it does not require that such products be combined with the display module in order to anticipate or infringe the claim. *See Boehringer Ingelheim Vetmedica v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003) (“An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.”).

We interpret claim 1 to be directed to a display module comprising a generally vertically disposed panel and a plurality of fixtures capable of

supporting gift wrap sheets, gift bags, bows and ribbons, and suitable for arranging the different types of gift wrap products in groups coordinated by color or theme. While claim 1 may not say what Appellants think it says, what it says is definite enough to pass muster under 35 U.S.C. § 112, second paragraph. The rejection of claim 1 for indefiniteness is reversed.

B. Claim 2

The Examiner rejects claim 2 as indefinite because “it is unclear whether the ‘additional types of gift wrap’ are parts of the ‘products’ set forth in . . . claim 1” (Ans. 4).

We do not agree that the limitation added by claim 2 makes it indefinite. Claim 2 is directed to the display module defined by claim 1, “further comprising additional types of gift wrap products including gift cards and novelties which are arranged in groups upon the panel and which have colors or themes which are coordinated with other gift wrap products of the gift wrap display.”

We have already concluded that claim 1 is directed to a display module comprising a generally vertical panel and a plurality of fixtures capable of displaying various gift wrap products in a certain way. Claim 2 requires that the display module also comprise gift cards and novelties, arranged on the panel in a specified way. In our view, the scope of claim 2 is reasonably definite. We therefore reverse the rejection of claim 2 under 35 U.S.C. § 112, second paragraph. *See All Dental Prodx LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774, 779 (Fed. Cir. 2002) (“The primary purpose of the definiteness requirement is to ensure that the claims are

written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent.”).

C. Claims 4-7 and 25

The Examiner rejected claim 4 as indefinite, on the basis that it is unclear whether the gift wrap sheets recited in claim 4 are positively required in the claimed product (Ans. 4). The Examiner rejected claims 5-7 and 25 based on similar reasoning (*id.*).

We will reverse this rejection. Claim 4 is directed to the display module of claim 1, wherein the gift wrap sheets are both folded and rolled, and supported by first and second fixtures, respectively. Thus, claim 4 further limits the display module defined by claim 1 by requiring that the fixtures of claim 1 include a first fixture capable of displaying folded gift wrap sheets, and a second fixture capable of displaying rolled gift wrap sheets. The limitations of claims 5-7 and 25 also add limitations to the nature of the fixtures required in the claimed display module. Since we conclude that the scope of claims 4-7 and 25 is reasonably definite, we reverse the rejection of these claims under 35 U.S.C. § 112, second paragraph.

D. Claim 10

Claim 10 is directed to the display module of claim 1, with a rack fixture supporting one type of product and a hook fixture supporting another type of product. The Examiner rejected claim 10 as indefinite on the basis that it is unclear how the rack fixture and hook fixtures are attached to the panel (Ans. 5).

We will reverse this rejection. The Specification states that the panel can take any of a variety of forms: “The panel 14 can be any material suitable for attachment of the various product display fixtures, and can be specifically configured as a slat wall, metal roll form wall with an array of parallel channels, a sheet form wall with openings, or an open lattice of parallel wires or rods” (Spec. 3). Those skilled in the art would appreciate that the mechanism by which a fixture is attached to the panel will depend on what form the panel takes, and that any mechanism of attaching a fixture to the panel will meet the disputed limitation.

In our view, the scope of claim 10 would be reasonably definite to those skilled in the art. We therefore reverse the § 112, second paragraph, rejection of claim 10.

3. ANTICIPATION

Claims 1, 8, 10, 12, and 15 stand rejected under 35 U.S.C. § 102(b) as anticipated by Kaplan.² The Examiner finds that Kaplan discloses a display module comprising a generally vertically disposed panel having a plurality of fixtures capable of supporting different types of gift wrap products (Ans. 5).

We agree with the Examiner’s reasoning and conclusion. Kaplan’s Figure 1, for example, shows a display rack that has a generally vertical panel (the back) to which are attached hooks and racks that are capable of supporting gift wrap sheets, gift bags, bows, and ribbons. The fixtures are suitable for arranging different types of gift wrap products in any desired

² Kaplan, U.S. Patent 5,344,027, issued Sept. 6, 1994.

configuration, including groups coordinated by color or theme. Thus, we agree with the Examiner that Kaplan anticipates claim 1.

