

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(2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY C. VALIULIS

Appeal No. 1997-4213
Application 08/359,407¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS
and GONZALES, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner
finally rejecting claims 1-5, which constitute all of the
claims of record in the application.

¹ Application for patent filed December 20 1994.

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The appellant's invention is directed to a molded plastic hanger. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Fearing 1938	2,109,213	Feb. 22,
O'Brien 1987	4,671,417	Jun. 9,
Brozak 1995	5,439,120	Aug. 8,

(filed May 4, 1993)

THE REJECTION

Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over O'Brien in view of Brozak and Fearing.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejection, we make reference to the Examiner's Answer (Paper No. 12) for the reasoning in support of the rejections, and to the appellant's Briefs (Paper Nos. 11 and 13), for the arguments in opposition thereto.

OPINION

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The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, ***Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The appellant's invention is directed to a plastic hanger adapted to be mounted onto a display unit to support a plurality of articles. A hanger of this type comprises a clip for mounting the hanger onto an edge portion of the display panel and a forwardly extending arm upon which the articles to

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be displayed are carried. According to the appellant, if too much weight is placed on the arm, the clip will tend to slip upwardly and off of the edge of the display panel, or the clip may be knocked off of this edge if it is accidentally bumped (specification, page 1). The objective of the appellants' invention is to solve this problem. As manifested in claim 1, the invention comprises a clip having a slot to receive an edge portion of a paperboard panel, an integrally molded arm extending from the clip for carrying the articles, and an integrally molded tooth projecting from the clip, the tooth having a relatively sharp end portion adapted to bite into the edge portion so as to resist removal of the clip from the edge portion and having an inclined surface adapted to slidably engage the edge portion when the clip is being slipped onto the edge portion.

The appealed claims stand rejected as being unpatentable over the combined teachings of O'Brien, Brozak and Fearing. O'Brien discloses a hanger that can be of molded plastic (column 4, lines 42-44). It is adapted to engage the edge of an aperture in a display panel by means of a clip, and to hold articles for display on an integrally molded arm. O'Brien

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also is concerned about the problem of inadvertent disengagement of the hanger from the edge portion of the display (column 3, lines 11-17). This is prevented by providing a portion (30) of the front face of the clip that extends upwardly immediately above the upper edge of the aperture through which it extends "to resist upward-acting forces exerted upon it without being dislodged from mounting aperture 46" (column 4, lines 25-32; Figure 2). Insofar as the requirements of claim 1 are concerned, O'Brien fails to disclose or teach an integrally molded tooth projecting from the clip to resist removal of the clip from the support edge.

Brozak is directed to a display system in which a metal support arm is mounted on a U-shaped metal clip that is positioned downwardly upon a metal mounting bar. As best shown in Figure 3, the clip is provided with an inwardly oriented projection (33) which, after the clip is installed on the bar, is located beneath the lower edge of the bar and provides resistance to dislodgement of the clip from the bar. The subject of the Fearing reference is a clip for holding wires, pipes or the like in position along the edge of a support. Prongs are provided on the inside of the clip to

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"dig" into the support to prevent the clip from jarring loose
"as friction alone will not work satisfactorily when a clip is
used on a moving support" (column 2, lines 10-14).

It is the examiner's position that it would have been
obvious to one of ordinary skill in the art to provide the
clip of O'Brien with a projection, as shown by Brozak, "to
better secure the clip," and that the type of clip "can be a
matter of engineering choice; for example it could be a tooth
as shown by Fearing if a stronger securing means were desired"
(Answer, page 4). We do not agree.

Our rationale for arriving at this conclusion begins
with the recognition that the mere fact that the prior art
structure could be modified does not make such a modification
obvious unless the prior art suggests the desirability of
doing so. See **In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125,
1127 (Fed. Cir. 1984). We fail to perceive any teaching,
suggestion or incentive which would have led one of ordinary
skill in the art to modify the O'Brien device in the manner
proposed by the examiner. The primary reason for this is that
O'Brien has recognized the problem enunciated by the
appellant, and already has solved it by the use of the clip

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extension above the slotted opening. Moreover, there is no teaching in Brozak or Fearing that the securing systems they disclose "better secure the clip" or are "stronger" than that of O'Brien, to use the language of the examiner in explaining the rejection on page 4 of the Answer. This being the case, there would appear to be no reason why the artisan would have been motivated to modify the O'Brien clip, thus merely providing an additional means for accomplishing the same task. It is our view that the only suggestion for combining the teachings of the three applied references in the manner proposed by the examiner is found in the luxury of the hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection under 35 U.S.C. § 103. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The references thus fail to establish a *prima facie* case of obviousness with regard to the subject matter of independent claims 1 and 2 or, it follows, of claims 3-5, which depend therefrom.

The rejection is not sustained.

The decision of the examiner is reversed.

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REVERSED

	Harrison E. McCandlish, Senior)	
	Administrative Patent Judge)	
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	Neal E. Abrams)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	John F. Gonzales)	
	Administrative Patent Judge)	

tdl

LEYDIG VOIT & MAYER
Two Prudential Plaza
Suite 4900
Chicago, IL 60601-6780