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MCKELLAR IP LAW, PLLC
784 SOUTH POSEYVILLE ROAD
MIDLAND, MI 48640

EXAMINER

RODRIGUEZ, CRIS LOIREN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIELLE SMITH

Appeal 2017-008504
Application 14/071,778
Technology Center 3700

Before DEMETRA J. MILLS, RICHARD M. LEBOVITZ, and
ULRIKE W. JENKS, *Administrative Patent Judges*.

JENKS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from Examiner's decision to reject the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

¹ Appellant identifies the real party in interest as Danielle Smith. Br. 2.

STATEMENT OF THE CASE

Claims 1 and 3–8 are on appeal, and can be found in the Claims Appendix of the Appeal Brief. Claim 1, the sole independent claim, is representative of the claims on appeal, and reads as follows:

1. A cosmetic organizer comprising in combination:
 - a solid base, said solid base having a surface cover affixed thereto, wherein a top surface of the surface cover is a one-half of a hook and loop fastener;
 - at least one cosmetic package having affixed thereto a fastener wherein a top surface of the fastener is a complement of said hook and loop fastener;
 - a bottom surface of said fastener having an adhesive for attaching said fastener to [a] cosmetic package.

Br. 6 (Claims Appendix).

The claims stand rejected as follows:

- I.* Claims 1, 3, 4, and 6 under 35 U.S.C. § 103(a) as unpatentable over Asser² in view of Most.³ Ans. 2.
- II.* Claims 5, 7, and 8 under 35 U.S.C. § 103(a) as unpatentable over Asser in view of Most and further in view of Merten.⁴ *Id.* at 3.

I. Obviousness over Asser and Most

Examiner finds that Asser teaches a cosmetic organizer using hook and fasteners, but recognizes that Asser does not teach a surface that is entirely covered with one half of a hook and loop fastener. Ans. 2. Examiner looks to the teachings of Most for disclosing a hook and loop fastening

² Diane Asser, US 6,189,698 B1, issued February 20, 2001 (“Asser”).

³ Ronald W. Most, US 2005/0136214 A1, published June 23, 2005 (“Most”).

⁴ Helmut-Wolfgang Merten, US 2002/0090265 A1, published July 11, 2002 (“Merten”).

system that covers the entire mounting surface with one half of a hook and loop fastening system. Ans. 2.

Appellant contends that there is no reason to combine Asser and Most. Specifically, arguing that Most utilizes a fastening system using mushroom shaped hooks and receivers, therefore, there is no reason to combine it with the hook and loop fasteners taught in Asser. Br. 3.

The issue is: does the preponderance of evidence of record support Examiner's conclusion that the combination of Asser and Most teaches a cosmetic organizer as claimed?

Findings of Fact

FF1. Asser teaches a cosmetic organizer using hook and loop fasteners.

Figure 2 of Asser, reproduced below, shows such an organizer.

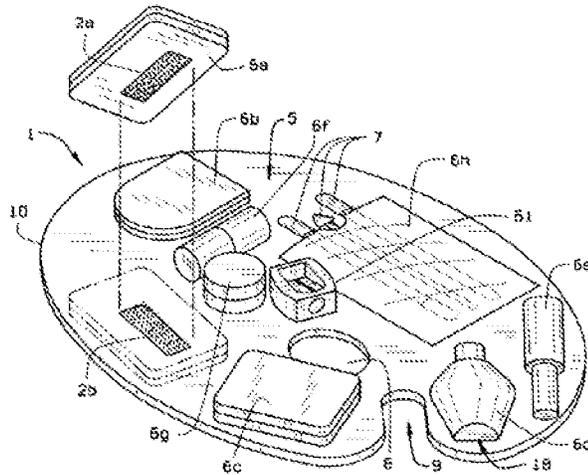


Figure 2 shows a cosmetics organizer that “includes a palette **10**, hook and loop fasteners **2** having mating halves **2a** and **2b** and at least one cosmetic item . . . [6a–6i]. Each cosmetic item **6** is removably secured to the palette **10** by at least one hook and loop fastener **2**.” Asser 2:24–30; Ans. 2. Asser further explains that “fasteners **2** are self-

adhesive such that the user of the kit can secure one mating half **2b** of each fastener **2** to the palette **10**.” Asser 2:39–41; Ans. 2.

FF2. Figure 1 of Most, reproduced below, shows an organizer using hooks.

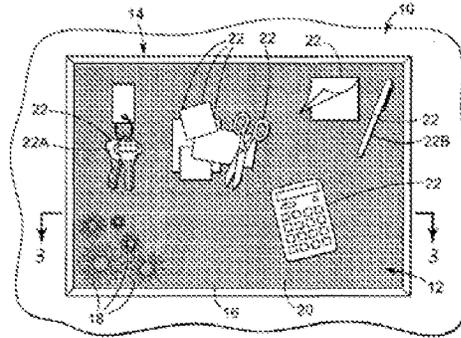


FIG. 1

Figure 1 shows a mounting board (i.e., as a bulletin board) that “includes mounting surface **12** and frame **14**.” Most ¶ 19; Ans. 2. “Mounting surface **12** includes a plurality of mushroom shaped projections (or ‘hooks’) **20** and a substantially continuous backing.” Most ¶ 20; Ans. 2.

FF3. Most teaches other suitable alternatives usable for the mounting surface.

Samples of hooks substantially identical mounting surface and samples of loop material (such as, for example, the loop portion of the SCOTCHMATE® brand SJ3571 hook and loop fastener, available from 3M Company, St. Paul, Minn.) attached to the mounting surface (such as, for example, 3M Brand™ DUAL LOCK™ Low Profile Fastener No. SJ4580, available from 3M Company, St. Paul, Minn.) may be tested for a dynamic shear force value, 90° peel force value, engagement force value and disengagement force value in accordance with the test method described below.

Most ¶ 30; Ans. 4.

Principle of Law

“[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007), citing *United States v. Adams*, 383 U.S. 39, 50–51 (1966).

Analysis

Upon consideration of the evidence on this record (*see* FF1–FF3) and Appellant’s contentions, we find that the preponderance of evidence on this record supports Examiner’s conclusions that the subject matter of Appellant’s claims 1, 3, 4, and 6 are unpatentable over the combination of Asser and Most. *See* Final Act.⁵ 2–3, 4; *see* Ans. 2–3, 4. We agree with Examiner that it would have been obvious “to substitute the hook of Asser in view of Most for a loop component, since a simple substitut[ion] of one known element (i.e. hook and loop) for another to obtain predictable results such as providing a fastening mechanism would have been obvious.” Ans. 2–3; *see* FF1–FF3. Accordingly, we affirm Examiner’s rejection of claims 1, 3, 4, and 6 for the reasons set forth in the Final Office Action and Answer which we incorporate herein by reference.

II. Obviousness over Asser, Most, and Merten

Examiner finds that Asser and Most disclose all the elements recited in claim 1. Examiner acknowledges that neither Asser nor Most teaches a hook and loop organization system where “the front and back of the solid

⁵ Final Office Action mailed October 5, 2015 (“Final Act.”).

base being entirely covered with one half of a hook and loop fastener, [and] wherein the covered solid base form a top of a box.” Ans. 3. Examiner looks to Merten for teaching a box wherein the entire surface of the box is covered with “one half of a hook and loop fastener.” *Id.* (citing Merten Fig. 17). Examiner concludes that it would have been obvious to modify the solid base as disclosed by Asser or Most with a “box like configuration as taught by Merten in order to releasably attach to other objects in a 360° direction.” *Id.* “[M]odify[ing] the solid base of Asser in view of Most with the box configuration as taught by Merten [is obvious] in order to provide greater attachment surfaces in different planes and to allow different attachment positions and configurations.” *Id.* at 4–5.

Appellant contends that Merten is not analogous art and thereby not combinable with Asser and Most. *See* Br. 4.

Merten describes sandbags for building protective walls. *See* Merten, Abstract. “Hook-and-loop sticking elements and hook-and-loop connecting elements are provided to form the hook-and-loop fastenings.” Merten ¶ 25. Merten discloses that the hook and loop pattern can vary, including having “both sides either hook-and-loop sticking elements or hook-and-loop connecting elements.” *Id.* ¶ 26.

We agree with Appellant that Merten is not analogous art because it is not in the same field endeavor, and is also not reasonably pertinent to the particular problem with which the inventor is involved, i.e., organizing small components such as cosmetics. *See In re Clay*, 966 F.2d 656, 658–59 (Fed. Cir. 1992). Examiner explains that

Merten teaches a solid box including an entire outer surface to be covered with hook and loop fasteners, . . . [and that] modify[ing] the solid base of Asser in view of Most with the box

configuration as taught by Merten . . . [would] provide greater attachment surfaces in different planes and to allow different attachment positions and configurations.

Ans. 4–5. We do not doubt Examiner’s rationale that a box configuration would allow for a greater overall attachment surface area per base area. The issue is that Examiner has not articulated why one of ordinary skill would have looked to the sandbag art in order to find a teaching of a hook and loop system that envelopes the entire outside surface of a solid rectangular object.

One of ordinary skill in the art would understand a box⁶ to describe “[a] container typically constructed with four sides perpendicular to the base and often having a lid or cover.” Here, Merten explains that the engaging envelope containing hook and loop elements has a cuboidal configuration only “after having been filled with a medium” such as sand or water. Merten ¶ 51. Contrary to Examiner’s assertion, Merten does not disclose a box because the structure does not contain an interior space bounded by the four perpendicular sides and nowhere to reasonably place a lid on it.

Examiner must have a basis found either in the application or the claimed invention for limiting or expanding the scope of the field of endeavor. Our reviewing court has reminded us that “‘it is necessary to consider ‘the reality of the circumstances’—in other words, *common sense*—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.’” *In re Bigio*, 381 F.3d 1320, 1326 (Fed. Cir. 2004) (citing *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (quoting *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979)) (emphasis added)). Here, Examiner has not

⁶ Definition of “box,” <https://www.thefreedictionary.com/box>, last visited January 17, 2019.

provided a sufficiently articulated rationale that would explain why one of ordinary skill in the art would have considered Merten's filled sandbags to disclose a box having an exterior that is covered with one-half of a hook and loop fastener or to be reasonably pertinent to the problem addressed by Asser, Most, and the claims.

We conclude that the preponderance of evidence of record does not support Examiner's conclusion that the claims are obvious. Accordingly, we reverse the rejection of claims 5, 7, and 8 based on the combination of Asser, Most, and Merten.

SUMMARY

We affirm the rejection of claims 1, 3, 4, and 6 under 35 U.S.C. § 103(a) over Asser and Most.

We reverse the rejection of claims 5, 7, and 8 under 35 U.S.C. § 103(a) over Asser, Most, and Merten.

TIME PERIOD FOR RESPONSE

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

AFFIRMED-IN-PART