

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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD J. HATTON

Appeal No. 2004-1053
Application No. 09/772,409

ON BRIEF

Before WARREN, WALTZ, and TIMM, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 29, which are the only claims pending in this application.¹ We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a hanging device 20 comprising a strip 40 and a pressure sensitive adhesive

¹Appellant submitted a minor amendment with the Brief that corrected the dependency of claim 19 (Brief, page 2, Section III; see the amendment dated Mar. 4, 2003, Paper No. 11 ½). This amendment has been entered by the examiner (Answer, page 3, ¶(4)).

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42, where the strip 40 has two end tab portions 44 and 46 and a neck portion 48 connecting the two tab portions (Brief, page 5). The adhesive layer 42 is located on the end tab portions 44 and 46 so that the strip 40 can be folded at the neck portion 48 and the tab portions applied to opposite sides of the signage item (*id.*). Appellant asserts that the invention provides a hanging device that can be made with a shortened neck portion, without adhesive on the neck portion, and/or without the use of foam adhesive (*id.*).

Appellant states that the claims do not stand or fall together and lists various groups on page 10 of the Brief. To the extent the groups of claims have been separately argued, we consider these claims separately. See 37 CFR § 1.192(c)(7)(2000) and *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Representative independent claim 1 is reproduced below:

1. A hanging device for folded attachment to an item to be suspended or tied down, said device comprising a strip and an adhesive;

the strip comprising two outer tab portions and a neck portion therebetween;

the adhesive being located on an inner surface of the tab portions so that the strip can be folded at the neck portion and the tab portions can be applied to opposite sides of the item; and

wherein the strip is made from a polymer and has thickness between about 3 mil and about 20 mil.

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The examiner has relied upon the following references as evidence of obviousness:

Hatton	5,378,515	Jan. 03, 1995
Hamerski et al. (Hamerski)	6,120,867	Sep. 19, 2000

Claims 1, 6, 12 and 16-24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hatton (Answer, page 5).² Claims 2-4, 7, 8, 10, 11, 13-15, 25, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hatton (*id.*). Claims 5, 9, 26 and 29 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hatton in view of Hamerski (Answer, page 7).³ We *affirm* all of the examiner's rejections on appeal essentially for the reasons stated in the Answer and those reasons set forth below.

OPINION

A. The Rejections over Hatton alone

For purposes of judicial economy, we will discuss the first two listed rejections together, since the same statutory basis

²We note that the examiner erroneously stated this rejection as based on section 102(b) in the final Office action, even though section 103(a) is quoted before this rejection (Paper No. 9, page 2). However, we hold this error harmless as appellant has correctly stated and argued this rejection as based on section 103(a) (Brief, pages 10-11) and the examiner has correctly stated the rejection on page 5 of the Answer.

³The final rejection of claim 12 over Conway in view of Hatton has been withdrawn by the examiner (Answer, page 3).

(section 103(a)) and reference (Hatton) is employed in each separate rejection.

With regard to claim 1 on appeal, the examiner finds that Hatton discloses a polymer strip with two tab portions, an adhesive on the inner surfaces of the tab portions, and a neck portion (Answer, page 5). The examiner recognizes that Hatton does not specifically teach a polymer strip having a thickness between about 3 and about 20 mil (*id.*), although Hatton teaches that the use of "thin sheets" was known in the art (Answer, page 8). However, the examiner concludes that it would have been obvious to one of ordinary skill in this art at the time the invention was made to have made the strip of various polymers with varying thicknesses (*id.*). We agree.

Appellant argues that the hanging devices in Hatton addressed the "gravitational strain" by using relatively thick (e.g., about 23 mil) high density polyethylene strip material, and thus there would be no motivation to decrease the thickness of the prior art hanging device (Brief, page 11). This argument is not well taken for several reasons. First, as noted by the examiner (Answer, page 8), Hatton does not disclose or suggest that the thickness of the strip is about 23 mil. Accordingly, appellant's argument is not directed to any reference disclosure. Secondly, Hatton teaches

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that the prior art tabs are "typically made from thin sheets of flexible plastic material" (col. 1, ll. 17-18) and gives examples of "thin flexible sheets" (col. 4, l. 9). Even assuming *arguendo* that Hatton discloses a strip material thickness of "about 23 mil," this thickness is sufficiently similar to the upper claimed range of strip material thickness ("about 20 mil") that one of ordinary skill in this art would have expected similar results. See *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781, 227 USPQ 773, 779 (Fed. Cir. 1985). Third, we note that even for thicknesses less than "about 20 mil" (see claims 4, 8, 10 and 11), the optimization of the thickness necessary to support the banner or sign, in conjunction with the strength of the plastic, would have been well within the ordinary skill in this art as a "result-effective variable." See *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Furthermore, Hatton teaches that any plastic material can be used as a strip material "provided it has sufficient flexibility to be folded over ... and has sufficient tensile strength to support the desired banner...." Col. 4, ll. 4-8. Hatton also teaches that it is desirable to use stronger plastic material in a tab (col. 1, ll. 45-51). Therefore we agree with the examiner that the selection of the strip material would also be well within the ordinary skill in this art, depending

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on the strength and flexibility desired (see claims 2, 3 and 7 on appeal).

