

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN WILLIAM MCLAUGHLIN

Appeal 2007-1400
Reexamination Control 90/006,825¹
Patent 6,457,239 B1²
Technology Center 3700

Decided: May 30, 2007

Before RICHARD E. SCHAFFER, SALLY C. MEDLEY, and
MARK NAGUMO, *Administrative Patent Judges*.

NAGUMO, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed 24 October 2003. The real party in interest is identified as Kevin W. McLaughlin.

² Issued 1 October 2002.

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A. Introduction

McLaughlin appeals under 35 U.S.C. §§ 134 and 306 from the final rejection, for anticipation and for obviousness over the prior art, of claims 1-20, all the claims present in his reexamination application. We have jurisdiction under 35 U.S.C. § 6. We AFFIRM.

B. Findings of Fact

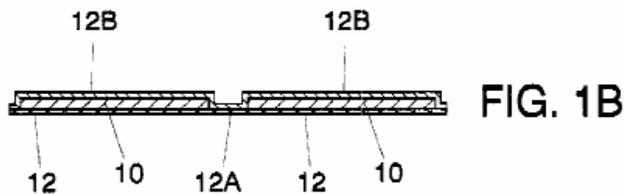
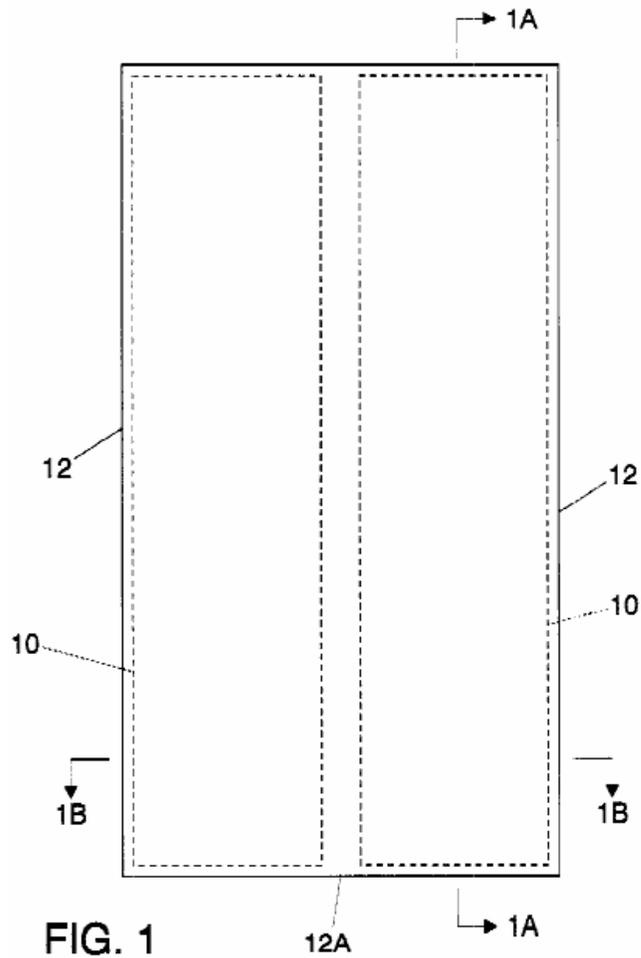
The following findings of fact and any set out in the Discussion section are supported by a preponderance of the evidence of record. Any conclusions of law should be treated as such.

1. The 09/006,825 application ("application") is the vehicle for reexamination of U.S. Patent 6,457,239 B1 (the application is cited as the "239 patent").
2. The claimed subject matter relates to a knife and a magnetic sheath.
3. According to McLaughlin, the real party in interest is the inventor, Kevin William McLaughlin. (Br. at 2.)

The application disclosure

4. According to the application, one of the objects of the invention is to provide a "lightweight, small and moveable means for securing and protecting knife blades." (239 patent at 2: 10–12.)

5. Figures 1 and 1B illustrate the main features of the claimed subject matter:



6. The application describes "magnetically charged faces" (**10**), "preferably made from lightweight magnets" (239 patent at 2: 43-44), attached to a magnetic support (**12**). (239 patent at 2: 41-49.)

7. The application describes the magnetic support **12** as being made from materials that are flexible, including vinyl and leather. (239 patent at 2: 48-56.)

8. According to the application, "a flexible portion, living hinge, or central hinge **12A** [is] located between the magnetically charged faces **10**." (239 patent at 3: 21-23.)

9. The application describes a preferred embodiment in which the "magnetically charged faces **10** are sealed between the magnet support **12** and interior face **12B**," which is also made of a flexible material. (239 patent at 2: 48-49 and 60-63, emphasis added.)

10. According to the application, "[t]he seal between magnet support **12** and interior face **12B** is preferabl[y] created through the application of heat, but the seal may also be created by adhesive or sealant." (239 patent at 2: 6-3:2.)

11. The application discloses another set of embodiments that do not contain an interior face **12B**, but rather "each magnetically charged face **10** adheres to magnet support **12** by virtue of either the application of adhesive . . . or the application of heat to form a thermal bond." (239 patent at 3: 6-10.)

Application Claims

12. Claims 1, 2, 7, and 9 are representative of the issues on appeal.

13. Claim 1 reads [bracketed fold reference numbers added]:

A device for securing knives in combination with a knife,

the device comprising two magnetically charged faces [10],
each magnetically charged face made of a magnet,

and each magnetically charged face moveably attached to the
other magnetically charged face by a magnet support [12] with
a central hinge [12A],

wherein, when in the closed position, the magnetically charged
faces cover all, or a part of, a knife blade, thereby securing and
protecting the knife blade.

(Br. at 20 (Claims Appendix); paragraphing added.)

14. Claim 2 reads:

A device for securing knives in combination with a knife
according to claim 1 wherein the magnetically charged faces
[10] are entirely sealed between the magnet support [12] and an
interior face [12B].

(Br. at 20 (Claims Appendix); paragraphing added.)

15. Claim 7 reads:

A device for securing knives in combination with a knife
according to claim 1 or 2 wherein the magnet support [12] and
the central hinge [12A] are comprised of a single piece of
flexible vinyl, plastic or other flexible material.

(Br. at 20 (Claims Appendix); paragraphing added.)

16. Claim 9 reads:

A device for securing knives in combination with a knife
having a knife blade, the device comprising:

a flat, flexible magnet support [12] with a surface for
supporting magnetically charged faces [10];

a central hinge [12A] bisecting the magnet support wherein the central hinge allows the magnet support [12] to move between an open position and a closed position; and

a plurality of magnetically charged faces [10] adhered to the magnet support surface [12] and positioned so that a first magnetically charged face [10] is adhered to the magnet support surface [12] on one side of the central hinge [12A] and a second magnetically charged face [10] is adhered to the magnet support surface [12] on the other side of the central hinge [12A],

wherein the magnetically charged faces [12] have magnetic poles and are positioned so that when the magnet support is in the closed position the magnetic poles of the first magnetically charged face are attracted to the magnetic poles of the second magnetically charged face,

and wherein the magnetically charged faces extend along the knife blade covering all or part of the knife blade, thereby securing and protecting the knife blade.

(Br. at 21 (Claims Appendix).)

17. Claims 3, 4, and 6–8 are each multiply dependent from claims 1 or 2.
18. Claims 10–17 depend from claim 9.
19. Claims 19 and 20 depend from independent claim 18.
20. Claims 3 and 18 recite the further limitation that the magnets are light weight (claim 10) or flexible (claim 14).
21. Claims 4, 12, and 18 recite the further limitation that the magnet support is comprised of a flexible material.
22. Claims 6, 13, and 19 recite the further limitation that the magnet support extends further beyond one magnetically charged face "than the other [9, 18: second] magnetically charged face."

23. Claims 7, 14, and 18 recite the further limitation that the magnet support and central hinge are comprised of a single piece of flexible vinyl, plastic, or other flexible material.
24. Claims 8, 17, and 18 recited the further limitation that "all materials used in the device are capable of being cleaned, sanitized, or sterilized."
25. Claim 5 depends from claim 2 and recites the further limitation that the interior face is comprised of a flexible material.
26. Claim 20 recites the further limitation that the "size and shape of the magnetically charged faces and magnet support 'corresponds' to the size of the knife blade."

The Prior Art

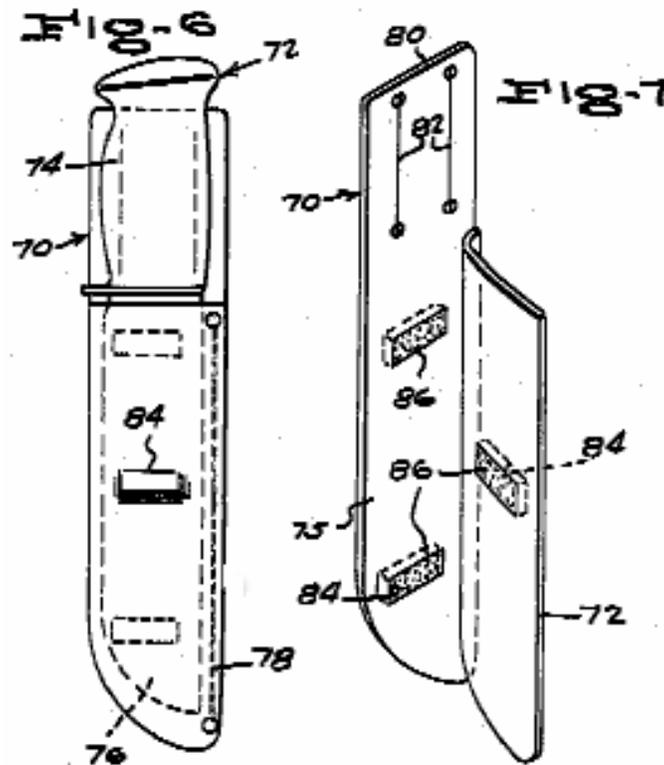
27. The Examiner has relied on the following references:

Villwock	US 3,008,617	Nov. 14 1961
Eldridge	US 3,727,658	Apr. 17 1973
Ray, Sr.	US 4,942,663	Jul. 24 1990

Villwock

28. According to the face of the 239 patent, U.S. Patent 3,008,617 issued to W.A. Villwock ("Villwock"), was not cited during the prosecution of the 239 patent.
29. Villwock describes "article containment devices," including holsters and sheaths.

30. Villwock describes, in Figures 6 and 7, shown below:



and at columns 3 and 4, "a sheath for a conventional hunting knife."
(Villwock at 3: 41 to 4:18.)

31. Villwock describes the sheath as comprising an elongated substantially rectangular wall 75 and a front wall 72, "secured together along a pair of confronting marginal edges by a line of stitching 78, the stitches providing means whereby the front wall 72 may be pivoted relative to the rear wall 75." (Villwock at 3: 51-54.)

32. According to Villwock, permanent magnets 86, "of the bar or other desired types" (Villwock at 4: 6) are disposed in "outwardly expressed portion 84" (*id.* at 3-5) of the front and rear walls.

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33. According to Villwock, the knife may be removed by sliding it out of the sheath or by pushing the knife blade **76** against the front wall **72** to open it to the position shown in Figure 7. (Villwock at 4: 10–18.)

34. Villwock discloses that the invented article containment devices, such as holsters and sheaths, may be formed of any flexible or resilient material, including leather or plastics. (Villwock at 2: 23–27.)

35. Villwock notes that the rear wall **75** includes an extension **80** that is adapted to receive a belt. (Villwock at 3: 55–4:2.)

Eldridge

36. According to the face of the 239 patent, U.S. Patent 3,727,658, issued to John D. Eldridge, Jr. ("Eldridge"), was not cited during the prosecution of the 239 patent.

37. Eldridge describes a "receiver for surgical implements" that can be sterilized along with the implements. (Eldridge at 1: 2 and at 2: 13–18.)

41. According to Eldridge, a ferromagnetic material such as barrium [sic: barium] ferrite, which is less dense than metal magnets, provides highly satisfactory magnets for the invention when embedded in nitrile rubber.

42. Eldridge describes a 10" × 16" sheet embodiment of the invention that weights about 4 ounces, compared to prior art magnetic drapes that weigh more than a pound. (Eldridge at 4: 49–53.)

43. According to Eldridge, the magnets are flexible, and where flexibility is not desired, a metal backing strip may be used to reinforce the magnets to prevent flexing. (Eldridge at 4: 26–30.)

44. Eldridge further teaches that the magnets are held on the pad by an impervious thin plastic laminate 4, which is vacuum formed around each magnet by suction through the porous pad. (Eldridge at 3: 8–13.)

45. According to Eldridge, adhesive coatings may be used to bond the laminate to the pad. (Eldridge at 3: 20–21.)

46. Eldridge also teaches, in the special case where sheet 4 is an Ionomer (Eldridge at 3: 16) and the foamed plastic is a polyurethane (*id.* at 2: 51–59), that an adhesive is not needed (*id.* at 3: 18-20).

Ray, Sr.

47. According to the face of the 239 patent, U.S. patent 4,942,663, issued to Edward D. Ray, Sr. ("Ray") was cited in the prosecution of the 239 patent.

48. Ray describes a knife sheath with elongated flexible magnetic strips that line the interior faces of the sheath, substantially the same length as the sheath. (Ray at 2: 25-32.)

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49. According to Ray, the magnetic strips retain the knife in the sheath.
(Ray at 2: 23–24.)

50. Ray further discloses that the magnetic strips may be held in place by a suitable adhesive. (Ray at 2: 32-33.)

Procedural History

51. Following the Final Rejection, which was mailed 15 September 2004, McLaughlin filed an amendment (14 November 2004), which the Examiner refused to enter (Advisory action, mailed 11 January 2005).

52. McLaughlin filed an appeal brief ("Br.") on 16 June 2006, and the Examiner's Answer ("Answer") was mailed on 30 October 2006.

53. In the Answer, the Examiner dropped rejections under 35 U.S.C. § 112 but maintained the rejections over prior art substantially unchanged.
(Answer at 3.)

54. McLaughlin did not file a Reply Brief.

The Examiner's Rejections and McLaughlin's Arguments

Anticipation by Villwock

55. The Examiner rejects claims 1, 3, 4, 6, 7, and 8 as anticipated under 35 U.S.C. § 102(b) by Villwock. (Answer at 4.)

56. The Examiner finds that Villwock describes in Figures 6 and 7 a device for securing knives having at least two magnetically charged faces and a magnet support having a central hinge, wherein the magnets cover part of the knife blade. (Answer at 4.)

57. McLaughlin does not contest the Examiner's findings in these regards. (Br. at 11–12.)

58. The Examiner finds further that Villwock teaches that the magnet support material is flexible, as required by claim 4; that the magnet support material extends beyond the magnetically charged faces, as required by claim 6; and that all parts of the Villwock sheaths were capable of being cleaned, as required by claim 8. (Answer at 4.)

59. McLaughlin does not contest the Examiner's findings in these regards. (Br. at 11–12.)

60. The Examiner also finds that the magnets, as required by claim 3, are "lightweight" due to their small size. (Answer at 4.)

61. McLaughlin protests that "Patent Owner simply cannot understand why the Examiner insists on such a reading of Villwock." (Br. at 12.)

62. The Examiner finds that Villwock discloses sheath made from a "single piece" of "flexible material" because the stitching rendered the front wall inseparable from the back wall, thereby meeting the further limitations of claim 7. (Answer at 4.)

63. McLaughlin argues that "Villwock clearly claims a two-piece magnet support . . . There is simply no basis for the Examiner's assertion that the Villwock magnet support is a single structure." (Br. at paragraph bridging 12-13.)

Anticipation by Eldridge

64. The Examiner rejects claims 1–20 as anticipated by Eldridge.

(Answer at 4.)

65. The Examiner finds that Eldridge describes a device, shown in Figure 1, for securing a knife having opposed and polarized magnetically charged faces and a magnet support having a central hinge, wherein the magnets cover part of the knife blade. (Answer at 4.)

66. The Examiner finds that the further limitations recited in each of the dependent claims are met by specific elements in Eldridge. (Answer at 5.)

67. McLaughlin does not contest the Examiner's findings summarized in facts 65 and 66 in these regards. (Br. at 11–12.)

68. However, McLaughlin argues that Eldridge does not teach "adhering" the "impervious thin plastic laminate **4**" to the magnet support with an adhesive or a thermal bond. (Br. at 13.)

69. More particularly, McLaughlin argues that "[i]t is clear that use of a plastic laminate requires far more material and is a different method of attachment than using glue, and demonstrates that Eldridge does not teach every element found in McLaughlin." (Br. at 13.)

70. McLaughlin argues further that the term "adhered" is defined in the patent as either "the application of adhesive . . . or the application of heat to form a thermal bond." (Br. at 13; ellipsis introduced.)

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71. Moreover, according to McLaughlin, the 239 patent "does not claim or teach the use of plastic laminate . . . to attach the magnets to the magnet support." (Br. at 13.)

72. McLaughlin concludes that Eldridge does not teach a limitation of the claimed subject matter, and that the rejection for anticipation is therefore improper. (Br., paragraph bridging 13–14.)

73. The Examiner points out that Eldridge teaches that an adhesive can be used to adhere the magnets to the support. (Answer at 11, citing Eldridge at 3: 20.)

Villwock and Eldridge

74. The Examiner rejects claims 1–20 as obvious under 35 U.S.C. § 103 over the combined teachings of Villwock and Eldridge. (Answer at 5-6.)

75. The Examiner finds that Villwock's magnets are neither flexible nor sealed. (Answer at 6.)

76. The Examiner finds further that Eldridge teaches sealing magnets with a flexible sealing material. (Answer at 6.)

77. The Examiner concludes that one of ordinary skill would have used a flexible sealing material such as that taught by Eldridge to seal Villwock's magnets in order to keep the magnets from falling out of the pockets. (Answer at 6.)

78. The Examiner also finds that Villwock does not teach opposed, polar opposite oriented magnets. (Answer at 6.)

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79. The Examiner finds that Eldridge teaches (and claims) such an arrangement, as well as flexible magnets. (Answer at 6.)

80. The Examiner concludes that it would have been obvious for one of ordinary skill in the art to arrange magnets in the manner taught by Eldridge to better hold the hinged flaps of Villwock's sheath together. (Answer at 6.)

81. The Examiner also concludes that it would have been obvious for one of ordinary skill in the art to substitute the magnet material and magnet support material of Villwock because they are recognized as equivalent to those of Villwock for the same purposes.

82. McLaughlin does not dispute any of the Examiner's findings of fact, nor the propriety of the Examiner's conclusions of obviousness as a prima facie case. (Br. at 8-11.)

83. Rather, McLaughlin argues that evidence of commercial success, as shown by Mr. McLaughlin's declaration, proves the nonobviousness of the claimed invention. (Br. at 8.)

84. According to McLaughlin, Mr. McLaughlin entered into an "exclusive negotiating agreement" with Dexter-Russell, and then with other companies when Dexter-Russell broke off negotiations in the fall of 2003. (Br. at 8.)

85. According to Mr. McLaughlin, he entered into a license agreement with Forschner/Swiss Army in which Forschner/Swiss Army agreed to purchase a minimum of 50,000 units per year. (McLaughlin Declaration filed 14 November 2004, at 1-2)

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86. Mr. McLaughlin also testifies that Forscher increased its order and advertised the device as described in McLaughlin's 239 patent. (Br. at 9; McLaughlin Declaration filed 14 November 2004, at 2.)

87. McLaughlin also argues that "[t]he Patent at issue contains structural changes over the prior art, and teaches a new use for the device. This combination renders the Patent non-obvious." (Br. at 10.)

88. McLaughlin does not explain what, in its view, are the structural changes, nor what is the "new use" of the claimed invention. (Br. at 10-11.)

Villwock, Eldridge, and Ray

89. We do not find it necessary to describe the Examiner's rejection over the combined teachings of Villwock, Eldridge, and Ray.

McLaughlin's complaints about the Reexamination

90. McLaughlin complains that a substantial new question of patentability was never identified by the requester or by the Examiner. (Br. at 15-16.)

91. More particularly, McLaughlin asserts that the prior art of record contain each and every teaching found in the "new" references, and that the new references therefore do not raise a substantial new question of patentability. (Br. at 16-17.)

92. McLaughlin argues that the request for reexamination, at pages 2-6, on which the Examiner relies for a statement of the substantial new question of patentability, "contains conflicting and unclear statements." (Br. at 17.)

93. As a result, according to McLaughlin, it was unable to address the Examiner's concerns, and was in effect deprived of one of his opportunities

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to respond with amendments; in particular, McLaughlin argues that the Examiner should have considered McLaughlin's amendments filed after the final rejection.

94. McLaughlin does not explain what it regards are the conflicting and unclear statements in the request.

95. Finally, McLaughlin argues that he is being harassed by a spiteful competitor, and that such harassment is contrary to the Congressional intent of the statute. (Br. at 18–19.)

C. Discussion

Reexamination is provided for by 35 U.S.C. §§ 302-307, and is subject to procedures established under 35 U.S.C. §§ 132 and 133. A patent owner's right of appeal in a reexamination proceeding is provided for by §§ 306 and 134(b). The latter provides for the "appeal from the final rejection of any claim by the primary examiner." 35 U.S.C. § 134(b). McLaughlin's complaint that its amendments filed after the final rejection should have been entered, must be sought by petition to the Director. The record indicates that McLaughlin was so advised, but that he chose not to take that route. Similarly, McLaughlin's complaints about the propriety of the reexamination itself must be pursued by petition to the Director. We can only review the rejections appealed. *In re Hiniker Co.*, 150 F.3d 1362, 1367, 47 USPQ2d 1523, 1527 (Fed. Cir. 1999); see also *Heinl v. Godici*, 143 F.Supp.2d 593, (E.D. Va. 2001).

Turning to the merits, on appeal, McLaughlin bears the burden of proving that the Examiner erred reversibly in making the rejections. During

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reexamination, claims are "given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims." *In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984). Moreover, because claims under reexamination can be amended, they do not enjoy a presumption of correctness. *In re Etter*, 756 F.2d 852, 858–59, 225 USPQ 1, 5-6 (Fed. Cir. 1985) (en banc).

To establish anticipation under 35 U.S.C. § 102, each and every element in a claim, arranged as is recited in the claim, must be found in a single prior art reference. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001) ("Invalidity on the ground of 'anticipation' requires lack of novelty of the invention as claimed. The invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior reference, arranged as in the claim.") (citations omitted).

The obviousness or nonobviousness of the claimed subject matter is to be assessed against the background of the scope and content of the prior art, the differences between the prior art and the claimed subject matter, and the level or ordinary skill in the pertinent art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 460 (1966). Numerous guidelines have been propounded to assist the conduct of this analysis. Recently, the Court explained, "If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. . . . a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct.

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1727, 1731 82 USPQ2d 1385, 1396 (2007). The so-called "secondary considerations," e.g., commercial success, long felt but unsolved needs, failure of others, may shed light on whether there is indeed more than expected in the claimed combination. *Graham*, 383 U.S. at 17-18, 148 USPQ at 460.

Anticipation by Villwock

The Examiner rejects claims 1, 3, 4, 6, 7, and 8 as anticipated by Villwock. In particular, the Examiner finds that Villwock describes in Figures 6 and 7 a device for securing knives having at least two magnetically charged faces and a magnet support having a central hinge, wherein the magnets cover part of the knife blade. (Answer at 4.) These are all the elements required by claim 1. Similarly, the Examiner finds that Villwock teaches that the magnet support material is flexible, as required by claim 4; that the magnet support material extends beyond the magnetically charged faces, as required by claim 6; and that all parts of the Villwock sheaths were capable of being cleaned, as required by claim 8. (Answer at 4.)

McLaughlin does not contest the Examiner's findings in these regards.

(Br. at 11–12.) Accordingly, we hold that McLaughlin has waived argument as to these findings of fact, and we find that claims 1, 4, 6, and 8 are anticipated by Villwock.

The Examiner finds that the Villwock magnets are "lightweight" based on their small size. (Answer at 4.) McLaughlin protests that this is incomprehensible, but we are not persuaded that the Examiner erred. McLaughlin's disclosure contains no special definition of the term

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"lightweight magnet," and McLaughlin has not directed our attention to any evidence of a specialized meaning of this term in the relevant arts.

