

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KEVIN D. WINNER

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Appeal No. 97-3194  
Application No. 08/442,816<sup>1</sup>

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ON BRIEF

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Before ABRAMS, McQUADE, 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 3, 4, 6, 9 to 24, 31 to 38 and 44 to 46, which are all of the claims pending in this application.

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<sup>1</sup> Application for patent filed May 17, 1995. According to the appellant, the application is a continuation-in-part of Application No. 08/233,291, filed April 26, 1994, now U.S. Patent No. 5,488,844.

Appeal No. 97-3194  
Application No. 08/442,816

We AFFIRM-IN-PART, however, for reasons explained infra, we denominate our affirmance of claims 3, 4, 6, 9 to 20 and 44 to 46 a new ground of rejection under 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a security device, more particularly a theft prevention device for use on bicycles, motorcycles, mopeds and other conveyance means (specification, page 1, lines 1-3). An understanding of the invention can be derived from a reading of exemplary claims 11, 31 and 44, which appear in the appendix to the appellant's brief.

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

Damon 1897	596,237	Dec. 28,
Wood 3, 1909	929,910	Aug.
Johnson 1989	4,856,308	Aug. 15,
Winner 1996	5,488,844	Feb. 6,
Lipschutz 1983	2,495,555 <sup>2</sup>	June 11,

(France)

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<sup>2</sup> In determining the teachings of Lipschutz, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

Clark  
1984

2,134,463  
(United Kingdom)

Aug. 15,

Claims 44, 45, 3, 11 and 12 stand rejected under 35  
U.S.C.  
§ 103 as being unpatentable over Damon.

Claims 44, 45 and 3 stand rejected under 35 U.S.C. § 103  
as being unpatentable over Wood in view of Damon.

Claims 4, 6, 18, 31 to 38 and 46 stand rejected under  
35 U.S.C. § 103 as being unpatentable over Damon in view of  
Johnson.

Claims 9, 10, 13 to 17, 19 and 20 stand rejected under  
35 U.S.C. § 103 as being unpatentable over Damon in view of  
Lipschutz.

Claim 38 stands rejected under 35 U.S.C. § 103 as being  
unpatentable over Damon in view of Johnson and Clark.

Claims 3, 4, 6, 9 to 24, 31 to 38 and 44 to 46 stand rejected under the judicially created doctrine of double patenting over the claims of Winner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections<sup>3</sup>, we make reference to the examiner's answer (Paper No. 16, mailed December 3, 1996) and the supplemental examiner's answer (Paper No. 18, mailed April 16, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 14, filed September 16, 1996) and reply brief (Paper No. 17, filed January 28, 1997) 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

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<sup>3</sup> The other rejections set forth in the final rejection and the answer have been withdrawn by the examiner in the Advisory Action of June 28, 1996 (Paper No. 10) and the supplemental examiner's answer (Paper No. 18).

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

**The double patenting issue**

The appellant has not argued the rejection of claims 3, 4, 6, 9 to 24, 31 to 38 and 44 to 46 under the judicially created doctrine of double patenting over the claims of Winner. The appellant has stated in the past (Paper No. 9, filed June 20, 1996) that he "is fully prepared, upon allowance of the claims of this application, to file a Terminal Disclaimer thereby overcoming this non-statutory objection [rejection]." Since no Terminal Disclaimer has yet been submitted to overcome this rejection, we summarily sustain the rejection of claims 3, 4, 6, 9 to 24, 31 to 38 and 44 to 46 under the judicially created doctrine of double patenting.

**The § 103 rejection utilizing Damon**

We find that the examiner has established a prima facie case of obviousness<sup>4</sup> with respect to the rejection of claims 44, 45, 3, 11 and 12 under 35 U.S.C. § 103 as being unpatentable over Damon.

