

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** DAVID P. McCRANE

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Appeal No. 98-2149  
Application No. 08/651,991<sup>1</sup>

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ON BRIEF

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Before MEISTER, FRANKFORT, and BAHR, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

***DECISION ON APPEAL***

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<sup>1</sup> Application for patent filed May 21, 1996.

David P. McCrane (the appellant) appeals from the final rejection of claims 1-18, the only claims present in the application.

We REVERSE.

The appellant's invention pertains to a protective device for use in active sports of the type having a cushioning pad with a replaceable wear cap and to a method of unfastening the wear cap from the cushioning pad. Independent claims 1 and 17 are further illustrative of the appealed subject matter and copies thereof may be found in the appendix to the brief.

The reference relied on by the examiner is:

Robinson	4,599,747	Jul. 15,
1986		

Claims 1-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Robinson. The examiner notes that Robinson teaches the attachment of a replaceable wear cap 40 to a cushioning pad 38 by means of hook and loop-type fasteners.

Thereafter, the examiner concludes that:

The placement of the fasteners in any pattern or direction could readily be determined through routine experimentation based on the direction of applied forces and magnitude of adhesion desired. Note that it has been held that rearranging parts of an

invention involves only routine skill in the art. **In re Japikse**, [181 F.2d 1019] 86 USPQ 70 [CCPA 1950]. In the instant case, the modification of the pattern in which the VELCRO[®] fasteners are applied between the cushioning pad (38) and replaceable wear cap (40) is considered an obvious expedient readily determined based on routine experimentation of the desired adhesion level. Any such

pattern, including plural strips with the hooks placed at an angle with respect to each other is considered obvious if a different adhesion level is desired.

\* \* \*

With regard to claims 17-18, the use of a[n] edged object such as a screwdriver or other blade-like tool to unfasten the cap is considered an obvious expedient with the proposed modification of the Robinson Patent. Blade-like tools such as screwdrivers are commonly used to pry open a variety of objects. [Answer, pages 4 and 5.]

We will not support the examiner's position. In rejecting claims under 35 U.S.C. § 103 the examiner bears the initial burden of presenting a **prima facie** case of obviousness. **In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. **Id.** If the examiner fails to establish a **prima facie** case, the rejection is improper and will be overturned. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

According to the specification, hook and loop-type fastening devices for attaching a replaceable wear cap to a

cushioning pad wherein the hook ends are randomly oriented are known, but that such fastening devices are not strong enough to securely hold the wear caps in place when subjected to certain forces (see, generally, pages 2 and 3). In order to overcome the deficiencies of the prior art:

A replaceable wear cap is provided together with a fastening structure which is releasably carried between the inner surface of the wear cap and the outer surface of the cushioning pad. The fastening structure comprises a cooperating pair of first and second layers. The first layer is comprised of a material having a plurality of loops. The second layer is formed into segments each of which is comprised of a material having a plurality of hooks. The hooks of each segment have distal ends which point substantially unidirectionally so that when the hooks interengage with the loops the segment **has a maximum resistance to force components vectored opposite the direction that the hook ends point**. The hooks are released by the method of moving the blade-like portion of a thin flat tool in the direction the hook ends point along the length of the interface between the hooks and loops. [Specification, pages 4 and 5; emphasis added.]

Independent claims 1 and 17, each expressly require at least first and second segments having unidirectionally oriented hook ends wherein the hook ends on one segment point in a direction which diverges from the direction the hook ends point on the other segment. In order to satisfy these limitations, the examiner relies on Robinson and states that

the orientation of the hook ends and the placement of the segments "could readily be" determined by routine experimentation based on the direction of applied forces and magnitude of adhesion desired. We must point out, however, that obviousness under § 103 is a legal conclusion based on **factual evidence** (*see In re Fine, supra,*) and the mere fact that the prior art **could be** modified would not have made the modifications obvious unless the prior art suggested the desirability of the modification (*see, e.g., In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Robinson shows nothing more than what the appellant on pages 2 and 3 of the specification has admitted to be old in the art. That is, Robinson simply shows a replaceable wear cap that is attached to a cushioning pad by means of a hook and loop-type fastener 42. There is no disclosure therein of unidirectionally oriented hook ends, much less unidirectionally oriented hook ends that are mounted on first and second segments in such a manner that the direction of orientation of the hook ends of the respective segments diverge at a predetermined angle relative to one another as claimed. Thus, Robinson does not

provide a factual basis for concluding that unidirectionally oriented hook ends mounted on first and second segments in the claimed manner would have been obvious.

The examiner's reliance upon the decision in *In re Japikse, supra*, is misplaced inasmuch as, in the facts of that particular case, the court found that the mere shifting of a part to a different position did not result in a device which operated any differently than the prior art. Here, however, not only is more than mere "shifting" involved, but the appellant's device clearly overcomes the described deficiencies of the prior art.

With respect to claims 17 and 18, the examiner has additionally noted that blade-like tools such as screwdrivers are commonly used to pry open a variety of objects. However, the mere fact that this might generally speaking be the case, does not provide a sufficient factual basis for concluding that the claimed method (which requires unfastening the above-noted first and second segments with unidirectionally oriented hook ends) would have been obvious within the meaning of 35 U.S.C. § 103. *See In re GPAC Inc*, 57 F.3d 1573, 1582, 35 USPQ2d 1116,

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1123 (Fed. Cir. 1995) and *In re Warner*, 379 F.2d 1011, 1017,  
154 USPQ 173, 178 (CCPA 1967).

The decision of the examiner to rejection claims 1-18 under 35 U.S.C. § 103 based on the reference to Robinson is reversed.

***REVERSED***

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JENNIFER BAHR	)	
Administrative Patent Judge	)	

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