

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOMINICK THERESA, MICHELE KRAMER,
and NICK THERESA

Appeal 2014-005835
Application 12/570,827
Technology Center 3600

Before: STEFAN STAICOVICI, LEE L. STEPINA, and
FREDERICK C. LANEY, Administrative Patent Judges.

STEPINA, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Dominick Theresa et al. (“Appellants”) filed a Request for Rehearing (“Request” or “Req.”) of the Decision on Appeal entered August 31, 2016 (“Decision”), in this Application. The Request seeks reconsideration of the Board’s affirmance of the rejection of claims 1, 3–6, 8, and 19–25.¹

(I²): Claim 25

The Decision affirmed the rejection of claim 25 as indefinite (Decision 3–4), and Appellants discuss a possible amendment to claim 25 to

¹ The rejection of claims 5, 20, and 24 was designated as a NEW GROUND OF REJECTION. *See* Decision 17.

² Our section numbering corresponds to the section numbering in the Request.

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address this rejection, but do not assert that the Board overlooked or misapprehended any points made by Appellants in the Appeal and Reply Briefs (*see* Req. 3). Accordingly, we do not change our Decision with respect to the rejection of claim 25 as indefinite.

(II): Claims 1, 3–6, 8, 19, and 20 and Erickson

The Decision affirmed the rejection of claims 1, 3–6, 8, 19, and 20 as unpatentable over Slater, Dompier, and Erickson (*see* Decision 4–17), and Appellants discuss the disclosure in Erickson, asserting that Erickson discusses color only in relation to a third party and “how someone may want to also place Erickson[’]s RFID tag upon [the] already color-coded file folder within [a] file room.” *See* Req. 3–6. Specifically, Appellants emphasize that “Erickson only speaks in ¶ 32 about [] THIRD PARTY file rooms that ha[ve] and use[] color-coded file folders within file rooms.” Req. 4. Appellants also set forth definitions of the terms “radio frequency identification,” “RFID tag,” “RFID reader,” “color-coded file folders,” “color-coded file room,” and “color-coded filing room.” *See* Req. 6–7.

The Decision adequately addresses Appellants’ arguments about Erickson’s disclosure of the use of color and whether a third party is the only user of color-coding in Erickson. *See* Decision 5–8. Appellants do not apprise us of any points overlooked or misapprehended in the Decision. Accordingly, the Decision remains unchanged with respect to claims 1, 3, 4, 6, 8, and 19. Further, as to claims 5 and 20, the rejections of which were designated as new grounds of rejection, the above-noted arguments are unpersuasive for the same reasons discussed on pages 5–8 of the Decision. Assuming, for the purpose of argument, that Erickson’s teaching of the use of color-coded files is presented in terms of a third party’s use of these

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items, this fact, by itself, would not negate this disclosure in Erickson. Additionally, even if this teaching is the not the focus of Erickson's disclosure, Erickson is available as prior art for all it teaches. Thus, we are apprised of no persuasive reason that Erickson was not properly applied in the rejection.

(III): Claims 5, 20, and 24 and "Symbols"

Appellants contend that the term "symbols" should be interpreted to be different from numbers and words. Req. 8. Appellants assert that Decision relies on Slater to disclose symbols. *See* Req. 8–11. Furthermore, Appellants assert "the Board decision mentioned just [s]o many mixed up sentences from page 8 to 17 about symbols and Slater [] **it's best to get to the point that Slater [] now DOES NOT DISCLOSE SYMBOLS** as well as Slater [] does not even TEACH PICTURES for symbols." Req. 8. Appellants' state, "The Board also using this word 'text' upon symbols of pictures is unfair but more overly the Board decision seems to be confusing the word 'text' with some other case, art and/or appeal." Req. 11.

The Decision agrees with Appellants' contention that the term "symbols" as recited in the claims, should be construed as something different from text and numbers. *See, e.g.*, Decision 10 (stating "In light of Appellants' Specification, we interpret the term 'symbols' as recited in the claims to exclude text and numbers."). Accordingly, Appellants' argument asserting that the Decision misinterpreted the word "symbols" is misplaced. Moreover, the broadest reasonable interpretation of claim 5 does not require symbols. *See* Decision 8–9. Rather, as discussed in the Decision, claim 5 further defines the symbols recited in claim 1, which recites symbols as one of *two alternatives*. *Id.* Thus, as also discussed in the Decision, Appellants'

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assertion regarding a failure of Slater to disclose markings that are symbols is not commensurate with the scope of claim 5. *See id.* at 9.

As for claims 20 and 24, the Decision finds that the *form* of the message carried on the recited labels (as text, numbers, or symbols) does not carry patentable weight. *See, e.g.*, Decision 11–13 (discussing non-functional descriptive material). The Decision explains the use of Slater in the rejection of claims 20 and 24 in light of this claim construction.

Decision 12–13. Appellants’ contention that Slater does not disclose symbols as recited is not commensurate with the rejection of claims 20 and 24 and the broadest reasonable interpretation of these claims.³

Appellants contend, without persuasive explanation, “the 4 arts shows there is no reasonable expectation of success, no suggestion or motivation in combining the reference teachings, it would not have been obvious for a person of ordinary skill in the art to combine Slater, Dampier, Erickson and Yu arts.” Req. 10.

This conclusory statement does not apprise us of any deficiency in the rejection of the claims. It is our understanding that a person of skill in the art would consider labeling systems such as those recited in Appellants’ claims to be predictable. In this regard, Appellants set forth no reason why a person of ordinary skill in the art, aware of the cited references, would have had any difficulty in producing the claimed identification system and assembly, much less why a person of ordinary skill in the art would not have had a reasonable expectation of success. As for the motivation for the proposed modifications, Appellants do not explain persuasively why any of

³ The analysis as to the interpretation and patentable weight of the term “symbol” also applies to the symbol mentioned, but not required, in claim 5.

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the motivation(s) set forth by the Examiner are inadequate. *See, e.g.*, Non-Final Act. 5 (discussing the motivation for a modification based on Erickson, stating “Such a modification would provide a means to enhance the identifying properties of the system.”). Further, the motivation for the proposed combination(s) does not have to be found in the references themselves.

DECISION

We grant Appellants’ Request to the extent that we have considered our Decision in light of the points raised by Appellants, but we deny the Request with respect to any modification to the Decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED