

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MATHEW PETER SZAPUCKI and RICHARD KULKASKI

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Appeal 2008-3951  
Reissue Application 10/909,941 (of U.S. Patent 5,671,958)  
Technology Center 3600

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Decided: August 27, 2008

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Before BRADLEY R. GARRIS, *Administrative Patent Judge*,  
FRED E. McKELVEY, *Senior Administrative Patent Judge*, and  
ROMULO H. DELMENDO, *Administrative Patent Judge*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 11-15 (Appeal Brief filed May 21, 2007, hereinafter “App. Br.”; Final Office Action mailed May 2, 2006). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Appellants state they invented a latch mechanism for a sash window (col. 1, l. 66 to col. 2, l. 50 of United States Patent 5,671,958, hereinafter “’958 Original Patent”). According to Appellants, “[w]indows that are hinged on one side of the sash require latch mechanisms at the other to keep them shut” (*id.* at col. 1, ll. 5-6). Such conventional latch mechanisms are said to generally comprise “an elongated housing containing a bolt that is biased by a spring so that one end extends beyond an end of the housing,” which end “has a biased striking surface that engages one side of a rail in the jamb when the window is almost closed so that further closure forces the bolt back into the housing” (*id.* at col. 1, ll. 6-11). Appellants state that “[w]hen the window is fully closed, the spring forces the bolt outwardly on the other side of the rail to hold it shut” (*id.* at col. 1, ll. 11-13). Appellants further explain that “[a]n opening in the housing permits access to the bolt so that the window can be opened by withdrawing it into the housing” (*id.* at col. 1, ll. 13-15).

Claims 11 and 15 on appeal read as follows (underlining omitted; bracketed drawing reference numerals added):

11. A latch mechanism for a sash window disposed within opposed jambs, the sash window comprising a top sash member [50], bottom sash member and two stiles connected together at their extremities, the latch mechanism adapted for releasably securing the sash window to the jambs, the latch mechanism comprising:

a housing [2] having a top plate [8], said housing adapted to be supported by the top sash member, the housing [2] further having a pair of side walls [11, 23] depending from said top plate [8];

flexible tabs [18, 18’ or 20, 20’] extending outwardly from the outer surface of each side wall [11, 23] and toward

said top plate [8], said tabs [18, 18' or 20, 20'] having an inner side surface [Fig. 6, 78]; and

a bolt [4] having first and second ends, the bolt being slidably disposed between said side walls [11, 23] of said housing [2].

15. A latch mechanism for a sash window disposed within opposed jambs, the sash window comprising a top sash member, bottom sash member and two stiles connected together at their extremities, the latch mechanism adapted for releasably securing the sash window to the jambs, the latch mechanism comprising:

a housing [2] having a top plate [8], the housing [2] adapted to be supported by the top sash member, the housing [2] further having a first side wall [11] and a second side wall [23] depending from the top plate [8];

a first flexible tab [18] and a second flexible tab [20] extending outwardly from an outer surface of the first side wall [11], the first flexible tab [18] proximate a front portion of the first side wall [11] and the second flexible tab [20] proximate a rear portion of the first side wall [11];

a third flexible tab [18'] and a fourth flexible tab [20'] extending outwardly from an outer surface of the second side wall [23], the third flexible tab [18'] proximate a front portion of the second side wall [23] and the fourth flexible tab [20'] proximate a rear portion of the second side wall [23];

a bolt [4] slidably supported within the housing [2]; and  
means for biasing [6] the bolt through an end opening [14] in the housing [2].

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Chang	5,068,932	Dec. 3, 1991
Schultz	5,139,291	Aug. 18, 1992
Schlack	5,158,329	Oct. 27, 1992

The only remaining rejections are as follows: (i) claims 11-15 under 35 U.S.C. § 251 as being based upon a defective reissue oath or declaration; and (ii) claims 11-15 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Schultz and Schlack (Examiner's Answer mailed September 25, 2007, hereinafter "Ans.," 3-10).

