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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte G. SCOTT MINDRUM

Appeal 2010-010342
Application 11/685,378¹
Technology Center 2100

Before CAROLYN D. THOMAS, JEFFREY S. SMITH,
and JOHN A. EVANS, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to methods of providing a registry service and a registry service. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ The real party in interest is Making Everlasting Memories, L.L.C.

Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed Jan. 29, 2010), the Answer (mailed Apr. 29, 2010), and the Reply Brief (filed June, 25, 2010). We have considered in this decision only those arguments Appellant actually raised in the Briefs. Any other arguments which Appellant could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

STATEMENT OF THE CASE

The claims relate to an on-line registry system comprising information relating to a plurality of deceased persons and a web based interface. An identifier may be provided on or near a good or concrete memorial, such as a headstone, to indicate that a deceased person is associated with the on-line registry system. (Abstract). Claims 17-36 are on appeal. Claims 17 and 21 are independent. Claims 1-16 are canceled. An understanding of the invention can be derived from a reading of exemplary claim 17, which is reproduced below:

17. A system for commemorating a deceased person, the system comprising:

(a) a concrete memorial for a deceased person, the concrete memorial comprising discernable information including the name of the deceased person;

(b) an on-line web site accessible over the Internet, the on-line web site comprising one or more web pages having information related to the deceased person; and

(c) an identifier on or near the concrete memorial for the deceased person, the identifier indicating to people visiting the concrete memorial that the information related to the deceased person is available on the on-line web site, wherein the identifier is not the name of the deceased person.

The claims are rejected as follows:

1. Claims 17, 18, 21-26, 29-31, 34, and 35 are rejected under 35 U.S.C. § 103(a) as obvious over Legacy, Manross (US 6,414,663 B1, filed Feb. 2, 1999), and Appellant's Admitted Prior Art (AAPA). (Ans. 3-11).
2. Claims 19 and 27 are rejected under 35 U.S.C. § 103(a) as obvious over Legacy, Manross, AAPA, and Wilz (US 6,076,733, filed Apr. 25, 1997). (Ans. 11-12).
3. Claims 20 and 28 are rejected under 35 U.S.C. § 103(a) as obvious over Legacy, Manross, AAPA, and Richardson (US 2002/0022962 A1, filed Dec. 29, 2000). (Ans. 12-14).
4. Claims 32, 33, and 36 are rejected under 35 U.S.C. § 103(a) as obvious over Legacy, Manross, AAPA, and Marx (US 6,173,266 B1, filed May 6, 1998). (Ans. 14-15).

Claim Groupings

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal on the basis of claims as set forth below. *See* 37 C.F.R. § 41.37(c)(1)(vii).

CONTENTIONS AND ISSUE

The Examiner has rejected claims 17, 18, 21-26, 29-31, 34, and 35 under 35 U.S.C. § 103(a) as obvious over Legacy, Manross, and AAPA. (Ans. 3-11).

Appellant contends that the subject matter disclosed in Specification paragraphs 0007 and 0008 is not prior art, as found by the Examiner, but is descriptions of embodiments of Appellant's invention. Appellant contends that the record does not constitute an admission that the accused disclosure is prior art under *Riverwood Int'l Corp. v. R.A. Jones & Co., Inc.*, 324 F.3d

1346, 1354 (Fed. Cir. 2003), or under *Constant v. Advanced Micro-Devices Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988). (App. Br. 11-12).

The Examiner answers that the location of the accused passage in the “background of invention” is a per se admission that the subject matter is prior art. (Ans. 17).

The contentions raise two issues: (1) whether Appellant has admitted the accused subject matter is prior art, either expressly or by implication; and (2) whether the “identifier on or near the concrete memorial” is entitled to patentable weight.

ANALYSIS

Appellant persuasively argues that, under *Riverwood* and *Constant*, two conjunctive elements must be established for a work to constitute admitted prior art: (1) the work itself must be identified by the applicant as prior art, and (2) the work itself must be identified by the applicant as the work of another. (App. Br. 10; Reply Br. 5-6). The Examiner makes no finding either that Appellant identified the subject matter as prior art, or as the work of another. The Examiner locates the accused subject matter in the “background” section and finds that it is thus per se admitted prior art.

Riverwood, cited by Appellant in both his principle and reply briefs, stands for the proposition that the doctrine of prior art by admission is “inapplicable when the subject matter at issue is the inventor’s own work.” (*Riverwood*, at 1354) (“We think that a finding of obviousness should not be based on an implied admission erroneously creating imaginary prior art. That is not the intent of § 103” (citation omitted)). Here, the locus of the accused disclosure is the “background” section of Appellant’s Specification. However, the *Riverwood* court “also held that the patentee’s discussion of

his own patent in the specification section entitled ‘Summary of the Prior Art’ did not constitute an admission that the patent was prior art.” (324 F.3d at 1355).

The subject matter identified as “Applicants’ Admitted Prior Art relates to the recitation in claim 17:

(c) an identifier on or near the concrete memorial for the deceased person, the identifier indicating to people visiting the concrete memorial that the information related to the deceased person is available on the on-line web site, wherein the identifier is not the name of the deceased person.

We agree with Appellant that under *Riverwood*, this recitation is not the subject of an admission. However, we decline to afford it patentable weight. The “[d]ifference between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter.” (*In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)). However, “The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *Id.* at 1386. Here, tombstones, marking the graves of decedents, and websites containing information about them, are not novel. The only potential point of novelty is an indicia printed or engraved on a grave monument. However, “where the printed matter 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) (quoting *Gulack* at 1387)). The *Ngai* court reasoned that if it “were to adopt Ngai’s position, anyone could continue patenting a product indefinitely provided that they add a new instruction sheet to the product.” *Id.*

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Because Appellant is not “entitled to patent a known product by simply attaching a set of instructions to that product” (*id.*), we sustain the rejection of claims 17, 18, 21-26, 29-31, 34, and 35.

The Examiner has also rejected claims 19 and 27 under 35 U.S.C. § 103(a) as obvious over Legacy, Manross, AAPA, and Wilz (Ans. 11-12); claims 20 and 28 under 35 U.S.C. § 103(a) as obvious over Legacy, Manross, AAPA, and Richardson (Ans. 12-14); and claims 32, 33, and 36 under 35 U.S.C. § 103(a) as obvious over Legacy, Manross, AAPA, and Marx (Ans. 14-15). Appellant re-alleges his contention that the accused passage is not admitted prior art, but advances no further contentions by way of traversal. (App. Br. 13-16). In view of our findings, discussed above, we sustain the rejections of claims 19, 20, 27, 28, 32, 33, and 36.

SUMMARY

We affirm the rejection of claims 17-36.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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