

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GLENN SIMMONS

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Appeal No. 97-2456  
Application 08/424,064<sup>1</sup>

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ON BRIEF

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Before CALVERT, Administrative Patent Judge, McCANDLISH, Senior Administrative Patent Judge and McQUADE, Administrative Patent Judge.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Glenn Simmons appeals from the final rejection of claims 1 through 18, all of the claims pending in the application.

The invention relates "generally to measuring devices, and more particularly, to measuring devices having color coded

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<sup>1</sup> Application for patent filed April 19, 1995.

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indicia thereon to facilitate the measurement of fractional lengths with a minimum of errors and loss of time"

(specification, page 1). Claim 1 is illustrative and reads as follows:

1. A measuring device comprising:

an elongated member having a measuring edge with a finite length; and

measuring indicia including successive groups of equally spaced color coded measuring marks located adjacent to and extending along the length of said measuring edge and a different group label identifying each of said successive groups;

wherein each individual measuring mark corresponds to a selected fractional portion of each of said successive groups and has a different color than all of the remaining measuring marks in said group and is the same color as said measuring marks in each of said successive groups which correspond to the corresponding fractional portion in each of said successive groups.

The references relied upon by the examiner as evidence of obviousness are:

Hamalainen	1,142,418	Jun. 8, 1915
Glaese	4,323,234	Apr. 6, 1982
Jones, Jr. (Jones)	5,335,421	Aug. 9, 1994
Cruickshank (British Patent Document)	2,186,692	Aug. 19, 1987

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The appealed claims stand rejected under 35 U.S.C. § 103 as follows:

a) claims 1, 3, 7 through 10, 12, 16 and 17 as being unpatentable over Jones in view of Glaese;

b) claims 2, 4, 5, 11, 13, 14 and 18 as being unpatentable over Jones in view of Glaese, and further in view of Cruickshank; and

c) claims 6 and 15 as being unpatentable over Jones in view of Glaese, and further in view of Hamalainen.

Reference is made to the appellant's main and reply briefs (Paper Nos. 9 and 11) and to the examiner's final rejection and answer (Paper Nos. 7 and 10) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

As indicated above, all of the examiner's rejections rest on the basic prior art combination of Jones in view of Glaese. The threshold issue in this appeal is whether the Glaese reference is non-analogous art as urged by the appellant (see page 23 in the main brief). A reference which is non-analogous is too remote to be treated as prior art in evaluating the obviousness of a claimed invention. In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

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Glaese relates to "systems used for measuring the vertical distance an individual is capable of jumping from a standing position" (column 1, lines 6 through 8). The Glaese system includes a jump and reach board 10 having "an easily readable board surface that can be quickly and accurately read by a recorder watching a jumper" (column 2, lines 18 through 20). In this regard, Glaese teaches that

[t]he front surface 11 of the board is provided with a visually perceptible full size scale (indicia) as generally shown at 16. The scale 16 is provided in equally spaced horizontal increments 17 spaced vertically intermediate the top and bottom board edges 13 and 14 respectively. Preferably, the increments 17 are arranged in wide groups 18, each having an equal number of increments. Each of these groups 18 is labeled with an individual reference character 19. The groups 18 are separated by successive base lines 20.

It is preferred that the increments 18 of each group be individually color coded. This arrangement is best illustrated with reference to FIG. 4 wherein the various colors are indicated by standard color reference symbols. The base lines 20, for example, may be colored red. The succession of increments spaced upwardly from the red base lines 20 for each group may then be a succession of different colors. In the example shown in FIG. 4, the next successive increment upwardly from each base line 20 is colored white. The colors next in vertical succession are blue, yellow, green, and black. It is noted that each increment of a group is colored differently from the remaining increments of the group and that the increments of the several groups match one another.

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. . . Therefore, an attendant need only recognize the reference character associated with a given group and one of the several colored increments associated with that group to record a specific elevation [column 3, lines 9 through 44].

There are two criteria for determining whether art is analogous: (1) whether the art is from the field of the inventor's endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference is reasonably pertinent to the particular problem which the inventor was involved. In re Clay, supra. In the present case, the field of the appellant's endeavor is measuring devices and the particular problem with which the appellant was involved was to facilitate the measurement of fractional lengths with a minimum of errors and loss of time (see the passage from the appellant's specification reproduced above). Glaese's jump measuring system clearly falls within this field of endeavor and is reasonably pertinent to this particular problem. Thus, the Glaese reference constitutes analogous art which was properly considered by the examiner in evaluating the obviousness of the appellant's invention.

Jones, the examiner's primary reference, pertains to "the provision of rules that minimize or eliminate the tendency of users to make inaccurate measurements when making measurements

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involving one-eighth inch or one-sixteenth inch graduations on the rule" (column 1, lines 24 through 28). By the term "rules," Jones intends to include "rulers, yardsticks, tape measures, carpenter squares and the like" (column 1, lines 10 and 11). As described by Jones, such rules

are marked along opposite edges with inch, half-inch, quarter-inch, eighth-inch and sixteenth-inch graduations. One edge having the one-sixteenth inch graduations in a color different from all the other graduation markings on that edge and sequentially numbered within each inch in the same different color. The other edge not having one-sixteenth inch graduations and the eighth-inch graduations being in a different color from all the other graduations on that side and preferably different from the color of the one-sixteenth inch graduations and sequentially numbered within each inch in the same different color [Abstract].

