

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 MICHELLE PRICE, DAVID E. BLINDERMAN, and JENNY LAVELLE

Appeal No. 2004-1992
Application No. 10/223,982

ON BRIEF

Before FRANKFORT, STAAB, and BAHR, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-40, all the claims currently pending in the application.

Appellants' invention pertains to a decorative bow for use in decorating gift packages, gift bags and the like. A further understanding of the invention may be derived from a reading of representative claim 1, a copy of which can be found in the appendix to appellants' brief.

Appeal No. 2004-1992
Application No. 10/223,982

The references relied upon by the examiner in the final rejection are:

Ruff	5,589,238	Dec. 31, 1996
Ramirez	6,237,819	May 29, 2001
Lopata et al. (Lopata)	6,360,413	Mar. 26, 2002

Claims 1, 3-34 and 36-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ramirez in view of Ruff.

Claims 2, 35 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ramirez in view of Ruff, and further in view of Lopata.

Attention is directed to appellants' brief (Paper No. 14) and to the examiner's answer (Paper No. 15) for the respective positions of appellants and the examiner regarding these rejections.

Discussion

With reference to appellants' drawing figures, each of the independent claims on appeal, in one form or another, calls for a decorative bow (10) comprising a plurality of ribbon strands (12) and at least one die cut piece (16) comprising a spine (18) and at least one design artifact (20) extending from the spine.

Ramirez, the examiner's primary reference in each of the rejections, pertains to a decorative bow comprising a plurality of loosely arranged, zigzag ribbon-like strands 12. The examiner

Appeal No. 2004-1992
Application No. 10/223,982

concedes that the bow of Ramirez does not include at least one die cut piece comprising a spine and at least one design artifact extending from the spine. To make up for this deficiency, the examiner turns to Ruff.

Ruff, in pertinent part, is directed to a decorative garland (see Figures 1 and 2) comprising an elongated base ribbon 11 and a plurality of fully annealed metal wires 18, 19 spirally wrapped around the base ribbon. The elongated base ribbon includes a plurality of spaced apart decorative members 12 extending generally perpendicular from the longitudinal axis of the ribbon. Extending from the decorative members are a plurality of fingers 13 having decorations or symbols 16. As explained at column 2, lines 27-32, because the wires are fully annealed, the garland may be twisted and formed into any particular position and the garland will stay in that position without springing back.

In rejecting claims 1, 3-34 and 36-39 as being unpatentable over Ramirez in view of Ruff, the examiner maintains that it would have been obvious to one of ordinary skill in the art in

Appeal No. 2004-1992
Application No. 10/223,982

view of the teachings of the applied references to include a die cut ribbon in the decorative bow of Ramirez "in order to provide a contrived structure" (answer, page 2¹).

It is true that the elongated base ribbon 11 of Ruff with its spaced apart decorative members 12, fingers 13 and symbols 16 is visually similar to appellants' die cut piece 16 having a spine and at least one design artifact. However, that is not enough to demonstrate the obviousness of the claimed subject matter, for the mere fact that the prior art structure *could* be modified does to make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is on this point that the examiner's rejection is defective, from our perspective. On the basis of the considerations that follow, we fail to perceive any teaching, suggestion or incentive in either of the references which would have led one of ordinary skill in the art to modify the bow of Ramirez in the manner proposed by the examiner.

¹The page numbering in the examiner's answer appears to be incorrect in that the third page is numbered "page 2" with the pages that follow being consecutively numbered in ascending order. For convenience, we shall use the page numbers as found in the answer in referring to particular pages of the answer.

Appeal No. 2004-1992
Application No. 10/223,982

First, the examiner has provided no convincing motivation for the proposed combination. In this regard, the examiner's stated rationale that it would have been obvious to one of ordinary skill in the art to combine the references in the proposed manner "in order to provide a contrived structure" (answer, page 2) does not suffice. On this basis alone, the rejection cannot be sustained.

Second, the decorative bow of Ramirez and the garland of Ruff have little in common aside from the circumstance that they both broadly serve a decorative function. More specifically, the bow of Ramirez is for decorating a gift package or the like, whereas the garland of Ruff is for decorating a Christmas tree or a room. There is simply no suggestion in either reference, or need in view of the divergent uses and objectives of the references, for their combination.

