

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS E. VALIULIS

Appeal No. 2000-1665
Application 08/752,529

HEARD August 14, 2001

Before ABRAMS, FRANKFORT, and PATE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4 through 8, 12 through 17, 19 through 32 and 35. Claims 9, 33 and 34 stand withdrawn from consideration as being directed to a non-elected species.

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Claims 3, 10, 11 and 18 have been canceled.¹

Appellant's invention relates to merchandise hangers such as so-called "Pegboard" hooks or "scanning hooks" like that seen in Figures 1 and 2 of the application drawings and to a method of maintaining current merchandising labels in association with merchandise being marketed from such hooks by providing the label supporting surface (28 in Fig. 2) of the hook with a release element or release layer that permits easy removal and replacement of adhesive merchandising labels. As indicated in the paragraph bridging pages 3 and 4 of the specification

A release layer, such as a thin coating of a silicone material, is provided on the outer surface of the label panel. This release layer adherently retains and supports an adhesively coated label that is pressed onto that surface and will readily release such a label, i.e. will permit the label to be peeled off cleanly with little effort, normally without tearing or splitting the label or leaving any residue therefrom on the label panel surface. Thereby labels applied to the label panel are exposed outwardly relative to the arm for viewing by customers who pass by the display. The labels also are readily removable and replaceable, as well as

¹ Decided concurrently herewith is the appeal in appellant's copending application S.N. 08/754,245, filed November 20, 1996 (Appeal No. 2000-1666).

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exchangeable, by merchandising personnel as the facts and circumstances to be displayed change from time to time.

Claims 1 and 23 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner as evidence of obviousness of the claimed subject matter are:

Thalenfeld et al. (Thalenfeld)	4,718,626	Jan. 12, 1988
Petrou	5,628,858	May 13, 1997
		(filed May 18,

1995)

As indicated in the seven rejections set forth on pages 4-9 of the examiner's answer, the claims before us on appeal stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over various claims of copending Application No. 08/940,859 taken further in view of Thalenfeld and Petrou, or

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Thalenfeld alone.

Claims 1, 2, 4 through 8, 12 through 17, 19 through 32 and 35 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thalenfeld in view of Petrou. In this regard, the examiner is of the view that Thalenfeld shows the invention as claimed except for the fact that this reference lacks a release layer between the label (60, col. 6, line 59 - col. 7, line 6) and the label support surface (40). To address this limitation, the examiner turns to Petrou, noting, *inter alia*, that

Petrou teaches the use of a release layer (Fig. 2) which is attached to a support surface 16, which has a release value which is less than the release value of the surface 16 (Petrou: Col. 1, lines 43-55). It would have been obvious to a person having ordinary skill in the art at the time of Appellant's invention to modify the support surface [40 of Thalenfeld] to have a release layer between the label and the label support surface in view of Petrou in order to provide a means of using inexpensive permanent pressure sensitive labels on a surface in which the labels are changed frequently (Petrou: Col 2, lines 56-65). (answer, page 10).

Reference is made to the examiner's answer (Paper No. 28) for the examiner's reasoning in support of the above-noted

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rejections and to the main and reply briefs (Paper Nos. 27 and 29) for appellant's arguments thereagainst.

OPINION

In arriving at our decision on the obviousness issues raised in this appeal, we have given careful consideration to the entire record of appellant's application, including the specification and claims, the teachings of the applied prior art references, the evidence of non-obviousness supplied by appellant, and the respective positions advanced by appellant and the examiner. Upon evaluation of the reference evidence before us, it is our initial conclusion that the examiner has established a prima facie case of obviousness with regard to claims 1, 2, 4 through 8, 12 through 17, 19 through 32 and 35 on appeal based on the combined teachings of Thalenfeld and Petrou. However, it is our further conclusion, after consideration of all of the evidence before us, that appellant's objective evidence of non-obviousness outweighs the evidence of obviousness presented by the examiner, and,

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accordingly, that the subject matter set forth in claims 1, 2, 4 through 8, 12 through 17, 19 through 32 and 35 would not have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 at the time appellant's invention was made. Our reasoning for these determinations follows.

