

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VINCENT J. PILEGGI

Appeal No. 97-0454
Application No. 08/089,375¹

ON BRIEF

Before CALVERT, ABRAMS and NASE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 5, 6, 10 and 11, which constitute all of the claims remaining of record in the application.

¹Application for patent filed July 12, 1993. According to appellant, this application is a continuation of Application 07/818,081, filed January 8, 1992, now U.S. Patent No. 5,239,707, issued August 31, 1993, which is a continuation-in-part of Application 07/774,796, filed October 10, 1991, now abandoned, which is a continuation-in-part of Application 07/724,835, filed July 2, 1991, now abandoned.

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The appellant's invention is directed to an apparatus for restraining a necktie. The subject matter before us on appeal is illustrated by reference to claim 5, which has been reproduced in an appendix to the Appeal Brief.

THE REFERENCES

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

Smith <i>et al.</i> (Smith)	4,324,004	Apr. 13, 1982
Jones	5,095,546	Mar. 17, 1992
		(filed Feb. 1, 1990)

THE REJECTIONS

According to the Examiner's Answer, the following rejections stand:

Claims 5, 6, 10 and 11 under 35 U.S.C. § 103 as being unpatentable over Jones in view of Smith.

Claims 5, 6, 10 and 11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Jones in view of Smith and claims 1, 3, 6 and 7 of U.S. Patent No. 5,239,707.

The rejections are explained in the Examiner's Answer. The opposing viewpoints of the appellant are set forth in the Appeal Brief.

OPINION

The Rejection Under Section 103

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 *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, 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, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

Independent claim 5 is directed to a self-restraining necktie which comprises, *inter alia*, a vertical member attached to the rear of the outwardly facing section (the front) of the tie and a horizontal member having a buttonhole therein slidably secured to the vertical member. The claim requires that the

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vertical and horizontal members be "formed from a sheet of stiffened cloth" made by bonding a sheet of the original tie material to a "fusion cloth." The purpose of utilizing stiffened cloth is to overcome a problem in the art by improving the sliding interface between the vertical and the horizontal members, thereby improving the ability of the necktie to automatically adjust to increases and decreases in slack when the wearer moves (specification, pages 14-16). "Fusion cloth" is a material used as a backing for shirt collars and the like to eliminate the development of wrinkles, bulges or other imperfections which would detract from the appearance of the garment.²

It is the examiner's position that Jones discloses all of the components of the tie recited in claim 5, except for making the horizontal and vertical members of a stiffened cloth. For this, the examiner looks to Smith, which discloses the use of "fusion cloth" in shirt collars. The examiner concludes that it would have been obvious to one of ordinary skill in the art to make the two members of Jones out of fusion cloth "where a crisp look and a long wearing accessory is desired" (Answer, page 6).

²This is explained in column 1 of the Smith reference, applied by the examiner against the claims.

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We do not agree. Jones discloses exactly the type of tie restraining device over which the appellant believes his invention to be an improvement, but there is no recognition in Jones of the problem solved by the appellant's invention. While the secondary reference teaches the use of stiffened cloth, it is not for use in a necktie or in an article of apparel in which there is a requirement for one member to slide upon another, nor is it for the purpose of facilitating sliding action. The purpose of the stiffened cloth in Smith is to improve the appearance of the outer layer of a garment by reducing the tendency of the outer layer to wrinkle or bulge (column 1). The horizontal and vertical members recited in claim 5 are on the back side of the necktie and are not the outer layers of a garment. Thus, from our perspective, one of ordinary skill in the art would not have found suggestion in the teachings of Smith to make the restraining members of a stiffened cloth such as the fusion cloth used as a backing for shirt collars.

It is our view that the combined teachings of Jones and Smith fail to establish a *prima facie* case of obviousness with respect to the subject matter recited in claim 5. We therefore will not sustain this rejection of claim 5 or, it follows, of claims 10 and 11, which depend therefrom.

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The rejection of independent claim 6 also will not be sustained, based upon the same reasoning.

We note in passing that in view of the reasoning set forth above, we need not address the examiner's allegation that the claims contain product-by-process limitations, which add no patentable distinction to the claims.

The Double Patenting Rejection

The presence of this rejection in the Examiner's Answer is a mystery to us. It was made in the first office action (Paper No. 5), to which the appellant responded by filing a terminal disclaimer (Paper No. 6). This was duly noted on the face of the file wrapper, and the examiner stated in the final rejection (Paper No. 15) that the terminal disclaimer overcame the double patenting rejection. However, the rejection was repeated in the very paper in which its success was acknowledged, as well as in the Examiner's Answer, and thus its status is not absolutely clear.

It would appear that the appellant believes this rejection has been overcome. However, to insure that the matter is settled, we shall take the initiative of not sustaining the double patenting rejection, based upon the record before us.

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SUMMARY

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge))	
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)	
NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge))	

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