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MCKELLAR IP LAW, PLLC 784 SOUTH POSEYVILLE ROAD MIDLAND, MI 48640			AGUDELO, PAOLA	
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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* CARMEN GUELI

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Appeal 2019-004436  
Application 14/710,692  
Technology Center 3600

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Before MICHAEL L. HOELTER, ANNETTE R. REIMERS, and  
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 2, 4, and 6. Claims 1, 3, 5, and 7–10 have been withdrawn from consideration. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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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 inventor[] [is] the real part[y] in interest.” Appeal Brief (“Br.”) 2, filed Nov. 7, 2017.

### CLAIMED SUBJECT MATTER

The claimed subject matter relates to “joist hangers that are imbedded into poured concrete for the purpose of retaining the joint support.” Spec. 1:9–11. Claim 2 is independent.

Claim 2 is representative of the claimed subject matter and recites:

2. A hanger for concrete walls, said hanger comprising a unitary metal U-shaped truss support having a first side having a bottom edge, and a second side having a bottom edge;

said first side having a downwardly extending first leg unitarily connected to said bottom edge of said first side;

said second side having a downwardly extending second leg unitarily connected to said bottom edge of said second side, each side having openings which receive fasteners that pass through the openings; each said downwardly extending leg having a plurality of barbs extending therefrom

wherein said hanger is a hanger for concrete walls and the barbs prevent the hanger from pulling out of the concrete wall.

### THE REJECTION

Claims 2, 4, and 6 stand rejected under 35 U.S.C. § 103 as unpatentable over Horton (US 5,488,810, issued Feb. 6, 1996) and Polyak (US 3,365,222, issued Jan. 23, 1968).

### ANALYSIS

Appellant does not offer arguments in favor of claims 4 and 6 separate from those presented for independent claim 2. Br. 3–5. We select claim 2 as the representative claim, and claims 4 and 6 stand or fall with claim 2. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that Horton discloses a hanger having most of the claimed limitations including “downwardly extending first and second legs

([lower portions] 27s) . . . which receive fasteners that pass through [] openings [(nail holes 22)].” Final Act. 2–3<sup>2</sup> (citing Horton 2:29–31, Figs. 1, 3); *see also* Horton Fig. 12. The Examiner acknowledges that “[a]lthough Horton’s downwardly extending legs have means for fastening to a structural member (See fig. 12), it does not explicitly teach each of said downwardly extend[ing] legs have a plurality of barbs extending therefrom.” Final Act. 3. The Examiner, however, finds that Polyak discloses “a device for supporting a joist” in which “the legs of the device include a plurality of barbs ([fastening means] 18) extending therefrom.” *Id.* (citing Polyak 2:54); *see also* Polyak Figs. 2, 3. The Examiner concludes that it would have been obvious to modify the hanger of Horton to incorporate the barbs of Polyak into the device of Horton “because nails and barbs are functionally equivalent materials” and are well-known in the art “for being used interchangeably . . . so as to provide a secure attachment without the need of additional materials which may delay the installation process.” Final Act. 3.

Appellant contends that “Horton teaches a device for joining two beams” and “Horton does not teach or suggest a hanger for [a] concrete wall.” Br. 4. Appellant further contends that “[i]n Horton the lower legs are not embedded into the concrete” and that “[o]ne skilled in the art would not look to Horton because of this difference.” *Id.*

Appellant’s contentions are unpersuasive. “[T]he patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002). “A patent

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<sup>2</sup> Final Office Action (“Final Act.”), dated June 12, 2017.

applicant is free to recite features of an apparatus either structurally or functionally . . . . Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk.” *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). “‘Functional’ terminology may render a claim quite broad. By its own literal terms a claim employing such language covers any and all embodiments which perform the recited function.” *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971). Therefore, “[i]f the prior art structure is capable of performing the intended use, then it meets the claim” (*id.*). Here, claim 2 recites a “hanger for concrete walls” and “the barbs prevent the hanger from pulling out of the concrete wall.” Br. 3 (Claims App.).<sup>3</sup> The Examiner correctly notes that “the hanger is not being claimed in an installed position with a concrete wall,” but merely requires the *capability* of such installation, and correctly finds that “[t]he hanger of the combination is fully capable of being installed in a concrete wall, thus fully capable of being a hanger for concrete walls.” Final Act. 3; *see also id.* at 4, Ans. 3–4.<sup>4</sup>

To the extent that Appellant is contending that Horton is non-analogous art, this contention is unpersuasive.

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

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<sup>3</sup> We refer to the Claims Appendix of the Revised Appeal Brief filed Jan. 2, 2018.

<sup>4</sup> Examiner’s Answer (“Ans.”), dated Mar. 9, 2018.

*In re Clay*, 966 F.2d 656, 658–659 (Fed. Cir. 1992). The Specification discloses that the purpose of “joist hangers” is for “retaining the joint support.” Spec. 1:9–11. Horton describes “hangers” (Horton 1:10–13) and discloses “a novel post cap that is especially useful for *joining* a horizontal beam to a vertical *supporting* post” (*id.* at 1:16–18; emphasis added). Thus, in regard to the first criteria, both Appellant and Horton are in the same field of endeavor, i.e., hangers and joint support. Accordingly, Horton is analogous art.

Appellant contends that “Horton is not even suitable as a hanger for concrete walls” and that “Horton does not teach or suggest using barbs to prevent the hanger from pulling out of the concrete wall.” Br. 4.

“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references []. [The reference] must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, the Examiner relies on Polyak, not Horton, for the disclosure of using extending barbs to resist the removal of the hanger from concrete. *See* Final Act. 3; *see also id.* at 4.

Appellant argues that “Polyak does not teach or suggest using barbs to secure the brace into the concrete wall.” Br. 4.

However, as noted above, the hanger is not being claimed in an installed position with a concrete wall. *See In re Schreiber*, 128 F.3d at 1478 and *In re Swinehart*, 439 F.2d at 213. Further, the Examiner explains that “when used in a concrete wall the barbs are perfectly capable of preventing the hanger from pulling out of the concrete wall.” Final Act. 3;

*see also id.* at 4. Stated differently, when Polyak’s barbs are embedded in a concrete wall, the protruding barbs would prevent the hanger from being pulled out of the concrete wall, the same as a protruding nail. *See* for example, Polyak’s Figure 1 showing what looks like a nail or pin 46 passing through aperture 32. *See also* Polyak 2:60–66. Thus, Appellant’s contention does not apprise us of Examiner error.

Appellant contends that “Polyak teaches the use of a hardened steel pin to affix the brace into the concrete foundation wall” whereas Polyak’s “barbs (fastening means 18) are used to hold the brace to the joist 34.”

Br. 4. Appellant also argues that “one skilled in the art would not look to replace the nail holes of Horton with the barbs of Polyak.” *Id.*; *see also id.* at 5 (arguing that “one skilled in the art would not know to select them”).

Appellant’s underlying arguments rest on the intended use of the barbs, which is unpersuasive for the reasons discussed above. Moreover, “when 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); *see also In re Fout*, 675 F.2d 297, 301 (CCPA 1982).

The Examiner points out that “nails and barbs are functionally equivalent materials” and are well-known in the art “for being used interchangeably . . . so as to provide a secure attachment.” Final Act. 3. Appellant’s statement that “[t]he [b]arbs of Polyak are simply another type of nail” (Br. 4) supports the Examiner’s position that nails and barbs are functional equivalents. *See* Ans. 3. We note Appellant’s contention refers

to Polyak’s disclosure of using a “hardened steel pin” rather than a “nail.” However, Polyak also discloses “[a] suitable fastener **44** *such as* a 16 penny nail, *or the like*, is inserted through the aperture **30**” and “a suitable hardened steel pin *or the like* which passes through the aperture **32**” (Polyak 2:58–63; emphasis added) evidences that hardened steel pins, nails, and barbs are functional equivalents as fastening means.

Appellant contends that “[t]he combination of Horton and Polyak as the Examiner has suggested would result in the barbs being used on the upper portion of the brace to hold the beam to the brace.” Br. 5.

This argument is unpersuasive because it does not address the Examiner’s rejection. The Examiner proposes modifying the hanger of Horton by replacing the nail holes 22 of the lower portion portions 27, rather than the upper portions 26, with the barbs of Polyak. *See* Final Act. 2–3; *see also* Ans. 4.

In summary, and based on the record presented, we are not persuaded the Examiner erred in rejecting independent claim 2 as unpatentable over Horton and Polyak. Accordingly, we sustain the Examiner’s rejection of claim 2. We further sustain the Examiner’s rejection of claims 4 and 6, which fall with claim 2.

## CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
2, 4, and 6	103	Horton and Polyak	2, 4, and 6	

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED