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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GILES FREDERICK MATTHEWS,
NATHANAEL ANDREW HUNT, and WARWICK JAMES BROWN

Appeal 2019-004073
Application 14/512,843
Technology Center 3700

Before WILLIAM A. CAPP, RICHARD H. MARSCHALL, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ seeks our review under 35 U.S.C. § 134(a) of the final rejection of claims 1, 3, 4, and 6–11. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies CA Acquisitions, LLC as the real party in interest. Appeal Br. 1.

THE INVENTION

Appellant's invention is a packaging device for hanging and displaying retail goods such as car floor mats. Spec. ¶ 1. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A packaging container for a car floor mat including:

a main body;

at least one post member extending from the main body for supporting the car floor mat;

a securing arrangement releasably secured to the post member, the car floor mat being supported and retained on the post member when the securing arrangement is secured to the post member;

wherein the securing arrangement includes a catch integrally formed together with and supported on the main body by a hinged connection, the catch including a ring member for encircling the post member when engaging the post member, the ring member having an inwardly directed engagement member for engaging an overbite provided on the post member when the catch is hinged towards and interlocks with the post member, wherein the engagement member includes a tooth extending inwardly within the ring member and located at an outermost position relative to the hinged connection, and wherein the tooth is displaceable away from the location of the hinged connection by deformation of the ring member into an elongate shape having an elongate axis extending through the hinged connection and the tooth respectively; and

first and second discrete finger rests positioned on diametrically opposed sides of the ring member and arranged on opposite sides of the tooth.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

NAME	REFERENCE	DATE
Hutchinson '938	US 5,075,938	Dec. 31, 1991
Hutchinson '139	US 5,199,139	Apr. 6, 1993
Cheng	US 6,330,736 B1	Dec. 18, 2001
Karmeli	US 6,584,656 B1	July 1, 2003
Fiumefreddo	US 9,301,625 B2	Apr. 5, 2016

The following rejections are before us for review:

1. Claims 1 and 6–9 are rejected under 35 U.S.C. § 103 as being unpatentable over Fiumefreddo, Hutchinson '139, and Karmeli.
2. Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Fiumefreddo, Hutchinson '139, Karmeli, and Hutchison '938.
3. Claims 4, 10, and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fiumefreddo, Hutchinson '139, and Cheng.

OPINION

Unpatentability of Claims 1 and 6–9 over Fiumefreddo, Hutchinson '139, and Karmeli

Claim 1

The Examiner finds that Fiumefreddo discloses the invention substantially as claimed, except for a catch that includes a ring member for encircling a post member and that includes a tooth and overbite engagement arrangement as claimed, for which the Examiner relies on Hutchinson '139. Final Action 3–4. The Examiner further finds that Fiumefreddo lacks finger rests that are discrete, for which the Examiner relies on Karmeli. *Id.* 4–5. The Examiner concedes that the prior art fails to disclose the claimed

arrangement of a tooth disposed relative to a hinge, but takes the position that modifying the prior art to conform to the claimed arrangement entails no more than a simple rearrangement of parts involving only routine skill in the art. *Id.* at 4. The Examiner relies on *In re Japikse*, 181 F.2d 1019 (CCPA 1950), as support for the rearrangement of parts determination.

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). The patent applicant may then attack the Examiner’s prima facie determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). However, where the Examiner fails to set forth a prima facie case of obviousness, the burden to rebut the Examiner’s findings and conclusion never shifts to Appellant. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Here, the Examiner did not make out a prima facie case of obviousness, because the *Japikse* decision, which is crucial to the Examiner’s case, does not support the Examiner’s position. *Japikse* involved a hydraulic power press. *Japikse*, 181 F.2d at 1031. The *Japikse* inventor’s claim 3 read on a certain prior art reference (Cannon), except for relocating the position of the starting switch. *Id.* The Court held that there is no invention in relocating the starting switch to a different position, “*since operation of the device would not thereby be modified.*” *Id.* (emphasis added). In the instant case, it is clear that the relative locations of: (1) the post, including the location of the overbite thereon, (2) the catch, including a ring member with a tooth thereon, (3) the hinge; and (4) the finger rests are

all critical to the operation of Appellant's securing device. *See* Figs. 2– 3. In such regard, we note that the claim explicitly recites that – “*the tooth is displaceable away from the location of the hinged connection by deformation of the ring member into an elongate shape.*” Claims App., claim 1. Under the circumstances, it cannot be said that “*operation of the device would not thereby be modified*” if the various components of the securing arrangement were relocated to different positions relative to each other. *Japikse*, 181 F.2d at 1031.

Inasmuch as the Examiner failed to make out a prima facie case of unpatentability, we need not address Appellants' arguments and evidence. We do not sustain the rejection of claim 1.

Claims 6–9

Claims 6–9 depend from claim 1. Claims App. The Examiner's rejection of these claims suffers from the same infirmity that we have discussed above with respect to claim 1. For the same reasons, we do not sustain the rejection of claims 6–9.

Unpatentability of Claim 3 over Fiumefreddo, Hutchinson '139, Karmeli, Hutchinson '938

Claim 3 depends from claim 1 and adds the limitations:

wherein the post member includes a tapered surface at a free end of the post member for engaging the ring member when the catch initially comes into contact with the post member, and wherein the overbite is located at the free end of the post member immediately adjacent the tapered surface.

Claims App. The Examiner relies on Hutchinson '938 for the tapered surface limitation. Final Action 6. Otherwise, the rejection relies on the same inappropriate application of *Japikse* that caused us not to sustain the

rejection of claim 1. *Id.* at 5. For the same reasons given above with respect to claim 1, we do not sustain the rejection of claim 3.

*Unpatentability of Claims 4, 10, and 11
over Fiumefreddo, Hutchinson '139, and Cheng*

Claim 4 is an independent claim that is substantially similar in scope to claim 1 and claims 10 and 11 depend directly from claim 4. Claims App. The Examiner's rejection relies on the same inappropriate application of *Japikse* that caused us not to sustain the rejection of claim 1. *Id.* at 5. For the same reasons given above with respect to claim 1, we do not sustain the rejection of claims 4, 10, and 11.

CONCLUSION

In summary:

Claims Rejected	§	Reference(s)	Aff'd	Rev'd
1, 6-9	103	Fiumefreddo, Hutchinson '139, Karmeli		1, 6-9
3	103	Fiumefreddo, Hutchinson '139, Karmeli, Hutchinson '938		3
4, 10, 11	103	Fiumefreddo, Hutchinson '139, Cheng		4, 10, 11
Overall Outcome				1, 3, 4, 6-11

REVERSED