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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CARLO ARMENISE

Appeal 2010-006444
Application 11/399,689
Technology Center 3700

Before JENNIFER D. BAHR, JOHN C. KERINS, and
EDWARD A. BROWN, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1-7 and 10-20. App. Br. 2. Claims 8 and 9 have been canceled. *Id.* We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We affirm-in-part and enter new grounds of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

THE CLAIMED SUBJECT MATTER

Claims 1, 7, and 12 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the appealed subject matter:

1. A combination gag gift and desktop accessory comprising:
 - a base with a plurality of spaces on said base for holding a plurality of desktop utility items;
 - at least one caricature figurine also attached to said base, said figurine being a human form and mocking at least one human stereotype or character trait;
 - said gag gift and desktop accessory also including a written title identifying a particular human stereotype or character trait.

THE REJECTIONS

Appellant requests review of the following rejections:

1. Claims 1, 2, 4-6, 11-14, and 16-20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Huang (US 5,040,673; iss. Aug. 20, 1991) and Chun-Hoi (US 4,824,416; iss. Apr. 25, 1989).
2. Claims 3 and 15 are rejected under 35 U.S.C. § 103(a) over Huang, Chun-Hoi, and MacNalley (US 3,464,564; iss. Sept. 2, 1969).

3. Claims 7 and 10 are rejected under 35 U.S.C. § 103(a) over Huang, Chun-Hoi, and Pasch (US 6,220,429 B1; iss. Apr. 24, 2001).

ANALYSIS

Rejection of claims 1, 2, 4-6, 11-14, and 16-20 –Huang and Chun-Hoi

Claims 1, 2, 5, 12-14, 16, and 18-20

The Examiner found that Huang discloses a desktop accessory comprising a base 1 and at least one caricature figurine 24 attached to the base 1. Ans. 3 (*see also* Huang, Fig. 1). Claim 1 recites that "said figurine being a human form and mocking at least one human stereotype or character trait." The Examiner found Huang's figurine 24 is not in human form, but found that Huang does disclose that "[t]he ornament 24 may be variously shaped as desired." Ans. 3 (quoting Huang, col. 2, ll. 7-8). The Examiner also found that Chun-Hoi discloses a base 20 with at least one figure 10, 12 in human form. Ans. 3. The Examiner concluded that it would have been obvious to one of ordinary skill in the art to modify Huang's figurine with the human form figurine of Chun-Hoi to accommodate different types of users. Ans. 3-4.

As to claim 1, Appellant contends that it not clear how the figurines of Huang or Chun-Hoi "mock" anything. App. Br. 8. We disagree. Appellant does not argue that the claim term "mocking" has any particular meaning. An ordinary meaning of "mock" is "to imitate (as a mannerism) closely: MIMIC." *See* MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY 797 (11th ed. 2003). Chun-Hoi's figurines are constructed to represent (imitate) dancing keiki dolls. *See* Chun-Hoi, col. 2, ll. 7-10, 38-39; Figs. 3, 4. One of

ordinary skill in the art would reasonably find that the Chun-Hoi figurines "mock[] at least one human stereotype or character trait," as claimed.

Regarding the claim limitation, "said gag gift and desktop accessory also including a written title identifying a particular human stereotype or character trait," the Examiner found that a title and/or written message identifying an object is well known in the art, and concluded that it would have been a matter of design choice to provide a title or written message for identifying the modified Huang device. Ans. 4.

Appellant contends that neither Huang nor Chun-Hoi describes a title (App. Br. 7), and that a person of ordinary skill in the art could not combine these references and "come up with a title identifying a human stereotype or character trait" (App. Br. 7-8). To the extent that Appellant is contending that either Huang or Chu-Hoi is required to provide an explicit teaching, suggestion, or motivation, Appellant acknowledges that this test has been rejected by the Supreme Court. App. Br. 7. The Examiner articulated a rational reason for modifying Huang's device. Appellant has not explained why one of ordinary skill in the art would not have possessed sufficient skill and creativity to provide a title identifying the modified device. Accordingly, this contention is also not persuasive.

Moreover, the specific content of the "written title," that is, "printed matter," will not distinguish the gag gift and desktop accessory from the prior art in terms of patentability where the printed matter is not functionally related to the substrate. *See In re Gulack*, 703 F.2d 1381, 1385-86 (Fed. Cir. 1983) ("[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.") In our view, there is no new and non-obvious functional

relationship between the claimed content of the written title and the gag gift and desktop accessory itself. Hence, we construe the claimed written title as non-functional descriptive matter. As such, the claimed content of the written title alone does not patentably distinguish the gag gift and desktop accessory from the combined teachings of Huang and Chun-Hoi. For this additional reason, we sustain the rejection of claim 1.

Claim 2 recites that the gag gift and desktop accessory "further compris[es] a recorded human voice presentation for providing an audio gag message." The Examiner found that Huang's device includes a voice presentation means (i.e., a whistle) for providing an audio gag message (Ans. 3), and that Chun-Hoi's device includes a recorded human voice presentation in the form of music with melody for providing an audio message (*id.* (citing Chun-Hoi, col. 3, ll. 48-55)).

Appellant contends that a whistle is not a voice. App. Br. 8; *see also* Reply Br. 2. While this contention appears to address Huang's teaching, Appellant has not apprised us of any error regarding the Examiner's finding for Chun-Hoi, and thus has not addressed the combination of teachings. We sustain the rejection of claim 2.

Appellant does not present any separate argument for claim 5. We sustain the rejection of this claim.

Independent claim 12 is directed to a method of providing a useful desktop accessory and recites "placing a gag figurine on said base, said gag figurine have human form and mocking a human personality trait," and "providing on said desktop accessory a written title identifying a particular human stereotype of character trait." The Examiner's findings (Ans. 3-4) and Appellant's arguments for patentability (App. Br. 7-8) for claim 12 are

the same as those discussed *supra* for claim 1. Accordingly, we sustain the rejection of claim 12.

Appellant does not present any separate argument for claim 13, which depends from claim 12. We sustain the rejection of claim 13.

Claim 14 depends from claim 12 and recites that the gag figurine is one of a group of listed gag figurines. Appellant contends that Chun-Hoi's dancers are not gag characters, but acknowledges that it is possible to make a gag gift and accessory holder for a dancer. App. Br. 8. Appellant also contends that the independent claims require a title identifying a human stereotype or character trait, and that the references do not teach or suggest this. App. Br. 8-9. For reasons discussed *supra* with respect to claim 1, this contention is not persuasive. We sustain the rejection of claim 14.

Appellant does not present any separate argument for claims 16 and 18, which depend from claim 12. We sustain the rejection of claims 16 and 18.

Claims 4, 6, 11, and 17

Claim 4 depends from claim 3, and claim 11 depends from claim 7. In rejecting claims 4 and 11, the Examiner did not address the limitations of claims 3 and 7, which are incorporated into claims 4 and 11, respectively. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Consequently, the Examiner failed to establish a prima facie case of obviousness of the subject matter of claims 4 and 11. Thus, we cannot sustain the rejection of claims 4 and 11.

Claim 6 depends from claim 1, and claim 17 depends from claim 12. The Examiner did not make any findings regarding the limitations recited in

claims 6 and 17, and did not respond to Appellant's contentions that none of the references teach gag representations on a base (claim 6) or a base made of moldable material (claim 17)(App. Br. 8). Accordingly, we do not sustain the rejection of claims 6 and 17.

Rejection of claims 3 and 15 - Huang, Chun-Hoi, and MacNalley

Claims 3 and 15 recite that the base rotates. The Examiner found that the combination of Huang and Chun-Hoi does not disclose the base as being rotatable. Ans. 4. The Examiner found that MacNalley discloses a utility desktop accessory having a base 15 that rotates relative to support structure 10, 12. *Id.* The Examiner concluded that it would have been obvious to modify the base of the combination with MacNalley's rotatable base to provide easy access to the utility devices. *Id.* at 5.

Appellant contends that "[t]here is simply [no] way to combine the Huang, Chun-Hoi and MacNalley references to arrive at the applicant's invention." App. Br. 9; *see also* Reply Br. 3. This contention is not persuasive. "[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review." *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . ."). Appellant has provided no persuasive reason why one of ordinary skill in the art would lack sufficient knowledge and skill to be able to modify the base of the Huang and Chun-Hoi combination to make it rotatable. Appellant also does not address the Examiner's stated rationale for the modification. We sustain the rejection of claims 3 and 15.

Rejection of claims 7 and 10 – Huang, Chun-Hoi, and Pasch

Independent claim 7 is directed to a combination gag gift and desktop accessory and recites "at least one human caricature figurine also attached to said base unit, said figurine mocking at least one human stereotype or character trait," and "said combination gag gift and desktop accessory also including a written title identifying a particular human stereotype of character trait."

Appellant contends that the combination of references does not disclose or suggest these features. App. Br. 9-10. For reasons similar to those discussed *supra* with respect to claim 1, we disagree. We sustain the rejection of claim 7.

Claim 10 depends from claim 7 and recites that the tape dispenser is gag related to the figurine. The Examiner relied on Pasch for its teaching of a desktop utility device having a tape dispenser 21 mounted on base 11. Ans. 5. The Examiner concluded that it would have been obvious to modify the combination of Huang and Chun-Hoi with the tape dispenser of Pasch to provide additional utility to the device. *Id.*

Appellant contends that the tape dispenser may be related by shape, color, or "otherwise," but that Pasch does not supply this missing element because it has no figurine. App. Br. 10. This contention is not persuasive. The Examiner did not rely on Pasch for teaching a figurine, but relied on Huang and Chun-Hoi for this feature. Furthermore, Pasch's tape dispenser would necessarily have a color and a shape, and claim 10 does not specify how the tape dispenser is "gag related" to the figurine. Indeed, Appellant's use of the word "otherwise" acknowledges that this term has a broad

meaning. As such, Appellant provided no persuasive reason why Pasch's tape dispenser would not be "gag related" to the figurine of Huang and Chun-Hoi. We sustain the rejection of claim 10.

New ground of rejection of claim 4 under 35 U.S.C. § 103(a) as unpatentable over Huang, Chun-Hoi, and MacNalley, as evidenced by MPEP § 608.02(IX)

Claim 4 depends from claim 3, which we above found to properly be rejected in view of Huang, Chun-Hoi and MacNalley, and further recites that the base is made of moldable material. Appellant contends that this feature is not taught by the references. However, we observe that Figures 3 and 4, for example, of Chun-Hoi depict sectional views of base 20. The cross-hatching pattern (symbol) shown for base 20 corresponds to the symbol that should be used in U.S. patent applications to indicate synthetic resin or plastic construction. *See* MPEP § 608.02(IX). We also note that Appellant's Specification states that "[t]he preferred material is plastic since it is easy to mold." *See* Spec. 7. Accordingly, we find that Chun-Hoi's base 20 is made of "moldable material," as this claim term would be construed in light of the Specification. Therefore, we enter a new ground of rejection of claim 4 under 35 U.S.C. § 103(a).

New ground of rejection of claim 6 under 35 U.S.C. § 103(a) as unpatentable over Huang and Chun-Hoi

Claim 6 recites that the base also contains gag representations. Appellant contends that none of the references teach this claim limitation. However, Appellant does not direct us to any specific definition for the term "gag representations." Figures 3 and 4 of Chun-Hoi, for example, show that

the figurines have objects in their hands that we find can be considered "gag representations," as claimed. It would have been obvious to a person of ordinary skill in the art to include similar "gag representations" on the base of the modified Huang device to supplement the theme and/or function of the figurine. Therefore, we enter a new ground of rejection of claim 6 under 35 U.S.C. § 103(a).

New ground of rejection of claim 11 under 35 U.S.C. § 103(a) as unpatentable over Huang, Chun-Hoi, and Pasch

Claim 11 recites a "job or career group" containing members from which the figurine is chosen. Appellant's contentions with respect to this claim are the same as those discussed *supra* for claim 14. App. Br. 8-9. As these contentions are not persuasive, we enter a new ground of rejection of claim 11 under 35 U.S.C. § 103(a).

New ground of rejection of claim 17 under 35 U.S.C. § 103(a) as unpatentable over Huang and Chun-Hoi, as evidenced by MPEP § 608.02(IX)

Claim 17 recites that the base is molded. For similar reasons as those discussed *supra* in regard to the new ground of rejection of claim 4, we enter a new ground of rejection of claim 17 under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision rejecting claims 1-3, 5, 7, 10, 12-16, and 18 is AFFIRMED, and the decision rejecting claims 4, 6, 11, and 17 is REVERSED.

This decision also contains New Grounds of Rejection of claims 4, 6, 11, and 17 pursuant to 37 C.F.R. § 41.50(b), which provides "[a] new

ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options *with respect to the new grounds of rejection* to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

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).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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