

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER LANCI

Appeal 2008-1713
Application 10/265,498
Technology Center 3600

Decided: September 4, 2008

Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and DAVID B. WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claim 4. We have jurisdiction under 35 U.S.C. § 6(b)(2002). We affirm.

Appellant claims an improved carousel type display (Specification 2). Claim 4, reproduced below with formatting added, is the sole claim on appeal.

Appeal 2008-1713
Application 10/265,498

4. In a carousel display device, including a relatively fixed base, a relatively rotatable turntable supported by said base, means disposed within said base for driving said turntable, said turntable having a generally circular periphery, a plurality of sockets arranged along said periphery, and a plurality of display elements depending from said periphery, the improvement comprising:

a representation of a train of arcuate configuration supported upon said turntable at said periphery, and rotating therewith,

said base including a vertically-oriented non-rotating shaft extending through said turntable, an upper end of which forms a cap, said cap simulating a building structure;

whereby during rotation of said turntable, said representation of said train rotates about said building structure.

THE REJECTION

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

Johnson	US 1,711,790	May 7, 1929
Cottrell	US 3,191,930	June 29, 1965

Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Cottrell in view of Johnson.

Appeal 2008-1713
Application 10/265,498

ISSUE

The issue before us is whether the Examiner erred in rejecting claim 4 as unpatentable over Cottrell in view of Johnson. The issue turns on whether the references are properly combined and whether the combination teaches a representation of a train and a cap as required by claim 4.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant 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) (2007).

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 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Cottrell teaches a carousel mechanism which includes a hollow vertical shaft mounted in a fixed position to a bottom plate. A canopy 15 extends from the shaft to an edge piece 16. Lights 25 are attached to the top of the fixed shaft (Cottrell, col. 2, 11-18 and Figure 1).
2. An upper disk or ceiling plate 12 and a lower disk or platform 13 joined by columns 14 are rotatably mounted on the vertical shaft. A number of

figurines 36 are mounted on push rods 35 in the space between the upper disk 12 and lower disk 13 (Cottrell, col. 2, ll. 11-15). The figurines are shown as horses in Figure 1 of Cottrell.

3. Johnson teaches a display device adapted for displaying representations of moving vehicles, such as representations of trains traveling on different tracks around a common axis (Johnson, 1:1-6).
4. Circular bands 49-52 with display matter in the form of trains are respectively independently removably mounted to permit each circular band to independently rotate in either a clockwise or counter-clockwise direction. The circular bands diminish in diameter from the bottom one to the top one as shown in Figure 1 to give the impression of each train traveling to the right or left at a speed depending on the size of its respective circular band (Johnson, 2:5-43).

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 (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 ordinary skill in the art, and (4)

Appeal 2008-1713
Application 10/265,498

where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 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.”)

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, 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.

Id. at 1740. 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.*

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward

with evidence or argument shift to the appellant. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

ANALYSIS

The Appellant argues that neither Cottrell nor Johnson teaches a cap simulating a building structure as claimed. The Appellant appears to misread the Examiner's rejection to rely solely on canopy 15 of Cottrell as the cap (Br. 4). In fact, the Examiner found that Cottrell discloses cap 25 fixed to the end of fixed shaft 10, which does not rotate relative to the base. The Examiner further found that cap 25 is a lighted dome, which constitutes a simulation of a building structure (Answer 3). The Examiner also found that part 25 is fixed to the shaft of the assembly and in combination with part 15 depicts a building structure (Answer 4). We find no error in the Examiner's characterization of parts 25 and 15 of Cottrell, which we find to meet the required cap limitation. The Appellant further argues that Johnson does not teach a cap as claimed (Br. 4), which we do not find persuasive, because the Examiner relies appropriately on Cottrell as teaching the cap limitation.

The Appellant also argues that there is no place to mount a representation of a train or any other decorative item on part 12 of Cottrell, which the Examiner relies on as the claimed turntable (Br. 5). The Examiner correctly notes that claim 4 requires only "a representation of a train of arcuate configuration supported upon said turntable at said periphery, and rotating therewith," and nowhere requires the

Appeal 2008-1713
Application 10/265,498

elements to depend from supports upon the turntable. The Examiner argues that replacing the carousel horses 36 of Cottrell with a train, like that of Johnson, meets the disputed claim limitation, since the horses of Cottrell depend from the periphery by posts 14 and are supported on the turntable by posts 14. We agree with the Examiner. Appellant argues that Cottrell has no corresponding vertical surface to those used in Johnson to display the representations of trains (Br. 5). We disagree. Carousel 12 of Cottrell as shown in Figure 1 appears to have a vertical surface similar to the circular bands 49-52 of Johnson. We see no reason why one of skill in the art would be unable to paint a train on the periphery of turntable 12 of Cottrell as it is on circular bands 49, 50, 51, and 52 of Johnson, which also would meet the disputed claim limitation.

The Appellant further argues that the holes where the posts (14) are connected to the upper and lower discs do not constitute a socket, which he argues is a recess adapted to engage a correspondingly shaped object (Br. 5). The Examiner found that, given the definition by the Appellant, the hole where posts 14 attach is a recess, since both the post and the hole are round in shape and the post engages the hole (Answer 5). We agree with the Examiner.

Appellant also argues that the combination of Cottrell and Johnson does not suggest a centrally-disposed train station, nor does Johnson suggest his representation of a train rotating about such a station (Br. 6). This argument is not commensurate with the scope of the claim, which requires only that the train rotates about the building structure simulated by the cap. Claim 4 does not require a train station.

Appeal 2008-1713
Application 10/265,498

Appellant argues that Cottrell is not capable of the modification required so as to suggest obviousness when taken with Johnson (Br. 5-6). To the extent the Appellant is arguing that it would not be obvious to combine Cottrell with Johnson, we disagree.

One of ordinary skill in the art would have been able to modify Cottrell to replace the carousel horses 36 of Cottrell with a train, like that of Johnson, using methods known in the art at the time the invention was made. Moreover, each of the elements of Cottrell and Johnson 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 v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976).

Claim 4 therefore is a combination which only unites old elements with no change in their respective functions and which yields predictable results. Therefore, the claimed subject matter likely would have been obvious under *KSR*. In addition, the train of Johnson has been used to improve the display device disclosed therein. The Appellant has provided no persuasive evidence that using the train of Johnson with the carousel mechanism of Cottrell is beyond the skill of one of ordinary skill in the art. 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 modify Cottrell by decorating an ornate element in the form of a representation of a train to enhance the aesthetic value of the apparatus to suit a user or customer of the apparatus (Answer 4).

Appeal 2008-1713
Application 10/265,498

The Appellant therefore has not shown error in the Examiner's rejection of claim 4.

CONCLUSIONS

We conclude that Appellant has not shown that the Examiner erred in rejecting claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Cottrell in view of Johnson.

DECISION

The decision of the Examiner to reject claim 4 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

Charles E. Temko
22 Marion Road
Westport, CT 06880