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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GINA M. GATTO-WEISING

Appeal 2019-004431
Application 14/701,016
Technology Center 3700

Before CHARLES N. GREENHUT, MICHAEL L. HOELTER, and
ANNETTE R. REIMERS, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–17 and 20–24. Final Act. 1 (Office Action Summary). We have jurisdiction under 35 U.S.C. § 6(b). For the reasons explained below, we do not find error in the Examiner's rejections of these claims. Accordingly, we AFFIRM the Examiner's rejections.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “Gina M. Gatto-Weising.” Appeal Br. 2.

CLAIMED SUBJECT MATTER

The disclosed subject matter relates to “an adjustable umbrella holder.” Spec. ¶ 25. Apparatus claims 1 and 21 are independent. Claim 1 is illustrative of the claims on appeal and is reproduced below.

1. An umbrella holder comprising:
a receptacle in a form of a cup adapted to receive a handle of an umbrella, the receptacle including a first ball joint as a unitary element of the receptacle;
a first clamp mechanism configured to receive the first ball joint at a proximate end of the first clamp mechanism and to receive a second ball joint at a distal end of the first clamp mechanism; and
the second ball joint connected to an attachment mechanism.

REFERENCES RELIED ON BY THE EXAMINER

Howson	US 180,881	Aug. 8, 1876
Giller	US 2,710,609	June 14, 1955
Gainey	US 4,927,117	May 22, 1990
Wu	US 5,310,155	May 10, 1994
Carnevali	US 6,581,892 B2	June 24, 2003
Hood	US 7,229,059 B1	June 12, 2007
Stallings, Jr. et al.	US 7,967,274 B1	June 28, 2011
Dunlop	US 8,487,169 B2	July 16, 2013
Woller	US 2008/0224017 A1	Sept. 18, 2008
Gatto-Weising ²	US 2013/0256355 A1	Oct. 3, 2013

THE REJECTIONS ON APPEAL

Claims 1–4, 7, and 21–23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Gatto, Stallings, and Giller. Final Act. 2.

² Because both the Examiner and Appellant refer to this reference as “Gatto,” we do the same. See Final Act. 2–7; Appeal Br. 9–18.

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Claims 5, 11, and 12 are rejected under 35 U.S.C. § 103(a) as unpatentable over Gatto, Stallings, Giller, and Hood. Final Act. 4.

Claim 6 is rejected under 35 U.S.C. § 103(a) as unpatentable over Gatto, Stallings, Giller, and Wu. Final Act. 4.

Claims 8–10 and 13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Gatto, Stallings, Giller, and Howson. Final Act. 5.

Claims 14 and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Gatto, Stallings, Giller, and Dunlop. Final Act. 6.

Claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Gatto, Stallings, Giller, and Carnevali. Final Act. 6.

Claim 20 is rejected under 35 U.S.C. § 103(a) as unpatentable over Gatto, Stallings, Giller, and Woller. Final Act. 6.

Claim 24 is rejected under 35 U.S.C. § 103(a) as unpatentable over Gatto, Stallings, Giller, and Gainey. Final Act. 7.

ANALYSIS

*The rejection of claims 1–4, 7, and 21–23
as unpatentable over Gatto, Stallings, and Giller*

Appellant focuses solely on the limitations of claim 1. *See* Appeal Br. 5–14. Accordingly, we select claim 1 for review.³ The remaining claims

³ Appellant states, “claims 2–4 and 7 are allowable at least by virtue of depending from allowable claim 1” and, with respect to these claims, reiterates arguments made for claim 1. *See* Appeal Br. 13. Appellant also states, “[s]imilar to claim 1, the combination of Gatto, Stallings, and Giller fails to teach or suggest all of the elements of Appellant’s independent claim 21;” “[d]ependent claims 22–24 are allowable at least by virtue of depending from an allowable claim;” and, with respect to these claims, reiterates arguments made for claim 1. *See* Appeal Br. 13.

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(i.e., claims 2–4, 7, and 21–23) stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claim 1 recites an umbrella holder having “a receptacle in a form of a cup adapted to receive a handle of an umbrella, the receptacle including a first ball joint as a unitary element of the receptacle.” Appeal Br. 20 (Claims App.). The Examiner primarily relies on Gatto for disclosing an umbrella holder having a receptacle (holder 130) and an articulable joint (armature 120), but acknowledges that Gatto does not disclose the joint as a ball joint.⁴ *See* Final Act. 2; *see also* Gatto Fig. 2. The Examiner relies on Giller for teaching an articulable ball joint. *See* Final Act. 2; *see also* Giller Fig. 3. The Examiner concludes that it would have been obvious to modify the umbrella holder of Gatto to have a ball joint, as taught by Giller “because doing so only involves a simple substitution of one known, equivalent articulating joint for another to obtain predictable results” and also notes that “the ball joint connection would provide greater freedom of movement for the joint.”⁵ Final Act. 2.

Regarding the recitation that the ball joint be “a unitary element of the receptacle,” the Examiner states,

In addition to Giller’s disclosure of a unitary ball joint formation, it is also noted that it would have been obvious to have made a unitary formation, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. MPEP [§] 2144.04(V)(B).

⁴ The Examiner relies on Stallings for teaching a receptacle having a bottom, which Appellant does not dispute. *See* Final Act. 2; Appeal Br. 5–14.

⁵ Appellant acknowledges that Gatto’s device has “limited articulation.” Appeal Br. 9.

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Final Act. 2–3. Appellant disagrees stating that the combined references do not disclose “a first ball joint *as a unitary element of the receptacle.*”

Appeal Br. 9.