Jones meets all of the limitations in independent claim 1 except for those requiring each individual measuring mark to have a different color than all of the remaining measuring marks in its group and to be the same color as the corresponding measuring marks in other groups. In this regard and notwithstanding the appellant's argument to the contrary (see page 8 in the main brief), the measuring indicia on either edge of the Jones measuring device comprises successive groups of equally spaced

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color coded measuring marks located adjacent to and extending along the length of the measuring edge as broadly recited in this claim.

The examiner's conclusion that it would have been obvious to one of ordinary skill in the art in view of the disclosure of Glaese to modify Jones' color coded indicia by providing individual measuring marks each having a different color than all of the remaining measuring marks in its group and the same color as the corresponding measuring mark in other groups (see page 3 in the final rejection), thereby arriving at the subject matter recited in claim 1, is well founded. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Glaese's teaching that each increment of a measuring group be colored differently from the remaining increments in the group and that the corresponding

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increments of successive groups match one another to facilitate the reading of the device would have furnished the artisan with ample suggestion to modify the Jones device in the manner proposed by the examiner. The appellant's various arguments that the references would not have suggested this combination, and in fact teach away therefrom, are not persuasive because they are predicated on the alleged shortcomings of each reference vis-a-vis the claimed invention. Non-obviousness, however, cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. In re Merck & Co., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

Accordingly, we shall sustain the standing 35 U.S.C. § 103 rejection of claim 1 as being unpatentable over Jones in view of Glaese.

We shall sustain the standing 35 U.S.C. § 103 rejection of claims 3, 7 through 9, 12 and 16 as being unpatentable over Jones in view of Glaese, and the standing 35 U.S.C. § 103 rejection of claims 6 and 15 as being unpatentable over Jones in view of Glaese and Hamalainen since the appellant has indicated that these claims stand or fall together with claim 1 for purposes of this appeal (see page 5 in the main brief).

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We also shall sustain the standing 35 U.S.C. § 103 rejection of claims 10 and 17 as being unpatentable over Jones in view of Glaese.

Claim 10, which depends from independent claim 9 and is similar in scope to claim 1, calls for a second set of measuring indicia that is adjacent to a second measuring edge and has measuring marks which are complementary with the measuring marks in the first set. Claim 10 also requires the measuring marks in the second set to be the same color. The Jones measuring device includes a second set of measuring indicia that is adjacent to a second measuring edge and has measuring marks which are complementary with the measuring marks in the first set. To make the measuring marks in this second set the same color in order to exhibit the look of the conventional single color measuring indicia implied in Jones' background discussion would have been obvious to one of ordinary skill in the art as a simple matter of common sense. In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

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Claim 17 depends ultimately from claim 9 and defines the claimed measuring device as including two members at right angles to one another (i.e., a carpenter's square) and first and second sets of measuring indicia on respective first and second measuring edges of the device with the marks in the second set being the same color as the corresponding marks in the first set. Jones teaches that the measuring device disclosed therein, which has complementary measuring marks on its two measuring edges, can take the form of a carpenter's square. It would have been obvious in view of Glaese to provide the Jones measuring marks with the coloring required by claim 17 for the reasons discussed above in connection with claim 1.

Finally, we shall sustain the standing 35 U.S.C. § 103 rejection based on the combined teachings of Jones, Glaese and Cruickshank with respect to claims 4 and 13, but not with respect to claims 2, 5, 11, 14 and 18.

Cruickshank discloses a tape measure composed of a flexible tape having a measuring scale on one side and items of information on the other side, a housing for storing the flexible tape, and an index on the housing denoting the positions along the measuring scale at which respective items of information are located.

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Claims 4 and 13, which depend ultimately from independent claims 1 and 9, respectively, recite a housing for storing a flexible tape measuring device. Cruickshank would have provided ample suggestion to the artisan to provide the tape measure embodiment disclosed by Jones with such a housing to store and protect the tape.

Claims 2 and 5, which ultimately depend from claim 1, claims 11 and 14, which ultimately depend from claim 9, and independent claim 18 recite measuring devices comprising, inter alia, a code chart correlating each color of the measuring marks to a fractional portion of each of the groups of marks. The examiner's reliance on Cruickshank's information index to remedy the conceded shortcomings of Jones and Glaese in this regard (see pages 3 and 4 in the final rejection) is not well taken. In short, Cruickshank's disclosure of the information index does not teach, as asserted by the examiner, "how a chart may be used for the purpose of interpreting markings on a tape" (final rejection, page 3), and would not have suggested a measuring device having a color chart of the type recited in claims 2, 5, 11, 14 and 18.

In summary and for the above reasons, the decision of the examiner to reject claims 1 through 18 is affirmed with respect

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to claims 1, 3, 4, 6 through 10, 12, 13 and 15 through 17 and reversed with respect to claims 2, 5, 11, 14 and 18.

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

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
HARRISON E. McCANDLISH	)	BOARD OF PATENT
Senior Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOHN P. McQUADE	)	
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