

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte LESLIE K. CROYLE

Appeal No. 2002-1778
Application No. 09/285,078

ON BRIEF

Before STAAB, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 12, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a holder for a wrist corsage and improvements in the attachment of a flower corsage to a wrist corsage holder (specification, p. 1). A copy of the claims under appeal is set forth 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:

Kaber	2,242,975	May 20, 1941
Gallagher	3,949,568	Apr. 13, 1976
Moore	5,553,326	Sep. 10, 1996
Jacks	GB 625,705	July 1, 1949

Claims 1, 6, 7 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jacks in view of Gallagher.

Claims 2 to 5 and 8 to 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jacks in view of Gallagher as applied to claims 1 and 7 above, and further in view of Kaber and Moore.¹

¹ In the answer (pp. 3 & 6-7), the examiner withdrew the rejection of claims 1, 7 and 12 under 35 U.S.C. § 112 that was advanced in the final rejection. Additionally, while the answer specifically includes (continued...)

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. 7, mailed October 20, 2000) and the answer (Paper No. 15, mailed February 21, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed July 20, 2001) and reply brief (Paper No. 16, filed April 30, 2002) 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, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The teachings of the applied prior art

Jacks

Jacks' invention relates to electric torch supports, devised mainly to facilitate the manipulation of tools in darkness by a person working alone without the assistance of another person to hold a lamp or torch. As shown in Figures 1-3, the electric torch

¹(...continued)
a statement of the rejection with regards to only claims 2 to 5, we believe that the answer, taken as a whole, maintains the rejections of claims 1 to 12 under 35 U.S.C. § 103 as set forth in the final rejection.

support includes a main spring clip 1 adapted to fit on the wrist or arm of a user; a secondary spring clip 2 of a size adapted to grip the body of a suitable torch² 3; and pivot pin 4 connecting the secondary spring clip 2 to the main spring clip 1 so that the direction of the light of the torch 3 may be angularly adjusted.

Gallagher

Gallagher's invention relates to a bouquet ring by means of which flowers may be worn on the finger. As shown in Figures 1-4, a bouquet ring 11 comprises a base and prong member 13 and a decorative ring band 15 connected to the base and prong member 13 by a rivet 17. Base and prong member 13 includes a support base 19 having a hole 21 formed centrally thereof for receiving rivet 17. Bendable grasping prongs 23 extend from support base 19 and are adapted to be bent to grasp fresh or artificial flowers, a synthetic foam-plastic flower support block 25 (see Figure 5), or a tube-type flower support 27 (see Figure 8). Prongs 23 may be provided with crease lines 29 and 31 that divide the prongs into tip portions 33, intermediate portions 35 and bottom portions 37. Ring band 15 is provided with ends 39 and 41 which are bent into overlapping position so as to permit expansion and contraction of the ring band to accommodate fingers of various sizes.

² The appellant characterizes the torch as a flashlight (brief, p. 7).

Kaber

Kaber's invention relates to bouquet holders. As shown in Figures 1-4, the bouquet holder has a relatively narrow, elongated, body strip 1 composed of pliable, form-retaining metal of sufficient length to partially or completely encircle, embrace and clamp firmly on and about a feminine wrist, for example. The strip 1 is provided with side projections 2 constituting parts of the same piece of metal of which the strip 1 is composed and which project laterally from opposite sides respectively of the middle portion, for example, of the strip 1, at right angles thereto. The oppositely extending projections 2 collectively form or constitute a single flower supporting bar or platform extending transversely to the wrist band 1. These projections 2 have relatively small lugs, tongues, or prongs 3, formed integrally therewith and projecting from the opposite sides, at right angles to the projections 2 and parallel to strip 1, in staggered relation one to another for bending around the stems of flowers placed on the support formed by the projections 2 to secure the flowers to the support.

The main strip 1 is composed of pliable metal of such characteristics that it may be readily bent into and retain the form of a split band suitable for clamping firmly on and about a lady's wrist, arm or ankle, if desired, and holding securely thereto. The cross bar formed of the projections 2 form a metal floor along which are laid the stems of the flowers of the bouquet. The tongues or prongs 3 of the same pliable metal may

be readily bent over or around and into firm contact with the flower stems, as clearly shown in Figure 1, and hold them securely in place.

Moore

Moore's invention provides a system for adapting a hat of the type which is originally provided with only a permanent sweat band, so that the hat can receive a removable, washable, and reusable sweat band. Moore teaches (column 5, lines 56-60) that the preferred plastic resin materials for forming the removable, washable, and reusable sweat band are polyolefins and thermoplastic elastomers, preferably a thermoplastic material such as polyethylene.

Claim 1

We sustain the rejection of claim 1 under 35 U.S.C. § 103.

Claim 1 reads as follows:

A body-worn holder for an ornamentation, comprising:
a generally curved band whose configuration is adapted to attach the band to a human body; and
a clamp having a pair of jaws arranged to receive an ornament;
wherein the clamp has a spring resilience that is sufficient to permit securement of an ornament between the jaws of the clamp by pressing the ornament between the jaws of the clamp against the spring resilience, whereby the spring resilience alone secures the ornament between the jaws after said pressing ceases.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Jacks and claim 1, it is our opinion that there is no difference. The only possible distinction between Jacks and claim 1 is the limitation that the clamp has a pair of jaws arranged to receive an ornament. It is our view that this limitation is met by Jacks. As disclosed, Jacks' secondary spring clip 2 has a size adapted to grip the body of a suitable torch. In our view, the claimed ornament³ is readable on Jacks' torch since a torch placed on his electric torch support would decorate or adorn the support. Additionally, Jacks' secondary spring clip 2 is capable of receiving other suitably sized ornaments such as a flower corsage. Claim 1 is readable on⁴ Jacks as follows: A body-worn holder for an ornamentation (Jacks' electric torch support), comprising: a generally curved band whose configuration is adapted to attach the band to a human body (Jacks' main spring clip 1 has a

³ The American Heritage Dictionary, Second College Edition, (1982) defines "ornament" as "something that decorates or adorns."

⁴ A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

configuration which is adapted to attach the main spring clip to a human body); and a clamp having a pair of jaws arranged to receive an ornament (Jacks' secondary spring clip 2 has a pair of jaws arranged to receive an ornament/torch as explained above); wherein the clamp has a spring resilience that is sufficient to permit securement of an ornament between the jaws of the clamp by pressing the ornament between the jaws of the clamp against the spring resilience (Jacks' secondary spring clip 2 has a spring resilience that is sufficient to permit securement of an ornament/torch between the jaws of the secondary spring clip 2 by pressing the ornament/torch between the jaws of the secondary spring clip 2 against the spring resilience), whereby the spring resilience alone secures the ornament between the jaws after said pressing ceases (the spring resilience alone of Jacks' secondary spring clip 2 secures the ornament/torch between the jaws after the pressing ceases).

For the reasons set forth above, we have concluded that Jacks teaches all the limitations of claim 1. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is affirmed.

Claim 2

We sustain the rejection of claim 2 under 35 U.S.C. § 103.

Dependent claim 2 adds to parent claim 1 the further limitation that the band comprises a plastic.

In our view, since Jacks is silent as to the material used to form his main spring clip 1, the choice of such material is left up to the person of ordinary skill in the art and that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have made Jacks' main spring clip from a plastic material.

Under similar circumstances, it has been determined that the mere substitution of glass for wood would not support the patentability of a display case. Substitution of materials will usually not, in and of itself, create patentability if the same purpose or function could be achieved through the use of old and well known materials (in this case, plastic). This applies even if the substituted material is more satisfactory, cheaper, or more durable. Substitution of materials to be patentable should bring about

a new mode of construction, or new properties or uses of the article that were not obvious and, in effect, make the old material obsolete. See Lyle/Carlstrom Associates Inc. v. Manhattan Store Interiors, Inc., 635 F.Supp. 1371, 1385, 230 USPQ 278, 288 (E.D.N.Y. 1986) (citations omitted), aff'd mem., 824 F.2d 977 (Fed. Cir. 1987); accord Graham v. John Deere Co., 383 U.S. 1, 11, 148 USPQ 459, 464 (1966).

For the reasons set forth above, the decision of the examiner to reject claim 2 under 35 U.S.C. § 103 is affirmed.

Claim 3

The appellant has grouped claims 2 and 3 as standing or falling together.⁵ Thereby, in accordance with 37 CFR § 1.192(c)(7), claim 3 falls with claim 2. Thus, it follows that the decision of the examiner to reject claim 3 under 35 U.S.C. § 103 is also affirmed.

Claims 4 and 5

We will not sustain the rejection of claims 4 and 5 under 35 U.S.C. § 103.

⁵ See page 5 of the appellant's brief.

Dependent claims 4 and 5 include the limitation that the band and the clamp are integral in a unitary construction and comprise a plastic.

In our view, absent the use of impermissible hindsight⁶, there is no teaching, suggestion or motivation in the applied prior art (i.e., Jacks, Gallagher, Kaber and Moore) to make Jacks main spring clip 1 and secondary spring clip 2 integral in a unitary construction and comprise a plastic. While Kaber does teach a band and a clamp that are integral in a unitary construction, it is our opinion that Kaber would not have suggested modifying Jacks' main spring clip 1 and secondary spring clip 2 to be integral in a unitary construction since Jacks teaches specifically to allow the secondary spring clip 2 to pivot about the main spring clip 1 and that removing this functionality would not have been obvious at the time the invention was made to a person of ordinary skill in the art from the teachings of the applied prior art.

For the reasons set forth above, the decision of the examiner to reject claims 4 and 5 under 35 U.S.C. § 103 is reversed.

⁶ The use of hindsight knowledge derived from the appellant's own disclosure to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Claim 6

We sustain the rejection of claim 6 under 35 U.S.C. § 103.

Dependent claim 6 adds to parent claim 1 the further limitation that the band is configured to be attached to a human wrist.

In our view, Jacks' main spring clip 1 is configured to be attached to a human wrist. As such we conclude that Jacks teaches all the limitations of claim 6. As set forth above with respect to claim 1, a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness."

For the reasons set forth above, the decision of the examiner to reject claim 6 under 35 U.S.C. § 103 is affirmed.

Claims 7 to 12

We will not sustain the rejection of claims 7 to 12 under 35 U.S.C. § 103.

Independent claims 7 and 12 read as follows:

7. A wrist corsage, comprising:
a generally curved band configured to be attached to a human wrist;

a clamp having a pair of jaws arranged to receive a flower corsage, wherein the clamp has a spring resilience that is sufficient to permit securement of a flower corsage between the jaws of the clamp by pressing the flower corsage between the jaws of the clamp against the spring resilience, whereby the spring resilience alone secures the flower corsage between the jaws after said pressing ceases; and

a flower corsage secured between the jaws of the clamp.

12. A method for producing a wrist corsage, comprising the following steps:
providing a holder including a generally curved band configured to be worn on a human wrist, and a clamp having a pair of jaws arranged to receive a flower corsage, wherein the clamp has a spring resilience that is sufficient to permit securement of a flower corsage between the jaws of the clamp;
inserting a flower corsage into the clamp by pressing the flower corsage between the jaws of the clamp against the spring resilience; and
ceasing said pressing, thereby securing the flower corsage between the jaws solely by the spring resilience of the jaws.

Independent claims 7 and 12, and claims 8 to 11 dependent on claim 7, include a flower corsage secured between the jaws of the clamp. In our view, absent the use of impermissible hindsight, there is no teaching, suggestion or motivation in the applied prior art (i.e., Jacks, Gallagher, Kaber and Moore) to have a flower corsage secured between the jaws of Jacks' secondary spring clip 2. While Gallagher and Kaber each teach a flower corsage secured in place by bendable prongs, it is our opinion that Gallagher and/or Kaber would not have suggested securing a flower corsage between the jaws of Jacks' secondary spring clip 2.

For the reasons set forth above, the decision of the examiner to reject claims 7 to 12 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3 and 6 under 35 U.S.C. § 103 is affirmed and the decision of the examiner to reject claims 4, 5 and 7 to 12 under 35 U.S.C. § 103 is reversed.

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

AFFIRMED-IN-PART

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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