

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUSUF M. BARRETT

Appeal 2008-1773
Application 10/684,954
Technology Center 3600

Decided: June 30, 2008

Before ERIC GRIMES, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1, 3-5, 8, 9, 11-16, 19, and 20. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a free-standing, animal-shaped structure for providing a child a place to take a nap, as well as a method of using the structure for a child's nap. Claims 1 and 13 are representative of the claims on appeal, and read as follows:

1. A hollow, three-dimensional, free-standing animal-shaped structure for providing a place for a child to take a nap, said structure being of such a size to allow a child to fit at least partially inside, said structure having features of a real animal, said structure being made of inflatable air-tight material, and said structure having an entrance for the child, said entrance having a swinging door, and said entrance being of such a size as to allow the child to crawl into the structure without changing the size of the entrance.

13. A hollow, three-dimensional, free-standing animal-shaped structure for providing a place for a child to take a nap, said structure being of such a size to allow a child to fit at least partially inside, said structure having features of a real animal, said structure being made of padded fabric, and said structure having an entrance for the child, said entrance having a swinging door, and said entrance being of such a size as to allow the child to crawl into the structure without changing the size of the entrance.

The Examiner relies on the following references:

Berman	US 6,722,084 B2	Apr. 20, 2004
Yercha	US 5,345,961	Sep 13, 1994

The Examiner contends that claims 1, 3-5, 8, 9, 11-16, 19, and 20, all of the claims on Appeal, are obvious over the combination of Berman and Yercha.

Appellant contends that the Examiner has failed to set forth a prima facie case of obviousness.

Thus, the issue of Appeal is: Has the Examiner set forth a prima facie case of obviousness that all of the claims on Appeal are obvious over the combination of Berman and Yercha?

FINDINGS OF FACT

The Scope and the Content of the Prior Art

Berman

FF1. Berman teaches an inflatable play tent that can assume a fanciful shape, such as a house (Berman, Fig. 2). The inflatable structure of Berman is not limited to a house or a tent, but may be in the form of “any structural design for use as an inflatable structure” (Berman, col. 2, ll. 36-40). (*See* Ans. 3.)

FF2. The tent may include an inflatable base or floor (20), a plurality of inflatable walls (30), a foot operated pump (300) to inflate the device, and a pivoted doorway (70) may be provided in one of the walls of the tent (*See, e.g.,* Berman, col. 2, ll. 47-60; col. 3, ll. 8-15; col. 4, ll. 4-15). (*See* Ans. 3.)

FF3. A sound generating means (200) may be attached to the tent (Berman, col. 4, ll. 16-42). (*See* Ans. 3)

FF4. Other means for sensory stimulation may be attached to the tent, including means for generating effects that access the normal human senses of touch, taste, feel, sight, and smell (Berman, col. 4, ll. 39-42). (*See* Ans. 3.)

FF5. The stimulation enhancing factors are appropriate for the decorative motif of the tent (*see, e.g.,* Berman, col. 4, ll. 27-39), and can be varied from that of a camping-style tent and/or a house (Berman, col. 2, ll. 40-45; col. 3, l. 65). (*See* Ans. 3-4.)

Yercha

FF6. Yercha teaches that it is well known in the art to produce a play enclosure that takes the form of an animal, such as a dinosaur. (See Ans. 4.)

FF7. Figure 1 of Yercha is representative, and is reproduced below:

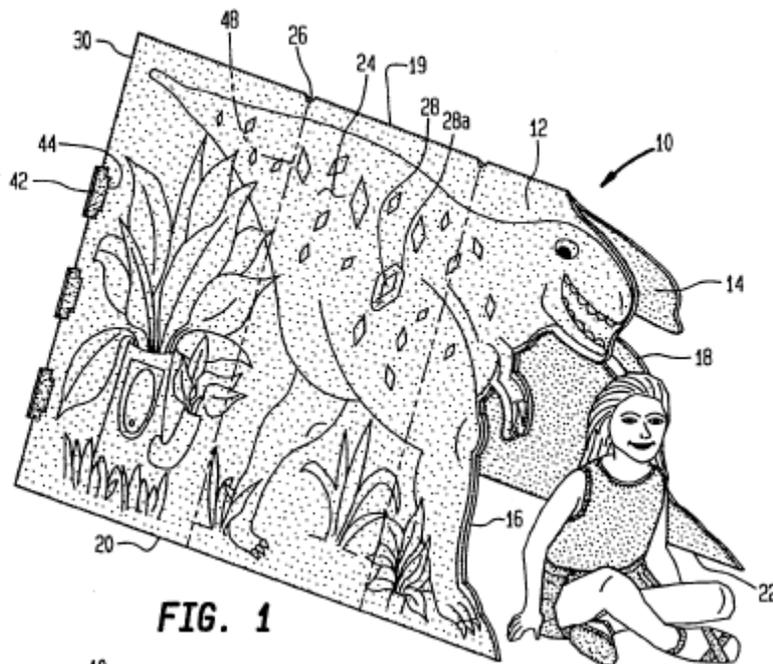


Figure 1 of Yercha shows a tent structure having the features of a dinosaur (col. 2, ll. 19-52.)

FF8. Yercha teaches that the tent may depict a large animal such as a dinosaur or a small animal such as a rabbit, with the frontal profile of the animal, or similar indicia, being coincident with contoured frontal edges (Yercha, col. 1, ll. 19-31).

FF9. Yercha further teaches that a child playing with the tent enjoys the feeling within the confines of a simulated animal, and also enjoys viewing the animal from the outside (Yercha, col. 2, ll. 46-52).

The Level of Ordinary Skill in the Art

FF10. The level of ordinary skill in the art, as evidenced by the Berman and Yercha references, would be someone who designs children's products.

The Differences between the Claimed Invention and the Prior Art

FF11. Berman fails to specifically teach an animal-shaped inflatable structure, the structure having features of a real animal. (See, e.g. Ans. 4.)

FF12. Berman fails to specifically teach an interior light. (See Ans. 4)

FF13. Berman fails to teach the use of decorative lights, such as an animal that has eyes that light up (Ans. 4).

ANALYSIS

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The Supreme Court has recently emphasized that “the [obviousness] 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.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739. Moreover, an “[e]xpress suggestion to substitute one equivalent for another need not be

present to render such substitution obvious.” *In re Fout*, 675 F.2d 297, 301 (CCPA 1982).

The Examiner concludes that “it would have been obvious to one of ordinary skill in the art to have used an animal type of decorative image or motif upon the Berman tent as taught by Yercha . . . to create a play enclosure that has a decorative effect which is pleasing and/or attractive to a child.” (Ans. 4) In addition, the Examiner concludes that providing an interior light would have been well known and within the level of skill of the ordinary artisan, as would the use of decorative lights, such as providing a structure that has the features of an animal, wherein the eyes light up (*Id.*) We now turn to Appellant’s arguments in rebuttal.

Appellant groups claims 1, 5, and 9 together (App. Br. 10). We focus our analysis on independent claim 1, and claims 5 and 9 stand or fall with that claim.

Appellant argues that the Examiner has failed to resolve the factual inquiries required by *Graham*. (App. Br. 10-14). Moreover, as to the level of ordinary skill in the art, Appellant asserts “that one skilled in the art would be the parent of a child using the device of this invention . . . [who] would have a college degree and no training in the field of sleeping area designs for children.” (App. Br. 12-13.)

Appellant’s arguments are not convincing. First, we conclude that the Examiner did resolve the factual inquiries required by *Graham*, even if not explicitly. The rejection of the Examiner did set forth the teaching of both Berman and Yercha (Ans. 3-4), and in stating that it “would have been obvious . . . to have used an animal type of decorative image or motif upon the Berman tent as taught by Yercha,” the Examiner is implicitly setting

forth the differences between the claimed invention and the prior art. With respect to level of skill in the art, the best evidence of that are the Berman and Yercha references. Although not explicitly stated by the Examiner, we find the level of skill in the art to be that of someone who designs children's products. We find no evidence in the record to support Appellant's assertion that a person skilled in the relevant art would be the parent of a child using the device of this invention who would have a college degree and no training in the field of sleeping area designs for children.

Appellant argues that the tent of Yercha "has a first end which is straight, a bottom which is straight, a top which is straight, and a second end which contains the outline of the front of an animal . . . that . . . cannot be accurately be said to be an enclosure that takes the form of an animal." (App. Br. 10.) Thus, Appellant asserts, the Examiner "has not made an accurate determination of the scope and content of the prior art." (*Id.* at 10-11.)

Again, Appellant's argument is not convincing. During prosecution before the Office, claims are to be given their broadest reasonable interpretation consistent with the Specification as it would be interpreted by one of ordinary skill in the art. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Note that "[a]n essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989). Moreover, it is during prosecution that applicants have "the opportunity to amend the claims to obtain more precise claim coverage." *American Academy*, 367 F.3d at 1364.

Claim 1 does not require that the enclosure take the entire form of an animal. All that is required by claim 1 is a “structure having features of a real animal.” The tent structures of Yercha have such features. For Example, the tent of Figure 1 has the likeness of a dinosaur drawn on the outside, and has been cut in front to the outline of the leg, the forelegs, the chest, and the mouth of a dinosaur. As can be seen in Figure 5, further features may be added, such as a mane or bony frill of an animal (Yercha, col. 3, ll. 30-45).

Appellant argues further that the Examiner asserts that the motivation to combine the references is “to create a play enclosure that has a decorative effect that is pleasing and/or attractive to a child,” but that motivation is not found in the references (App. Br. 13.) Appellant argues further that there would be no expectation of success “if one were to substitute the tent of Yercha [] for one of the forms taught by Berman as there would be too much open space and balance would be a problem.” (*Id.* at 14.)

The issue of motivation to combine references has recently been addressed by the United States Court in *KSR International Co., v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). The Court rejected a rigid application of the teaching-suggestion-motivation test, *id.* at 1739, but noted:

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 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. In this case, Berman teaches an inflatable tent, and although explicitly providing embodiments of a camping tent and a house, notes that the structure may be in the form of “any structural design for use as an inflatable structure” (Berman, col. 2, ll. 36-40). Yercha teaches a tent-like structure that may depict a large animal such as a dinosaur or a small animal such as a rabbit, with the frontal profile of the animal, or similar indicia, being coincident with contoured frontal edges (Yercha, col. 1, ll. 19-31), and that a child playing with the tent enjoys the feeling within the confines of a simulated animal, and also enjoys viewing the animal from the outside (Yercha, col. 2, ll. 46-52). Thus, we conclude that it would have been well within the level of skill of the ordinary artisan to provide a structure having features of a real animal as taught by Yercha to the inflatable structure of Berman.

As to a reasonable expectation of success, all that is required is a reasonable expectation of success, not absolute predictability of success. *In re O’Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988). Moreover, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR*, 127 S.Ct. at 1742. Thus, we find that the ordinary artisan would understand how to address the issues of open space and balance.

Thus, we conclude that the Examiner has set forth a prima facie case of obviousness as to claim 1 that has not been rebutted by Appellant, and as claims 5 and 9 stand or fall with that claim, the rejection is affirmed as to claims 1, 5, and 9.

As to claim 3, Appellant argues that the Examiner “has not urged that the animal of Yercha [] has a mouth and that the entrance for the child is

located at the mouth of the animal.” (App. Br. 15.) As to claim 4, Appellant argues that the Examiner “is correct in omitting any reference to a chest having an entrance for a child as the prior art does not contain this teaching.” (App. Br. 16.)

Appellant’s arguments as to claims 3 and 4 are not convincing. In the structure of Yercha, the frontal profile of the animal or similar indicia, is coincident with contoured frontal edges (Yercha, col. 1, ll. 19-31), thus it would have been obvious to the ordinary artisan to use any frontal portion of the animal, such as the chest or the mouth, as the entrance, depending on the animal being portrayed. Thus, we also affirm the rejection as to claims 3 and 4.

As to claim 8, Appellant argues that the Examiner “has not urged that the animal of Yercha [] has eyes that light up,” and is correct in doing so “as the prior art does not contain this teaching.” (App. Br. 18.)

We agree with the Examiner that it would have been within the level of skill of the ordinary artisan to use decorative lights, such as providing a structure that has the features of an animal, wherein the eyes light up, in view of Berman’s teaching that stimulation enhancing factors are appropriate for the decorative motif of the tent (*see, e.g.*, Berman, col. 4, ll. 27-39), and can be varied from that of a camping-style tent and/or a house (Berman, col. 2, ll. 40-45; col. 3, l. 65). Therefore, the rejection is also affirmed as to claim 8.

As to claims 11 and 12, Appellant reiterates the arguments made with respect to claim 1 (App. Br. 19-22). Thus, the rejection is affirmed for the reasons set forth with respect to the discussion of claim 1.

As to claims 13-16, 19, and 20 (of which claim 13 is the independent claim), Appellant argues that “the [E]xaminer has chosen not to comment on claim 13.” (App. Br.

Claim 13 requires that the structure be made of padded fabric. As the Examiner has made no factual finding in this record with regard to the use of a padded fabric to make the structure, we are compelled to reverse the rejection as to claims 13-16, 19, and 20.

CONCLUSIONS OF LAW

We conclude that the Examiner has set forth a prima facie case of obviousness as to claims 1, 3-5, 8, 9, 11, 12, but has failed to set forth a prima facie case as to claims 13-16, 19, and 10.

TIME LIMITS

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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