

The opinion in support of the remand being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STANLEY F. GOULDSON

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Appeal No. 1998-3421  
Application No. 08/646,995

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HEARD: AUGUST 16, 2000

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Before McCANDLISH, Senior Administrative Patent Judge, and  
COHEN and FRANKFORT, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL  
AND  
REMAND TO THE EXAMINER

This is a decision on an appeal from the examiner's final rejection of claims 1 through 12. No other claims are pending in the application.

Appellant's invention relates to [a] method of reuse for hangers having size indicia removably mounted thereon (claim 1, lines 1-2). As described in appellant's

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specification, the hangers are plastic hangers for garments, and the size indicia are in the form of caps 18 for indicating the sizes of garments on the hangers. The used hangers retained by retail stores following a sale of the garments are returned to a recycling or reuse center 423. According to claim 1, the only independent claim on appeal, the size indicia are automatically removed from the returned hangers at the reuse center. Based upon an inspection at the reuse center, returned hangers in reusable condition are delivered to garment manufacturers for reuse. The other returned hangers not suitable for reuse may be ground to recycle the plastic hanger material.

A copy of the appealed claims is appended to appellant's brief.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejection under 35 U.S.C. § 103:

Marshall et al. (Marshall)      5,272,806      Dec. 28, 1993  
  
Myer Grace Bros. "Waste Management: Rethinking and Recycling." pp. 45-49, (prior to January, 1996)<sup>1</sup>.

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<sup>1</sup> Appellant does not challenge the examiner's position that the Waste Management publication constitutes prior art.

Claims 1 through 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Waste Management publication (hereinafter the WMRR publication) in view of Marshall. The examiner relies on the WMRR publication for its teaching of a method of collecting and reusing garment hangers made of plastic. He relies on the Marshall patent for its teaching of removably mounting size-indicating caps on garment hangers. Reference is made to the examiner's answer for details of this rejection.

The examiner concedes that the WMRR publication lacks a disclosure of size-indicating caps or other size indicia for garment hangers and hence lacks a disclosure of automatically removing such indicia from the hangers as defined in claim 1. He nevertheless takes the position in substance that it would have been obvious to employ Marshall's plastic hangers with the size-indicating caps in place of hangers lacking size indicia (see pages 4-5 of the answer). The examiner also contends that it would have been obvious to remove the size indicia from the hangers in order to sort the hangers and size indicia for

redistribution to the clothing manufacturers" (answer, page 5).

Finally, the examiner concludes on page 5 of the answer that it would have been obvious to "automate the [size indicia] removal process . . ." In support of this position the examiner relies on In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)<sup>2</sup> (citing In re Rundell, 48 F.2d 958, 959, 9 USPQ 220, 221 (CCPA 1931)) for the holding that "it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result."

We agree that it would have been obvious to substitute Marshall's plastic hangers with the size indicia thereon for the plastic hangers disclosed in the WMRR publication for the reasons stated by the examiner on pages 4-5 of the answer. However, there is nothing in the applied references, taken singly or collectively, that would have suggested the claimed step of removing the size indicia at the reuse center in the WMRR publication. In reusing

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<sup>2</sup> See also MPEP ¶ 2144.04 (7<sup>th</sup> ed. Rev. 1, Feb. 2000).

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garment hangers having size indicia thereon, the used hangers returned by the retail stores may just as well be sorted according the size indicia at the reuse center, thus eliminating the need to remove the size indicia before sending the reusable hangers back to the garment manufacturers for reuse. Alternatively, hangers having size indicia may simply be recycled by grinding the hangers to obviate the need for removing the size indicia. Given the total lack of any teaching or suggestion in the applied prior art of removing the size indicia at the reuse or recycling center, we conclude that the examiner has not provided a sufficient factual basis to support a prima facie case of obviousness. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 CCPA 1967). As a result, consideration of Venner is not required at this time to decide the obviousness issue before us.

The examiner's decision rejecting appealed claims 1 through 12 under 35 U.S.C. § 103 is reversed.

This application is remanded to the examiner to consider the appropriateness of a § 103 rejection of the appealed claims based on the U.S. Patent No. 5,558,280

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issued to Donald F. Morgan on September 24, 1996 (based on an application filed June 7, 1995)<sup>3</sup> alone or in combination with the WMRR publication. The Morgan patent discloses a method of reusing and recycling plastic garment hangers similar the method disclosed in the WMRR publication. Morgan, however, is more pertinent than the WMRR publication in that it expressly teaches the step of removing size indicating parts from the returned hangers at a reuse collection center 18 (see column 5, lines 56-60). As such, the Morgan patent appears to supply the deficiencies of the WMRR publication, so that the only difference between Morgan and the subject matter of claim 1

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<sup>3</sup> This patent was cited by appellant in a supplemental information disclosure statement (Paper No. 16).

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resides in the recitation that the removal of the size  
indicia is accomplished automatically.

REVERSED/REMANDED

HARRISON E. McCANDLISH	)	
Senior Administrative Patent Judge)	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
IRWIN CHARLES COHEN	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	

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