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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LARRY TRIGG, PAMELA CHEW, and
PETER GYSLING

Appeal 2011-000046
Application 11/796,905
Technology Center 3600

Before: WILLIAM V. SAINDON, SCOTT A. DANIELS, and
JILL D. HILL, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Larry Trigg, Pamela Chew, and Peter Gysling, (Appellants) appeal under 35 U.S.C. § 134 from a rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

The claims are directed to connecting devices displaying indicia such as “a logo system having a first logo and a second logo that removably attaches to the first logo.” Spec. 3, para. [008]. Claims 1 and 8, reproduced below, are illustrative of the claimed subject matter:

1. An apparatus, comprising:
 - a first device displaying an indicia and a flexible periphery for receiving stitches to affix to a surface;
 - a second device displaying the indicia, the second device removably connecting over the first device and being removed from the first device in order to change between displaying the indicia on the surface with the second device to displaying the indicia on the surface with the first device.

8. A method, comprising:
 - affixing a first logo to an object;
 - providing plural different second logos that are connectable to and removable from the first logo in order to change which of the second logos is visible on the object;
 - passing a portion of one of the second logos through the first logo to cover the first logo with the one of the second logos.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Devine	US 2,028,740	Jan. 28, 1936
Wishnia	US 3,295,236	Jan. 3, 1967
Kidd	US 6,568,044 B1	May 27, 2003

REJECTIONS

The Examiner made the following rejections:

Claims 1-6, 8-14, 16, 17, 19 and 20 stand rejected under 35 U.S.C §103(a) as being unpatentable over Wishnia and Kidd. Ans. 4.

Claims 7, 15 and 18 stand rejected under 35 U.S.C §103(a) as being unpatentable over Wishnia, Kidd and Devine. Ans. 8.

ANALYSIS

Appellants initially argue claims 1, 3, 5, 6, 14, 16, 17, 19 and 20 as a group¹, where claims 1 and 14 are the independent claims, and present separate arguments as to dependent claims 2, 4 and also to independent claim 8 and respective dependent claims 9-13. *See App. Br. 9-11.* We select claim 1 as representative of the group where claims 3, 5, 6, 14, 16, 17, 19 and 20 stand or fall with claim 1, and address in turn Appellants' separately argued claims. *See 37 C.F.R. § 41.37(c)(1)(vii) (2011).*

Claims 1, 3, 5, 6, 14, 16, 17, 19 and 20

The Examiner found that Wishnia's golf club cover 10, specifically inner layer 24, teaches Appellants' recited "first device" having a flexible

¹ Although Appellants assert that the claims do not stand or fall together (App. Br. 9), they do not separately address claims 3, 5, 6, 14, 16, 17, 19 and 20 except within the context of claim 1. App. Br. 11-12.

periphery for receiving stitches to affix the first device to the golf club head cover 10. Ans. 4. The Examiner also determined that like the claimed “second device,” Wishnia’s panel 40 displayed indicia and was removably connected by a snap fastener over the first device. Ans. 4, Wishnia col. 1, ll. 61-70 and see figs. 1-4. The Examiner further found that “Kidd teaches an apparatus comprising a first device displaying indicia (Figure 4, #12 and claim 10) and a second device with indicia (Figure 4, #60 and claim 11)” and explained that it would be obvious to one of ordinary skill in the art to provide Wishnia with the first and second devices both displaying indicia “to provide more information on each device and allow for display of either as needed by the user.” Ans. 4. The Examiner further indicated that patentability could not be principally supported by reliance on the indicia itself, as the indicia provided no patentable novelty to the physical structure. Ans. 4-5 and 10.²

Appellants argue that the inner layer 24 in Wishnia does not have indicia. App. Br. 11. According to Appellants, contrary to the Examiner’s finding, Kidd also fails to disclose indicia displayed on two devices where only the ornamental member 60 as shown in Fig. 4 is provided with indicia. App. Br. 12. Appellants contend that neither reference discloses, teaches or suggests the limitation of claim 1 where *both* the first and second devices display indicia “in order to change between displaying the indicia on the surface with the second device to displaying the indicia on the surface with the first device.” *Id.*

² Appellants do not contest the Examiner’s findings or conclusions with respect to this alternative rationale.

We agree with Appellants that Wishnia does not disclose any indicia on the inner panel 24. *See* Wishnia, fig. 3. What we cannot agree with is Appellants' conclusion that "[i]n Fig. 4 of Kidd, an ornamental member 60 with indicia fits over a head carrier 14. **The head 14 does not include indicia.**" App. Br. 12. Despite the fact that indicia is not shown in Kidd's Figure 4, Kidd does indeed disclose indicia on the carrier head 14. Kidd's Specification describes that both the ornamental member 60 *and* the carrier head 14 may include indicia:

Preferably, an ornamental member is attached to the carrier head with an ornamental member being formed to resemble a button. Alternatively, the carrier head may be formed to resemble a button. In another alternate embodiment, *the carrier head includes an indicia carrying surface.* Alternately, the ornamental member attached to the carrier head may include an indicia carrying surface.

Kidd col. 3, ll. 4-10, (emphasis added). Moreover, as the Examiner points out, Kidd's dependent claim 10 also recites that "said carrier head includes an indicia carrying surface." The Examiner explains that where Kidd discloses the indicia on both the carrier head and on the ornamental member "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Kidd into the invention of Wishnia in order to provide more information on each device and allow for display of either as needed by the user." Ans. 5.