### ISSUES

Have Appellants demonstrated error in the Examiner's determination that the appealed claims do not comply with the requirements of 35 U.S.C. § 251 as being based upon a defective reissue oath or declaration in violation of 37 C.F.R. § 1.175?

Have Appellants demonstrated error in the Examiner's determination that a person having ordinary skill in the art would have found the subject matter of the appealed claims obvious in view of the applied prior art?

### FINDINGS OF FACT

1. The real party in interest is said to be NEWELL OPERATING COMPANY (App. Br. 4).
2. The present Reissue Application is a continuation of Reissue Application 10/229,726, filed on August 28, 2002, which is a continuation of Reissue Application 09/408,395, filed on September 29, 1999 and issued as United States Reissue Patent RE37,916 E on December 3, 2002, which was based on the '958 Original Patent (Preliminary Amendment filed on July 30, 2004).

3. Except for a sentence at column 1 identifying continuity and the claims, the Specification and drawings of the present reissue application, as filed on July 30, 2004, are identical to those of the '958 Original Patent.

#### DEFECTIVE OATH OR DECLARATION

4. In an Office Action mailed on August 23, 2005, the Examiner found that the reissue oath or declaration filed with the present reissue application was defective because it did "not identify an error not corrected in the parent reissue application 10/229,726 or 09/408,395" (August 23, 2005 Office Action at 3).
5. In reply to the August 23, 2005 Office Action, Appellants submitted, *inter alia*, a Supplemental Reissue Declaration on January 23, 2006.
6. The January 23, 2006 Supplemental Reissue Declaration at page 1 reads in part

We believe we are the original, first and joint inventors of the subject matter which is described and claimed in U.S. Patent No. 5,671,958, granted September 30, 1997, and for which a Reissue Application is being sought on the invention entitled "SNAP ON LATCH MECHANISM FOR A SASH WINDOW," *the specification of which is attached hereto.*

We hereby state that we have reviewed and understand the contents of the above-identified specification, including the claims, *as amended by the Preliminary Amendment attached hereto*" [emphases added].

7. Neither a specification nor a preliminary amendment was attached to the January 23, 2006 Supplemental Reissue Declaration.

## OBVIOUSNESS

### APPELLANTS' INVENTION

8. Figure 1 of the '958 Original Patent is reproduced below:

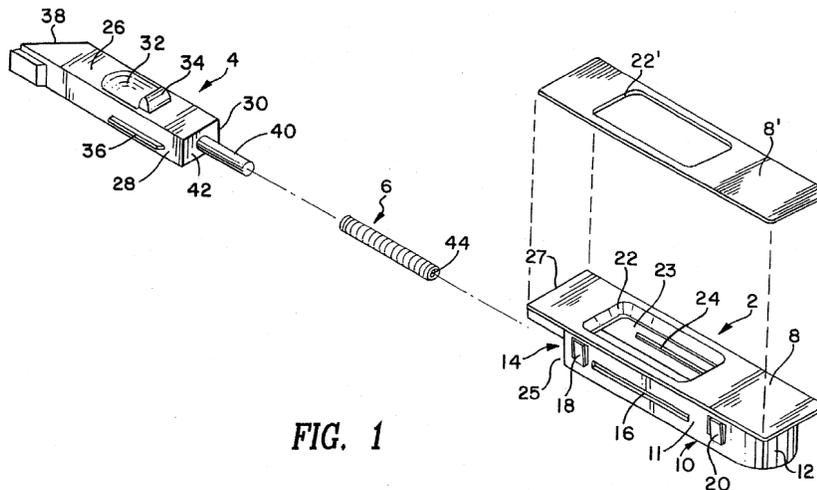


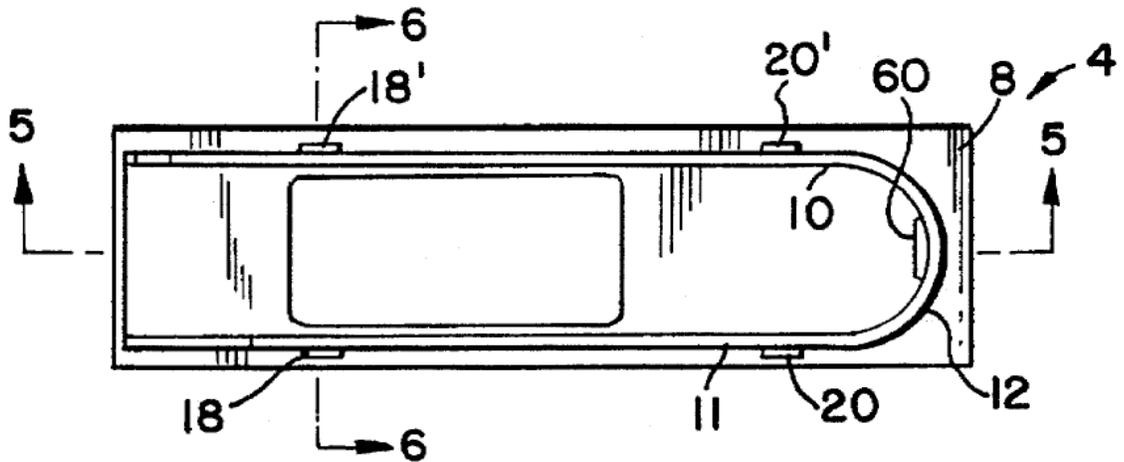
FIG. 1

9. Figure 1 of the '958 Original Patent is said to depict an exploded isometric view of a latch mechanism in accordance with Appellants' invention (col. 2, ll. 52-53).
10. In Figure 1 of the '958 Original Patent, the reference numerals are identified as follows: 38 cut bias end of bolt; 26 top of bolt; 32 fingerwell; 34 upwardly projecting knob; 4 bolt; 30 side wall of bolt; 40 post; 28 side wall of bolt; 36 elongated wing; 6 coiled compression spring; 44 end of spring; 22' aperture; 8'



end; 18 resilient tab; 16 slot; 20 tab; 10 dependent wall; 11 side wall; 36 wing; 50 top wall of sash; 48 elongated opening in sash; 56 and 56' edges; 51 opening; 46 hollow window sash; 54 outside wall; and 55 stile (col. 3, l. 58 to col. 4, l. 17).

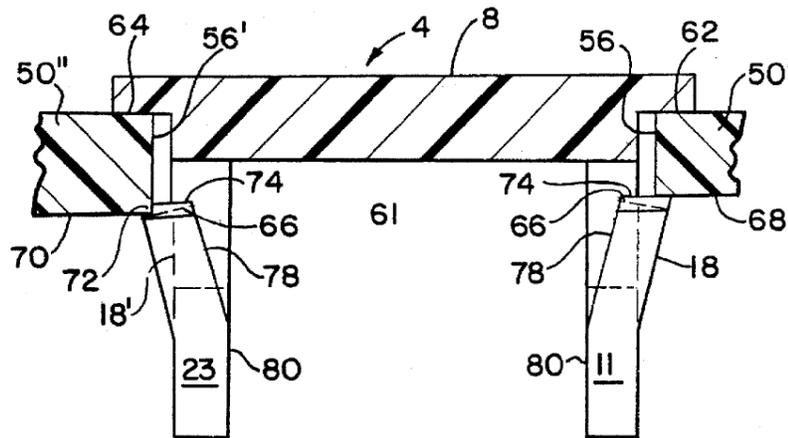
14. Figure 4 of the '958 Original Patent is reproduced below:



**FIG. 4**

15. Figure 4 of the '958 Original Patent is said to depict a bottom view of the housing of the latch mechanism, wherein the reference numerals are as follows: 4 housing; 18, 18', 20, 20' tabs; 11 wall; 60 cup-like formation; 8 top plate; and 12 end wall (col. 4, ll. 22-27).

