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Row 2: 32116, 7590, 01/24/2013, WOOD, PHILIPPS, KATZ, CLARK & MORTIMER, 500 W. MADISON STREET, SUITE 1130, CHICAGO, IL 60661, EXAMINER TURNER, SONJI LUCAS
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL
BOARD

Ex parte DIRK NIEDERMANN

Appeal 2011-000295
Application 11/644,460
Technology Center 1700

Before HUBERT C. LORIN, JEFFREY T. SMITH, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

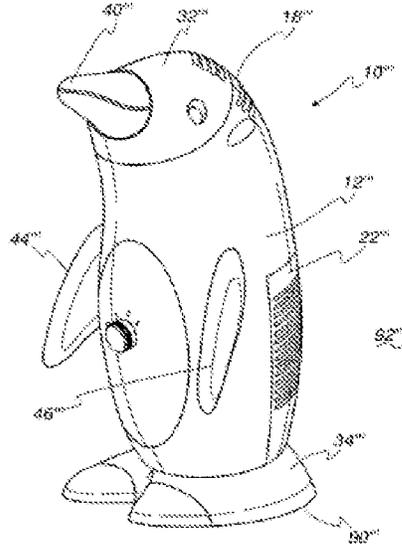
Appellant appeals under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-4, 6, 8-10, 12-14, 16-23, 26-30, and 32 under 35 U.S.C. § 103(a) as unpatentable over the combined prior art of Sievers (US 3,757,495, issued Sept. 11, 1973), Marvin (Des. 335,340, issued May 4, 1993), and Armbruster (US 4,856,968, issued Aug. 15, 1989). We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

A copy of representative claim 1, drawn to an air purifier having a housing that is "shaped to simulate the appearance and shape of an animate

object having a head, a tail/feet and a torso” may be found in the Claims Appendix of the Appeal Brief (claim 1, Claims App’x at Br. 16).

A representative view of the air purifier as shown in Fig. 11 of the Specification is reproduced below:

Fig. 11



The air purifier of Fig. 11 “is shaped to simulate the appearance of a penguin.” (Spec. 16:4-5).

PRINCIPLES OF LAW

“A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 421. The obviousness analysis need not seek out precise teachings directed to the specific subject matter of the claim, for it is proper to take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *Id.* at 418. *See also DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006) (“Our

suggestion test is in actuality quite flexible and not only permits, but requires, consideration of common knowledge and common sense.”).

ANALYSIS

Upon consideration of the evidence on this record and each of Appellant’s contentions, we find that the preponderance of evidence on this record supports the Examiner’s conclusion that the subject matter of Appellant’s claims is unpatentable over the applied prior art¹. We sustain the above rejections based on the findings of fact, conclusions of law, and rebuttals to arguments expressed by the Examiner in the Answer.

We add the following for emphasis.

Appellant’s main argument, that the Examiner has not considered the functional characteristics imparted to the structure of the claimed air purifier by the recited ornamental design thereof of an upright animate object (App. Br. 6-10) is unavailing, as it fails to consider the prior art as a whole. In this regard, the claimed invention merely applies a well-known alternative

¹ Appellant mainly presents arguments directed to the feature of the sole independent claim 1 (App. Br. 6-11). To the extent the features of the dependent claims may be considered to have been separately argued, we find that the preponderance of the evidence supports the Examiner’s § 103 rejection of these claims (App. Br. 12-14; Ans. 4-7). Moreover, Appellant’s statements regarding the dependent claims may be considered to be nothing more than general allegations of patentability and are not considered separate patentability arguments. See 37 C.F.R. § 41.37(c)(1)(vii) (“A statement Appeal which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

design as exemplified in Marvin of an animal shape, further bolstered by the alternative design choice of an air purifier with an elongated housing having a peripheral convex shape as exemplified in Armbruster, to yield predictable results in the air purifier of Sievers.

Appellant's argument that the combination of Sievers with the design patent of Marvin would not result in the claimed subject matter (App. Br. 10) is without merit. It is well established that the obviousness inquiry does not ask "whether the references could be physically combined but whether the claimed inventions are rendered obvious by the teachings of the prior art as a whole." *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (en banc); see also *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (stating "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference").

Furthermore, as pointed out by the Examiner, it has long been established that differences in ornamentation are entitled to little weight in determining the obviousness of a claim to a structure. See *In re Seid*, 161 F.2d 229, 231 (CCPA 1947). (Ans. 4). The recited shape "appears to function no differently than [the prior art] in that both . . . function to guide air through a purifier" (Ans. 7). Any differences in mechanical functions argued by Appellant are de minimis over the applied prior art (Ans. 7), especially as Appellant's Specification stresses that the shape of the air purifier is meant to be aesthetic to induce young children to have one in their room (e.g., Spec. 2:5-13; Spec. 9:10-15).

Appellant's reliance on *In re Dembiczak* 175 F.3d 994 (Fed. Cir. 1999) for the proposition that "ornamental features . . . functionally coordinated with the structural features" can constitute patentable subject

matter (App. Br. 8) is misplaced. In that case, our reviewing court reversed the rejection of a claim to a decorative trash bag because the Examiner failed to articulate a teaching, suggestion or motivation which might have led one of ordinary skill in the art to include any facial indicia, much less facial indicia including recited ornamental features, on the claimed bag. *See Dembiczak*, 175 F.3d at 1000. That case neither mentioned *Seid* nor held that the claimed subject matter was patentable due solely to particular differences in ornamentation.

We agree with the Examiner (Ans. 6, 7) that Appellant has not established with any evidence that the claimed shape of the internal surface of the air purifier that results from the exterior design shape is critical or results in any unexpected advantages. Attorney's arguments in a brief cannot take the place of evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974); *see also Meitzner v. Mindick*, 549 F.2d 775, 782 (CCPA 1977), cert. denied, 434 U.S. 854 (1977) (mere attorney argument does not take the place of evidence lacking in the record).

The decision of the Examiner 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).

AFFIRMED

kmm