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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CHRIS PARENTI and LOREN VENEGAS

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Appeal 2011-006204  
Application 12/015,337  
Technology Center 3600

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*Before* JOHN C. KERINS, BRADFORD E. KILE and WILLIAM A. CAPP,  
*Administrative Patent Judges.*

CAPP, *Administrative Patent Judge.*

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-4 and 7-10. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was conducted in this appeal on March 11, 2013.

We AFFIRM.

## THE INVENTION

Appellants' invention relates to a sleeve cover that fits over a vertical post and displays advertising. Spec. 1, para. [0001]. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

### 1. Display apparatus, comprising:

a generally cylindrical body having an open lower end adapted for placement over a post extending upwardly from a ground surface and an upper end including an advertising holder;

the advertising holder comprising a transparent or translucent form having an open top and an inner surface to receive a single, flexible insert bearing textual or graphical material visible through the transparent or translucent form when installed;

the transparent or translucent form comprising a continuous cylindrical shape, enabling the insert to be seen from any angle around the form; and

a cap to close off the open top of the transparent or translucent form.

### EVIDENCE RELIED UPON AND THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Montgomery	US 5,309,656	May 10, 1994
Fite	US 5,329,716	Jul. 19, 1994
Venegas	US 6,779,287 B2	Aug. 24, 2004
Rachowitz	US 6,802,143 B1	Oct. 12, 2004
Foster	US 6,976,329 B1	Dec. 20, 2005

The following rejections are before us for review:

1. Claims 1-4 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Venegas and Rachowitz.
2. Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Venegas, Rachowitz, and Fite.
3. Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Venegas, Rachowitz, Fite, and Montgomery.

### OPINION

#### *Obviousness Rejection of Claims 1-4 and 7 Over Venegas and Rachowitz*

##### *Claim 1*

The Examiner finds that Venegas discloses all of the limitations of claim 1 except that it fails to disclose a flexible sheet insert and a cap to close off the open top of the transparent or translucent form. Ans. 3-4. The Examiner relies on Rachowitz as disclosing a display comprising a transparent or translucent form with a cap to close off an open top. Ans. 4. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Venegas with a cap as taught by Rachowitz. According to the Examiner, the person of

ordinary skill in the art would have been motivated to make the combination in order to protect the display inserts. *Id.* The Examiner further concludes that it would be obvious to use a flexible sheet insert as it is well known to use inserts that are flexible for insertion into curved, cylindrical channels. *Id.*

Appellants traverse the Examiner's rejection by first arguing that Venegas fails to disclose a continuous cylinder that displays a single, flexible insert. App. Br. 3-4. Appellants concede that Figure 4 of Venegas shows a cylindrical signage area; nevertheless, Appellants argue that the Figure 4 cylinder is "clearly configured" for multiple signs. App. Br. 3. In response, the Examiner points to column 3 of Venegas as disclosing an omni-directional signage area. Ans. 9 (citing Venegas, col. 3, ll. 23-27).

We agree with the Examiner that Venegas discloses a cylindrical signage area. While Venegas's Figure 4 cylinder may be capable of displaying a plurality of smaller signs around the circumference of its cylindrical shape, Appellants have not directed us to any disclosure in either the drawings or specification of Venegas that would prevent the Figure 4 embodiment from displaying a single, flexible insert capable of being seen from any angle around the form.<sup>1</sup>

Appellants have failed to apprise us of error in the Examiner's findings and conclusions. Accordingly, we sustain the Examiner's rejection of claim 1.

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<sup>1</sup> Indeed, the disclosure in column 3, lines 3 through 15, of Venegas regarding the optional use of transparent materials throughout the signage area undermines Appellants' argument that Venegas's cylindrical embodiment is necessarily limited to displaying a plurality of separate signs.

*Claim 2*

Claim 2 depends from claim 1 and adds the limitation: “wherein the cap is removable, allowing the insert to be changed.” App. Br., Clms. App’x. The Examiner finds that Rachowitz discloses a display apparatus with a removable cap that allows the insert to be changed. Ans. 5 (citing Rachowitz, Fig. 1, element 34).

In traversing the rejection, Appellants argue that the Examiner’s purported reason for modifying Venegas with Rachowitz is to provide a means to protect the display inserts. App. Br. 5. Appellants argue that removability tends to work against protection. *Id.*

Appellants’ argument mischaracterizes the Examiner’s position and we, therefore, reject it. There is nothing inherently inconsistent about adding a cap to protect the signage inserts from inclement weather and vandalism and yet nevertheless making the cap removable so that the signage can be changed from time to time. We sustain the rejection of claim 2.

*Claim 3*

Claim 3 depends from claim 1 and adds the limitation: “wherein the cap is permanently affixed to the transparent or translucent form.” App. Br., Clms. App’x. The Examiner finds and concludes that it would have been an obvious modification to provide a means of attachment that would allow the cap to be permanently attached.<sup>2</sup> Appellants argue that permanently bonding the cap to the transparent form makes disassembly impossible. App. Br. 5.

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<sup>2</sup> In Appellants’ specification, “permanency” of affixing the cap to the transparent display form is accomplished with glue. Spec. 4, para. [0015].

Claim 3 depends directly from claim 1, not from claim 2. Thus, there is no requirement that the cap be both removable from and permanently affixed to the transparent or translucent form. Thus, it is perfectly consistent with the claims that the claim 2 embodiment has a removable cap and the claim 3 embodiment has a permanently affixed cap. We agree with the Examiner that if a person of ordinary skill in the art desired the cap to be permanently affixed to the display area, accomplishing such a result, such as by merely gluing the two pieces together, would be well within the skill level of a person of ordinary skill in the signage art. Ans. 5.

*Claim 4*

Claim 4 depends from claim 1 and adds the limitation: “wherein the body and transparent or translucent form are fabricated as an integrally molded article.” App. Br., Clms. App’x. The Examiner finds that Venegas discloses a display apparatus where the body and transparent form are fabricated as an integrally molded article. Ans. 5.

Appellants argue that Venegas does not teach integral molding as claimed. App. Br. 5. In response, the Examiner states that column 3, lines 9 through 13, of Venegas discloses that elements 320 and 322 of Figure 3 are integrally formed with the cover. Ans. 9. The Examiner’s observation is correct. We sustain the rejection of claim 4.

*Claim 7*

Claim 7 depends from claim 1 and adds the limitation: “wherein: the cap includes a light source to back-light the insert through the transparent or translucent form.” App. Br., Clms. App’x. The Examiner finds that Venegas and Rachowitz do not directly disclose light sources in the cap portion. Ans. 6. However, the Examiner finds that Rachowitz discloses

light sources in a region below the cap portion. *Id.* (citing Rachowitz, Fig. 4, element 52). The Examiner concludes that it would have been obvious to move the light source to the cap. *Id.* The Examiner reasons that such a modification would provide a means to illuminate the display from a light source attached to the cap. *Id.*

Appellants challenge the Examiner's finding that relocating the light source of Rachowitz is a modification that is common and well known in the art. App. Br. 5. Appellants argue that, since Rachowitz already locates a light source immediately behind the panel, Rachowitz can illuminate the display with or without a cap. App. Br. 6.

As we understand Appellants' argument, a person of ordinary skill in the art would not be motivated to move Rachowitz's light source from behind the panel to the cap, because the light source is already in an acceptable, if not preferable, location. However, the issue is not whether it is preferable to relocate the light source to the cap; it is whether it would have been obvious to do so. Rachowitz obtains its electrical power from its base, which is situated below the display area. Rachowitz, (57) Abstract. The Appellants' invention includes embodiments that obtain electrical power from a solar panel, which is situated above the display area and, more specifically, in the cap. Spec. 4, para [0017], Fig. 3. Otherwise, both Rachowitz and Appellants' invention provide backlighting for the advertising when their respective products are fully assembled. We agree with the Examiner that merely relocating the light source is an obvious modification that is common and well known in the art. Ans. 6.

We reject Appellants' argument that the Examiner's failure to cite references, court decisions, or Office Rules relegates the rejection to nothing more than the Examiner's own opinion. *See* App. Br. 5-6. As persons of

scientific competence in the fields in which they work, examiners are responsible for making findings, informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art and the motivation those references would provide to such persons. *In re Berg*, 320 F.3d 1310, 1315 (Fed. Cir. 2003). Absent legal error or contrary factual evidence, those findings can establish a prima facie case of obviousness. *Id.* We, therefore, reject Appellants' argument that the Examiner's rejection is *per se* legally insufficient because the Examiner's finding as to each and every element of the claim is not supported by a citation to a reference, case authority, or office rule.<sup>3</sup>

*Obviousness Rejection of  
Claims 8 and 9 Over Venegas, Rachowitz, and Fite*

Claim 8 depends from claim 7 and adds the following limitations:

wherein:

the cap includes:

a rechargeable battery,

a solar panel to recharge the battery, and

wherein the light source is powered by the battery.

App. Br., Clms. App'x. Claim 9 also depends from claim 7 and is substantially similar to claim 8 except that it also claims a photocell that

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<sup>3</sup> Although the Examiner did not expressly rely on Fite in rejecting claim 7, Fite provides an obvious and common sense example of locating a solar panel on the top of a device where it will be better exposed to solar radiation. Further use of practical, common sense would motivate an ordinary practitioner to locate a rechargeable battery and light proximate to the solar panel in order reduce the overall length of the electric circuitry. Thus, Appellants' placement of a light source in the cap, where it is proximate to the solar panel and battery amounts to no more than the exercise of common sense by a person of ordinary skill in the art.

causes the light source to be activated only when it is sufficiently dark outside. The Examiner acknowledges that Venegas and Rachowitz do not disclose a rechargeable battery and a solar panel. Ans. 6. The Examiner relies on Fite as disclosing a display apparatus with a rechargeable battery to power the light source and a solar panel to recharge the battery. *Id.* The Examiner concludes that it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Venegas and Rachowitz with Fite's solar powered rechargeable battery. Ans. 6-7. According to the Examiner, a person of ordinary skill in the art would be motivated to make such a modification because it would provide a means for the display to be seen in the dark. *Id.*

Appellants argue that the Examiner's rejection is "insufficient." App. Br. 6.<sup>4</sup> The Examiner responds by pointing out that Venegas and Rachowitz disclose a lighted display that is powered by some means. Ans. 9. The Examiner notes that Fite teaches a lighted advertising display powered by a solar panel with a rechargeable battery. *Id.* "Venegas in view of Rachowitz does not directly disclose the source of power. Fit[e] merely further characterizes the properties of the power source of the illuminated lights." Ans. 9-10. The Examiner reasons that modifying the power source of Venegas and Rachowitz with Fite's power source is common and well known. Ans. 9. Appellants' only reply is an unsubstantiated, conclusory statement that the Examiner's position lacks foundation or support. Reply 2.

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<sup>4</sup> In Appellants' own words: "At the very least, Appellants are entitled to a reasoned rejection, perhaps including an indication as to why the modification would be 'obvious,' not to mention [sic] to which "art" the Examiner is referring." App. Br. 6-7.

We agree with the Examiner that a person of ordinary skill in the art, armed with the knowledge provided by Venegas, Rachowitz, and Fite, would have found it obvious to achieve a solar powered, lighted display as claimed. Accordingly, we sustain the rejection of claims 8 and 9.

*Obviousness Rejection of  
Claim 10 Over Venegas, Rachowitz, Fite, and Montgomery*

Claim 10 depends from claim 7 and adds the following limitations:  
wherein:

the cap includes:

- a rechargeable battery to power the light source,
- a solar panel to recharge the battery, and
- a proximity detector causing the light source to be activated only when a viewer is proximate to the display apparatus.

App. Br., Clms. App'x. The Examiner finds that the combination of Venegas, Rachowitz, and Fite disclose all of the elements of claim 10 except for the proximity detector. Ans. 8. The Examiner relies on Montgomery as disclosing a solar powered display apparatus with a proximity detector. *Id.* The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time of invention to modify the combination of Venegas, Rachowitz, and Fite with Montgomery's proximity detector. *Id.* According to the Examiner, a person of ordinary skill in the art would be motivated to make such a modification because it would save power. *Id.*

Appellants argue that the Examiner has failed to establish a prima facie case of obviousness and dismisses the Examiner's reasons for combining the references as mere "self-evident statements." App. Br. 7 (emphasis omitted). The Examiner has cited references that disclose or

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suggest all of the elements of claim 10 and the Examiner has offered cogent reasons why a person of ordinary skill in the art would combine them to achieve the claimed invention. The Examiner's rationale has not been persuasively shown to be unreasonable or lacking in rational underpinnings. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), cited with approval in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) .

We sustain the Examiner's rejection of claim 10.

#### DECISION

The decision of the Examiner to reject claims 1-4 and 7-10 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).

AFFIRMED

babc