

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

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUBERT J. GAETKE

Appeal No. 2001-1453
Application No. 08/990,945

HEARD: October 9, 2001

Before CALVERT, ABRAMS, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 6-11. The remaining claims have been withdrawn by the examiner as being directed to a non-elected species of the invention (Paper No. 11).

We REVERSE.

BACKGROUND

The appellant's invention relates to a U-shaped clip adapted for retaining in a rolled-up configuration a portion of a collapsible container such as a tube of toothpaste. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

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

Robb	1,513,009	Oct. 28, 1924
Bright	2,986,793	Jun. 6, 1961
Brown	3,604,067	Sep. 14, 1971
Hand II <u>et al.</u> (Hand)	3,892,334	Jul. 1, 1975
Frantz	4,960,304	Oct. 2, 1990

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Brown.

Claims 1, 6 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robb in view of Frantz.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Robb in view of Frantz and Brown.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robb in view of Frantz and Bright.

Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robb in view of Frantz and Hand.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 17) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 16) and Reply Brief (Paper No. 19) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The Rejection Under Section 102

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The appellant's invention is directed to a U-shaped clip adapted for retaining a rolled-up configuration of a portion of a collapsible container that holds a quantity of a

product. According to claim 1, the sole independent claim, the U-shaped clip comprises “an inner layer of a resilient open-cell foam material” and a continuous outer layer of structural material to which the inner layer of foam material is bonded. The outer layer supports the inner layer and includes a pair of opposing, spaced-apart arms that are joined to each other by a juncture segment located at a base of the U-shaped clip. The foam material substantially fills a gap located between the opposing arms, which provides an opening adapted for admitting the rolled-up convoluted roll of a collapsible container, with the open-cell foam material “becoming juxtaposed with and compressing to conform to the convoluted roll.” In this regard, we point out that the appellant has explained in the specification that the open-cell foam material exhibits frictional properties which cause the inner layer not to stick to the resilient polymeric material conventionally used in collapsible containers such as toothpaste tubes, while providing sufficient friction so that the clip does not inadvertently slip off of the tube (paragraph bridging pages 10 and 11).

Brown discloses a paper clip comprising a folded metal strip 12 lined with a layer of “resilient and compressible backing, such as a foam or sponge cushion 14 secured to one surface thereof” (column 2, lines 27 and 28). To use the clip, papers are inserted between the legs which are then pressed together. The resiliency of the foam combined with the spring quality of the legs generates sufficient friction to hold the papers in the interior of the clip.

Among the arguments presented by the appellant in opposition to the examiner's position that Brown discloses all of the subject matter recited in claim 1 is that the reference fails to disclose that the foam is of the open-cell type, as is required by the claim, and therefore it cannot anticipate the subject matter of the claim. We agree, and thus we will not sustain the Section 102 rejection of independent claim 1 or, it follows, of claim 2, which depends therefrom.

The Rejections Under Section 103

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, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, 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 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).

The first of these rejections is that the subject matter recited in claim 1 would have been obvious to one of ordinary skill in the art in view of the combined teachings of Robb and Frantz. Robb discloses a clip intended to be used for securing the turned-over portion at the top of bed linens at the head end of a bed. It comprises a U-shaped metal spring clip 14 having a tip 16 of frictional material secured to one end of the clip (Figure 2) or, as an alternative, layers of frictional material 17 secured to the facing portions of both ends of the clip (Figure 4). The frictional material "may be of soft vulcanized rubber or of other frictional material such as suede leather" (page 1, lines 103-105). The examiner admits that Robb fails to disclose or teach the use of open-cell foam material, but takes the position that Frantz discloses that such "is an old and well-known engineering material" and it would have been obvious to one of ordinary skill in the art to modify the Robb clip by replacing the disclosed frictional material with open-cell foam "so that the clip may be light weight and may adequately engage the object placed between the clip arms" (Answer, page 4).

Frantz is directed to contour cushions for supporting a human body or a portion thereof in devices such as an immobilizing seat or a wheelchair. Each cushion is described as having a casing 24 which covers an inflatable cell that is encased in an open-cell high density foam material (columns 4 and 5). The open-cell foam provides the

desired cushioning effect, but does not function in such a manner as to frictionally engage an element inserted between layers thereof.

We do not agree with the examiner's conclusion that the teachings of these two references render claim 1 obvious, for two reasons. First, it is our view that Frantz is not analogous art, and thus is not properly combinable with Robb. The test for analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved (In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)), and a reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals (In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992)). Clearly, Frantz is not within the field of the appellant's endeavor, and we see no reason why this patent to seat cushions would logically have commended itself to the attention of an inventor who was attempting to solve the problem of frictionally holding a collapsible toothpaste tube in a spring clip.

Second, even assuming, arguendo, that Frantz can be considered to be analogous art, the mere fact that structure could be modified does not make such modifications obvious unless the prior art suggests the desirability thereof (In re Gordon 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)), and we fail to perceive any teaching,

incentive, or suggestion in either of these references that would have led one of ordinary skill in the art to combine them in the manner proposed by the examiner. The examiner's argument that the use of open-cell foam would make the Robb clip "light weight" is not persuasive because there is no reason to believe this would, even if true, improve or be advantageous to the Robb device; the examiner's opinion that such would cause the clip to "adequately engage" the object, which we shall assume is meant to suggest that the engagement of the clip with the object being held is improved, is not based upon any evidence, and therefore also is not persuasive. It appears to us that the only suggestion for modifying the Robb clip by replacing the disclosed frictional material with open-cell foam is found in the hindsight afforded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection under Section 103. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

It therefore is our conclusion that the combined teachings of Robb and Frantz fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claim 1. This being the case, we will not sustain the rejection of claims 1, 6 and 9.

The defects noted above with regard to the basic combination of Robb and Frantz are not cured by further consideration of Brown (added with regard to claim 2 for its teaching regarding the thickness of the foam material), of Bright (added with regard to

claims 7 and 8 for its teaching of clip arms having diverging outer ends), or of Hand (added with regard to claims 10 and 11 for its teaching of forming the structural material of thermoformable styrene). The other three rejections under Section 103 also are not sustained.

SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

IAN A. CALVERT
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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DECISION: REVERSED

Prepared By:

DRAFT TYPED: 28 Jun 02

FINAL TYPED: