



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/204,828	07/07/2016	Hannah Rosenberg	545.451	7007
85444	7590	06/08/2020	EXAMINER	
Bay Area Technolgy Law Group PC 2171 E. Francisco Blvd., Suite L San Rafael, CA 94901			BURGESS, MARC R	
			ART UNIT	PAPER NUMBER
			3647	
			MAIL DATE	DELIVERY MODE
			06/08/2020	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HANNAH ROSENBERG, VICTORIA DAVILA,
and CHARLES FLOYD

Appeal 2019-003746
Application 15/204,828
Technology Center 3600

Before ANTON W. FETTING, PHILIP J. HOFFMANN, and
AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), the Appellant¹ appeals from the Examiner’s final decision to reject claims 1, 3–13, and 15–18, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as “its owner, Worldwise, Inc.” Appeal Br. 1.

CLAIMED SUBJECT MATTER

The Appellant’s invention “involves a cat attracting toy capable of amusing and occupying a domestic cat for extended periods of time and without the need for significant human intervention.” Spec. 1, ll. 5–7.

Claims 1 and 13 are the independent claims. Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A pet toy, in combination, comprising:

a containment structure having a longitudinal axis and cross section defining an interior volume, said containment structure comprising a plurality of containment openings along said longitudinal axis exposing said interior volume to a pet during use of said pet toy; and

an electronic component comprising a hollow shell having a shell opening configured therein, a motor having a rotatable shaft extending toward said shell opening and a power supply for powering said motor, said motor and power supply being supported within the interior of said hollow shell, an attractant being affixed to said rotatable shaft and extending through said shell opening, said electronic component and said attractant being visible to a pet during use of the pet toy and wherein, in use, *said pet toy is configured such that said attractant intermittently extends through said plurality of containment openings.*

Appeal Br. 8 (Claims App.) (emphasis added).

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Harkins	US 5,045,014	Sept. 3, 1991
Evans et al. (“Evans”)	US 5,572,951	Nov. 12, 1996
Cesa	US 6,964,572 B2	Nov. 15, 2005
Morrison	US 7,320,296 B2	Jan. 22, 2008
del Pinal et al. (“del Pinal”)	US 8,011,326 B2	Sept. 6, 2011
Floyd et al. (“Floyd”)	US 2016/0302388 A1	Oct. 20, 2016

REJECTIONS

Claims 1 and 4–10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morrison in view of Harkins.

Claims 12, 13, 15, and 16² stand rejected under 35 U.S.C. § 103 as being unpatentable over Morrison in view of Harkins and further in view of del Pinal.

Claims 3 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morrison in view of Harkins, alone, or in view of del Pinal, and further in view of Floyd.

Claims 11 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morrison in view of Harkins, alone, or in view of del Pinal, and further in view of Evans.

Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Morrison in view of Harkins in view of del Pinal, and further in view of Cesa.

² We consider the Examiner’s inclusion of canceled claim 14 to be harmless error.

OPINION

Each of independent claims 1 and 13 requires the highlighted feature above, i.e., that the toy comprise an attractant affixed to a rotatable shaft that intermittently extends through the containment or shell openings. *See* Appeal Br. 8–9 (Claims App.). After careful review of the record before us, we agree with the Appellant’s contention that the Examiner’s rejections of independent claims 1 and 13 are in error because the Examiner has not adequately explained how the combination of Morrison and Harkins, upon which the Examiner relies, teaches the recited limitation. *See* Appeal Br. 5; Reply Br. 2–3.

