

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD LOUIS UNDERHILL and DAVID JON WEARS

Appeal 2008-1098
Application 11/000,719
Technology Center 3700

Decided: January 9, 2009

Before WILLIAM F. PATE, III, LINDA E. HORNER, and
JOHN C. KERINS, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Richard Louis Underhill and David Jon Wears (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 26-30, 32-40, 42-47, 49-52, 54 and 55, the only claims now pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants' claimed invention is to a method and apparatus for displaying toilet training materials. (Appeal Br., Claims Appendix, claims 26, 36) The method involves providing a supply of at least two different types of toilet training materials, housing the materials within a display, and providing insignia on the display which conveys toilet training information to the consumer, the information relating to particular toilet training materials.

Claim 26, reproduced below, is representative of the subject matter on appeal.

26. A method of displaying toilet training materials comprising:

providing a supply of at least two different types of toilet training materials;

housing the materials within a display; and

providing insignia on the display which conveys toilet training information to the consumer, wherein the toilet training information describes, recommends, or promotes particular toilet training materials.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Walter

US 5,725,382

Mar. 10, 1998

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Miller	US 5,865,322	Feb. 2, 1999
Gabig	US 5,882,209	Mar. 16, 1999

The Examiner has rejected Claims 26-30, 32-40, 42-47, 49-52, 54 and 55 under 35 U.S.C. § 103(a) as being unpatentable over Gabig in view of Walter and Miller.

ISSUE

The Examiner found that the combined teachings of the Gabig, Walter and Miller patents fairly suggests a display method for toilet training materials in which at least two different types of toilet training materials are housed in a display with insignia or indicia related to the materials being present on the display.

Appellants urge that the references are not properly combinable, due to a lack of any teaching or suggestion to combine; that the references teach away from the Examiner's combination; that the combination would render one or more of the devices disclosed in the references inoperable for their intended purpose. Appellants further contend, with respect to several dependent claims, that the combination does not teach or suggest providing toilet training information directing a consumer to purchase toilet training material appropriate to a child's particular level of development.

The issues joined in this appeal are: did the Examiner err in combining the teachings of Gabig, Walter and Miller in rejecting the claims; and does the element argued by Appellants to not be taught or suggested by the combination render the claims containing that element patentable?

FINDINGS OF FACT

The following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

FF 1. The Gabig patent discloses a display having a plurality of regions thereon displaying a plurality of related product samples. (Gabig, Fig. 1; col. 1, l. 66-col. 2, l. 9).

FF 2. The Gabig display houses, in shelves 26 and literature display member 27, a supply of promotional literature and pricing information sheets related to the product samples presented on the display. (Gabig, Fig. 1; col. 3, ll. 54-59).

FF 3. The Gabig display includes several examples of providing insignia 25 on the display that describe the products and materials included in the display. (Gabig, Fig. 1; col. 2, ll. 54-55).

FF 4. The Gabig patent specifically discloses displaying memorial service-related products, and states generally that the display is directed to displaying a plurality of product lines and design features having a related theme. (Gabig, Col. 1, l. 66-col. 2, l. 6; col. 2, ll. 18-29).

FF 5. The Walter patent discloses a self-contained kit displaying to the user a plurality of different types of products, materials, and information related to toilet training. (Walter, Figs. 2, 9; col. 7, l. 29-col. 8, l. 11).

FF 6. Walter discloses that grouping of the several different types of toilet training materials into a single self-contained kit, the contents of which are displayed to the user, will enable children to more easily progress through the toilet training process. (Walter, col. 3, ll. 3-17).

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.*, 550 U.S. 398, ___, 127 S. Ct. 1727, 1734 (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. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at ___, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

Where non-functional descriptive material or printed matter is claimed that is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004)(invention consisting of addition of a new set of instructions into a known kit not patentable where printed matter does not interrelate with nor depend on kit, and kit does not depend on the printed matter); *cf. In re Gulack*, 703 F.2d 1381, 1385-86 (Fed. Cir. 1983).

ANALYSIS

Appellants argue claims 26-30, 34-40, 44-47, 51 and 52 as a first group, and separately argue for the patentability of claims 32, 33, 42, 43, 49,

50, 54 and 55 as a second group. Claims 26 and 32 will be treated as representative of the first and second groups, respectively, and all other claims in each group stand or fall with their representative claim. 37 C.F.R. §41.37(c)(1)(vii) (2007).

Claims 26-30, 34-40, 44-47, 51 and 52

The Examiner cites to the Gabig patent for its disclosure of a display having a plurality of regions thereon, with each region housing a particular type of product. (Final Rejection 2)¹(FF 1). The Examiner looks to the Walter patent as teaching a self-contained kit having a plurality of compartments for displaying different types of materials and information related to toilet training. (Final Rejection 2)(FF 5). The Examiner concludes that it would have been obvious to modify the Gabig display, by replacing the plurality of memorial products with a plurality of toilet training products, in view of the disclosure in the Walter patent that it is desirable to group together various types of toilet training materials. (Final Rejection 2-3).

Appellants attack the sufficiency of the Gabig disclosure, asserting that Gabig lacks a disclosure of, “selling multiple types of related products, much less different types of toilet training products”, and of, “selling multiple types of related products together on a region of shelf space”. (Appeal Br. 6). Claim 26, however, is not specifically limited to “selling” any product, nor is there any limitation present directed to “a region of shelf

¹ The Examiner’s Answer in this appeal refers back to the Final Rejection dated February 22, 2006, for the full exposition of the grounds of rejection of the claims.

space”. As such, these attempts by Appellants to distinguish their invention from Gabig fall short.

Focusing on the actual language of claim 26, the Gabig display unit includes a display of a plurality of related product samples, and provides a supply of at least two different types of product-related materials, in the form of promotional literature and pricing information sheets and the like. (FF 1, 2). Promotional literature and pricing information sheets fall within the categories of educational materials and promotional materials, which Appellants expressly disclose as being types of toilet training materials. (Specification 4:22-24). These materials are housed in the Gabig display, in shelves 26 and literature display member 27. (FF 2). The display unit as described and illustrated in Gabig further provides several examples of insignia 25 that describe the products and materials displayed thereon. (FF 3).

While the Gabig patent focuses, in its preferred embodiments, on the display of memorial products, the patent more generally discloses a product display for displaying a plurality of product lines having a plurality of design features. (FF 4). The Examiner contends, and Appellants do not contest, that a person of ordinary skill in the art would have understood that the teachings of Gabig could be applied to other types of merchandise. (Answer 4).

The Examiner cites to the Walter patent as evidencing the grouping of several types of toilet training materials, including toilet training information that describes particular toilet training materials. (*Id.*)(FF 5). The Walter patent describes that, by bringing the plurality of types of toilet training materials together into a self-contained kit, children will more easily

progress through the toilet training process. (FF 6). The Examiner concludes that it would have been obvious to employ the Gabig display in connection with toilet training materials, in view of the knowledge imparted by Walter of grouping several types of toilet training materials in a manner that displays the different types of materials to the user. (Answer 4).

Appellants urge that Walter teaches away from a combination with Gabig, in that the kit in Walter is intended to be portable, which a display is not. Appellants cite to Section 2143.01 of the Manual of Patent Examining Procedure, as well as to *In re Ratti*, 270 F.2d 810 (CCPA 1959), arguing that, where a proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to establish a prima facie case of obviousness. (Appeal Br. 6).

This argument is unavailing. The prior art invention here being modified, namely the Gabig display, would not undergo a change in its principle of operation in the combination proposed by the Examiner, rather, the same principle of operation would be employed with another category of merchandise.² The portability aspect of the Walter toilet training kit is not at issue here.

² Indeed, the language in the claims directed to “toilet training materials” is sufficiently broad that the materials may be nothing more than printed matter or non-functional descriptive material that is not functionally related to the substrate (display) with which it is connected. No new and unobvious functional relationship appears to exist between this material and its substrate, and thus it would be entirely appropriate to conclude, in the alternative, that the descriptive material does not patentably distinguish the invention over the Gabig patent. See, *In re Ngai*, 367 F.3d at 1339; *In re Gulack*, 703 F.2d at 1385-86.

The Examiner further cites to the Miller patent as evidencing that it is known in the art of merchandise displays to provide insignia on the display to convey information about the merchandise to prospective customers. (Answer 4-5). In addition, the Examiner notes that it is well known in general to provide such informational insignia on merchandise displays.³ (Answer 4). The Examiner also concludes that the indicia as claimed are printed matter having no new and nonobvious functional relationship with its underlying substrate, the display. (Answer 5).

Appellants critique the inclusion of the teachings of Miller as a cobbling of a third reference into the combination on which the rejection is based, and argue that Miller is directed to absorbent products of a type not related to toilet training. To the extent that the Miller patent is even necessary to establish a prima facie case of obviousness (*see*, fn. 3; and rejection based on non-functional descriptive material), Appellants have not established why here the citation to three references in combination amounts to error on the Examiner's part. Further, advancing the argument that the Miller patent is not specifically directed to toilet training products is nothing more than an attack on the reference individually, and not on the combined teachings of the references. The argument is thus not persuasive that error exists in employing the reference in the rejection. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986). In the combination of the Gabig and Walter teachings, a display of toilet training materials is produced. Miller teaches

³ The Examiner states that Gabig and Walter fail to disclose informational insignia on a display; however, it appears that Gabig does include such insignia. As but one example, headings 25 are provided to identify particular design features displayed in the product samples. (FF 3).

the provision of insignia directed to the products being displayed, so in the Gabig/Walter display, such insignia would be information directed to the toilet training materials being displayed.

Appellants have further not established that the Examiner erred in concluding that the claimed insignia is not functionally related to the display. Appellants argue only that the cited prior art does not disclose insignia conveying toilet training information. Like the Examiner, we fail to see any new and nonobvious functional relationship between the display and the insignia as claimed, and the insignia thus does not serve to patentably distinguish the invention from the prior art. *In re Ngai*, 367 F.3d at 1339.

Appellants have not persuaded us that error was committed in rejecting claim 26 under 35 U.S.C. § 103(a) over Gabig, Walter and Miller. The rejection of claims 26-30, 34-40, 44-47, 51 and 52 will be sustained.

Claims 32, 33, 42, 43, 49, 50, 54 and 55

Appellants contend that the combination of the teachings of Gabig, Walter, and Miller does not teach or suggest the claim element, “[wherein] the toilet training information directs a consumer to purchase a toilet training material appropriate to a child’s particular level of development”. (Appeal Br. 7). Representative claim 32 containing this element depends from claim 26, which sets forth that this toilet training information is conveyed by the “insignia” provided on the display.

As discussed above with respect to the claim element directed to providing “insignia” on the display, Appellants have not demonstrated that the insignia conveying toilet training information, whether of the type recited in claim 32 or otherwise, has any functional relationship with, or

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interdependence with, the display on which the insignia appears. As such, the provision of insignia conveying toilet training information directing a consumer to purchase material of an appropriate developmental level does not serve to patentably distinguish the invention. *Id.* The rejection of claims 32, 33, 42, 43, 49, 50, 54 and 55 will be sustained.

CONCLUSION

Appellants have not established that reversible error exists in the rejection of claims 26-30, 32-40, 42-47, 49-52, 54 and 55 under 35 U.S.C. § 103(a) as unpatentable over Gabig in view of Walter and Miller.

ORDER

The decision of the Examiner to reject claims 26-30, 32-40, 42-47, 49-52, 54 and 55 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) (2007).

AFFIRMED

vsh

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