

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW J. COLLINS

Appeal No. 1997-3087
Application 08/541,519¹

HEARD: August 4, 1999

Before MEISTER, STAAB and McQUADE, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 2, 4 and 5, all the claims currently pending in the application.

¹ Application for patent filed October 10, 1995.

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Appellant's invention pertains to an over-center toggle latch of the type where a door can be held closed by a predetermined, specific force, and in particular to an over-center toggle latch that incorporates an electronic switch that provides an electronic signal indicating whether the door to which the latch is attached is in an opened or closed position. Independent claim 1, a copy of which appears in an appendix to appellant's brief, is illustrative of the appealed subject matter.²

The prior art references relied upon by the examiner in support of the rejection are:

Guth	3,841,677	Oct. 15,
1974		
Bisbing	4,687,237	Aug. 18, 1987

Claims 1, 2, 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bisbing in view of Guth.

Considering first independent claim 1, the broadest claim on appeal, there is no dispute that Bisbing discloses an over-

²Consistent with appellant's specification, the term "said first guide member" appearing in claim 4, paragraph (e), should apparently be --said second guide member--. When queried on this point at oral hearing, counsel for appellant agreed. Accordingly, for purposes of this appeal, claim 4 is so interpreted.

center toggle latch that meets the limitations of paragraphs (a), (b), (c), (d), (g) and (h) of the claim. The examiner acknowledges that Bisbing fails to disclose the paragraph (e) limitation of a protruding tab disposed on the retaining means, the paragraph (f) limitation of a switch having a two-position actuator, and the paragraph (i) limitation of how the switch is actuated by the protruding tab on the retaining means. However, the examiner has taken the position that:

Guth teaches a protruding tab (switch actuator 44) disposed [on] the toggle mechanism for engagement with a toggle switch (50) having a two-position push button actuator.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bisbing as taught by Guth to provide a protruding tab on a reciprocating portion of a latch mechanism for physically actuating a microswitch corresponding to the relative position of the latch mechanism moving between an open and a closed position. [Answer, page 5.]

Concerning the specific placement of the protruding tab on the retaining means, the examiner further maintains that "it would have been an obvious matter of design choice to orient the protruding tab . . . on any reciprocating portion of the toggle latching mechanism to activate the micro-switch"

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(answer, page 11) because appellant

fails to . . . state both why it is necessary and of critical importance to have the micro-switch toggling protrusion on the lower portion of the retainer, and offers no explanation as to why the micro-switch toggling protrusion would not perform equally well if it were placed on any other reciprocating portion of the latch while engaging the micro-switch. [Answer, pages 10-11.]

While we are not unmindful of the points raised by the examiner in the answer, including those set forth above, in rejecting the appealed claims, we cannot support the positions taken by the examiner in concluding that appellant's claims are unpatentable under 35 U.S.C. § 103. Assuming as a general proposition that it would have been obvious in light of the teachings of Guth to provide a microswitch and actuator in Bisbing for the purpose of indicating the condition of the latch, the examiner's further position that the specifically claimed location of the protruding tab can be dismissed as an obvious matter of design choice is inappropriate. First, criticality is not a requirement for patentability under 35 U.S.C. § 103. *See, for example, W. L. Gore & Assocs. v.*

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Garlock, Inc., 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Second, the examiner's implied position that

the toggle latch will perform equally well irrespective of the placement of the protruding tab and microswitch is speculative. Third, the examiner has not adequately addressed appellant's argument in the paragraph spanning pages 9 and 10 of the brief concerning the alleged benefit of the claimed placement of the protruding tab.³ In this matter, appellant's argument regarding the benefits of the compactness and simplicity of design of the claimed structure is reasonable and cannot be ignored simply because the specification does not expressly attribute these benefits to the specifically claimed placement of the protruding tab on the retaining means. *Compare In re Chu*, 66 F.3d 292, 298, 36 USPQ2d 1089,

³These arguments mirror the benefits of simplicity of construction and use, reduced manufacturing costs, and simplicity of assembly asserted on pages 2 and 3 of the specification as flowing for the disclosed invention.

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1094 (Fed. Cir. 1995) (held, in case where examiner and Board alleged that difference between prior art and appealed claim was "design choice," that there is no basis supporting position that a patent applicant's evidence and/or argument traversing rejection must be contained within specification in order to be considered) and *In re Kuhle*, 526

F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975) (use of electrical connection which solves *no stated problem* in lieu of those used in the reference held to be obvious matter of design choice within the skill in the art). Fourth, the latch structure of Guth is much more complex and not at all like the toggle latch of Bisbing. For example, Guth's latch mechanism includes a lockout mechanism 46 for precluding manipulation of the pivoting latch bolt 40, 42 that has no counterpart in Bisbing. On the other hand, Bisbing's spring biased retaining means for supplying the over center biasing force for the toggle mechanism of the latch has no apparent equivalent in

Guth.⁴ The dissimilarity in construction and purpose of the latches of Guth and Bisbing undercuts the examiner's position that a structure containing all of the limitations of independent claim 1 would have been obvious to one of ordinary skill in the art from a consideration of the combined teachings of the applied references. Fifth, the switch actuator 44 of Guth that the examiner equates to the claimed

protruding tab is located on the pivoting latch bolt 42. Thus, at best, Guth would appear to suggest placing a switch actuating tab on Bisbing's latch-like toggle member 24 rather than on the retaining means 34.

Where prior art references require a selective combination to render obvious a claimed invention, there must be some reason for the combination other than hindsight gleaned from the invention disclosure, *Interconnect Planning*

⁴In Guth, the biasing force for the toggle mechanism is supplied by what appears to be a conventional helical spring 88. See Figures 1 and 2, and column 4, lines 1-8.

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Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). For the reasons stated above, we are unable to agree with the examiner that one of ordinary skill in the art would have been motivated by the teachings of Guth to incorporate a protruding tab into the retaining means 34 of Bisbing for actuating a microswitch. It follows that we cannot sustain the examiner's rejection.

The decision of the examiner is reversed.

REVERSED

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Administrative Patent Judge)	
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