Looking first to the examiner's seven rejections based on provisional obviousness-type double patenting, we note that appellant (brief, pages 2-3) has erroneously characterized these rejections as being "moot at this time," because the claims of Application No. 08/940,859 were not yet allowed. Accordingly, appellant has merely urged that these rejections "will be dealt with in whichever of the applications is appropriate in due course." In response, the examiner has remained silent in the answer and has not challenged appellant in any way on this characterization of the double patenting rejections. Unfortunately, the problem has arisen that Application No. 08/940,859 was issued as U.S. Patent No. 6,145,231 on Nov. 14, 2000. Thus, one or more of the

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examiner's obviousness-type double patenting rejections may no longer be valid and, at the very least, the double patenting rejections would no longer be provisional. Neither appellant nor the examiner has addressed these possibilities.

Accordingly, we REMAND this application back to the examiner for consideration of the obviousness-type double patenting rejections now that the application (08/940,859) relied upon therein has issued as a U.S. patent.

Regarding the examiner's rejection of claims 1, 2, 4 through 8, 12 through 17, 19 through 32 and 35 under 35 U.S.C. § 103(a) based on Thalenfeld and Petrou, we have reviewed the applied references and agree with the examiner that one of ordinary skill in the labeling art would have found it prima facie obvious to employ the release layer labeling approach disclosed in Petrou in association with the merchandise holder and adhesive label of Thalenfeld so as to gain the advantages discussed in Petrou at column 1, lines 36-58, and set forth in claims 4 and 5 of Petrou.

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Having arrived at the conclusion that the evidence of obviousness as applied by the examiner in the rejection of claims 1, 2, 4 through 8, 12 through 17, 19 through 32 and 35 is sufficient to establish a prima facie case of obviousness, we also recognize that evidence of secondary considerations, such as that presented by appellant in this application must be considered and weighed in route to a determination of obviousness/nonobviousness under 35 U.S.C. § 103. Accordingly, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating and weighing both the evidence relied upon by the examiner and the objective evidence of nonobviousness provided by appellant. See Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) and In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Appellant has submitted five declarations, i.e., from Stanley C. Valiulis, Robert W. Harrell, Carol Hopson, Theodore J. Stipanovich, and Frank N. Shope. According to the examiner (answer, page 13), those declarations are of little weight

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because 1) there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long; and 2) there is no showing that persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references (Thalenfeld and Petrou) and still were unable to solve the problem.

On the whole, we find that the evidence submitted by appellant demonstrates the existence of a labeling problem associated with merchandising display supports recognized in the merchandising industry for a long period of time and also that efforts have been made, for many years, by those who design and sell such merchandising supports, as well as by those who use such supports, to solve this labeling problem, without any satisfactory success. See paragraphs 3-6, 11 and 12 of the Valiulis declaration; paragraphs 2-5 of the Harrell declaration; and paragraphs 2-4 of the Hopson, Stipanovich, and Shope declarations. In addition, we find from the evidence submitted by appellant that those skilled in the art of merchandising supports and labeling for such supports have

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found appellant's claimed invention to be a solution to the labeling problem and, thus, to satisfy the long-felt need. See paragraphs 13-26 of the Valiulis declaration; paragraphs 6-8 of the Harrell declaration; paragraphs 5-10 of the Hopson declaration; paragraphs 5-7 of the Stipanovich declaration; and paragraphs 5 and 6 of the Shope declaration. In this regard, we agree with appellant's arguments put forth on pages 25-28 and 39-42 of the brief and on pages 5-6 of the reply brief. More particularly, we agree with appellant (brief, pages 40-42) that the examiner's reasons, set forth above, for not giving the declaration evidence adequate weight are without foundation (factually or legally) and are therefore unpersuasive.

Thus, we have now carefully considered all of the evidence of nonobviousness supplied by appellant, and weighed that evidence along with the evidence of obviousness relied upon by the examiner. As a result of our considerations, we reach the conclusion that appellant's invention as set forth in claims 1, 2, 4 through 8, 12 through 17, 19 through 32 and

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35 on appeal would not have been obvious to the person of ordinary skill in the art within the meaning of 35 U.S.C. 103. The evidence of nonobviousness taken as a whole, in our view, clearly outweighs the evidence of obviousness relied upon by the examiner.

In summary:

The examiner's rejection of claims 1, 2, 4 through 8, 12 through 17, 19 through 32 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Thalenfeld in view of Petrou is not sustained.

As for the double patenting rejections, we REMAND this application back to the examiner to reconsider the provisional nature of the obviousness-type double patenting rejections now that the application (08/940,859) relied upon in those

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rejections has issued as a U.S. patent.

The decision of the examiner on the sole issue ripe for appeal (i.e., the rejection of claims 1, 2, 4 through 8, 12 through 17, 19 through 32 and 35 under 35 U.S.C. § 103) is, accordingly, reversed.

REVERSED AND REMANDED

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