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ROBERT A. PARSONS 15615 North 71st Street Suite 106 Scottsdale, AZ 85254			COX, STEPHANIE A	
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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* MARK WILLIAM AVERY

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Appeal 2015-002440  
Application 12/857,360  
Technology Center 1700

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Before BEVERLY A. FRANKLIN, KAREN M. HASTINGS, and  
JENNIFER R. GUPTA, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> requests our review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 1, 2, and 4–11 under 35 U.S.C. § 103(a) as unpatentable over Official Notice of The Boy Scouts of America Merit Badge Program (BSA) in view of Eggesfield (US 2008/0189830 A1; Aug. 14, 2008) as evidenced by “Historical Merit Badge Program,” “Introduction to Merit Badges,” “BSA Historical Merit Badge Program,” and “eBay Jamboree Patches.”

We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> The real party in interest is stated to be “Mark William Avery” (App. Br. 2).

Claim 1 is illustrative of the subject matter on appeal (emphasis added to highlight some key limitations):

1. An event memento system comprising:

a set of different shapes;

a plurality of different event categories;

*each different event category of the plurality of different event categories associated with a different shape of the set of different shapes;*

a set of different colors;

a plurality of different distances or features for each of the plurality of different event categories;

*each different distance or feature of the plurality of different distances or features associated with a different color of the set of different colors;*

*a first event memento* designating a first event category of the plurality of different event categories and a distance or feature of the first event category of the plurality of different distances or features, the first event memento including a body having a peripheral edge;

a viewable surface on the body within the peripheral edge, the viewable surface having a shape from the set of different shapes associated with the first event category of the plurality of different event categories;

a color from the set of different colors associated with the distance or feature of the plurality of different distances or features displayed on the body within the peripheral edge;

*a second event memento* designating a second event category of the plurality of different event categories, the second event category different from the first event category, and a distance or feature of the second event category of the plurality of different distances or features, the second event memento including a body having a peripheral edge;

a viewable surface on the body within the peripheral edge, the viewable surface having a shape from the set of different shapes associated with the second event category of the plurality of different event categories; and

a color from the set of different colors associated with the distance or feature of the plurality of different distances or features of the second event category displayed on the body within the peripheral edge.

Independent claim 5 recites a method of standardizing an event memento system similar to claim 1; independent claim 9 recites an event memento system similar to claim 1 (Claims Appendix)<sup>2</sup>. Appellant's arguments are substantially the same for each independent claim, even though presented in a separate section of the appeal brief (App. Br.; Reply Br. *generally*).

#### ANALYSIS

Upon consideration of the evidence on this record and each of Appellant's contentions, we find that the preponderance of evidence supports the Examiner's conclusion that the subject matter of Appellant's claims is unpatentable over the applied prior art. We sustain the Examiner's

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<sup>2</sup> Should there be further prosecution of this application, the Examiner may wish to review the claims for compliance under 35 U.S.C. § 101 in light of the examination instructions on patent eligible subject matter. See "Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*," Memorandum to the Examining Corps, June 25, 2014, as well as the USPTO's "July 2015 Update: Subject Matter Eligibility" and "May 2016 Subject Matter Eligibility Update (May 2016)."

§ 103 rejection essentially for the reasons set out by the Examiner in the Answer.

We add the following primarily for emphasis.

Appellant's principal arguments are 1) that the combined teachings do not disclose or suggest each event memento having a different shape to represent a different event category (App. Br. 14) 2) the Examiner has taken an unreasonably broad interpretation of "viewable surface" (App. Br. 16, 17); 3) Egglesfield does not suggest different shapes represent specific events (App. Br. 20) 4) that there is no teaching or suggestion to modify the references to arrive at the claimed invention (App. Br. 23) and 5) the Examiner is using impermissible hindsight to arrive at the claimed invention (Reply Br. 4–7).

We are unpersuaded of error in the Examiner's determination of obviousness. Appellant's arguments mainly address the references separately and do not fully address the inferences of these references that are presented on this record for our review.

It has been established that "the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Likewise, it is also well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in the art would have reasonably been expected to draw therefrom. *See In re Fritch*, 972 F.2d 1260, 1264–65 (Fed. Cir. 1992).

In *KSR Int'l Co.*, the Supreme Court also observed that:

In determining whether the subject matter of a . . . claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is . . . [unpatentable] under § 103.

550 U.S. at 419–420.

A person of ordinary skill in the art would have, using no more than ordinary creativity, reasonably designed or used an event memento system with each event category having a memento having a distinct shape associated therewith and having distinct colors to designate different distances or features of an associated event as recited in the claims on appeal (including a method of standardizing an event memento system as recited in claims 5–8) from the teachings of the references as detailed by the Examiner (Ans. 3–9).

Contrary to Appellant’s urging, we see no error in the Examiner’s claim interpretation of a “viewable surface” (App. Br. 16, 17). Even assuming that Appellant is correct that the Specification has a limiting definition of “a viewable surface,” the Examiner de facto merely determined that one of ordinary skill in the art would have inferred from the different shapes depicted on different Boy Scout badges that a memento/badge itself could have different shapes, consistent with Appellant’s argued definition (e.g. Ans. 4, 5).

Furthermore, we agree with the Examiner that, “matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art [in a utility patent application]. *In re Seid*, 161 F.2d 229, 73 USPQ 431.” (Final Action 7; *see also* Ans. 5, 7). *Cf. In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir.

2004) (stating that “[w]here 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”; finding no functional relationship where the printed matter in no way depends on the substrate and the substrate in no way depends on the printed matter; and holding claimed subject matter anticipated where such printed matter was the only difference between the claimed subject matter and the prior art). The features in Appellant’s claims directed to the shape/design and colors of the different event mementos are ““useful and intelligible only to the human mind.”” *See In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (*quoting In re Bernhart*, 417 F.2d 1395, 1399 (CCPA 1969)) (distinguishing such claim limitations from claim limitations defining functional characteristics). They do not exploit or interrelate with any other structural elements of the mementos.

Accordingly, we do not find that the appearance limitations (shapes, colors) at issue are functionally related to the mementos so as to patentably distinguish the subject matter of Appellant’s claims from the applied prior art.

Assuming arguendo that these features are functionally related as Appellant urges (e.g. Reply Br. 2, 3), Appellant’s arguments remain unpersuasive of error in the Examiner’s obviousness determination. We “take account of the inferences and creative steps that a person of ordinary skill in the art would employ,” and find a person of ordinary skill in the art would have modified the Boy Scout concept of different badges to include different shaped badges signifying different events as inferred from the Jamboree patches and Egglefield (e.g., to signify different athletic events, such as running, swimming, bicycling, etc.), and provide as much pictorial

and/or graphical and/or colors to designate different distances or features of each event type within their level of skill. *KSR Int'l* 550 U.S. at 418; *see also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”); *Ball Aerosol & Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009) (under the flexible inquiry set forth by the Supreme Court, the PTO must take account of the “inferences and creative steps,” as well as routine steps, that an ordinary artisan would employ (emphasis omitted)).

To the extent Appellant argues any of the claims separately (e.g. dependent claim 10 which adds a third event memento; App. Br. 25–26), a preponderance of the evidence supports the Examiner’s obviousness determination.

Accordingly, we affirm the Examiner’s prior art rejection of the claims under 35 U.S.C. § 103(a) for the reasons given above and presented by the Examiner.

#### DECISION

The Examiner’s § 103 rejection is affirmed.

#### TIME PERIOD FOR RESPONSE

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).

AFFIRMED