

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES W. SHIEK, SR.

Appeal No. 1999-0266
Application No. 08/290,678¹

ON BRIEF

Before CALVERT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3, 6, 7, 9 to 13 and 18 to 20, which are all of the claims pending in this application.

¹ Application for patent filed August 15, 1994. According to the appellant, the application is a continuation of Application No. 08/023,300, filed February 26, 1993, now abandoned, which was a continuation of Application No. 07/728,742, filed July 12, 1991, now abandoned.

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We REVERSE.

BACKGROUND

The appellant's invention relates to a support and utility belt. An understanding of the invention can be derived from a reading of exemplary claim 9, 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:

Welsand 1926	1,600,027	Sep. 14,
Creper 1940	2,185,834	Jan. 2,
Schrieber 4, 1962	3,052,236	Sep.
Taigen 1990	4,964,401	Oct. 23,

The appealed claims stand finally rejected on the following grounds:

(1) Claims 3, 7, 9 to 11, 13 and 18 to 20 under 35 U.S.C. § 103 as being unpatentable over Taigen in view of Creper or Schrieber; and

(2) Claims 6 and 12 under 35 U.S.C. § 103 as being unpatentable over Taigen in view of Creper or Schrieber, and further in view of Welsand.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 25, mailed May 12, 1996) and the examiner's answer (Paper No. 28, mailed November 18, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 27, filed September 23, 1996) 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, to the second declaration of John Schiek dated March 26, 1996 (attached to Paper No. 23, filed March 29, 1996) and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our

conclusion that the examiner has not established obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejections under 35 U.S.C. § 103. Our reasoning for this determination follows.

The evidence of nonobviousness submitted by the appellant must be considered en route to a determination of obviousness/nonobviousness under 35 U.S.C. § 103. See Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Accordingly, we must carefully evaluate both the combined teachings of the applied prior art and the objective evidence of nonobviousness supplied by the appellant. See In re Oetiker, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

The teachings of the applied prior art relied upon by the examiner as establishing obviousness of the claimed invention are set forth on pages 2-4 of the final rejection which we incorporate by reference.

Although the appellant argues that Creper or Schreiber would not have suggested the modification of Taigen as set forth by the examiner (final rejection, pp. 2-4), we do not agree. Creper teaches that his belt is provided with reduced side sections to accommodate the belt to movement of the wearer (column 2, lines 10-17). Schreiber teaches that his belt is provided with reduced side portions to embrace the sides of the wearer and provide a comfortable conformation to the body contours (column 3, lines 25-28). In view of the teaching of either Creper or Schreiber, we consider that it would have been prima facie obvious to one of ordinary skill to have made the belt of Taigen with reduced side sections in order to better fit the wearer as suggested and taught by either Creper or Schreiber.

Having determined that a prima facie case of obviousness has been established, we now evaluate the evidence directed to secondary considerations to determine whether it is sufficient to rebut the prima facie case. In re Piasecki, supra.

The objective evidence of nonobviousness supplied by the appellant² establishes the following: (1) Commercial Success as set forth in paragraphs 2-15 of the second declaration of John Schiek; (2) Copying by the appellant's competitors as set forth in paragraphs 16-20 of the second declaration of John Schiek; and (3) Customer and expert response as set forth in paragraph 21 of the second declaration of John Schiek.

It is well settled that, to consider objective evidence of nonobviousness, the appellant has the burden of showing that there is a nexus, i.e., a legally and factually significant connection, between the proven success and the claimed invention. In re Paulsen, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994). We consider that appellant has carried that burden here. The invention in issue is a relatively simple one, involving a support belt which is conventional except for the presence of reduced side

² As to this objective evidence of nonobviousness the examiner states (answer, p. 6) that she "finds no faults with the secondary evidence presented."

sections. Since the support belt does not appear to include any feature distinguishing it from conventional support belts other than the claimed reduced side sections, it seems evident that the claimed invention was the reason for the commercial success and copying of the invention set forth in the second declaration of John Schiek, in other words, that there was a nexus between the claimed invention and the commercial success and copying of the appellant's support belt.

Accordingly, we conclude that the evidence of secondary considerations submitted by the appellant is sufficient to overcome the prima facie case of obviousness as to the claimed subject matter. Rejections (1) and (2) will therefore not be sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 3, 6, 7, 9 to 13 and 18 to 20 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/290,678

APJ NASE

APJ CALVERT

APJ McQUADE

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 03 Jun 99

FINAL TYPED: