

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON J. BIER and JOSHUA A. GUTSTEIN

Appeal 2008-1530
Application 10/440,592
Technology Center 3700

Decided: September 29, 2008

Before WILLIAM F. PATE, III, LINDA E. HORNER, and ANTON W.
FETTING, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 13-16 and 21-25. Claims 1-12, 17, 19-20, and 26-29 have been canceled. Claim 18 has been withdrawn from consideration. We have jurisdiction under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is the combination of a device for storing at least one perforated collar stay and a perforated collar stay stored thereon. Claim 13, reproduced below, is further illustrative of the claimed subject matter.

13. A device for storing at least one perforated collar stay comprising:
first and second arcuate members releasably engageable to form a closed loop, at least one arcuate member being pivotable; and
a collar stay having a perforation, and an arcuate member extending through the perforation.¹

The references of record relied upon by the Examiner as evidence of lack of novelty and obviousness are:

Pyros	US 2,146,227	Feb. 7, 1939
Brunner	US 2,783,637	Mar. 5, 1957
McKinney	US 3,069,890	Dec. 25, 1962
Rubio	US 3,075,202	Jan. 29, 1963
Uliano	US Des.225,301	Dec. 5, 1972
Vaage	US 3,952,382	Apr. 27, 1976
Wolter	US 4,376,383	Mar. 15, 1983
Patterson	US 5,867,877	Feb. 9, 1999

Claims 13-16 and 21-23 stand rejected under 35 U.S.C. § 102 as being unpatentable over Wolter.

Claim 22 stands rejected under 35 U.S.C § 103 as being unpatentable over Wolter in view of Patterson or Vaage.

Claims 24 and 25 stand rejected under 35 U.S.C. § 103 as unpatentable over Wolter in view of McKinney.

¹ We construe “an arcuate member extending through the perforation” to refer to one of the previously recited arcuate members.

Claims 13-16 and 21-23 stand rejected under 35 U.S.C. § 103 as unpatentable over Wolter in view of Pyros or Rubio.

Claim 22 stands rejected as unpatentable over Wolter in view of Pyros or Rubio, as applied to claim 21, and in further view of Patterson or Vaage.

Claims 24 and 25 stand rejected under 35 U.S.C. § 103 as unpatentable over Wolter in view of Pyros or Rubio, as applied to claim 13, and in further view of McKinney.

ISSUES

The issues for our consideration include whether Appellants have established that the Examiner erred in rejecting claims 13-16 and 21-23 for lack of novelty over the Wolter reference. Also for consideration is whether Appellants have established that the Examiner erred in rejecting: claim 22 as unpatentable over Wolter in view of Patterson or Vaage, claims 24 and 25 as unpatentable over Wolter in view of McKinney, claim 13-16 and 21-23 as unpatentable over Wolter in view of Pyros or Rubio, claim 22 as unpatentable over Wolter in view of Pyros or Rubio and further in view of Patterson or Vaage, and claims 24 and 25 as unpatentable over Wolter in view of Pyros or Rubio and further in view of McKinney. All of these rejections turn on the issue of whether the Examiner has established that the prior art discloses or renders obvious the combination of a storage device and a perforated collar stay.

Appellants have also furnished a Declaration under 37 C.F.R. § 1.132 with respect to lack of novelty and obviousness. One point raised by the Declaration is that a key is not suitable as a collar stay.

FINDINGS OF FACT

Wolter discloses a device for storing keys which has first and second arcuate members, jaws 2, releasably engageable to form a closed loop with at least one of the arcuate members being pivotable. (See col. 3, ll. 55-60.) Wolter does not show a collar stay, nor does Wolter teach a collar stay with a perforation.

Patterson and Vaage have been cited to disclose a spring disposed between two arcuate members for urging arcuate members to a closed position. Patterson teaches spring 80 disposed between first and second arcuate members 42. (See Fig. 1 in Patterson.) Vaage discloses a spring member 8 disposed between first and second arcuate members 4 and 5. (See Fig. 1 in Vaage.)

McKinney discloses an attachment component such as a magnet for storing a ringed object and for attachment of the ringed object to a surface. (McKinney col. 2, ll. 5-7 and Figs. 1-3.)

Pyros teaches a collar stay 10 having apertures in its intermediate position and its free end. (See aperture 11 in Fig. 1.) The aperture is not disclosed as useful in storage.

Rubio discloses a collar stay having apertures 10C for the reception of rivets which allow the size of the collar stay to be adjusted. (See e.g., Fig. 1 in Rubio.) The apertures are not disclosed as useful in storage.

Uliano and Brunner have not been named in the statement of any rejections. They have been cited by the Examiner as disclosing long slender keys that have the general appearance of collar stays.

PRINCIPLES OF LAW

"A claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995). Where a patentee uses the claim preamble to recite structural limitations of his claimed invention, the PTO and courts give effect to that usage. *See id.*; *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989). Conversely, where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation. *See Bell Communications*, 55 F.3d at 620; *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951).

The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257. The inquiry involves examination of the entire patent record to determine what invention the patentee intended to define and protect. *See Bell Communications*, 55 F.3d at 621 (looking to patent specification to determine whether claimed invention includes preamble recitations); *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994) (examining "patent as a whole"); *Vaupel Textilmaschinen KG v. Meccanica Euro Italia SPA*, 944 F.2d 870, 880 (Fed. Cir. 1991) (looking to claims, specification, and drawings); *Gerber Garment Tech., Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 689 (Fed. Cir. 1990) (noting that preamble recitations provided antecedent basis

for terms used in body of claim); *Corning Glass Works*, 868 F.2d at 1257 (considering the specification's statement of the problem with the prior art); *Kropa*, 187 F.2d at 152 (noting that preamble sets out distinct relationship among remaining claim elements); *Rowe v. Dror*, 112 F.3d 473, 478-79 (Fed. Cir. 1997).

The prior art may anticipate a claimed invention, and thereby render it non-novel, either expressly or inherently. *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). Express anticipation occurs when the prior art expressly discloses each limitation (i.e., each element) of a claim. *Id.* In addition, “[i]t is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it.” *Id.*

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of ordinary skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

ANALYSIS

Turning to the rejection of claims 13-16 and 21-23 under 35 U.S.C. § 102 it is our finding that the claims are not anticipated by Wolter. Appellants argue that the collar stay is an element of the claimed combination and we agree. Inasmuch as Wolter does not show a collar stay, it cannot be said to anticipate the claimed subject matter. Furthermore as indicated above, since the collar stay is positively recited in the claims, Appellants' preambular limitation to a collar stay storing device must be given patentable weight. Therefore, a key ring cannot satisfy an anticipation rejection for the claimed subject matter of a collar stay storing device. The cited collar stay in the combination of claim 13 gives life, meaning, and vitality to the preambular limitation of a device for storing at least one perforated collar stay, and this claimed preambular limitation cannot be disregarded.

We acknowledge the Examiner's argument that a key 9 is considered a collar stay, since a key is capable of functioning as a collar stay. (Answer 4:3-6.) The first part of the Examiner's statement is simply erroneous. A key is not a collar stay. And the Examiner is in error for "considering" it so. The second premise is that a key is capable of functioning as a collar stay. This statement is amenable to proof, but the Examiner, who bears the burden of establishing anticipation by a preponderance of the evidence, has offered no proof for this assertion. Inasmuch as this assertion has been challenged on the record by the Appellants, it is incumbent on the part of the Examiner to offer more than a bare assertion that this is so. Since the Examiner has merely repeated his argument in more detail at page 11, we must conclude that this finding is based on speculation.

With respect to the rejection of claim 22 as unpatentable over Wolter in view of Patterson or Vaage, while we are in agreement that it would have been obvious to place a spring in the key ring of Wolter, such a key ring would not correspond to the claimed subject matter of claim 22. Claim 22 is directed to a collar stay storage device with a collar stay thereon. Neither Wolter, Patterson, or Vaage disclose such collar stays. Furthermore the idea that a long slender key as disclosed by Uliano or Brunner would satisfy the subject matter of these claims is not persuasive. Keys are not collar stays, and there is no suggestion in the prior art for using a key as a collar stay.

Turning to claims 24 and 25, while it might have been obvious to secure a magnet or other attachment device, as taught in McKinney, to the key ring of Wolter, such structure would not render obvious the claimed subject matter of claims 24 and 25, for the reasons given above. The key ring of Wolter modified with an attachment means would not satisfy the claim limitation of a collar stay storage device, nor would it include the required collar stay.

Turning to the rejection of claims 13-16 and 21-23 as unpatentable over Wolter in view of Pyros or Rubio, we do acknowledge that Pyros and Rubio disclose collar stays. These collar stays also possess apertures therein, albeit for different purposes than storage. However, the suggestion of using a device with first and second arcuate members that form a closed loop that stores collar stays is not found in the references nor is it suggested thereby. The only disclosure of this subject matter has been by Appellants, and we regard this rejection as classic hindsight. However, such hindsight cannot form the basis for a valid rejection under § 103.

Turning to claim 22, while we acknowledge that Patterson and Vaage disclose springs for biasing arcuate members, nothing in these references teaches using arcuate members to store collar stays.

Finally with respect to claims 24 and 25 we find no teaching in the prior art of using a device with first and second arcuate members to store collar stays having perforations therein. Accordingly, the claimed subject matter of claims 24 and 25 is not unpatentable over Wolter, in view of Pyros or Rubio, and further in view of McKinney.

We need not consider Appellants' declaration, inasmuch as Appellants have established that the Examiner's findings regarding anticipation and the Examiner's prima facie case of obviousness were erroneous. The burden was never shifted to Appellants, and Appellants' evidence need not be considered.

CONCLUSION

For the reasons outlined above, the Appellants have satisfied their burden of showing error in the Examiner's rejections under 35 U.S.C. §§ 102 and 103.

The rejections of all claims on appeal are reversed.

REVERSED

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