16. Figure 6 of the '958 Original Patent is reproduced below:



**FIG. 6**

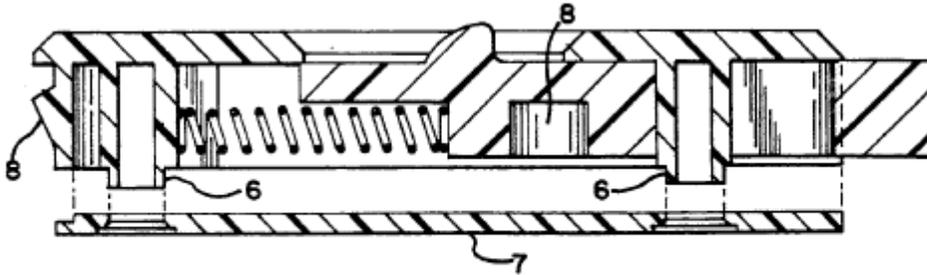
17. Figure 6 of the '958 Original Patent is said to depict transverse cross section 5,5 of the housing shown in Figure 4, wherein the reference numerals in Figure 6 are identified as follows: 50', 50'' top wall of the sash; 62, 64 outwardly extending ledge; 56, 56' edges of the opening in the top wall 50', 50''; 66 cylinder; 61 central section; 78 inner surfaces of the tabs; 68 bottom of the sash wall 50'; 70 under surface of the top wall 50''; 18, 18' tabs; 72 corner; and 11, 23 side walls (col. 4, ll. 28-67).
18. Appellants explain the function of the tabs 18, 18', 20, and 20' as follows (col. 3, l. 65 to col. 4, l. 9):

As the assembled mechanism is lowered, the tabs 18 and 20 as well as tabs 18' and 20' on the opposite wall...come in contact with the edges 56 and 56' respectively, and further lowering compresses them inwardly. With still further lowering, the tops of the tabs, such as 18, 20 and 18', 20' are below the edges 56 and 56' respectively so that they snap outwardly under it. The dimensions are such that when this occurs, the under side of the top plate 8 will be in contact with

the top wall 50 of the sash as indicated by a dashed line 57 so that the mechanism is tightly clamped into position by the resilient forces exerted by the tabs 18, 20 and 18', 20'.

#### THE SCHULTZ REFERENCE

19. Schultz describes a flush mounted pivot latch, said to be sold by Ro-Mai Industries, Inc., for insertion in a hollow top sash of a sash window (col. 1, ll. 51-54; Figure 5).
20. Schultz's Figure 5 is reproduced below:

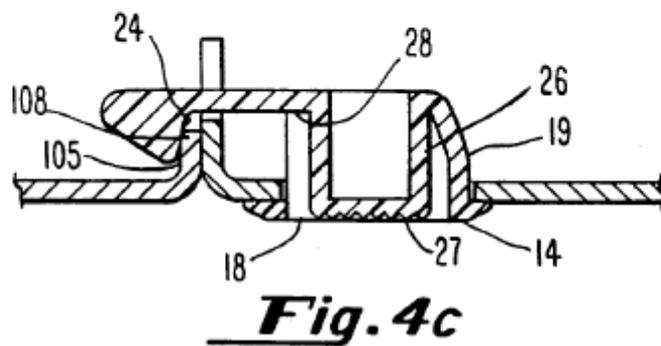
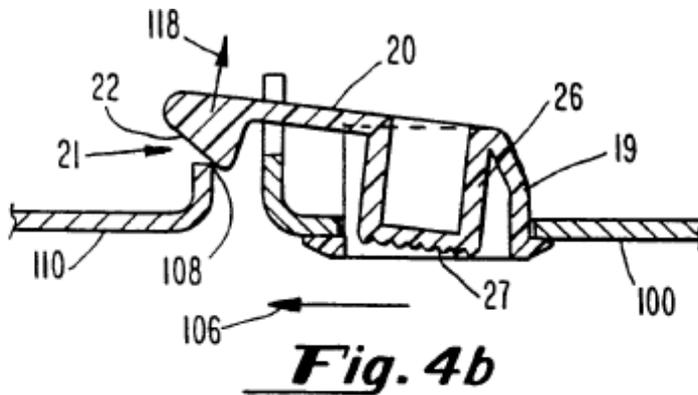


21. Schultz's Figure 5 is said to depict a sectional view of the prior art Ro-Mai pivot latch (col. 3, l. 7).
22. Schultz' Figure 5 shows that the Ro-Mai latch mechanism includes a housing with a top plate, a spring-biased bolt contained within the housing, tabs 8 flaring upwardly towards the top of the housing, and a pair of bosses 6 that engage base 7.
23. Schultz does not state that the tabs 8 of the Ro-Mai latch mechanism are "flexible" and have an "inner side surface" as required by appealed claim 11.

