

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM R. BOND

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Appeal No. 98-1193  
Application 08/448,687<sup>1</sup>

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ON BRIEF

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Before COHEN, MEISTER, and ABRAMS, Administrative Patent  
Judges.

ABRAMS, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner  
finally rejecting claims 1-14 and 74-90, which constitute all  
of the claims remaining of record in the application.

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<sup>1</sup> Application for patent filed May 24, 1995.

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The appellant's invention is directed to a multi-purpose positioning and fastening strap for use in the construction of buildings. The subject matter before us is illustrated by reference to claim 1 which, along with the other claims on appeal, has been reproduced in an appendix to the Appeal Brief.

**THE REFERENCES**

The references relied upon by the examiner to support the final rejection are:

Walker	4,811,489	Mar, 14,
1989		
Sobjack	5,161,345	Nov. 10,
1992		
Jansen	5,452,523	Sep. 26,
1995		
		(filed Mar. 11, 1994)

**THE REJECTION**

Claims 1-14 and 74-90 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sobjack in view of Jansen and Walker.

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The rejection is explained in the Examiner's Answer.

The arguments of the appellant in opposition to the positions taken by the examiner are set forth in the Brief and the Reply Brief.

#### OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellant as set forth in the Answer and the Briefs. The determinations we have made and the reasoning behind them are set forth below.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed

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invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). Claim 1 is directed to a positioning and fastening strap that is "elongated, flexible, durable and non-stretchable." As explained in the specification, the strap is provided with at least two sets of marks along its length, the purpose of this being to allow a single strap to be utilized to locate the position of different construction elements such as roof trusses and wall joists. As defined in claim 1, the strap comprises a flat surface having two sets of marks on one side, with each set extending inward from an opposite edge of the strap. Both sets of marks are "T-shaped" with each "T" forming a centerline that is perpendicular to its respective edge, and with the cross-bar being located inwardly from the edge. A key factor in the claim is the requirement of "said periodic

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marks of said another [second] set being at spaced intervals different from said periodic marks of said one [first] set."

The examiner finds in Sobjack all of the subject matter recited in claim 1 except for the double set of markings, the T-shaped configuration of the marks, and the different space intervals of the periodic marks of the two sets of marks. It is the examiner's position, however, that Jansen teaches providing a double set of differently spaced interval index markings placed on opposite edges of a tape, that Walker teaches the required T-shaped markings, and that it would have been obvious to one of ordinary skill in the art to combine the teachings of the three references in such a manner as to render the subject matter of claim 1 obvious. See Answer, pages 4 and 5. As can be expected, in the Brief the appellant takes issue with these conclusions, and provides a number of reasons why the rejection is defective. We find ourselves in agreement with the appellant.

Our quarrel with the examiner's position begins with the conclusion that combining the teachings of Sobjack and Jansen would have yielded the required two sets of markings having different spaced intervals. First of all, to the extent that

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Sobjack might appreciate the problem to which the appellant has directed his inventive efforts, this patent solves it by utilizing a plurality of straps, each having a single set of marks with different spaced intervals (columns 4 and 5). It is clear to us, from the disclosure, that the double point indicators shown in Figure 8 are but an alternative to the single point systems disclosed in the other embodiments (column 4, lines 40-43). Thus, from our perspective, Sobjack discloses but a single set of markings in the embodiment of Figure 8, with each mark consisting of a pair of transversely aligned indicators that are used to locate the pair of nails that will be used to secure the strap to the elements being erected. There is no teaching in Sobjack, express or implied, that a strap be provided with multiple sets of marks of differing spaced intervals so that a single strap can be used to position two different groups of structural members that require different intervals between them.

Jansen is directed to a strap for forming band clamps. Each clamp is provided with indicators so that the length of the band needed for a pipe having a particular diameter can easily be determined. The embodiment of Figure 7 shows these

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in the form of measuring scales along its opposite edges, in centimeters along one edge and in inches along the other. Therefore, Jansen does disclose two "sets" of marks along opposite edges of a strap and with each set having marks at spaced intervals different than the other. However, they are, in essence, merely duplicates of one another in different languages, and are not in the context of, or for the purpose of, the sets of marks in the claimed invention. Be that as it may, the mere fact that the prior art structure could be modified does not 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). Therefore, even considering, *arguendo*, Jansen to be analogous art, and evaluating its content in the most charitable manner, we fail to perceive any teaching, suggestion or incentive in these two references which would have led one of ordinary skill in the art to modify the Sobjack strap by spacing the indicator points 24c that are along one edge of the strap shown in Figure 8 at intervals different from those of the indicator points that are along the other edge. This deficiency is not alleviated by further

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considering the teachings of Walker, which the examiner cited with regard to the use of "T" shaped symbols.

For the reasons set forth above, we conclude that the combined teachings of the three applied references fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in claim 1, and we therefore will not sustain the rejection of claim 1 or, it follows, of claims 2-14 and 90, which depend therefrom.

Independent claim 74 sets forth the invention in somewhat different terms than did claim 1. However, it also includes the two sets of marks located along the opposite edges of the strap, with the periodic marks of one set being at intervals different than that of the other set. The rejection of this claim fails for the same reasons as were set out above with regard to claim 1 *et al.*, and we therefore will not sustain the rejection of claims 74-89.

**SUMMARY**

The rejection is not sustained.

The decision of the examiner is reversed.

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REVERSED

	Irwin Charles Cohen	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	James M. Meister	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	Neal E. Abrams	)	
	Administrative Patent Judge	)	

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