Appellant argues that claim 12 requires the inner surface of the neck portion to be free from adhesive while Hatton requires the adhesive be on the neck portion to allow adjacent portions of the neck to "snap lock" together (Brief, page 12; Reply Brief, page 2). This argument is not persuasive. As noted by the examiner (Answer, pages 9-10), Hatton teaches that it was well known in the art to have a neck portion without adhesive (see prior art Figure 5 and col. 1, ll. 56-59 and 65-67), and only teaches "one embodiment" where the neck is covered at least in part by adhesive to create the "snap lock" feature (col. 5, ll. 5-20 and 42-49). Therefore we agree with the examiner that it would have been well within the ordinary skill in this art to use adhesive on part, all or none of the neck portion of the hanging device, depending on the bond desired, the strength of the tab portions, and the banner or sign that must be supported.

Appellant argues that claim 13 recites that the length of the neck portion is less than 40% of the length of the strip while the Hatton patent specifically uses a "long neck" to counteract the memory forces that otherwise cause the end portions to pull away from the banner (Brief, paragraph bridging pages 12-13; Reply

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Brief, paragraph bridging pages 3-4). This argument is not persuasive since, as noted by the examiner (Answer, page 11), Hatton teaches that such a reduced length neck portion was known in this art (see Figure 1). Therefore we agree with the examiner that it would have been well within the ordinary skill in this art to use any reduced length for the neck portion in Hatton as long as the rope 40 (Figure 5) or string 182 (Figures 10-12) could go through the folded neck portion and the neck has sufficient strength to display the sign or banner. We note that with holes 29 or 166 (see Figures 1 and 7 of Hatton) used to display the sign or banner (as per appellant's Figures 2A and 6A-6D), the neck length is immaterial.

With regard to claims 14, 15, 27 and 28, appellant argues that neither the examiner nor the cited prior art has offered any suggestion that the tab shape should be changed (Brief, page 13; Reply Brief, page 4). This argument is not persuasive. As noted by the examiner (Answer, page 11), Hatton teaches various shapes for the tab portions (for the prior art and the Hatton invention - see Figures 1 and 6). Furthermore, Hatton teaches that the shapes of the corner tabs should be arranged to manufacture a plurality of tabs with a minimum of waste material (col. 4, ll. 37-55; Figure 9). Thus, absent a showing of criticality, we agree with the

examiner that the shape of any individual tab strip would have been well within the ordinary skill in this art.

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Accordingly, we affirm the examiner's rejections under 35 U.S.C. § 103(a) over Hatton.

B. The Rejection over Hatton in view of Hamerski

The examiner makes the same findings as discussed above regarding Hatton but recognizes that Hatton does not teach a non-foam adhesive (Answer, page 7).⁴ The examiner finds that Hamerski teaches a hanging device for folded attachment using a non-foam adhesive as an alternative to the foam adhesive of Hatton (*id.*). From these findings, the examiner concludes that it would have been

⁴The examiner also finds that, with regard to claims 16 and 29, Hatton does not teach that adhesive is located on the outer tab surface and applies Hamerski for a teaching of this feature (Answer, page 7). Appellant does not present any specific, substantive arguments regarding claim 29 (see the Brief and Reply Brief in their entirety). Accordingly, we do not consider this claim separately. See 37 CFR § 1.192(c)(7)(2000).

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obvious for one of ordinary skill in this art to have used the adhesive of Hamerski for the foam adhesive of Hatton with the expectation of similar results (*id.*).

Appellant argues that the foam adhesive taught by Hatton serves a very express objective, namely to absorb the shear stress by deflection, and therefore one of ordinary skill in this art would not have been motivated to replace the foam adhesive of Hatton (Brief, page 14; Reply Brief, page 5). This argument is not well taken since, as noted by the examiner (Answer, sentence bridging pages 12-13), Hatton does not teach that memory forces are such an issue in every application of the invention that a foam adhesive must be employed. We note that Hatton teaches, in one embodiment (Figures 6A and 8A), that a single adhesive layer 162 may be used and this adhesive is preferably a pressure-sensitive adhesive (col. 3, ll. 54-64 and col. 4, ll. 13-17). We also note that appellant discloses that the present invention provides a hanging device comprising a strip and a pressure sensitive adhesive (specification, page 3, ll. 25-26). Therefore we determine no difference between the adhesive taught by Hatton and the adhesive used in the claimed hanging device. Even assuming *arguendo* a difference in adhesives, we agree with the examiner that the use of a different adhesive to achieve the same result in a hanging device

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would have been well within the ordinary skill in this art, as taught by Hamerski.

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a *prima facie* case of obviousness based on the reference evidence. Based on the totality of the record, including due consideration of appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Accordingly, the examiner's rejection under section 103(a) over Hatton in view of Hamerski is affirmed.

C. Conclusion

The decision of the examiner is affirmed.

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

AFFIRMED

CHARLES R. WARREN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
CATHERINE TIMM)	
Administrative Patent Judge)	

TAW/jrg

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Renner, Otto, Boisselle, & Sklar, L.L.P.
19th Floor
1621 Euclid Avenue
Cleveland, OH 44115