24. Schultz teaches that the Ro-Mai “pivot latch is installed in the top sash by pushing it downwardly into the respective top sash slot until the tabs retainingly catch the top sash” (col. 1, ll. 60-63).

#### THE SCHLACK REFERENCE

25. Schlack teaches that the latching devices “for latching sliding or hinging doors, panels or the like” (col. 1, ll. 6-8).
26. Schlack further discloses that the concepts disclosed in the reference can be applied by persons skilled in the art to other applications and that, for example, “instead of securing together two panels, the latch can be used to secure a door to some other stationary element, such as a frame member” (col. 4, ll. 33-42).
27. Schlack’s Figures 4b and 4c are reproduced below:



28. Schlack's Figure 4b is said depict a sectional plan view showing a flexible lower plate of a slam latch forced backwards as the panels are being latched together, while Figure 4c is said to depict a sectional plan view showing the slam latch in a latched position, wherein the reference numerals are identified as follows: 118 directional arrow; 20 flexible lower plate; 22 camming surface; 21 catch; 26 release means; 19 rear wall; 110 second panel; 108; edge of second panel; 27 upper surface of release means; 100 first panel; 106 directional arrow; 24 locking surface; 28 front surface of the lower plate (col. 3, l. 47 to col. 4, l. 19).
29. Referring to Figure 4b, Schlack teaches that "[t]he catch 21 is formed with a camming surface 22 which will contact and pass

over the edge 108 of the second panel 110, and force the *flexible lower plate 20* backwards, as the first panel 100 and second panel 110 are being *latched together...*” (emphases added; col. 3, ll. 54-59).

30. Schlack discloses that the latch “is easy to manufacture, and at low cost, and...can be provided in a one-piece assembly” (col. 2, ll. 18-21).

### PRINCIPLES OF LAW

On appeal to this Board, Appellants must show that the Examiner committed reversible error in finally rejecting the claims. *Cf. In re Kahn*, 441 F.3d 977, 985-986 (Fed. Cir. 2006)(“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”)(quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

“The reissue regulations...require an applicant to file an oath or declaration with an application.” *Nupla Corp. v. IXL Manufacturing Co., Inc.*, 114 F.3d 191, 193 (Fed. Cir. 1997). Specifically, 37 C.F.R. § 1.175(a) requires a reissue applicant to comply with the requirements of 37 C.F.R. § 1.63. In turn, 37 C.F.R. § 1.63(b)(2) provides that the oath or declaration must “[s]tate that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment *specifically referred to* in the oath or declaration” (emphasis added).

It is well settled that the United States Patent and Trademark Office (PTO) is obligated to give claim terms their broadest reasonable interpretation, taking into account any enlightenment by way of definitions or otherwise found in the specification. *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (“[T]he PTO must give claims their broadest reasonable construction consistent with the specification . . . . Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation.”); *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (“[T]he PTO gives a disputed claim term its broadest reasonable interpretation during patent prosecution.”).

This longstanding principle is based on the notion that “during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.” *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). That is, a patent applicant has the opportunity and responsibility to remove any ambiguity in claim term meaning by amending the application. “Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d at 322.

“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).

*KSR* reaffirms the analytical framework set out in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), which states that an objective obviousness

analysis includes: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. *KSR*, 127 S. Ct. at 1734. Secondary considerations such as commercial success, long felt but unsolved needs, or failure of others “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Id.* (quoting *Graham*, 383 U.S. at 17-18).