Appellants argue that the

Kaplan patent does not disclose a display of gift wrap products, much less a display of coordinated gift wrap products. . . . [I]t does not disclose color coordination of gift wrap products of the same or different type, as claimed. The Kaplan patent does not disclose gift wrap sheets, bows or ribbons as expressly claimed. . . . The Kaplan patent cannot therefore anticipate the claims.

(Appeal Br. 5.)

Claim 1, as we interpret it, requires only a panel and fixtures; the recited gift wrap products modify the characteristics of the required fixtures but are not themselves part of the display module defined by the claim language. Therefore, Kaplan anticipates even though it does not disclose all of the gift wrap products (and configuration thereof) recited in claim 1. The rejection of claim 1 under 35 U.S.C. § 102(b) is affirmed. Claims 8, 10, 12, and 15 fall with claim 1.

4. OBVIOUSNESS

Claims 2-7, 9, 11, 13, 14, 16-20, and 22-26 stand rejected under 35 U.S.C. § 103 as obvious in view of Kaplan and Johnson.³ Claim 5 is representative of the rejected claims, and is directed to the display module of claim 1, “wherein the gift bags comprise gift bags of at least two different sizes.”

The Examiner cited Johnson for its disclosure of a gift wrap display and concluded that, based on the cited references, “it would have been

³ Johnson et al., Des. 265,024, issued June 22, 1982.

obvious to one of ordinary skill in the art to have the display include[] different types of gift wrapping products, (paper, bags, ribbon, novelties, etc.), of different sizes and configurations . . . for such basic reasons as product accommodation, marketability, creating an aesthetically pleasing display, etc.” (Ans 7-8).

We agree with the Examiner that claim 5 would have been obvious to those of ordinary skill in the art based on the cited references. Kaplan is discussed above. Johnson is a design patent that shows a “greeting card and gift wrap display unit” (Johnson, Description) that includes different-sized shelves, bins, and rotating stands (Johnson, Figs. 1 and 2). We agree with the Examiner that it would have been obvious to a person of ordinary skill in the art to modify Kaplan, based on Johnson, to include fixtures capable of supporting gift wrap products, including gift bags, of at least two different sizes.

Appellants argue that “there is no disclosure of the different types of gift wrap products [in Johnson] . . . , or the claimed arrangement of different types of gift wrap products in groups, or coordination of the claimed different types of gift wrap products by color or theme or occasion” (Appeal Br. 6). For the reasons discussed above, however, we conclude that the claim language relied on by Appellants does not limit the claimed display module to one that actually includes the recited products and arrangements; claim 5 as written merely requires that the display module be capable of supporting the recited products, arranged in the recited manner. The product defined by claim 5 would have been obvious based on the cited references.

Appellants also argue that “[b]ecause the Kaplan patent does not disclose the different types of gift wrap products which are expressly claimed, there is no suggestion by the Kaplan patent that it be combined with any other prior art reference to arrive at the invention as claimed” (Appeal Br. 6).

This argument is not persuasive. First, we do not agree that the recited gift wrap products are “expressly claimed,” as discussed above. Second, we do not agree that those skilled in the art would not have considered it obvious to combine the cited references. Kaplan expressly teaches that the disclosed device is used to display gift wrap products. See Kaplan, col. 2, ll. 45-55 (“Appropriate ‘gift’ packaging for all of the items displayed on the rack 10 is separately packaged and displayed for sale on the rack as shown at 36 As shown . . . the packaging is a decorative bag 37 which is folded flat in the polybag. Tissue wrapping material 44, and, if desired, a gift tag accompany the packaging.”). Johnson discloses a display capable of displaying multiple types and sizes of gift wrap products (Johnson, Figs. 1 and 2).

The obviousness analysis “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.* at 1742. In our view, the teachings of Kaplan and Johnson would have suggested modifying Kaplan’s display (to the extent modification would be required) to make it capable of displaying at least two different sizes of gift bags.

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We affirm the rejection of claim 5 under 35 U.S.C. § 103. Claims 2-4, 6, 7, 9, 11, 13, 14, 16-20, and 22-26 fall with claim 5.

SUMMARY

We reverse the rejection for indefiniteness but affirm the rejections under 35 U.S.C. §§ 102(b) and 103(a).

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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