

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(2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES S. STANFIELD

Appeal No. 97-3298
Application 08/349,426¹

ON BRIEF

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

¹Application for patent filed December 5, 1994. According to appellant, this application is a continuation-in-part of Application 08/058,450, filed May 7, 1993, now Patent No. 5,372,510.

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U.S.C. § 103 as being unpatentable over Bonfigli.

The rejection is explained in the Examiner's Answer.

The opposing viewpoints of the appellant 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. We also have recognized that the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references, rather, the test for obviousness is what the

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combined teachings of the references would have suggested to one of ordinary skill in the art (see *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)).

The sole reference cited against all of the claims is Bonfigli which, like the appellant's invention, is directed to a shoe tying instructional device. Bonfigli discloses a rectangular panel (12) upon which the outline of a shoe has been depicted, and upwards from which extends a pair of flaps (14, 16) provided with holes (30, 32) for receiving a shoe lace. Some directional landmarks are provided on the panel, in the form of three circles with the numerals 1, 2 and 3 inscribed therein. A tab (46) is provided beneath one of the

side flaps to hold down the center of a shoe lace before lacing is commenced.

The appellant has taken issue with only one of the aspects of the examiner's rejection of claim 1, and that is the shape of the marking on the device that represents the shoelace loop. The claim requires that the marking be "at least one line extending along a loop that is elongated rather than circular." Bonfigli does not explicitly disclose a marking which illustrates the claimed elongated loop. What Bonfigli teaches is that the user places a finger on the numeral "3," and then loops one lace around it to form one loop of a "bow" (column 2, lines 28-31). As illustrated in Figure 4a, the loop thus formed follows the line defining the circumference of the circle within which the numeral is located for a major portion of its length, whereupon it becomes elongated (Figure 4a).

We agree with the examiner that one of ordinary skill in the art would have found it obvious to additionally mark the Bonfigli device with an elongated loop to assist the user in forming the correct loop configuration. We arrive at this

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conclusion in view of the teaching in the reference that the shoe lace forms the loop of a bow, which in our view conventionally is considered to be elongated, as well as the depiction in Figure 4a of an elongated loop. Suggestion for this is found in the self-evident advantage of providing the most accurate directions possible to the user, and in the explicit use of markings by Bonfigli along which the laces are to be disposed (Fig. 1, markings 36 and 38).

A *prima facie* case of obviousness therefore is established with regard to the subject matter of claim 1, and we shall sustain the rejection of this claim.

Claim 3 adds to claim 1 the requirement that there be a holdown "lying substantially along said line" which marks the shoe lace loop. The reference discloses a holdown (46) located below the side flaps (column 2, lines 51 and 52). It is adjacent to the midpoint of the shoe lace, and its function is to hold the center portion of the lace in place under the side flaps, akin to the function of the holes in the appellant's device. It therefore does not meet the terms of the claim, for it does not lie along the line of the shoe lace

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loop, or anywhere near enough to be considered to be "substantially along" it.

In view of the above, we are of the opinion that a *prima facie* case of obviousness has not been established, and we will not sustain the rejection of claim 3.

Claim 6 adds to claim 1 the requirement that the first and second ends of the shoe lace be of different colors, and the marking be of the same color as the first end. We agree with the examiner that this would have been obvious, suggestion being found in the teaching of Bonfigli of using color matching between the shoe lace and other components of the device to enhance its teaching function (column 2, lines 1-12). The rejection of this claim is sustained.

Independent claim 7 sets forth a shoe device and shoe lace combination comprising a plate having a front portion with a rounded perimeter and largely parallel sides lying rearwardly thereof to represent the outline of a child's shoe as seen in plan view, and which is marked in the front to represent the front portion of a shoe. The Bonfigli device comprises a rectangular plate upon which the outline of a shoe

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is depicted. Thus, its perimeter is not in conformity with the language of the claim. The examiner is of the view that it would have been obvious to cut away non-essential portions of the plate, leaving the shoe as an outline of the perimeter. However, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to make such a modification, especially in view of the fact that the patentee contemplates using the device as an insert in a rectangular shoe box top (Figure 7).

A *prima facie* case of obviousness has not been established with regard to claim 7, and we therefore will not sustain the rejection. It follows that the rejection of claims 8 and 9, which depend from claim 7, also cannot be sustained.

The holdown that we decided above with regard to claim 3 is not taught by Bonfigli also is recited in independent claim 11. We therefore will not sustain the rejection of claim 11 or dependent claims 13 and 14.

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SUMMARY

The rejection of claims 1 and 6 is sustained.

The rejection of claims 3, 7-9, 11, 13 and 14 is not sustained.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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