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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* HARDY A. LASKIN and RYAN JAMES MURRAY

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Appeal 2019-002256  
Application 14/332,713  
Technology Center 3700

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Before BRUCE T. WIEDER, BRADLEY B. BAYAT, and  
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), the Appellant<sup>1</sup> appeals from the Examiner's decision rejecting claims 1–6, 8–11, 19–22, 25, and 26. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as “the named inventors, Hardy A. Laskin and Ryan J. Murray.” Appeal Br. 3.

### ILLUSTRATIVE CLAIM

1. A cigar holder comprising in combination:

a) a first member including a first base, the first member further including a retainer secured to, and integral with, the first base to form a one-piece structure therewith, the retainer including a split band adapted to releasably extend about a cigar for securing the cigar to the first member, the first base including a generally planar base surface of a first surface area;

b) a first magnet having a generally planar magnet surface of a second surface area secured to the generally planar base surface of the first base of the first member;

c) the first surface area being at least as large as the second surface area; and

d) a second member having a second base, the second base including a metallic member for being attracted to the first magnet and for releasably securing the second base to the first base when the second base is brought proximate to the first base, the second member including a clip secured to the second base and adapted to couple the second member to a hat.

### REFERENCES

The prior art relied upon by the Examiner is:

| Name      | Reference          | Date          |
|-----------|--------------------|---------------|
| Markowitz | US 2,644,212       | July 7, 1953  |
| Potter    | US 5,025,966       | June 25, 1991 |
| Heydt     | US D408,097        | Apr. 13, 1999 |
| Ferrari   | US 6,530,510 B2    | Mar. 11, 2003 |
| Steele    | US 2014/0043580 A1 | Feb. 13, 2014 |

### REJECTIONS

I. Claims 1, 2, 6, 10, 11, and 25 are rejected under 35 U.S.C. § 103 as unpatentable over Markowitz.

II. Claims 3–5 are rejected under 35 U.S.C. § 103 as unpatentable over Markowitz and Ferrari.

III. Claims 8 and 9 are rejected under 35 U.S.C. § 103 as unpatentable over Markowitz and Steele.

IV. Claims 19 and 26 are rejected under 35 U.S.C. § 103 as unpatentable over Markowitz and Potter.

V. Claim 20 is rejected under 35 U.S.C. § 103 as unpatentable over Markowitz, Potter, and Ferrari.

VI. Claim 21 is rejected under 35 U.S.C. § 103 as unpatentable over Markowitz and Heydt.

VII. Claim 22 is rejected under 35 U.S.C. § 103 as unpatentable over Markowitz, Potter, and Heydt.

#### FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

#### ANALYSIS

*Markowitz Does Not Teach “the first surface area being at least as large as the second surface area”*

Independent claims 1 recites, in part: a “first base including a generally planar base surface of a first surface area”; “a first magnet having a generally planar magnet surface of a second surface area secured to the generally planar base surface of the first base of the first member”; and “the first surface area being at least as large as the second surface area.”

The “first surface area” is the size of the “generally planar base surface” and the “second surface area” is the size of the “generally planar magnet surface.” The Specification illustrates such a relationship between the “first surface area” and the “second surface area,” in Figure 5, reproduced below, an upward-looking plan view showing a surface of first

base 32, which has an area larger than the area covered by first magnet 42  
(see Spec. 6, ll. 13–19):

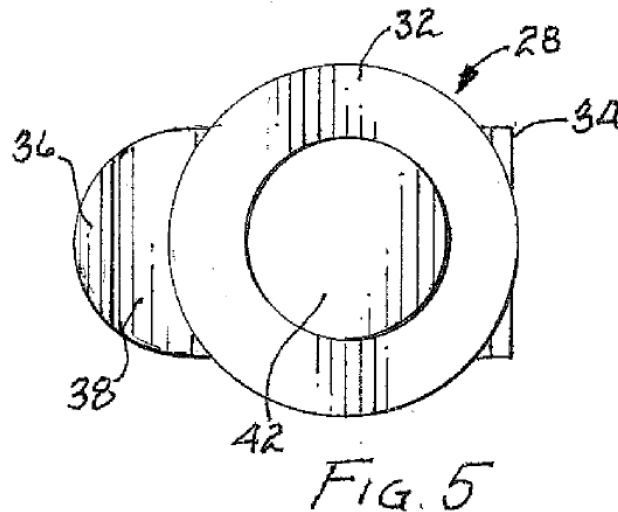


Figure 5 is an upward-looking view of a disclosed embodiment, showing the relationship of surface areas of first base 32 and first magnet 42. *See id.*

The Examiner rejects claim 1 as obvious over the combination of two embodiments of Markowitz’s pencil-holding device, with the embodiment of Figures 1–5 teaching claim 1’s “first surface area being at least as large as the second surface area.” Final 3. According to the Examiner, Markowitz’s housing 18 teaches a “generally planar base surface of a first surface area” and Markowitz’s magnet 21 teaches the “generally planar magnet surface of a second surface area.” *Id.* Figure 5 of Markowitz, reproduced below, provides a cross-sectional view of housing 18 and magnet 21:

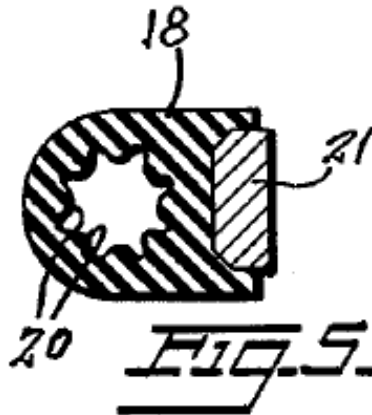


Figure 5 of Markowitz is a cross-sectional view, showing part of the arrangement of housing 18 and magnet 21.

The Appellant does not contend that the cross-sectional representation of Markowitz's Figure 5, by itself, fails to show claim 1's "first surface area [of the base] being at least as large as the second surface area [of the magnet]." Yet, the Appellant argues that, even if the embodiment of Markowitz's Figures 8–11 were modified, by combining it with features of the embodiment of Markowitz's Figures 1–5 (per the Examiner's rejection of claim 1), the resulting combination "would still fail to provide" claim 1's "first surface area being at least as large as the second surface area." Reply Br. 4. Indeed, as the Appellant points out, a portion of Markowitz's magnet 21 "protrudes beyond" housing 18. *Id.* Markowitz describes this configuration as follows:

According to the invention the magnet 21 extends longitudinally beyond one end 22 of the housing 18 which is cut back angularly, as shown most clearly in Fig. 2. Thus, the projecting end of the magnet forms a sort of finger 23 whose purpose will be described hereinafter.

....

. . . [I]f, due to jostling or the like, the pencil 15 and the magnet 21 should slip downward, the finger 23 of the latter engages behind the lip 26 and effects an even firmer holding in place of the pencil, see Fig. 2.

Markowitz col. 2, ll. 42–47, col. 3, ll. 9–13. The dimensional relationship of Markowitz's magnet 21 and housing 18 is seen in Figures 1 and 2. Figure 1 of Markowitz is reproduced below:

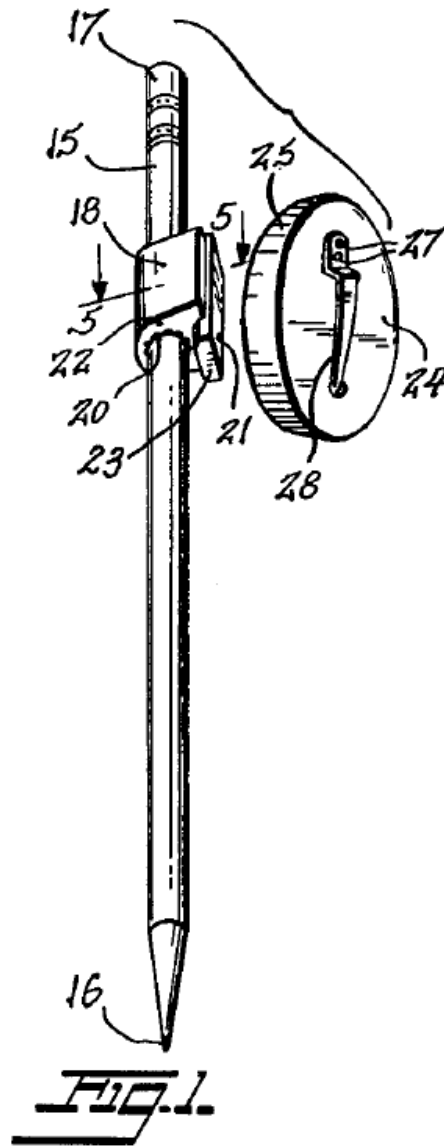


Figure 1 of Markowitz is an exploded perspective view of the pencil-holder embodiment of Markowitz's Figures 1–5. *Id.* at col. 1, ll. 37–39, col. 2, ll. 32–35. Figure 2 of Markowitz is reproduced below:

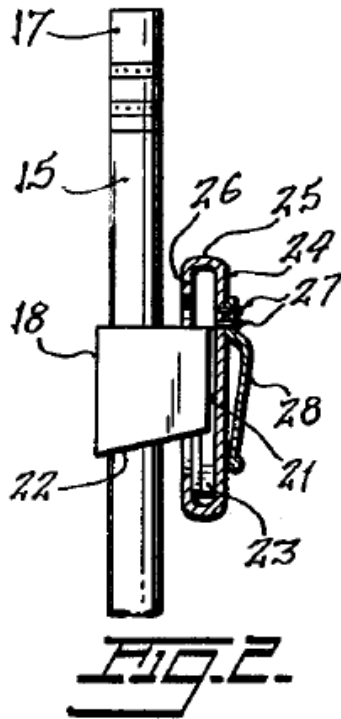


Figure 2 of Markowitz is a side elevation view of the embodiment of Markowitz's Figures 1–5. *Id.* at col. 1, ll. 40–42, col. 2, ll. 42–47.

In view of Markowitz's Figures 1, 2, and 5, and the related description (*id.* at col. 2, ll. 42–47, col. 3, ll. 9–13), we find that the embodiment of Figures 1–5 does not teach the claimed “first surface area [of the base] being at least as large as the second surface area [of the magnet],” by a preponderance of the evidence. Indeed, the surface area of the generally planar surface of magnet 21 (which faces housing 18) appears to be greater than the surface area of the generally planar surface of housing 18 (which faces magnet 21).



Accordingly, we do not sustain the rejection of independent claim 1 and dependent claims 2–6, 8–11, 21, and 25 under 35 U.S.C. § 103.

The other independent claim in the Appeal (claim 19) also recites “the first surface area being at least as large as the second surface area.” In claim 19, the “first surface area” is the size of the “generally planar base surface” and the “second surface area” is the size of the “generally planar surface” of “a first metallic member.” Claim 19 also recites a “second metallic member,” with “at least one of said first and second metallic members being a magnet.” With respect to claim 19, the Examiner relies upon Markowitz, in the same manner discussed above, to teach the claimed “first surface area being at least as large as the second surface area.” *See* Final 7.

Our analysis of claim 1, in regard to Markowitz, applies equally to the rejection of claim 19. Accordingly, we do not sustain the rejection of independent claim 19 and dependent claims 20, 22, and 26 under 35 U.S.C. § 103.

*Reasons to Combine/Modify  
Distinct Embodiments of Markowitz*

The Examiner’s rejections of independent claims 1 and 19 involve combining the teachings of separate embodiments within a single reference (Markowitz). *See* Final 3–4, 7.

The Appellant argues that the Examiner has failed to provide a reason for combining features of distinct embodiments in Markowitz. *See* Appeal Br. 9–12.

Our reviewing court has explained the need for a reason to combine such teachings, notwithstanding their appearance within a single reference:

Whether a rejection is based on combining disclosures from multiple references, combining multiple embodiments from a single reference, or selecting from large lists of elements in a single reference, there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.

*In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017). *See also B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582 (Fed. Cir. 1996) (“When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.”)

