

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte CHRISTOPHER M. PANGALLO

Appeal No. 2006-1431  
Application No. 10/386,855  
Technology Center 3677

ON BRIEF

Before OWENS, CRAWFORD, and LEVY, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 9-16. Claims 1-8 and 20 stand allowed. Claims 17-19 have been cancelled (brief, page 1).

We REVERSE.

BACKGROUND

The appellant's invention relates to a cinch strap (specification, page 1).

Claim 9 is representative of the invention, and is reproduced as follows:

9. A cinch strap comprising:

a latch block defining first and second substantially parallel apertures therethrough;

an elongated flexible strap extending from said latch block in a substantially perpendicular relationship to said apertures, said strap having first and second strap segments; and

said strap segments and said apertures being configured for said second strap segment to pass through both said apertures and for said first strap segment to enter only said first aperture and not said second aperture.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Litwin	3,257,694	Jun. 28, 1966
Iscovich	5,395,343	Mar. 7, 1995

Heaton (United Kingdom)	GB 2,243,401	Oct. 30, 1991
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Claims 9-14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Litwin in view of Heaton.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Litwin in view of Heaton and Iscovich.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed August 24,

2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed June 8, 2005) and reply brief (filed September 8, 2005) for the appellant's arguments thereagainst.

Only those arguments actually made by the appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claims 9-14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Litwin in view of Heaton.

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 (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. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., 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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039,

228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, page 4) is that Litwin does not disclose the strap to extend from the latch block in a substantially perpendicular relationship to the apertures in the latch block. To overcome this deficiency of Litwin, the examiner turns to Heaton for a teaching of the desirability of extending the strap from the latch block in a substantially perpendicular relationship to the parallel apertures so as to provide a tamper resistant strap useful for securement around a bag.

Appellant's position (brief, page 5) is that the creation of a second loop in Litwin would destroy its purpose and function. It is argued (id.) that "[t]here is no disclosure in either Litwin or Heaton that would suggest or motivate one skilled in the self-locking strap art to modify Litwin in the manner proposed by the Examiner." It is further argued (brief, page 6) that because of the importance of the locking means and its associated structure, Litwin is not concerned with two loops for securing two objects, and that the creation of a second loop would teach away from Litwin's purpose and function of designing

a self-locking tamper proof strap for the securement of a single object.

The examiner responds (answer, page 6) that "[b]oth Litwin and Heaton are utilizing tamper resistant straps and Heaton would suggest modifying the strap of Litwin so that the apertures are oriented perpendicular to the strap extending from the locking block." With respect to appellant's assertion (brief, page 5) that modifying Litwin to provide a second loop would destroy the function and purpose of Litwin, the examiner asserts that appellant's argument is not pertinent because the claims on appeal do not recite forming two loops or having the capability of securing two objects. The examiner argues (id.) to the effect that Heaton shows it to be desirable to have the strap extend perpendicular to the apertures, and that Heaton's structure would provide broader utility to the strap of Litwin so as to hold a cash bag. The examiner adds (id.) that Litwin will function in the same fashion if the strap extended perpendicular to the apertures in the locking block.

In the reply brief, appellant asserts (pages 2 and 3) that since Litwin is only concerned with creation of a single loop, an artisan would not think to modify the latch block as suggested by Heaton because there is no reason to do so. Appellant adds

(reply brief, page 3) that the focus of the analysis should not be the fact that claim 9 does not recite forming two loops or securing two objects, but rather whether an artisan would look to Heaton for the purpose of modifying the latch block of Litwin. It is additionally argued (*id.*) that the location of the apertures in the locking block in relation to the strap is significant in order for the device to function as intended. Changing the location of the apertures in the locking block in relation to the strap would adversely affect the locking means of Litwin.

From the disclosure of both Litwin and Heaton, we find that both references are directed to a single piece tie or strap that is self locking and tamper resistant (Heaton, page 1, line 3 and page 5, line 32 through page 6, line 7; and Litwin col. 1, line 63 and col. 2, lines 27-29). From these disclosures we agree with the examiner that an artisan would have been motivated to modify the tie strap of Litwin to provide the increased capability of securing more than one object (or more than one bundle of objects) with the tie strap as taught by Heaton. However, for the reasons which follow, we find that the resultant structure would not meet all of the limitations of independent claim 9. Upon modifying Litwin as taught by Heaton, we find that

the strap of Litwin would be extended in the area between juncture 32 and locking face 57 of teeth 55, which would result in the strap having the ability of securing more than one object.

However, we find no suggestion for changing the orientation of the strap as it extends from the buckle portion 3 (latch block) so as be perpendicular to the apertures of the latch block absent the teachings of appellant's disclosure. "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 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)).

"It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

From all of the above, we find that the examiner has failed to establish a prima facie case of obviousness of independent claim 9. Accordingly, the rejection of claim 9 under 35 U.S.C.

§ 103(a) as being unpatentable over Litwin in view of Heaton is reversed, along with claims 10-14 and 16, which depend from claim 9.

We turn next to the rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Litwin in view of Heaton and Iscovich. We reverse the rejection of claim 15 because Iscovich does not make up for the deficiencies of the basic combination to Litwin and Heaton.

## CONCLUSION

To summarize, the decision of the examiner to reject claims 9-16 under 35 U.S.C. § 103 is reversed.

REVERSED

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