

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte PATRICK A. HARGABUS

Appeal No. 2004-0087
Application No. 09/677,705

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 6, 12, 14 and 21 to 35, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an infinity mirror display apparatus, and a method for its manufacture, which allows a user to rapidly change out or add to a selection of display objects used with mirrors able to cause an infinity mirror effect (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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| Singerman | 1,880,026 | Sept. 27, 1932 |
| Mullis | 5,787,618 | Aug. 4, 1998 |

Claims 1, 2, 6, 12, 14 and 21 to 35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mullis in view of Singerman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 12, mailed March 26, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 11, filed January 10, 2003) and reply brief (Paper No. 13, filed May 27, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 2, 6, 12, 14 and 21 to 35 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 1, 12 and 33, the independent claims under appeal, read as follows:

1. An infinity mirror display apparatus for enhanced exhibition of different groupings of independently prized collectible objects without injury to and

permanent modification thereto, which allows for frequent and prompt replacement of currently exhibited collectible objects by newly selected collectible objects so as to maintain within said apparatus a selection of collectible objects that continually updates the artistic and aesthetic effect it exhibits to maintain a fresh and interesting effect for the operator and other viewers, said apparatus comprising:

a housing having a stationary base member and a cover which together define an enclosed interior space, said cover being easily movable between a closed position against said stationary base member and a plurality of opened positions wherein rapid access to said interior space is provided without moving said base member from its operational position;

at least two opposed mirrors positioned adjacent to said interior space with said mirrors being at a spaced-apart distance from one another and at least one of said mirrors being a partially reflective mirror;

a plurality of collectible objects each smaller than said interior space, at least one of said collectible objects being initially operator selected and positioned between said mirrors;

support means adapted for secure positioning of at least one of said collectible objects within said interior space without permanent modification to said collectible object and without restriction on rapid replacement of said securely positioned and currently exhibited collectible object by a new one of said collectible objects selected according to operator impulse;

at least one light source positioned within said interior space and configured for sufficient illumination of each said selected collectible object positioned between said mirrors to create multiple closely spaced-apart reflected images rearwardly therefrom and make an infinity mirror effect; and

electrical connection means adapted for connecting each said light source to a source of power so that when said selected collectible objects and said support means are within said interior space in operational positions and electrical power is provided to each said light source, exhibition of each said collectible object within said interior space is enhanced by an infinity mirror effect to observers looking at said collectible object through each said partially reflective mirror and also when a new appearance is desired for said apparatus an operator can promptly make additions and removals of said collectible objects to and from said interior space without having to substantially dismantle said apparatus, move said base member from its operational position, or disturb any of said collectible objects already positioned within said interior space.

12. A method of making an infinity mirror display apparatus for enhanced exhibition of objects treasured apart from their use with said apparatus, including

objects that are part of a collection, which allows prompt exchange of one collectible object for another, as well as exhibition of objects without a need for any permanent modification thereto, said method comprising the steps of:

providing a housing having an interior spaced defined by a stationary base member and an easily separable cover, at least one totally reflective mirror, a plurality of partially reflective mirrors, a plurality of collectible objects each smaller than said interior space, at least one light source, electrical connection means, and a power source;

attaching a first one of said partially reflective mirrors to said cover in a position where said partially reflective mirror is adjacent to said interior space and also so that an illuminated object positioned behind said partially reflective mirror can be viewed by an observer looking through said partially reflective mirror;

positioning a remaining one of said mirrors adjacent to said interior space so that a reflected image from an illuminated object positioned behind said partially reflective mirror can be viewed by an observer looking through said partially reflective mirror;

positioning selected ones of said collectible objects within said interior space and between the ones of said mirrors positioned adjacent said interior space;

positioning each said light source within said interior space in a position remote from each said partially reflective mirror used and also in a position to provide sufficient illumination for at least one of said collectible objects so that multiple reflected images of all of said collectible objects selected for positioning within said interior space can be seen through said partially reflective mirrors;

optionally forming an opening within said stationary base member and said cover for extension therethrough of said electrical connection means; and

using said electrical connection means to connect each said light source to said power source so that when each said light source is activated, each of said selected collectible objects viewed through one of said partially reflective mirrors positioned adjacent to said interior space is enhanced by said multiple reflected images creating an infinity mirror effect.

33. An infinity mirror display apparatus for enhanced exhibition of a plurality of independently prized collectible objects without injury to and permanent alteration thereof, which allows for repeated and prompt replacement of currently exhibited collectible objects by new collectible objects selected according to operator impulse for maintaining within said apparatus a selection of collectible objects that remains fresh and interesting to the operator, and other viewers, said apparatus comprising:

a housing having a stationary base member and a cover which together define an enclosed interior space, said cover being easily movable between a closed position against said stationary base member and a plurality of opened positions wherein rapid access to said interior space is provided without moving said base member from its operational position;

fastening means adapted for securing said cover against said base member when said cover is in said closed position, and wherein said fastening means is selected from a group consisting of hinges, magnetic closure means, keyed locking means, and snap-fit types of closure means;

at least two opposed mirrors positioned adjacent to said interior space with said mirrors being at a spaced-apart distance from one another and at least one of said mirrors being a partially reflective mirror;

a plurality of collectible objects each smaller than said interior space, at least one of said collectible objects being initially operator selected and positioned between said mirrors;

support means adapted for secure positioning of at least one of said collectible objects within said interior space without permanent alteration and modification to said collectible objects and without restriction on prompt replacement of said securely positioned and currently exhibited collectible object by a newly selected one of said collectible objects according to operator impulse, and wherein said support means is selected from a group consisting of transparent lower supports, translucent lower supports, opaque lower supports having at least one aperture therethrough, supports attachable to glass through suction cup means, means for suspending display of at least one of said collectible objects within said interior space, and support means comprising interlocking protrusions and peg holes. [sic, ;]

at least one light source positioned within said interior space and configured for sufficient illumination of each said selected collectible object positioned between said mirrors to create multiple closely spaced-apart reflected images rearwardly therefrom and make an infinity mirror effect, and wherein each said light source is selected from a group consisting of incandescent bulbs, multiple miniature incandescent light bulbs encased within elongated flexible plastic tubing, neon lights, light emitting diode lighting, and electroluminescent lights; and

electrical connection means adapted for connecting each said light source to a source of power so that when said selected collectible objects and said support means are within said interior space in operational positions and electrical power is provided to each said light source, exhibition of each said collectible object within said interior space is enhanced by an infinity mirror effect to observers looking at said collectible object through each said partially

reflective mirror and also when a new appearance is desired for said apparatus an operator can promptly make additions and removals of said collectible objects to and from said interior space without having to substantially dismantle said apparatus, move said base member from its operational position, or disturb any of said collectible objects already positioned within said interior space.

In the rejection (answer, pp. 3-5) before us in this appeal, the examiner ascertained that Mullis teaches all of the claimed subject matter of independent claims 1, 12 and 33 except for the movable/separable cover and that it would have been obvious to one of ordinary skill in the art to have provided Mullis with an openable panel in view of the teachings of Singerman.

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree. In our view, even if it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Mullis to have a movable/separable cover such would not arrive at the claimed invention for the reasons which follow.

With respect to independent claims 1 and 33, Mullis does not teach or suggest the recited "support means." The examiner has not treated this means-plus-function recitation in the manner required by 35 U.S.C. § 112, sixth paragraph. As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the

USPTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Accordingly, the USPTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

In order to meet a "means-plus-function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989).

Mullis clearly fails to teach any of the support means disclosed in the present application. In addition, the examiner has not set forth a sufficient basis as to why Mullis' fastening system 100 or surface 96 would be equivalent to any of the support

means disclosed in the present application.¹ Therefore the examiner's proposed modification to Mullis based on the teachings of Singerman would not arrive at the claimed invention as set forth in independent claims 1 and 33.

With respect to independent claim 12, Mullis does not teach or suggest either (1) providing at least one totally reflective mirror and a plurality of partially reflective mirrors; or (2) attaching one of the partially reflective mirrors to the easily separable cover. In our view, the combined teachings of the applied prior art would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have attached Mullis' partially reflective mirror to an easily separable cover.

Therefore the examiner's proposed modification to Mullis based on the teachings of

¹ While there is no litmus test for an "equivalent" that can be applied with absolute certainty and predictability, there are several indicia that are sufficient to support a conclusion that one element is or is not an "equivalent" of a different element in the context of 35 U.S.C. § 112, sixth paragraph. Among the indicia that will support a conclusion that one element is or is not an equivalent of another are: (A) Whether the prior art element(s) performs the function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element(s) disclosed in the specification. Odetics Inc. v. Storage Tech. Corp., 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir. 1999); (B) Whether a person of ordinary skill in the art would have recognized the interchangeability of the element(s) shown in the prior art for the corresponding element(s) disclosed in the specification. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999); Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc., 145 F.3d 1303, 1309, 46 USPQ2d 1752, 1757 (Fed. Cir. 1998); (C) Whether the prior art element(s) is a structural equivalent of the corresponding element(s) disclosed in the specification. In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990); (D) Whether there are insubstantial differences between the prior art element(s) and the corresponding element(s) disclosed in the specification. IMS Technology, Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1436, 54 USPQ2d 1129, 1138-39 (Fed. Cir. 2000); Valmont Indus., Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1043, 25 USPQ2d 1451, 1455 (Fed. Cir. 1993).

Singerman would not arrive at the claimed invention as set forth in independent claim 12.

For the reasons set forth above, the decision of the examiner to reject independent claims 1, 12 and 33, and claims 2, 6, 14, 21 to 32, 34 and 35 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 6, 12, 14 and 21 to 35 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2004-0087
Application No. 09/677,705

Page 12

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