

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HORST MERCHEL

Appeal No. 1997-3483
Application 08/254,575¹

ON BRIEF

Before FLEMING, LALL and BARRY, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection² of claims 20 to 28.

The disclosed invention pertains to a pledge card for

¹ Application for patent filed June 6, 1994.

² An amendment after final [paper no. 15] was filed and its entry approved [paper no. 16], however, it did not make any changes to the claims.

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unlocking a pledge lock used to lock one shopping cart to a string of other carts. The insertion of the card moves a control member which unlocks a closure bolt, which releases a coupling member of an adjacent cart and the cart can be released. The card is seized and retained in the released cart and is released from the cart only when the cart is brought back and coupled back to the string of carts. The invention is further illustrated by the following claim.

Representative claim 20 is reproduced as follows:

20. In combination with at least two carts, a lock system comprising:

a pledge lock on one of said carts;

a locking member of the other of said carts receivable in said pledge lock and releasable therefrom;

a card for operating said pledge lock, said card having along an edge or on a surface thereof at least one recess or at least one projection constituting a formation specific to said card and distinguishing said card from cards free from said formation; and

bolt release and card seizure means in said lock operated by said formation upon insertion of said card into said lock for releasing said member and seizing said card and for retaining the seized card until the member associated with the other cart is inserted into said lock.

The references relied on by the Examiner are:

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Randall et al. (Randall) 1971	3,629,834	Dec. 21,
Crafton	3,906,447	Sep. 16, 1975
Kilborn	4,527,052	Jul. 2, 1985
Lo	4,627,252	Dec. 9, 1986
Seckinger et al. (Seckinger) 1987	4,686,358	Aug. 11,
Lepage et al. (Lepage)	5,069,324	Dec. 3, 1991

Claims 20 to 28 stand rejected under 35 U.S.C. § 103 over various combinations of Randall, Crafton, Kilborn, Lo, Seckinger and Lepage.

Reference is made to Appellant's brief and the Examiner's answer for their respective positions.

OPINION

We have considered the record before us and we will reverse the rejection of claims 20 to 28.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467

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(CCPA 1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or

knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. System., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Furthermore, the Federal Circuit states that "[the] mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification

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obvious unless the prior art suggested the desirability of the modification." In re Fitch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or

suggestions of the inventor." Para-Ordnance Mfg. V. SGS Importers Int'l, 73 F.3d at 1087, 37 USPQ 2d at 1239 (Fed. Cir. 1995), citing W. Lish. Gore & Assocs., v. Garlock, Inc., 721 F.2d 1551, 1553, 220 USPQ 311, 312-13 (Fed. Cir. 1983).

Next we review the rejections of the different claims.

Claims 20 to 24 and 28

These claims have been rejected as being obvious over Lo in view of Lepage and Kilborn. Lo discloses a generic card lock. Lepage shows a string of carts locked to each other using a non card (conventional) lock. Kilborn teaches a user card being seized and retained by an autoteller. The Examiner

asserts [answer, page 3] that "[i]t would have been obvious ... that the structure of the locking mechanism of Lo could be modified to operably connect shopping carts as taught by Lepage." Realizing that this combination is still deficient, the Examiner contends [answer, page 4] that "[i]t would have been obvious ... to provide a card retaining means as taught by Kilborn in the card lock of Lo." Appellant argues that none of these references teaches or offers any suggestion to combine these references and concludes [brief, page 6] that "what we have here is a combination of nonanalogous art based on hindsight, a rejection made with eyes taught by the instant invention."

We are persuaded by Appellant's arguments. The card means of Kilborn are seized and retained for a totally different purpose or reason and are not at all suggestive of the use of a card for a locking mechanism as contemplated by the invention and claimed in independent claim 20. Even if combinable, there would be still lacking in the combination the limitation of "bolt release and card seizure means in said lock ... for releasing said member and card seizing said card

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and for retaining the seized card until the member associated with the other cart is inserted into said lock." (Claim 20, lines 11 to 15).

Therefore, we do not sustain the rejection of independent claim 20 and, hence, of dependent claims 21 to 24 and 28.

Claim 25

This claim depends on claim 20 and has been rejected as being obvious over Lo in view of Lepage and Kilborn, and further in view of Crafton. The additional reference, Crafton does not cure the above noted deficiency of Lo, Lepage and Kilborn. Therefore, we do not sustain the rejection of claim 25 over Lo, Lepage, Kilborn and Crafton.

Claim 26

This claim depends on claim 20 and is rejected over Lo in view of Lepage and Kilborn, and further in view of Seckinger. However, Seckinger still does not meet the above noted deficiency of the combination of Lo, Lepage and Kilborn.

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Therefore, we do not sustain the rejection of claim 26 over Lo, Lepage, Kilborn and Seckinger.

Claim 27

This claim also depends on claim 20 and is rejected over Lo in view of Lepage and Kilborn, and further in view of Randall. The additional reference, Randall, does not meet the above noted deficiency of the combination of Lo, Lepage and Kilborn. Therefore, we do not sustain the rejection of claim 27 over Lo, Lepage, Kilborn and Randall.

In conclusion, we have reversed the decision of the Examiner rejecting claims 20 to 28 over various combinations of Lo, Lepage, Kilborn, Crafton, Seckinger and Randall.

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REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
PARSHOTAM S. LALL)	
Administrative Patent Judge)	APPEALS AND
)	
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Administrative Patent Judge)	

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