Third, the zigzag strands of Ramirez are not fixed rigidly in a single position but are allowed to curve and move in response to different placement of the bow (column 2, lines 38-41), whereas the garland of Ruff is specifically designed to be stiff and without any spring back characteristics (column 2, lines 27-32). This stiffness of Ruff's overall device would act as a disincentive to the combination proposed by the examiner.

Appeal No. 2004-1992
Application No. 10/223,982

See Tec Air Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999); *Gordon*, 733 F.2d at 902, 221 USPQ at 1127 (if a proposed modification would render the prior art device being modified unsuitable for its intended purpose, the proposed modification would not have been obvious).

Fourth, the examiner's position (answer, page 2) to the effect that the claimed invention would have been obvious because no unexpected results are seen as compared to the bow of Ramirez is not persuasive because unexpected results are not a requirement for patentability under 35 U.S.C. § 103(a).

Fifth, the examiner's further position that it would have been obvious in combining the references to eliminate the stiffening wires of Ruff from the proposed reference combination because "it is well settled that deletion of an element . . . with subsequent loss of its function would [have been] obvious" (answer, page 8) is not well taken. While there is some support in the case law for the principle that omission of an element and its function involves only routine skill in the art (*see, for example, In re Karlson*, 311 F.2d 581, 584, 136 USPQ 184, 186 (CCPA 1963)), the court has also recognized that this is not a mechanical rule, and that the language in *Karlson* was not intended to short circuit the determination of obviousness

Appeal No. 2004-1992
Application No. 10/223,982

mandated by 35 U.S.C. § 103 (see *In re Wright*, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965)). Further, we direct the examiner's attention to *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) wherein the Federal Circuit has held that the claimed invention as a whole must be evaluated under the standards set down in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 , 148 USPQ 459, 466 (1966) and its progeny, and that the use of *per se* rules is improper in applying the test for obviousness under 35 U.S.C. § 103 since such rules are inconsistent with the fact-specific analysis of claims and prior art mandated by section 103.

From our perspective, the only suggestion to combine the teachings of the applied references in the manner proposed by the examiner is found in the luxury of the hindsight accorded one who first viewed appellants' disclosure. This, of course, is improper. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). This being the case, the teachings of Ramirez and Ruff fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in independent claims 1, 22, 31 and 39 or, it follows, dependent claims 3-21, 23-30, 32-34 and 36-38. Accordingly, we shall not

Appeal No. 2004-1992
Application No. 10/223,982

sustain the standing rejection of claims 1, 3-34 and 36-39 as being unpatentable over Ramirez in view of Ruff.

We reach the same conclusion with regard to claims 2, 35 and 40, which stand rejected as being unpatentable over Ramirez in view of Ruff taken further in view of Lopata. While we appreciate that Lopata teaches the use of helical ribbon strands in a decorative bow, consideration of the examiner's basic reference combination further in view of Lopata's teachings does not cause us to alter the position we voiced above that the combination of Ramirez and Ruff fails to disclose or teach the claimed subject matter found in each of the independent claims on appeal, namely, a decorative bow comprising a plurality of ribbon strands and at least one die cut piece comprising a spine and at least one design artifact extending from the spine. Hence, we also shall not sustain the rejection of claims 2, 35 and 40 as being unpatentable over Ramirez in view of Ruff and further in view of Lopata.

Remand

This case is remanded to the examiner for consideration of the following matter.

US Patent 6,450,933 to Gruenke, of record, discloses in Figure 2 a decorative foil assembly 20b comprising a body made up

Appeal No. 2004-1992
Application No. 10/223,982

of a plurality of foil-like strips 24b and a snowflake 22b having radiating arms. The examiner should consider whether the foil assembly of Gruenke comprises a "decorative bow" as called for in the preamble of appellants' claims and, if so, whether the plurality of ribbon strands and die cut piece having a spine and at least one artifact called for in the body of the appealed claims read on the snowflake 22b having radiating arms of Gruenke.

The decision of the examiner is reversed.

REVERSED AND REMANDED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	
LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

LJS:hh

Appeal No. 2004-1992
Application No. 10/223,982

JAMES C. SCOTT, ESQ.
ROETZEL & ANDRESS
1375 E. 9TH ST.
ONE CLEVELAND CENTER, 10TH FLOOR
CLEVELAND, OH 44114