Appellants argue that Examiner's reasoning is flawed and there is no motivation in the references to place indicia on the inner panel 24 which is covered up by the panel 40 because "[w]hen the panel 40 is placed on the golf club head cover 10, the inner layer #24 cannot be seen. One would not

be motivated to spend time and money to place indicia on a location that is covered and cannot be seen.” Rep. Br. 2. We are not however apprised of error in the Examiner’s reasoning because the Examiner is merely using Kidd to show that it is known in the art to provide indicia on both a first device (the carrier head 14), and on a second device (the ornamental member 60) which can be attached/detached from one another. Ans. 10. Whether or not there is a motivation in Wishnia to apply indicia to the inner layer 24 is immaterial; the Examiner finds ample reason to do so in Kidd.

Appellants further argue that because Wishnia only places the indicia on the outer panel 40 “[t]here is no motivation whatsoever to place indicia on the inner layer #24 in Wishnia because this layer is designed with a connector that receives the panel,” and further that the indicia would be “unsightly” because of the connector. Rep. Br. 2. We are not persuaded by Appellants’ argument here because the Examiner has provided an articulated reasoning with rational underpinnings based on the combination of Wishnia and Kidd, and in determining whether the subject matter of a claim is obvious, “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.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) and *see, e.g., In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006). (pointing out that “the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references.”). Here we agree with the Examiner that Kidd discloses indicia on both a first device (carrier head 14) as well as a second device (the ornamental member 14) and that such “indicia could be placed on the

surface of #14 if desired, and then covered by the display panel #40 of Wishnia when needed, as taught by Wishnia.” Ans. 10. For these reasons we sustain the Examiner’s rejection of claims 1 and 3, 5, 6, 14, 16, 17, 19 and 20 as obvious in view of Wishnia and Kidd.

Claim 2

Appellants argue separately with regard to claim 2 that Wishnia and Kidd do not teach or suggest “a cavity that receives the first device so the indicia of the second device covers the indicia of the first device,” and that the Examiner’s finding “is flawed because the device 40 in Wishnia does not include indicia.” App. Br. 12-13. Giving claim 2 its broadest reasonable interpretation, as we must, we also agree with the Examiner that Wishnia’s snap fastener elements 42, 44 disclose a cavity included with the second device, and for the reasons discussed *supra* in regards to Kidd, such a snap fastener would permit the covering of indicia on the first device with the indicia of the second device as recited in claim 2. Ans. 5. Therefore, we also sustain the rejection of dependent claim 2 as obvious in view of Wishnia and Kidd.

Claim 4

Appellants point out the Examiner’s acknowledgement that Wishnia does not teach using an adhesive for affixing the first device to a product. App. Br. 13. Appellants do not, however, contradict the Examiner’s explanation, with any evidence or technical reasoning, that adhesive is not a simple substitute or known to those of ordinary skill in the art as a predictable alternative for stitches. *See KSR Int’l Co. v. Teleflex Inc.*, 550

U.S. 398, 416 (noting that “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.”) Thus, we also sustain the Examiner’s rejection of claim 4 in view of Wishnia and Kidd.

Claims 8-11 and 13

Appellants argue that claims 8-13, which also depend from claim 1, are allowable because in Kidd’s Figure 4 “[t]he head 14 does not include indicia.” App. Br. 13. For the reasons discussed *supra* in regards to Kidd’s written description and claims, this argument is again not persuasive. With respect to Appellants argument that the first and second indicia could be different logos, and that the second indicia could be a plurality of different logos in order to change which logo is visible on the object, we see no error in the Examiner’s reasoning that these recitations of claim 8, given their broadest reasonable interpretation, are disclosed by Wishnia. App. Br. 13, and *see* Ans. 6. Wishnia explains that changing out of different panel(s) 40 to provide the appropriate number to identify the requisite golf club used with the cover 10 “is a simple matter to remove the panel in place and to replace it with another panel bearing the proper number or indicia.” Wishnia col. 2., ll. 33-35. Accordingly, we sustain the obviousness rejection of claims 8-11 and 13.

Claim 12

Appellants argue again that “[n]owhere does Wishnia in view of Kidd teach or even suggest covering a first logo with a second logo.” App. Br. 14. For the reasons discussed above in regards to claim 1 we similarly sustain

the Examiner's obviousness rejection of claim 12 in view of Wishnia and Kidd.

Claims 7, 15 and 18

Claim 7 depends from claim 1, and claims 15 and 18 both depend directly from independent claim 14. Regarding the structure and material recited in claims 7, 15 and 18, the Examiner relies on the teachings of Devine at Figure 7 and pg. 2, col. 1, ll. 4-22, to use a bendable metal such as aluminum to fasten the second device to the object and also to use a translucent first logo to enhance the appearance of the device. Ans. 9.

Appellants do not offer separate arguments regarding the Examiner's rejection of claims 7, 15 and 18 aside from the reasons given with respect to the respective independent claims, and therefore for the reasons discussed *supra* we also sustain the rejection of claims 7, 15 and 18 as unpatentable over Wishnia, Kidd and Devine.

DECISION

For the above reasons, the Examiner's rejection of claims 1-20 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)(1)(iv) (2009).

AFFIRMED

Klh