The Examiner finds, in relevant part, that Morrison teaches the claimed pet toy with a containment structure comprising a plurality of openings and an electronic component comprising a shell, a motor inside the shell, and a power supply, the component being visible during use. *See* Final Act. 2, 6–7. Acknowledging that “Morrison does not teach details of the electronic component,” the Examiner finds that Harkins teaches a pet toy with a hollow shell having a shell opening, a motor with a rotatable shaft extending toward the shell opening, a power supply, and an attractant affixed to the rotatable shaft and extending through the opening, with the electronic component and attractant visible during use. *Id.* at 3, 7. The Examiner further finds “[a]s taught and in use, the pet toy is configured such that said attractant intermittently extends through said plurality of containment openings.” *Id.* at 4; *see also id.* at 7. The Examiner notes that Harkins’s wand can be two to twelve inches long and that as Morrison’s device is intended for a cat, it would be several inches tall. *Id.* at 4, 7. Alternately, the Examiner determines, for claim 1, that “it would have been an obvious

matter of design choice to make the housing larger or the wand/ball smaller in order to allow the device to operate, since such a modification would have involved a mere change in the size of a component.” *Id.* at 4. For claim 13, the Examiner determines that alternately, “[i]t would have been an obvious matter of design choice to make the different portions of the containment structure . . . square, rectangular, or of whatever form or shape was desired or expedient.” *Id.* at 7–8.

Morrison discloses “[a]n entertainment device for use by pets . . . [which] can have a hollow enclosure with access openings and exit openings.” Morrison, Abstract. The hollow enclosure can have larger play items with diameters larger than the access and exit openings and smaller play items with diameter larger than the access openings but smaller than the exit openings such that the smaller items can be used external to the hollow enclosure. *Id.* The play items can include a motor with a power source within the play items. *Id.* at col. 6, ll. 4–10.

Harkins discloses “[a] toy displaying erratic and unpredictable motion for the amusement and fascination of people and pets.” Harkins, Abstract. The toy includes a spherical casing having within it a motor with a drive shaft and rechargeable battery, a flickering element, and “means for operably attaching the flickering element to the drive shaft so that the flickering element protrudes from the casing and rotates when the motor is operated.” *Id.* The rotation of the flickering element causes “the toy to move or roll in unpredictable directions, thus providing a source of amusement for people and pets.” *Id.* The element is described as “intermittently moving or flickering” and can include a wand with an attached amusement element at the end. *Id.* at col. 2, ll. 13–18. The

amusement element can comprise “different amusement elements [that] provide different appearances for the fascination and amusement of both people and pets,” such as a plurality of streamers, a pompom, cellophane fan, or small rubber tire. *Id.* at col. 3, ll. 22–35.

The Examiner emphasizes that it is the combination of Morrison and Harkins that teaches having a motorized ball with the claimed elements inside a pet toy structure. Ans. 10–11. However, the Examiner does not adequately explain how the combination teaches the toy being configured to have the attractant intermittently extend through the openings and why one of ordinary skill in the art would do so. As best we understand, the Examiner modifies Morrison’s play item to have a motor with a rotatable shaft, the shaft having attached thereto a wand with a length of 2 or more inches that has an attractant attached to the end, as taught by Harkins, such that the modified play item would at times extend through the openings through erratic and unpredictable movement. *See* Ans. 12–13.

In the Final Action, the Examiner states, with reference to the proposed modification of Morrison based on Harkins, that “[a]s taught and in use, the pet toy is configured such that said attractant intermittently extends through said plurality of containment openings.” Final Act. 4, 7. There is no further explanation in support of this conclusion. In the Answer, the Examiner explains that Harkins’s teaching of having erratic and unpredictable motion would “allow [the modified play item] to roll about inside a containment structure as taught by Morrison, [such that] it would inherently intermittently extend through the openings,” and the Examiner provides diagrams of “scenarios” as support. Ans. 12–13. However, inherency “may not be established by probabilities or possibilities.” *Par*

Pharmaceuticals, Inc. v. TWI Pharmaceutical, Inc., 773 F.3d 1186, 1195 (Fed. Cir. 2014) (quoting *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)). “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* (citing *In re Rijckaert*, 9 F.3d 1531, 1533–34 (Fed. Cir. 1993)). And, “[t]hat which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.” *In re Spormann*, 363 F.2d 444, 448 (C.C.P.A. 1966). Neither Morrison nor Harkins teaches their attractant intermittently extending through openings. We agree with the Appellant that the Examiner’s scenarios are simply speculation. *See* Reply Br. 3.

