

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(2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM C. BALDWIN

Appeal No. 1999-2243
Application 08/567,081¹

ON BRIEF

Before CALVERT, NASE and GONZALES, Administrative Patent
Judges.

CALVERT, Administrative Patent Judge.

¹ Application for patent filed December 4, 1995.

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DECISION ON APPEAL

This is an appeal from the final rejection of claims 12 to 28, 30 to 36 and 38. Of the other claims remaining in the application, claims 2 to 11 have been allowed, and claims 29 and 37 have been indicated as allowable, subject to being rewritten in independent form.

The appealed claims are drawn to a casino change cart, and are reproduced in the appendix of appellant's brief.

The references applied in the final rejection are:

Johnson	D-179,687	Feb. 12, 1957
Boldt et al. (Boldt)	2,413,164	Dec. 24, 1946
Jones et al. (Jones)	5,289,936	Mar. 1, 1994
Pike et al. (Pike)	5,306,028	Apr. 26, 1994
Evans	5,306,033	Apr. 26, 1994

Additional references of record,² applied herein in rejections pursuant to 37 CFR § 1.196(b), are:

Losi	4,861,049	Aug. 29, 1989
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² Losi was cited by the examiner in the first Office action (Paper No. 3), and Whorton was cited in the Information Disclosure Statement filed by appellant on March 6, 1996 (Paper No. 2).

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Whorton

4,886,286

Dec. 12, 1989

The appealed claims stand finally rejected under 35 U.S.C. § 103(a) on the following grounds:³

- (1) Claim 12, unpatentable over Pike;
- (2) Claims 13 to 15, unpatentable over Pike in view of Evans and Jones;
- (3) Claims 16, 20, 23 to 25, 27, 28, 31, 32 and 34 to 36, unpatentable over Johnson in view of Pike;
- (4) Claims 17 to 19, 26 and 38, unpatentable over Johnson in view of Pike and Boldt;
- (5) Claims 22, 30 and 33, unpatentable over Johnson in view of Pike, Evans and Jones;
- (6) Claim 21, unpatentable over Johnson in view of Pike, Boldt, Evans and Jones.

³ An additional rejection of claims 24, 25 and 34 under 35 U.S.C. § 112, second paragraph, is not repeated in the examiner's answer and therefore is presumed to have been withdrawn. Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

Rejection (1)

The Pike patent discloses a box shaped casino change cart with a pair of wheels, and side panels 14, 16 on which "the casino name and logo can be placed to help achieve high visibility for the cart to players" (col. 2, lines 15 to 17).

The examiner takes the position that this constitutes the claimed "means adapting said cart to match a selected casino theme" because (answer, page 4):

It is common for casinos to have a theme and make a logo to visually display the theme. The placement of a logo on the side panel of a change card would adapt the cart to match a selected casino theme.

Appellant, on the other hand, asserts that "dictionary definitions of 'logo' also do not relate that term to matching 'themes,' nor does any prior art of record" (reply brief, page 2).

After fully considering the record in light of the arguments presented in appellant's brief and reply brief, and in the examiner's answer, we conclude that this rejection is well taken.

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A "logo" is "a graphic representation or symbol of a company name, trademark, abbreviation, etc., often uniquely designed for ready recognition."⁴ The logo of a casino would itself constitute a "selected casino theme," as recited in claim 1, because in normal usage the logo or symbol of the casino

would be used throughout the casino, generally wherever the casino's name was displayed. Therefore, placing the casino logo on the side panels of the Pike cart, as disclosed by Pike, would constitute the claimed "means adapting said cart to match a selected casino theme," and all the limitations of claim 1 would be met.

In effect, our conclusion is that claim 1 is anticipated by Pike, under 35 U.S.C. § 102(b). Nevertheless, we will sustain the rejection of claim 1 under § 103, since

⁴ The Random House Dictionary of the English Language (2nd Ed. 1987).

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anticipation is the ultimate or epitome of obviousness. In re Avery, 518 F.2d 1228, 1234, 186 USPQ 161, 166 (CCPA 1975).⁵

Rejection (2)

The examiner states the basis of this rejection as (final rejection, page 4):

Based on the teachings of Evans and Jones et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cart of Pike et al. to have means and panels on the

sides of the cart to display advertising or a particular casino theme depending upon the design choice of the owner.

In our view, this rejection is well taken as to claim 13. Contrary to appellant's arguments, the motivation for providing the sides of Pike's cart with side panels which are "slideably insertable and removable" would be the obvious

⁵ We note that on December 22, 1997, appellant filed a declaration of the inventor, William C. Baldwin, purportedly showing commercial success and copying of the invention by others. This evidence has not been considered in relation to rejections (1) and (2), since appellant only argues that it supports the patentability of claims 16, 17, 31 and 38 (brief, pages 17 and 18).

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one of permitting the use of advertisements along with the casino name and logo disclosed by Pike. We consider that such an arrangement would have been readily suggested to one of ordinary skill by Evans' disclosure of the use of change-able advertising placards 38 on a cart.

Rejection (2) will therefore be sustained as to claim 13.

Claim 14 reads:

14. The apparatus of claim 12 wherein said means includes a plurality of components attached to said cart, said components comprising means for suggesting to an observer an object other than a change cart.

With regard to the claimed "plurality of components," the examiner finds that these are disclosed by Pike because (answer, page 5):

Every component on Pike et al. is capable of being means of suggesting something that the object is something other than a change cart.

For example, the two doors on top of the cart might suggest to an observer that the object is an ice cream cart as opposed to a change cart. Furthermore, the removable side panels as taught by Evans and Jones et al. in addition to the logo shown by Pike et al. would provide a component that may

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suggest to an observer that the object is something other than a change cart.

The examiner's examples are not commensurate with the language of claim 14, however, because this claim recites that "said means [i.e., the "means adapting said cart to match a selected casino theme" of parent claim 12] includes a plurality of components [etc.]" (emphasis added). Since the "means adapting" disclosed by Pike is the logo attached to the side panels (see rejection (1), supra), the examiner's first example of a "plurality of components" is not well taken because the two doors 90 on the top of Pike's cart are not included in the logo. As for the second example, if removable side panels were added to Pike's cart, it is not apparent to us what object other than a change cart they would suggest.

Accordingly, we conclude that the combination of Pike in view of Evans and Jones does not render the subject matter of claim 14 obvious, and therefore we will not sustain rejection (2) as to claim 14, or as to claim 15 dependent thereon.

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Rejection (3)

As stated on page 5 of the final rejection, the essence of this rejection is:

Based on the teachings of Pike et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cart of Johnson to include a cash receptacle to keep money in for change.

Appellant argues at page 15 of the brief that (a) one skilled in the art would not have been motivated to install a cash receptacle in Johnson's cafeteria tray cart, and (b) since the wheels of the Johnson cart are all tangent to the same plane, the two centrally located wheels are not "sized for carrying the primary load of said cart," and do not cooperate "to enable manual turning of said cart on its own centerline," as recited in claim 16.⁶

⁶ We do not find antecedent basis in appellant's specification for the expression "on its own centerline." See 37 CFR § 1.75(d)(1). From the disclosure at page 6, line 28, to page 7, line 3, we assume that any cart whose central pair of wheels is tangent to a floor plane lower than the plane to which the corner wheels (casters) are tangent would meet claim 16's recitation of being able to turn "on its own centerline."

We agree with both of these arguments. As to (a), the examiner asserts that "[i]t would be possible for a tray cart

that carried items for sale would need a cash tray to do business" (answer, page 6). However, this assumes that Johnson's cart carries items for sale, but there is no disclosure in Johnson that it does.⁷ The fact that it would be possible to use a cash tray on Johnson's cart is not a sufficient basis for concluding that it would have been obvious to do so, it being well settled that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). We do not consider that Pike's disclosure of a cash receptacle 62 in a casino cart, which is used in a casino to provide gamblers, especially those playing slot machines,

⁷ Since Johnson is a design patent, the only description of the item shown in the drawings is that it is a "tray cart."

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with ready access to change, would have suggested to one of ordinary skill that such a receptacle be provided in the tray cart of Johnson, since as far as can be determined Johnson's tray cart is not used for collecting or providing anyone with cash.

With respect to argument (b), we do not consider that Johnson meets the limitations in question because, as we

interpret the limitation concerning turning "on its own centerline" (see footnote 6), the bottoms of the five wheels on Johnson's cart are all tangent to the same plane.

Accordingly, rejection (3) will not be sustained.

Rejection (4)

This rejection will likewise not be sustained. Even assuming that it would have been obvious, in view of Boldt, to provide Johnson's cart with a wheel arrangement as recited in claim 17, the rejected claims still distinguish over the prior art applied in that it would not have been obvious to provide

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the claimed cart with a cash receptacle, as discussed above in connection with rejection (3).

Rejections (5) and (6)

These rejections will not be sustained because the additional references applied, Evans and Jones, do not supply the deficiencies noted in the preceding discussions of rejections (3) and (4).

Rejections Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), we enter the following new grounds of rejection:

(I) Claims 16 to 19 and 31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Losi, which discloses a cart having a box structure, a cash receptacle 69, and central wheels 10 projecting below casters 12, 14. The Losi cart is not a "casino change" cart, as recited in the preamble of claim 16, but this recitation does not constitute a claim limitation because it recites no structural limitations of the claimed invention, but rather, a structurally complete invention is defined in the body of the claim, and the preamble merely states the purpose

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or intended use of the invention. Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997), cited in Pitney Bowes Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999).

With regard to claim 17, the "common distance" recited is met by Losi, who discloses that the casters 12, 14 are raised "an inch or so above the floor" (col. 3, line 19). This would "permit the casters to touch carpet" as recited, since they would all touch the carpet if its pile were deep enough, and even if it were not, the distance would permit them to touch carpet, as by tipping the cart somewhat about the central wheels 10.

(II) Claims 16 to 21, 23 to 28, 31, 32, 34 to 36 and 38 are rejected under 35 U.S.C. § 103 as unpatentable over Whorton in view of Boldt. Whorton discloses a food-carrying cart having a

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box structure, a cash receptacle 54, handles 64, 66, and an open-faced storage compartment at the rear of the cart with panel

means 42, etc. Whorton does not disclose centrally located wheels which project below the plane of casters 58, 60, but does state that "any other suitable rolling means could also be provided [on] the bottom surface 62 of portable concession stand 10 if desired" (col. 5, lines 3 to 7).

Boldt discloses a cart for serving food which is equipped with central, larger-diameter wheels 18 which project below the corner-mounted casters 19; according to Boldt, with this arrangement "the medial wheels will carry the major portion of the load and steering of the cart will be made easier" (col. 3, lines 23 to 28). In view of this disclosure, one of ordinary skill would have been motivated to use the wheel arrangement of Boldt on the Whorton cart in order to obtain the advantage thereof (easier steering) taught by Boldt.

The dimensions recited in claims 27, 28, 35 and 36 are not considered of patentable significance, but would be

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simply obvious matters of design depending upon what size one would have desired the Whorton cart to be. Appellant has not shown that they are in any respect critical to the claimed invention. See

In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990).

The recitation of a "casino change" cart does not constitute a patentable limitation, for the reasons stated under rejection (I), supra.

In making this rejection, we have taken into account the declaration of the inventor (see footnote 5, supra), but do not consider it sufficient to rebut the prima facie case of obviousness established by the combination of Whorton and Boldt.⁸

⁸ The declaration is not relevant to rejection (I), since that rejection is based on anticipation, rather than obviousness. In re Paulson, 30 F.3d 1475, 1482 n.11, 31 USPQ2d 1671, 1676 n.11 (Fed. Cir. 1994).

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The declaration is to the effect that after marketing of the change cart disclosed in the application began, (1) "a number of other casino change carts appeared in the market which I believe were inspired by the design of the subject application" (two examples of such other change carts are shown in Exhibits A and B), and (2) 292 of the previous carts, without the centrally located large wheels, were sold between September 27, 1992, and October 6, 1995, while 803 of the new carts, with the centrally located large wheels, were sold between October 6, 1995 and

November 16, 1997. This evidence is insufficient as a rebuttal of prima facie obviousness because, first, mere copying is not enough, without any evidence to explain the motivation behind the alleged copying. Dotolo v. Quiqg, 12 USPQ2d 1032, 1038 (D.D.C. 1989). See also In re GPAC Inc., 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1122 (Fed. Cir. 1995). Second, "evidence

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related solely to the number of units sold provides a very weak showing of commercial success, if any." In re Huang, 100 F.3d 135, 140, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). There must be an indication of whether the sales represent a substantial quantity in the market, and proof of a nexus between the sales and the merits of the claimed invention, as opposed to other economic and commercial factors unrelated thereto. Id. Such evidence is lacking here.

(III) Claims 20, 24 to 26 and 34 are rejected for failure to comply with the second paragraph of 35 U.S.C. § 112, in that the following terms have no antecedent basis:

- (i) "said handle" in claim 20, line 2;
- (ii) "said housing structure" in claims 24 to 26 and 34.

Remand to the Examiner

Pursuant to 37 CFR § 1.196(e), this case is remanded to the examiner to determine whether claims 22 and 33, or any other

claims in the application, should be rejected under § 103 as

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unpatentable over Losi, or Whorton in view of Boldt, in view of other prior art.

Conclusion

The examiner's decision to reject the claims on appeal is affirmed as to claims 12 and 13, and reversed as to claims 14 to 28, 30 to 36 and 38. Claims 16 to 21, 23 to 28, 31, 32, 34 to 36 and 38 are rejected pursuant to 37 CFR § 1.196(b), and the application is remanded to the examiner pursuant to 37 CFR § 1.196(e).

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) and a remand pursuant to 37 CFR § 1.196(e). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review." 37 CFR § 1.196(e) provides that

[w]henEVER a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter

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an order otherwise making its decision final.

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),

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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).

This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

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AFFIRMED-IN-PART and REMANDED
37 CFR § 1.196(b)

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	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
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