*KSR* disapproved a rigid approach to obviousness (*i.e.*, an analysis limited to lack of teaching, suggestion, or motivation). *KSR*, 127 S. Ct. at 1741 (“The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.”). See also *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006) (“Our suggestion test is in actuality quite flexible and not only permits, but requires, consideration of common knowledge and common sense”); *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1291 (Fed. Cir. 2006) (“There is flexibility in our obviousness jurisprudence because a motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires an actual teaching to combine...”).

*KSR* further instructs “that when a patent claims a structure already known in the prior art that is altered by mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR*, 127 S. Ct. at 1740.

“It is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced...” *In re Harza*, 274 F.2d 669, 671 (CCPA 1960).

## ANALYSIS

### I. DEFECTIVE REISSUE OATH OR DECLARATION

Appellants do not contest the Examiner’s finding that the Supplemental Reissue Declaration filed on January 23, 2006 states that the inventors “have reviewed and understand the contents of” an attached specification and an attached preliminary amendment (Facts 4-6; Ans. 9-10; App. Br. 21-22). It is also undisputed that no such specification or preliminary amendment was attached to the Supplemental Reissue Declaration (Fact 7; Ans. 9-10; App. Br. 21-22).

Appellants contend that the Examiner’s rejection is in error because no law, rule, or provision of the Manual of Patent Examining Procedure (MPEP) requires the attachment of the specification and preliminary amendment, which Appellants believe to have been previously submitted, to the Supplemental Reissue Declaration (App. Br. 21). According to Appellants, “such filing would greatly increase the amount of paper in the file...” (App. Br. 21-22). Nevertheless, Appellants offer to file a corrected submission should we “decide that it is necessary” (*id.*).

Appellants’ arguments are unpersuasive. 37 C.F.R. § 1.175(a), promulgated pursuant to the Director's rulemaking authority, requires a reissue applicant to comply with the requirements of 37 C.F.R. § 1.63. In turn, 37 C.F.R. § 1.63(b)(2) provides that the oath or declaration must “[s]tate that the person making the oath or declaration has reviewed and

understands the contents of the application, including the claims, as amended by any amendment *specifically referred to* in the oath or declaration” (emphasis added).

Contrary to the *sworn* statement in the Supplemental Reissue Declaration, no specification or preliminary amendment was attached (Fact 7). This inaccurate Declaration statement in and of itself renders the Declaration defective. Furthermore, Appellants do not direct us to anything in the record to support their belief that the “attached” specification and the preliminary amendment were in fact those submitted with the originally filed Declaration. Thus, the record is not clear as to what the Declarants meant when they specifically referred to an “attached” specification and preliminary amendment. This violates the regulations pertaining to a reissue oath or declaration.

For these reasons, we uphold the Examiner’s 35 U.S.C. § 251 rejection of claims 11-15.

## II. OBVIOUSNESS UNDER 35 U.S.C. § 103(a)

Appellants submit separate arguments for claims 11, 12, and 15, with one specific argument common to claims 11 and 12. Accordingly, we confine our discussion to claims 11 and 15, with the other claims (namely claims 12-14) standing or falling with claim 11. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants contend that the Examiner’s rejection is in error because: (1) “there is no motivation to combine Schultz and Schlack” and, therefore, the Examiner used impermissible hindsight reconstruction; and (2) “a tilt latch formed by combining the teachings of Schlack and Schultz may not

function properly” (App. Br. 18-19). These contentions do not demonstrate error.

Like Appellants’ latch mechanism of claim 11, the Ro-Mai latching device described in Figure 5 of Schultz includes a housing with a top plate, tabs 8 flaring upwardly towards the top of the housing, and a spring-biased bolt slidingly disposed within the side walls of the housing (Facts 8-24). Thus, the Ro-Mai device differs from Appellants’ claimed mechanism only in that the prior art does not explicitly disclose “flexible tabs...having an inner side surface” as required by claim 11 (Fact 23).