In regard to the proposed combination of teachings, within Markowitz, the Examiner states:

[T]he level of ordinary skill in the art at the time of the invention would certainly have included the knowledge that such a one piece construction would reduce material costs, assembly costs during manufacture, and reduce the possibility of breakage during use due to fewer parts being used.

Final 4. Yet, the sufficiency of these particular reasons would depend upon the nature of the particular manufacturing techniques involved, which the Examiner has not articulated — let alone supported with evidence.

The Examiner also states that changing the size/shape of elements in Markowitz’s embodiments “would have been an obvious matter of design choice.” Final 4.

A so-called “design choice” rationale has been deemed appropriate where one prior art element or property is proposed to be substituted for another that achieves the same purpose. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367 (Fed. Cir. 2016) (“The prior art

consistently locates the two sensors at issue in the shredder’s feed, and no party disputes that an ordinary artisan would have found this the obvious location for the combination of sensors. The ordinary artisan would then be left with two design choices.”); *Ex parte Maeda*, Appeal 2010-009814, 2012 WL 5294326, at \*3 (PTAB Oct. 23, 2012) (informative). *Cf. In re Gal*, 980 F.2d 717, 719 (Fed. Cir. 1992) (“The Board held that Gal had simply made an obvious design choice. However, the different structures of Gal and Matsumura achieve different purposes.”) Our reviewing court has cautioned that “[m]erely stating that a particular [limitation] is a design choice does not make it obvious.” *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1069 n.4 (Fed. Cir. 2018) (first alteration in original) (quoting *Cutsforth, Inc. v. MotivePower, Inc.*, 636 F. App’x 575, 578 (Fed. Cir. 2016) (nonprecedential)).

In the present Appeal, the Examiner’s invocation of the design-choice theory is not supported by the findings that Federal Circuit case law requires — e.g., that the available “choices” function equally well. Indeed, Markowitz presents the opposite situation. As discussed above, the reference itself indicates that the use of a larger surface area of magnet 21 (resulting in the protruding finger 23), relative to the opposing surface area on housing 18, plays a significant role in establishing a secure connection with the magnetically attracted disc 24. *See* Markowitz col. 2, ll. 42–47, col. 3, ll. 3–13.

Although the Examiner does not identify an adequate reason to combine teachings of Markowitz’s embodiments, we are not deciding that no such reason might be articulated on the present record. Markowitz discloses at least some inter-embodiment combinations of elements. *See*

Markowitz col. 3, ll. 40–45 (“The pencil engaging clip just described [i.e., of Figs. 8–11], is illustrated as used with a pocket clip disc 24 such as that shown in Figs. 3 and 4, but it is appreciated that this modified clip could also be used with the pocket clip shown in Figs. 6 and 7.”) Yet, we do not address the sufficiency of any such suggestion, in the first instance.

The insufficiency of the Examiner’s reasons to combine teachings of distinct references in Markowitz provides an additional reason for not sustaining the Examiner’s rejections of the claims in the Appeal under 35 U.S.C. § 103.

### CONCLUSION

In summary:

| <b>Claims Rejected</b> | <b>35 U.S.C. §</b> | <b>Reference(s)/Basis</b>  | <b>Affirmed</b> | <b>Reversed</b>          |
|------------------------|--------------------|----------------------------|-----------------|--------------------------|
| 1, 2, 6, 10, 11, 25    | 103                | Markowitz                  |                 | 1, 2, 6, 10, 11, 25      |
| 3–5                    | 103                | Markowitz, Ferrari         |                 | 3–5                      |
| 8, 9                   | 103                | Markowitz, Steele          |                 | 8, 9                     |
| 19, 26                 | 103                | Markowitz, Potter          |                 | 19, 26                   |
| 20                     | 103                | Markowitz, Potter, Ferrari |                 | 20                       |
| 21                     | 103                | Markowitz, Heydt           |                 | 21                       |
| 22                     | 103                | Markowitz, Potter, Heydt   |                 | 22                       |
| <b>Overall Outcome</b> |                    |                            |                 | 1–6, 8–11, 19–22, 25, 26 |

REVERSED