The Examiner also states that, alternatively, for claim 1

it would have been an obvious matter of design choice to make the housing larger or the wand/ball smaller in order to allow the device to operate, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Final Act. 4–5. The Examiner provides a similar alternative for claim 13,

that Morrison teaches that the containment structure 110 can be of any shape desired (column 3, lines 38–43). It would have been an obvious matter of design choice to make the different portions of the containment structure, square, rectangular, or of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Final Act. 7–8 (bold omitted). However, our reviewing court has cautioned that “[m]erely stating that a particular [limitation] is a design choice does not make it obvious.” *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1069 n.4 (Fed. Cir. 2018) (quoting *Cutsforth, Inc. v. MotivePower, Inc.*, 636

F. App'x 575, 578 (Fed. Cir. 2016) (nonprecedential)). Similarly, the Manual of Patent Examining Procedure (“MPEP”) states that “[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness.” MPEP § 2144.04 (quoting *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)). The Examiner must still provide a reason for one of ordinary skill in the art, “without the benefit of the appellant’s specification, to make the necessary changes in the reference device.” *Id.*

Rather than provide any evidence or technical analysis relevant to the specific facts at issue relating to the modified play item intermittently extending through the openings, the Examiner summarily reaches a conclusion of obviousness relying on, without more, a per se rule that “[a] change in size [or form or shape] is generally recognized as being within the level or ordinary skill in the art.” Final Act. 4–5, 7–8. “This method of analysis is founded on legal error because it substitutes supposed per se rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *In re Ochiai*, 71 F. 3d 1565, 1571 (Fed. Cir. 1995). Further, the Appellant argues that the different structures of Morrison and Harkins achieve different purposes, while for the Appellant’s invention, the feature of the attractant intermittently extending through openings is critical for its purpose. *See* Appeal Br. 4–5; Reply Br. 2–3. Specifically, the Appellant argues that this feature “not only makes the toy more effective in that it stimulates the hunt and pounce instincts of a cat[,] but also helps protect the attractant by periodically withdrawing it within the structure to minimize its degradation during vigorous play.” Reply Br. 2;

see also Appeal Br. 4; Spec. 1 (discussing a cat’s natural instinct to hunt and pounce and prior art problems of instability). The Appellant argues that in contrast to their invention, Morrison’s device prevents boredom and dissatisfaction (*see* Appeal Br. 4; *see also* Morrison, Abstract, col. 6, ll. 4–10 (providing an “entertainment device” that “spark[s] the interest of the pet in chasing the play items”)), and that Harkins teaches a tennis ball like structure with a tune and rotating flickering element (*see* Appeal Br. 5) that provides a toy “for the amusement of people and pets[,] . . . to fascinate people and pets . . . [and] that will not cause injury to either people or pets” (Harkins, col. 1, ll. 35–42). The Appellant thus provides sufficient reasons why the feature of the attractant intermittently extending through openings and the sizing of Morrison’s play item as modified by Harkins are not simply design choices. *See In re Chu*, 66 F.3d 292, 298–99 (Fed. Cir. 1995).

Thus, based on the record before us, we are persuaded of Examiner error, and we do not sustain the rejections of independent claims 1 and 13. We also do not sustain the rejections of dependent claims 4–10, 12, 15, and 16 under the same grounds of rejection. The rejections of claims 3, 11, 17, and 18 as further obvious over Floyd, Evans, and Cesa are also not sustained, as they fail to include additional findings and/or reasoning that cures the deficiency in the rejections of the independent claims, from which they depend.

CONCLUSION

The Examiner’s decision to reject claims 1, 3–13, and 15–18 is not sustained.

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 4–10	103	Morrison, Harkins		1, 4–10
12, 13, 15, 16	103	Morrison, Harkins, del Pinal		12, 13, 15, 16
3, 17	103	Morrison, Harkins, del Pinal, Floyd		3, 17
11, 18	103	Morrison, Harkins, del Pinal, Evans		11, 18
17	103	Morrison, Harkins, del Pinal, Cesa		17
Overall Outcome				1, 3–13, 15–18

REVERSED