Claim 44 recites:

A bicycle theft prevention device comprising:

a) a first generally U-shaped rod member including first and second parallel arms joined by a bight, at least one arm of said rod member including a plurality of lock engaging means evenly spaced therealong,

b) a second U-shaped member being movable along the arms of said rod member toward and away from said bight and including first and second arms to telescopically engage respectively the first and second parallel arms of said rod member, and

c) a lock housing joined to said second U-shaped member and containing lock means to prevent disengagement of the arms of said second U-shaped member from the arms of said rod member when the device is locked, and to permit disengagement of the arms of said second member from the arms of said rod member when the device is unlocked, the arms of said second U-shaped member being freely disengaged from the arms of said U-shaped rod member when the device is unlocked and the members are telescoped away from one another.

Claim 45 recites:

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<sup>4</sup> 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).

The device according to claim 44, wherein the lock engaging means comprises ratchet teeth along one arm of the rod member and the lock means comprises a pawl that is spring biased into abutting contact with one of said ratchet teeth when the device is locked.

Claim 3 recites:

The device according to claim 45, wherein said ratchet teeth partially circumscribe said at least one arm.

Claim 11 recites:

A theft deterrent device comprising a) a first generally U-shaped member, b) a second generally U-shaped member, each member having first and second parallel arms, the parallel arms of the first member being telescopically received into the parallel arms of the second member, the first member containing a plurality of ratchet teeth spaced along its first parallel arm, and c) lock means associated with the second U-shaped member, said lock means including a pawl engaging individual ratchet teeth when said lock means is locked, to prevent said members when engaged from being separated, while allowing said members to be telescoped together, and when said lock means is unlocked, allowing the members to be freely disengaged when telescoped away from one another.

Claim 12 recites:

The device according to claim 11, wherein the first U-shaped member comprises a rod, with the ratchet teeth spaced uniformly along said first parallel arm thereof.

Damon's invention relates to locks and latches, and particularly to a lock for bicycles, baggage, and other

portable articles to lock the same against removal or transportation (page 1, lines 8-11). As shown in Figure 2, Damon's lock includes

(1) a U-shaped bar or rod 1 having upon one end teeth 2, (2) a U-shaped hollow tube 3, and (3) a locking assembly mounted upon one end of the tube 3 for engagement with the teeth 2.

Damon's locking assembly includes flanges 7 integral with the tube 3, a toothed plate 8, a spring 10, a cover 11, a screw-threaded projection 16, and a key 18. In addition, Damon teaches (page 1, lines 42-54) that

[t]he other end of the bar 1 has a longitudinal groove 4, terminating in an L-shaped groove 5, which engages a lug 6 on the inside of one end of the tube or sleeve 3, so that the shackle [bar 1] may be operated to slide in or out of the sleeve the whole length of the said groove 4 with the toothed end of the shackle in or out of the sleeve without separating the shackle from the sleeve, said shackle being turned to have the lug 6 engage the L-shaped groove 5 to put the toothed end of the shackle out of the line with the sleeve or to separate the sleeve entirely.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Damon and claims 44, 45, 3, 11 and 12, it is our opinion that there are no differences.

The examiner had implicitly determined (answer, p. 2) that Damon lacked "the arms of said second U-shaped member being freely disengaged from the arms of said U-shaped rod member when the device is unlocked and the members are telescoped away from one another" as recited in independent claim 44 and "when said lock means is unlocked, allowing the members to be freely disengaged when telescoped away from one another" as recited in claim 11. We do not agree.

We agree with the appellant's understanding of the operation of Damon's lock as set forth on page 8 of the brief. However, it is not apparent to us how the above-noted limitations of claims 44 and 11 are not readable on Damon's lock.<sup>5</sup> In that regard, when the device of Damon is unlocked

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<sup>5</sup> It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the

and the rod 1 and tube 3 are telescoped away from one another so that the rod 1 is entirely separated from tube 3, the arms of the U-shaped tube 3 are freely disengaged from the arms of the U-shaped rod 1. We find no recitation in these claims which would exclude the 90° rotation that is necessary in Damon's lock to completely disengage rod 1 from tube 3.

The appellant's argument concerning claims 44, 45, 3, 11 and 12 are unpersuasive for the following reasons. The issue of whether it would have been obvious to removing Damon's lug 6 and groove 4 as set forth by the examiner is moot in view of our determination above that all limitations of claims 44, 45, 3, 11 and 12 are taught by Damon. With regard to claims 45 and 11, we find that Damon's pawl (i.e., locking plate 8) is spring biased into abutting contact with one of the ratchet teeth 2 (claim 45) or engagement with individual ratchet teeth

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specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

2 (claim 11) when the device is locked. In that regard, we find no limitation in either claim 45 or claim 11 which requires the pawl to engage one and only one tooth. With regard to claim 3, as clearly shown in Figure 3, the ratchet teeth 2 of Damon partially circumscribe the one arm of rod 1.

As noted above, Damon does teach all the limitations of claims 44, 45, 3, 11 and 12. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, the examiner has established a prima facie case of obviousness.

**The § 103 rejection utilizing Wood in view of Damon**

We will not sustain the examiner's rejection of claims 44, 45 and 3 under 35 U.S.C. § 103 as being unpatentable over Wood in view of Damon. In that regard, we agree with the

appellant's argument (brief, pp. 11-15) that it would not have been obvious to modify Wood to arrive at the claimed invention absent impermissible hindsight. See W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

**The § 103 rejection utilizing Damon in view of Johnson**

We find that the examiner has established a prima facie case of obviousness with respect to the rejection of claims 4, 6, 18, 31 to 36 and 46 under 35 U.S.C. § 103 as being unpatentable over Damon in view of Johnson, but not the rejection of claims 37 and 38.

Johnson discloses an automobile steering lock. Johnson teaches that one problem with prior antitheft devices is that they appear susceptible to being overcome by physical force or manipulation. Specifically, Johnson teaches (column 1, lines 43-50) that the locking mechanism of Moore U.S. Patent No. 3,462,982 is exposed, and includes pry points thereabout in which a crowbar may be inserted in an attempt to overcome such mechanism and that irrespective of whether such a device can

be overcome by physical manipulation, they present prospective thieves with the appearance of being breakable.

As shown in Figure 1, Johnson's lock is comprised of an elongated body member 10, an elongated rod member 12 which is dimensioned to move in telescopic fashion within body member 10, and a housing 14. Hooks 16, 18, for engaging diametrically opposed portions of the steering wheel from the inside thereof, are provided on body member 10 and rod member 12, respectively. Locating means 20 and locking means 22 are provided within housing 14 to position and lock rod member 12 stationary with respect to body member 10 at any one of a plurality of positions. More specifically, body member 10 is comprised of an elongated tube 30 of circular cross-section. Tube 30 defines a central passage 38 of circular cross-section. A durable plastic coating 40 is provided over sleeve 32 and hook 16 to provide a nonabrasive surface over section 36. Rod member 12 is comprised of an elongated rod 46 of circular cross-section. The outer diameter of rod 46 is dimensioned slightly less than the diameter of passage 38 in body member

10 to enable rod 46 to move freely in telescopic fashion in body member 10. Annular grooves 50, transverse to the axis of rod 46 are provided along a major portion thereof. Grooves 50 are generally semi-circular and are axially spaced along rod 46 to provide intermediate surfaces 52. The hook end of rod member 12 is provided with a plastic coating 54 similar to that provided on section 36 of body portion 10.

As shown in Figures 4 and 5, Johnson's locating means 20 and locking means 22 are within housing 14. Locating means 20 is generally comprised of a spherical bearing 60, and biasing spring 62 disposed within a bore 64 in housing 14. Bore 64 communicates with passage 38 by extending through portion 34 of tube 30. Spring 62 is confined within bore 64 in compression such that bearing 60 is biased towards, and partially exposed in, passage 38. Locking means 22 includes a boss 70, a conventionally known key lock 72 and a locking member 74. Locking member 74 is generally cylindrical in shape and includes an arcuate outer surface 76 of a diameter generally matching the semicircular grooves 50 in rod 46, and

a flat or recessed portion 78. A washer member (not shown) is provided between lock 72 and locking member 74 to effect rotational movement of locking member 74 about its axis when lock 72 is locked and unlocked. To accommodate lock 72 and locking member 74, bore 84 of varying diameter is provided through boss 70 into housing 14. Bore 84 intersects tube 30 and produces a slot or aperture 86 which intersects passage 38, as shown in Figure 1. Bore 84 is aligned relative to passage 38 such that arcuate surface 76 of locking member 74 is partially disposed within passage 38 when locking member 74 is in a first position, and recess 78 is oriented toward passage 38 when member 74 is rotated 180° to a second position. Further in this respect, bore 84 is disposed relative to bore 64 such that when spherical member 60 is aligned with a groove 50 on rod 46, locking member 74 is likewise aligned with a groove 50 on rod 46. Spherical bearing 60 and locking member 74 are disposed opposite each other in housing 14 such that they align with the same groove 50 on rod 46.

The examiner determined (answer, pp. 4-5) that it would have been an obvious exchange of known equivalents to one of ordinary skill in the art at the time the invention was made to modify the locking device and engaging notches of Damon with a locking mechanism and engaging notches like that taught by Johnson. We agree. In addition, apparently with respect to claims 37 and 38, the examiner also determined that plastic coating 40 of Johnson was a "bubble wrap" material and that it would have been obvious to one of ordinary skill in the art to place the plastic coating 40 of Johnson over all lock portions, including the lock housing, to provide a non-abrasive surface. We do not agree.

The appellant argues (brief, pp. 16-20) that there is no suggestion or motivation to modify Damon by the teachings of Johnson absent impermissible hindsight. We do not agree. Initially we note that while there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination (see B.F. Goodrich Co. v. Aircraft Braking Systems

Corp., 72 F.3d 1577, 1583, 37 USPQ2d 1314, 1319 (Fed. Cir. 1996) and In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)). Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). In this case, however, Johnson specifically teaches that a problem exists with prior antitheft devices such as the locking mechanism of Moore U.S. Pat. No. 3,462,982 (see column 1, lines 41-50) and that his device presents a formidable obstacle to a potential theft (see column 5, lines 49-54). In that the locking mechanism of Moore<sup>6</sup> is a ratcheting device similar to that disclosed in Damon, it is our opinion that

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<sup>6</sup> Copy attached.

Johnson does provide the necessary teaching, reason, suggestion, and motivation to replace Damon's ratcheting type lock with the more formidable lock taught by Johnson.

With respect to claim 4, the appellant argues (brief, p. 17) that Johnson does not disclose the use of ratchet teeth and a spring biased pawl as claimed. We do not agree. The claimed ratchet teeth which fully circumscribe the arm read on Johnson's grooves 50 and the claimed spring biased pawl reads on Johnson's spherical bearing 60 biased by spring 62.

With respect to claims 37 and 38, the appellant argues (brief, pp. 21-23) that the applied prior art does not teach or suggest the lock housing being "enclosed in a protective cover" as recited in claim 37 or the protective cover comprising "bubble wrap material" as recited in claim 38. We agree. First, the examiner's determination that plastic coating 40 of Johnson was a "bubble wrap" material is without a proper foundation. In that regard, Johnson describes the coating 40 as being a durable plastic coating and is shown in Figure 5 as a flat coating. Thus, there is no evidentiary

basis for the examiner to conclude that coating 40 is a "bubble wrap" material since "bubble wrap" is a well known material. Second, the examiner's determination that it would have been obvious to one of ordinary skill in the art to place the plastic coating 40 of Johnson over the lock housing also lacks the necessary evidentiary basis. In that regard, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual 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). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011,

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1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S.  
1057 (1968).

**The § 103 rejection utilizing Damon in view of Lipschutz**

We find that the examiner has established a prima facie case of obviousness with respect to the rejection of claims 9, 10, 13 to 17, 19 and 20 under 35 U.S.C. § 103 as being unpatentable over Damon in view of Lipschutz.

Lipschutz discloses an antitheft device for motor vehicles. In Figures 2-4, Lipschutz teaches to apply the antitheft device to a two-wheeled motor vehicle. In Figures 5-7, Lipschutz teaches to apply the antitheft device to a four-wheeled motor vehicle. In the embodiment of the antitheft device shown in Figures 8-9, Lipschutz teaches (page 5, lines 7-9) that a bellows 33 "ensures the protection for portion A and prevents the user from being in contact with the shaft 17."

The examiner determined (answer, p. 5) that it would have been obvious to one of ordinary skill in the art at the time the invention was made to place an expandable protective sleeve around the notched locking rod of Damon in a manner set

forth in Lipschutz to protect the locking notches from dirt and debris. We agree.

The appellant argues (brief, pp. 25-26) that Lipschutz is non-analogous art. We do not agree. The test for non-analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). In the present instance, we are informed by the appellant's originally filed specification that the invention is particularly directed to a security device, more particularly a theft prevention device for use on bicycles, motorcycles, mopeds and other conveyance means (specification, page 1, lines 1-3). Lipschutz discloses an antitheft device for both two-wheeled and four-wheeled vehicles and thus falls at least into the former category of the Wood test. Thus, we conclude that Lipschutz is analogous art.

The appellant argues (brief, pp. 23-25) that there is no suggestion or motivation to modify Damon by the teachings of

Lipschutz absent impermissible hindsight. We do not agree. Lipschutz specifically teaches that bellows 33 is provided to ensure the protection for portion A (i.e., threaded shaft 17) and to prevent the user from being in contact with the shaft 17. It is our opinion that Lipschutz does provide the necessary teaching, reason, suggestion, and motivation to provide an expandable protective sleeve around the notched locking rod of Damon to protect the locking notches from dirt and debris and to prevent the user from contacting the notched locking rod in a manner suggested and taught by Lipschutz.

With respect to claim 17, the appellant argues (brief, p. 26) it is not obvious to modify Damon to provide the specific ratchet teeth as claimed. We do not agree. The claimed ratchet teeth including "a flat stop surface" and "a second surface sloping inwardly toward the rod axis from the radially outer edge of the stop surface" read on Damon's teeth 2. Thus, there is no need to modify Damon to provide the specific ratchet teeth as claimed.

**The § 103 rejection utilizing Damon in view of Johnson and Clark**

We will not sustain the examiner's rejection of claim 38 under 35 U.S.C. § 103 as being unpatentable over Damon in view of Johnson and Clark since the examiner has not established a prima facie case of obviousness. In that regard, it would not have been obvious in our view to modify Damon to arrive at the claimed invention absent impermissible hindsight.

Claim 38 requires both (1) the lock housing being "enclosed in a protective cover" as recited in parent claim 37, and (2) the protective cover comprising "bubble wrap material" as recited in claim 38. We agree. First, the examiner's determination that material 17 of Clark is a "bubble wrap" material is without a proper foundation. In that regard, Clark describes element 17 as a plastic sleeve and is shown in Figures 1 and 2 as having an undulating surface. Thus, it is our opinion that there is an insufficient evidentiary basis for the examiner to conclude that sleeve 17 is a "bubble wrap" material since "bubble wrap" is a well known material. Second, the examiner's implicit

determination that it would have been obvious to one of ordinary skill in the art to place the plastic sleeve 17 of Clark over Damon's lock housing also lacks the necessary evidentiary basis.

#### **CONSIDERATION OF EVIDENCE OF NONOBVIOUSNESS**

Having arrived at the conclusion that the teachings of the prior art are sufficient to establish a prima facie case of obviousness with respect to claims 3, 4, 6, 9 to 20, 31 to 36 and 44 to 46, we recognize that the evidence of nonobviousness submitted by the appellant must be considered en route to a determination of obviousness/nonobviousness under 35 U.S.C.

§ 103. See Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Accordingly, we consider anew the issue of obviousness of claims 3, 4, 6, 9 to 20, 31 to 36 and 44 to 46 under 35 U.S.C. § 103, carefully evaluating therewith the objective evidence of nonobviousness supplied by the appellant. See In re Oetiker, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

In this case the appellant has submitted evidence in the form of a declaration from John F. Hornbostel, Jr. (attached to Paper No. 6, filed Mach 11, 1996). The declaration provides:

1. In August, 1994, Winner [Winner International Royalty Corporation, assignee of the appealed application] introduced a line of bicycle security locks into the United States market to permit bicycle owners to secure a bicycle to an immoveable object. This line of locks represents the first products introduced by Winner into the bicycle accessory market. Winner sells four different styles and sizes of bicycle locks. I am advised that all four of the locks are covered by one or more claims of the above-captioned application.

2. Following the commercial introduction of the bicycle locks in 1994, these locks enjoyed immediate substantial commercial success and have experienced a continuous sales growth. In the most recent three month period from October through December 1995, the dollar volume of sales of these locks at the wholesale level has exceeded \$185,000.00.

3. In my opinion, the success of the bicycle lock in the marketplace is due in large measure to the features of the locks that are covered by the claims of the patent application. More specifically, the use of two U-shaped members which telescopically move toward and away from one another and which utilize either a pawl/ratchet tooth arrangement or a plurality of semicircular grooves with a lock mechanism, to provide a wide degree of adjustability are features which have contributed to the almost instantaneous success and popularity of the lock devices.

4. Another reason for the success of the lock devices is the relative simplicity of the design and operation of each device and the claimed features thereof which protect the bicycle and the lock components from marring, damage and weathering.

5. In my opinion, the Winner line of bicycle locks have displaced the United States sales of locks manufactured by

well established sellers of bicycle security devices, and has resulted in a net decrease in the market share of these competitive devices. This is even more surprising when considering the dominance of the market by these other manufacturers compared to the total absence of Winner from the bicycle lock market until less than two years ago.

We do not believe that the declaration establishes commercial success of the invention as set forth in claims 3, 4, 6, 9 to 20, 31 to 36 and 44 to 46. In that regard, the declaration provides no data concerning whether the amount of sales of the bicycle lock represents a substantial share in this market. Although the declaration indicates that over \$185,000 had been spent on the bicycle locks in a three month period, the declaration provides no indication of whether this represents a substantial amount in this market. Our reviewing court has noted in the past that evidence related solely to the number of units sold provides a very weak showing of commercial success, if any. See In re Huang, 100 F.3d 135, 137, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1026-27, 226 USPQ 881, 888 (Fed. Cir. 1985) (finding that sales of 5

million units represent a minimal showing of commercial success because "[w]ithout further economic evidence . . . it would be improper to infer that the reported sales represent a substantial share of any definable market"); see also In re Baxter Travenol Lab., 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("[I]nformation solely on numbers of units sold is insufficient to establish commercial success."); Kansas Jack, Inc. v. Kuhn, 719 F.2d 1144, 1151, 219 USPQ 857, 861 (Fed. Cir. 1983) (determination of obviousness not erroneous where evidence of commercial success consisted solely of number of units sold and where no evidence of nexus). On the basis of the limited information provided by the declarant, we conclude that the appellant has failed to establish commercial success.

Even assuming that the appellant had sufficiently demonstrated commercial success, that success is relevant in the obviousness context only if it is established that the sales were a direct result of the unique characteristics of the claimed invention, as opposed to other economic and commercial factors unrelated to the quality of the claimed

subject matter. See Cable Elec., 770 F.2d at 1027, 226 USPQ at 888. In other words, a nexus is required between the sales and the merits of the claimed invention. In ex parte proceedings before the Patent and Trademark Office, an applicant must show that the claimed features (i.e., the subject matter of claims 3, 4, 6, 9 to 20, 31 to 36 and 44 to 46) were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. Merely showing that there was commercial success of an article which embodied the invention is not sufficient. See Ex parte Remark, 15 USPQ2d 1498, 1502-03 (Bd. Pat. App. & Inter. 1990). Compare Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), cert. denied, 488 U.S. 956 (1988). See also Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot

could be due to the contemporary drive toward greater use of automated data processing techniques).

The declaration contain only assertions that the locks being sold are "covered by one or more claims of the above-captioned application" and that "the success of the bicycle lock in the marketplace is due in large measure to the features of the locks that are covered by the claims of the patent application." This is insufficient to establish the required nexus. Claims are not technical descriptions of the disclosed inventions but are legal documents like the descriptions of lands by metes and bounds in a deed which define the area conveyed but do not describe the land. Because of this characteristic of claims, the commercial success of a machine "claimed" may be due entirely to improvements or modifications made by others to the invention disclosed in the application for patent. Such success is not pertinent to the nonobviousness of the advantages inherent in what is specifically disclosed in the application are not to be considered in determining nonobviousness. In re Vamco Machine and Tool, Inc., 752 F.2d 1564, 1577, 224 USPQ 617, 625

(Fed. Cir. 1985). Furthermore, the appellant failed to submit any factual evidence that would demonstrate the nexus between the sales and the claimed invention - for example, an affidavit from the purchaser explaining that the product was purchased due to the claimed features. In the present case, the sales may have been due to lower manufacturing costs, the market position of Winner, prior relations between Winner and the companies to which the locks were sold, advertising, the use of a trademark similar to Winner's trademarks used for their steering wheel locks, or features of the locks attractive to customers or other companies but unrelated to the claimed subject matter (e.g., the protective cover as recited in claims 37 and 38, the notch as recited in claim 22). In sum, the appellant simply has not carried his burden to establish that a nexus existed between any commercial success and the novel features claimed in claims 3, 4, 6, 9 to 20, 31 to 36 and 44 to 46.

In the final analysis, evidence of nonobviousness, although being a factor that certainly must be considered, is not necessarily controlling. See Newell Companies, Inc. v.

Kenney Manufacturing Co., 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988).

In view of the foregoing, we are satisfied that when all the evidence and arguments are considered, the evidence of nonobviousness fails to outweigh the evidence of obviousness as in Richardson-Vicks Inc. v. Upjohn Co., 122 F.3d 1476, 44 USPQ2d 1181 (Fed. Cir. 1997) and EWP Corp. v. Reliance Universal, Inc., 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985). Accordingly, we sustain the rejections of claims 3, 4, 6, 9 to 20, 31 to 36 and 44 to 46 under 35 U.S.C. § 103 set forth above wherein we had determined that a prima facie case of obviousness had been established.

**New ground of rejection under 37 CFR § 1.196(b)**

In view of our finding above that independent claims 11 and 44 are anticipated by Damon, we denominate our affirmance of independent claims 11 and 44, and claims 3, 4, 6, 9, 10, 12 to 20, 45 and 46 dependent thereon, a new ground of rejection under 37 CFR § 1.196(b).

CONCLUSION

To summarize, (1) the decision of the examiner to reject claims 3, 4, 6, 9 to 24, 31 to 38 and 44 to 46 under the judicially created doctrine of double patenting over the claims of Winner is affirmed; (2) the decision of the examiner to reject claims 44, 45, 3, 11 and 12 under 35 U.S.C. § 103 as being unpatentable over Damon is affirmed; (3) the decision of the examiner to reject claims 44, 45 and 3 under 35 U.S.C. § 103 as being unpatentable over Wood in view of Damon is reversed;

(4) the decision of the examiner to reject claims 4, 6, 18, 31 to 36 and 46 under 35 U.S.C. § 103 as being unpatentable over Damon in view of Johnson is affirmed; (5) the decision of the examiner to reject claims 37 and 38 under 35 U.S.C. § 103 as

being unpatentable over Damon in view of Johnson is reversed; (6) the decision of the examiner to reject claims 9, 10, 13 to 17, 19 and 20 under 35 U.S.C. § 103 as being unpatentable over Damon in view of Lipschutz is affirmed; and (7) the decision of the examiner to reject claim 38 under 35 U.S.C. § 103 as being unpatentable over Damon in view of Johnson and Clark is reversed. In addition, for reasons explained supra, we have denominated our affirmance of claims 3, 4, 6, 9 to 20 and 44 to 46 to be a new ground of rejection under 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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VICKERS DANIELS AND YOUNG  
TWENTIETH FLOOR TERMINAL TOWER  
CLEVELAND, OH 44113

APPEAL NO. 97-3194 - JUDGE NASE  
APPLICATION NO. 08/442,816

APJ NASE

APJ ABRAMS

APJ McQUADE

DECISION: **AFFIRMED-IN-PART;**  
**37 CFR § 1.196(b)**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 29 Oct 98

**FINAL TYPED:**