Nevertheless, we agree with the Examiner that a person having ordinary skill in the art would have found the claimed subject matter obvious in view of the applied prior art. The function of the upwardly flaring tabs 8 of the Ro-Mai device as described in Schultz is to latch one body (*i.e.*, the latch housing) to another (*i.e.*, the top sash) (Fact 24). In the same manner, Schlack’s flexible plate with a camming surface 22 and a catch 21 performs the same or similar function by latching one body to another (Facts 25-29). According to Schlack, the flexible latch described therein “is easy to manufacture...at low cost...and can be provided in a one-piece assembly” (Fact 30). Under these circumstances, a person having ordinary skill in the art would have found it obvious to substitute the tabs 8 of the Ro-Mai device with the flexible latch of Schlack with the reasonable expectation that these devices would be interchangeable and would perform the same or similar function in an entirely expected fashion. Appellants have not proven otherwise.

We find no merit in Appellants’ position that there is no motivation to combine the references. For one thing, *KSR* disapproved a rigid approach to

obviousness (*i.e.*, an analysis *limited to* lack of teaching, suggestion, or motivation). *KSR*, 127 S. Ct. at 1741 (“The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.”). Moreover, *KSR* further instructs “that when a patent claims a structure already known in the prior art that is altered by mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR*, 127 S. Ct. at 1740. Here, Appellants have not shown that the claimed mechanism is anything more than the combination of old elements that function in an entirely expected way. Those skilled in the art are entitled, and therefore are necessarily motivated, to use known elements for their known purpose. While Appellants point out that “Schultz states that the problem with the [Ro-Mai] latch shown in FIG. 5 is that the latch is too difficult to assemble and tends to disengage from the sash,” this would have been a compelling reason for one of ordinary skill in the art to modify the Ro-Mai device by applying the teachings of Schlack (App. Br. 18; Fact 30).

Appellants assert that “a tilt latch formed by combining the teachings of Schlack and Schultz may not function in a satisfactory manner, because the tongues may obstruct the movement of the latch bolt...” (App. Br. 19). But Appellants failed to direct us to any evidence or persuasive reasoning why a person having ordinary skill in the art would not have configured the flexible latch in the Ro-Mai device such that obstruction of the bolt is avoided.

Appellants also urge that the proposed combination of Schultz and Schlack does not disclose, teach, or suggest every element of claim 11

because the claim “includes, among other elements, ‘flexible tabs extending outwardly from the outer surface of each side wall and toward said top plate,’” referring to the four tabs shown in Figures 3 and 4 of the present application (App. Br. 20). We disagree. Claim 11 reads on only two flexible *tabs* total – *i.e.*, one on each side wall. Appellants had the opportunity and responsibility to remove any ambiguity in claim term meaning by amending the application. They chose not to do so. *In re Zletz*, 893 F.2d at 322 (“Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).

Even if we accept Appellants’ proposed claim construction, it does not alter our conclusion. A person having ordinary skill in the art would have had good reason to distribute multiple tabs along the length of each sidewall, including at each end of the sidewall, of the Ro-Mai device with the reasonable expectation of further securing the device in the sash window. *In re Harza*, 274 F.2d at 671 (“It is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced...”). Hence, Appellants have not shown error in the Examiner’s determination that a person having ordinary skill in the art would have found the subject matter of claims 11 or 15 obvious within the meaning of 35 U.S.C. § 103(a).

We have considered all the arguments, including those in the Reply Brief filed on November 26, 2007, but find them unpersuasive for reasons given above. *Cf. Hartman v. Nicholson*, 483 F.3d 1311, 1315 (Fed. Cir. 2007)(all remaining arguments were considered, but none were found that warrant reversal).

### CONCLUSION

On this record, we determine that Appellants have failed to demonstrate any error in the Examiner's determination that: (i) claims 11-15 fail to comply with the requirements of 35 U.S.C. § 251; and (ii) claims 11-15 are unpatentable over the combined teachings of Schlack and Schultz.

### DECISION

The Examiner's decision to reject appealed claims 11-15 is affirmed. 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).

AFFIRMED

tf/lr

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