According to the application, an object of the invention is to provide "lightweight, small and moveable means for securing and protecting knife blades." (239 patent at 2: 10–12.) Villwock teaches a sheath for a conventional hunting knife that is intended to be worn on a waist belt. (Villwock at 3: 45 and 3: 55 to 4: 2.) Thus, Villwock teaches a sheath that is reasonably characterized as lightweight, small, and moveable. Magnets that are parts of such a sheath are reasonably characterized as lightweight.

The Examiner also finds that Villwock's sheath is made from a single piece of flexible material because the stitching renders the front wall inseparable from the back wall, thereby meeting the limitation of claim 7 that "the magnet support and the central hinge are comprised of a single piece of flexible vinyl, plastic or other flexible material." (Answer at 3.) McLaughlin denies that Villwock's sheath is "a single structure."

(Br. at 11-12.)

We find, however, that if one picked up any part of Villwock's sheath, the entire sheath would also be picked up, so it seems to be "a single piece," in the broadest reasonable and ordinary interpretation of that term. Just as an unlined shirt with a non-detachable collar is fairly characterized as being comprised of a single piece of fabric if it doesn't fall into two or more pieces in ordinary use, so we find that the limitations recited in claim 7 which includes the open transitional language "comprised," encompass the sewn sheath taught by Villwock.

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The rejection of claims 1, 3, 4, 6, 7, and 8 over Villwock is
AFFIRMED.

Anticipation by Eldridge

The Examiner rejects claims 1–20 as anticipated by Eldridge. More particularly, the Examiner finds that Eldridge describes a device having all the limitations of the claims, citing specific structures that meet the limitations recited in the dependent claims. (Answer at 4-5.) McLaughlin does not object to any of the Examiner's specific findings (Br. at 11-12), and we hold that such objections have been waived. McLaughlin does argue that Eldridge does not teach "adhering" the "impervious thin plastic laminate 4" to the magnet support with an adhesive or a thermal bond. (Br. at 13.) As independent claims 9 and 18 recite that "magnetically charged faces" are "adhered to the [magnet support] surface," the rejection of claims 9–20 must be reversed for lack of a recited limitation if McLaughlin is correct. Thus, the meaning of the term "adhered" is dispositive.

McLaughlin argues that the term "adhered" is defined in the patent as either "the application of adhesive . . . or the application of heat to form a thermal bond." (Br. at 13; ellipsis introduced.) However, that passage (239 patent at 3:6-10) occurs in the description of a particular embodiment — one that expressly omits an "interior face **12B**" covering the magnet. (239 patent at 3:5–10.) We cannot read limitations from the specification into the claims. Claims 9 and 18 contain no language that excludes the presence of an "interior face **12B**" or the laminating sheet **4** taught by Eldridge, just as claim 1 contains no language excluding the "adhered to" limitation recited in claims 9 and 18. Limitations in the specification may

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not be read into the claims. A general definition of "adhere" is "to hold fast or stick by or as if by gluing, suction, grasping, or fusing." *Webster's Third New Int'l Dictionary* (1971). The laminating sheet 4 of Eldridge holds fast or sticks the magnets to the support as if by gluing, etc., both when an adhesive coating is used (Eldridge at 3: 20-21) and when the laminating sheet sticks to the support without an additional adhesive coating.

Accordingly, we find that every limitation is met, and that McLaughlin has not carried his burden of showing that the Examiner committed reversible error. The rejection of claims 1–20 for anticipation over Eldridge is AFFIRMED.

Obviousness in view of Villwock and Eldridge

We address this rejection primarily to explain our decision to the appellant, as secondary considerations supporting a conclusion of nonobviousness have no bearing on the conclusions we have already reached that the claimed subject matter is anticipated.

The Examiner rejects claims 1–20 as obvious under 35 U.S.C. § 103 over the combined teachings of Villwock and Eldridge. The Examiner argues that the limitations not taught by Villwock are taught by Eldridge. Moreover, according to the Examiner, it would have been obvious to one of ordinary skill in the art to modify the Villwock sheath by using the flexible sealing material taught by Eldridge, in order to better keep the magnets in position, and to arrange the magnets in opposed polar opposite configurations in order to better keep the sheath closed. (Answer at 5–6.)

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McLaughlin does not dispute that the Examiner established a prima facie case of obviousness. Rather, McLaughlin contends that the evidence of commercial success established by Mr. McLaughlin's declarations, and the long-felt but unmet need, established by the lapse of time between the issuances of Villwock and Eldridge, prove the nonobviousness of the claimed subject matter. (Br. at 8-11.)

A showing of commercial success, to be relevant as rebuttal evidence in the face of a prima facie case of obviousness, must demonstrate a nexus between the merits of the claimed subject matter and the sales. *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996) (requiring "proof that the sales were a direct result of the unique characteristics of the claimed invention — as opposed to other economic and commercial factors unrelated to the quality of the patented subject matter.") Because the PTO lacks the means or resources to gather evidence that supports or refutes an applicant's assertion that the sales constitute commercial success, the Federal Circuit has recognized that the applicant must provide the hard evidence of commercial success. *Id.* at 139–40, 40 USPQ 2d at 1689.

In the present case — as in *Huang* — we have only the inventor's opinion as to the purchaser's reasons for buying the product. We do not have, for example, a declaration from Forschner explaining that it purchased the product because of the claimed features of the invention as opposed to unrelated economic and commercial factors. Moreover, Mr. McLaughlin has only told us that the patented invention was the subject of the licensing agreements. It has not been explained which novel features, or which novel combination of features, were responsible for the alleged commercial

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success. We conclude that Huang has failed to establish the nexus between the claimed subject matter and the sales that would be necessary to rebut the prima facie case of obviousness.

Even assuming that McLaughlin had sufficiently demonstrated a nexus between the claimed subject matter and the sales, McLaughlin has not provided sufficient information for us to determine whether the sales represent commercial success. We have not been provided with any indication whether the 50,000 or 60,000 units per year represent a substantial quantity in the relevant market. For example, we have been provided only the scantiest evidence as to what is the nature of the market—who are the buyers, what are comparable products, and how do the features and costs of the comparable products compare to the features and costs of the patented products. These issues are particularly important in the present circumstances where the principal buyer of the product is a company that intends to resell the product: it is not going to use the product itself (e.g., in a chain of restaurants). Thus, the principal buyer here is wagering that it can resell enough units to other purchasers that it can make a reasonable profit. The purchasing decisions of such a commercial buyer are certain to be more complicated, and therefore likely to be more remote from the particular qualities of the product than the personal sales alleged by Mr. McLaughlin. Moreover, Mr. McLaughlin's sales are too vague in number and circumstances to weigh strongly in our considerations.

We conclude that the Examiner's prima facie case of obviousness has not been rebutted by evidence of commercial success.

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The short answer to McLaughlin's argument that the need for his invention was long felt but unmet need is that, in the absence of evidence that the problem was recognized, and that others had tried and failed efforts to solve it, mere silence on this record is not proof that there was a need, that the need was long felt, or that it was unmet.

The rejection of claims 1–20 as obvious over the combined teachings of Villwock and Eldridge is AFFIRMED.

We therefore also AFFIRM the rejection of claims 1-20 over the combined teachings of Villwock, Eldridge, and Ray, as cumulative with the first rejection for obviousness.

D. Conclusion

In view of the foregoing facts and considerations, it is:

ORDERED that the rejection of claims 1, 3, 4, and 6–8 as anticipated under 35 U.S.C. § 102(b) by Villwock is AFFIRMED.

FURTHER ORDERED that the rejection of claims 1-20 as anticipated under 35 U.S.C. § 102(b) by Eldridge is AFFIRMED.

FURTHER ORDERED that the rejection of claims 1-20 as obvious under 35 U.S.C. § 103 over the combined teachings of Villwock and Eldridge is AFFIRMED.

FURTHER ORDERED that the rejection of claims 1-20 as obvious under 35 U.S.C. § 103 over the combined teachings of Villwock, Eldridge, and Ray is AFFIRMED.

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FURTHER ORDERED that 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) (2006).

AFFIRMED

hlj

Sharon Adams
Adams Law Firm
1867 Ygnacio Valley Road, Suite 230
Walnut Creek, CA 94598

Marvin Feldman
Lackeback Siegel LLP
Lackeback Siegel Building
One Chase Road
Scarsdale, NY 10583