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EXAMINER
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LIU, JONATHAN

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* WILLIAM E. ADAMS<sup>1</sup>

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Appeal 2017-001907  
Application 12/396,971  
Technology Center 3600

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Before MICHAEL C. ASTORINO, BENJAMIN D. M. WOOD, and  
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Appellant states that the real party in interest is Adams Mfg. Corp.  
App. Br. 1.

## STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a rejection of claims 1–19. An oral hearing in accordance with 37 C.F.R. § 41.47 was held on October 23, 2018. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

## THE INVENTION

The claims are directed to a door hook. Claims 1, 8, 14, and 16 are independent. App. Br. 15–19 (Claims App.). Claim 1, reproduced below, is illustrative of the claimed subject matter:

1 A door hook comprising:  
a top member having a first end and a second end;  
a back member having a first end and a second end, the first end of the back member attached to the first end of the top member;  
a front member having a first end and a second end, the first end of the front member attached to the second end of the top member such that the front member extends below the top member;  
the front member being resilient;  
a hook having a first end and a second end, the first end of the hook attached to the front member adjacent the second end of the front member and the second end of the hook being a free end;  
a leg attached directly to the second end of the front member, the leg extending below the hook;  
a resilient foot attached to the leg such that the resilient foot is below the hook; and  
wherein the front member is made of a material and shape that allows the front member to flex into a generally convex shape when a downward force acts on the hook.

#### REFERENCES

Weekley	US 2,080,990	May 18, 1937
Heine	US 4,203,175	May 20, 1980
Peterson	US 5,085,387	Feb. 4, 1992

#### REJECTIONS

Claims 1–7, 10–15, 18, and 19 are rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Heine and Weekley.

Claims 8, 9, 16, and 17 are rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Heine, Weekley, and Peterson.

#### ANALYSIS

*Claims 1–7, 10–15, 18, and 19—Unpatentable over Heine and Weekley*

Independent claims 1 and 14 recite a “front member” that is “resilient” and “made of a material and shape that allows the front member to flex into a generally convex shape when a downward force acts on the hook.” App. Br. 15, 18 (Claims App.). Claims 2–7 and 10–13 depend from claim 1, and claims 15, 18, and 19 depend from claim 14. *Id.* at 15–20. The Examiner finds that Heine discloses most of the limitations of claim 1, including the claimed front member. Final Act. 3 (citing Heine, Fig. 3). The Examiner explains that Heine’s hook is resilient and capable of flexing as claimed “in view of Hooke’s law (i.e., all materials have some degree of elasticity), during when sufficient downward force acts on the [hook].” *Id.* The Examiner relies on Weekley to teach the “resilient foot” of claim 1. *Id.* (citing structure identified with reference number 15 in Figures 1 and 2 of

Weekley). The Examiner makes similar findings with respect to independent claim 14. *Id.* at 8–9.

Appellant responds that the Examiner’s conclusion that Heine inherently discloses the convex flexing limitation “is directly contrary to the test results presented in the declaration of Robert Schreiber,” which is appended to the Appeal Brief. App. Br. 11; *see* Declaration of Robert Schreiber (“Schreiber Decl.”). In his Declaration, Mr. Schreiber, a former employee of the assignee, reports that he made a prototype of Heine’s slipper holder shown in Figures 1 through 3 of Heine from Lexan plastic, which is the same material used to make a commercial embodiment that practices the claims at issue. Schreiber Decl. 1–2. Mr. Schreiber then “placed this hook on a test fixture that is similar to the bed rail shown in [Heine],” and “applied a two pound load on the hook such that a downward force was acting on the hook.” *Id.* at 2–3, Exs. 1, 2. According to Mr. Schreiber, the front member of Heine’s slipper holder flexed into “generally a concave shape,” rather than a convex shape as claimed, “because of the configuration of the slipper holder which causes the fulcrum to be below the load.” *Id.* at 3, Ex. 3.<sup>2</sup>

The Examiner responds that the Schreiber Declaration “is insufficient to overcome the rejection.” Ans. 17. The Examiner asserts that “[t]he instant experiment fails [to] take into consideration that the bed rails of Heine were not relied upon in making the instant rejection of the claims,”

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<sup>2</sup> Mr. Schreiber also tested a door hook as disclosed and claimed in the pending application. *Id.* at 3, Exs. 4–5. However, we do not consider these test results to be relevant to whether Heine inherently discloses the convex-flexing limitation.

and that Appellant's "invention recited in the claims is not a combination claim directed to a combination of the door hook and the door being positively claimed together." *Id.* at 18. The Examiner concludes that the experiment is "outside of the scope of the claimed invention." *Id.* The Examiner asserts, alternatively, that

[C]onsidering the thinness of the front member of Heine across its transverse cross-section along the x-axis, and the degree of the elasticity of the front member as evidenced by Hooke's law, the front member will flex into the generally convex shape during when the sufficient downward force acts on the hook.

*Id.* at 20. In support of this assertion, the Examiner provides annotated versions of Figure 3 of Heine illustrating how the Examiner contends the hook would flex when mounted on Heine's bed rails (Figure 3'', *id.* at 22) or a door (Figure 3''', *id.* at 23) upon the application of "sufficient force."

We first address the Examiner's response to Mr. Schreiber's test results. The Examiner is correct that the claims do not recite a door, or require that the front member be capable of flexing in a generally concave shape only when the hook is mounted on a door. None of the claims specifies the precise circumstances under which the front portion must be able to flex into a generally convex shape when a downward force acts on the hook. Indeed, the claims do not specify that the door hook be mounted at all. But the Examiner is not correct that the conditions under which Mr. Schreiber tested Heine's hook are "outside of the scope of the claimed invention." On the contrary, because the claims do not limit the circumstances under which the claimed convex flexing must occur, testing Heine's hook using Heine's bed rails is within the scope of the claims.

Thus, we find that the Examiner erred in not considering Appellant's test results.

We have also considered the Examiner's alternate position that Heine's hook would flex in a generally convex shape, notwithstanding Appellant's test results. We initially note that in the annotated versions of Figure 3, the Examiner illustrates what appears to be a rotational force acting at the point where the hook joins the front member. Ans. 22–23. The Examiner has not explained how that force corresponds to the claimed “downward force” specified in the claims. In any event, the Examiner's annotations are not supported by a persuasive explanation for why the device would curve in the manner shown.

In light of the Examiner's erroneous reason for not considering Appellant's test results, and because we do not find the Examiner's analysis otherwise persuasive, we do not sustain the rejection of claims 1–7, 10–15, 18, and 19 as unpatentable over Heine and Weekley.

*Claims 8, 9, 16, and 17—Unpatentable over Heine, Weekley, and Peterson*

Independent claims 8 and 16 contain the same front-member limitation discussed above. App. Br. 17, 19 (Claims App.). As with the previous rejection, the Examiner relies on Heine to teach this limitation (Final Act. 11–13), and rejects Mr. Schreiber's test results for the same reason that we found erroneous above (Ans. 17–19). Peterson is not relied on to cure this deficiency. Accordingly, we do not sustain the Examiner's rejection of claims 8, 9, 16, and 17 as unpatentable over Heine, Weekley, and Peterson.

Appeal 2017-001907  
Application 12/396,971

DECISION

For the above reasons, the Examiner's rejection of claims 1–19 is reversed.

REVERSED