To be clear, the Examiner references Giller’s “first ball joint (30) as a unitary element of the supported object (mirror 32).” Final Act. 2; *see also* Giller Fig. 3. Giller is not explicit that ball 30 and mirror 32 are “unitary” stating only that “[t]he stem **31** of the latter [i.e., ball 30] supports a mirror **32** or other desired device.” Giller 2:48–49. We decline to understand MPEP § 2144.04(V)(B) as a *per se* rule that “forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art” because our reviewing court has stated that neither their precedent, nor that of their predecessor court, should be construed as formulating any *per se* rules of obviousness. *See In re Ochiai*, 71 F.3d 1565, 1571–72 (Fed. Cir. 1995).

However, in an obviousness analysis, we have been instructed to “not ignore the modifications that one skilled in the art would make to a device borrowed from the prior art.” *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007). This follows from the prospect that “[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 (2007).

In the matter before us, we believe the Examiner has the stronger position. This is because, as stated above, Giller clearly teaches ball 30 having a “stem **31**” (Giller 2:48), and the opposite (e.g., distal) end of that stem 31 is clearly illustrated as being unitary with mirror 32 (*see* Giller Fig. 3). Further, even presuming the ball 30/stem 31 interface comprise separate units, Appellant does not explain how it would not have been obvious to render them unitary so as to render moot any separation force that may be

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encountered (such as by adjusting mirror 32). As such, making ball 30 unitary with stem 31 would provide a predictable result (better stability), which is well within the creative abilities of a person of ordinary skill in the art. Further, nothing in the record suggests that the Examiner's proposed modification would involve anything more than common sense and/or routine engineering effort. We thus are not persuaded that Giller fails to teach or suggest a unitary assembly to one skilled in the art. Likewise, we are not persuaded by Appellant's contentions that the combination of references fails to render obvious the substitution of the recited ball joint for Gatto's limited articulating joint. *See* Final Act. 2.

Appellant next contends that the Examiner applies "impermissible hindsight in selecting and combining the references" because Giller's "[h]ead bands are not an analogous art field to umbrella holders." Appeal Br. 10; *see also id.* at 11. Appellant further argues that the Examiner fails to establish sufficient motivation to combine the teachings of the references but, instead, bases the rejection on conclusory statements. *See* Appeal Br. 11–12.

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

In re Clay, 966 F.2d 656, 658–659 (Fed. Cir. 1992). *See also In re ICON Health and Fitness, Inc.*, 496 F.3d at 1379–80. As to the second criteria, the Specification discloses "[t]he apparatus 200 may have one or more elements that are articulable via a ball and socket joint or other means." Spec. ¶ 25. Giller addresses a similar topic of articulation stating, "[t]he general object

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of the invention is to provide an instrument supporting head band having improved characteristics of ease and certainty of adjustment.” Giller 1:17–19. The Examiner thus responds that Giller’s disclosure is “reasonably pertinent to the problem of increasing articulation . . . because [Giller] disclose[s] holding brackets with articulating mounts.” Ans. 11. In view of the above, we are not persuaded by Appellant’s non-analogous art argument.

Additionally, and as noted above, the Examiner provided a sound basis for modifying Gatto’s umbrella holder by substituting its joint with that of Giller. *See* Final Act. 2. This is because, as expressed by the Examiner, Giller’s “ball joint connection would provide greater freedom of movement for the joint” than Gatto’s attachment mechanism. Final Act. 2. Appellant does not dispute that Giller’s ball joint is a known equivalent of another joint, such as Gatto’s mechanism, nor does Appellant dispute that there is a reasonable expectation of success in such a substitution.

Accordingly, we do not agree with Appellant that the Examiner’s rejection is based on impermissible hindsight or conclusory statements. Nor are we persuaded that the Examiner failed to provide sufficient motivation to combine the references. In summation, and based on the record presented, Appellant does not apprise us of Examiner error. We sustain the Examiner’s rejection of claims 1–4, 7, and 21–23 as being obvious over Gatto, Stallings, and Giller.

*The rejection of claims 5, 11, and 12
as obvious over Gatto, Stallings, Giller, and Hood*

*The rejection of claim 6
as obvious over Gatto, Stallings, Giller, and Wu*

*The rejection of claims 8–10 and 13
as obvious over Gatto, Stallings, Giller, and Howson*

*The rejection of claims 14 and 15
as obvious over Gatto, Stallings, Giller, and Dunlop*

*The rejection of claims 16 and 17
as obvious over Gatto, Stallings, Giller, and Carnevali*

*The rejection of claim 20
as obvious over Gatto, Stallings, Giller, and Woller*

*The rejection of claim 24
as obvious over Gatto, Stallings, Giller, and Gainey*

Appellant does not provide substantive arguments concerning the above rejections of claims 5, 6, 8–20, and 24 and, instead, relies on arguments provided for claim 1. *See* Appeal Br. 14–18. Because we find no deficiencies in the Examiner’s rejection of independent claim 1 in view of Gatto, Stallings, and Giller, we likewise sustain the Examiner’s rejections of claims 5, 6, 8–20, and 24 as being obvious over these three references in addition to the cited art listed above.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–4, 7, 21–23	103(a)	Gatto, Stallings, Giller	1–4, 7, 21–23	
5, 11, 12	103(a)	Gatto, Stallings, Giller, Hood	5, 11, 12	
6	103(a)	Gatto, Stallings, Giller, Wu	6	
8–10, 13	103(a)	Gatto, Stallings, Giller, Howson	8–10, 13	
14, 15	103(a)	Gatto, Stallings, Giller, Dunlop	14, 15	
16, 17	103(a)	Gatto, Stallings, Giller, Carnevali	16, 17	

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Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
20	103(a)	Gatto, Stallings, Giller, Woller	20	
24	103(a)	Gatto, Stallings, Giller, Gainey	24	
Overall Outcome			1-17, 20-24	

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