

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN F. CONROY

Appeal No. 2004-2214
Application No. 10/068,983

ON BRIEF

Before PAK, KRATZ and TIMM, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-9, 14-16, 20-23, 25, 26 and 28-32.

BACKGROUND

Appellant's invention relates to a bottle storage rack and a method of storage. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A storage space comprising:
a wine rack configured to be at least partially recessed in a wall and including a wine cradle configured to store a wine bottle with a stopper in contact with a stored wine.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Coglin	5,707,125	Jan. 13, 1998
Borgen	6,361,129	Mar. 26, 2002 (filed May 19, 2000)

Claims 1-7, 9, 16, 20-23, 25, 26, 31 and 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Coglin. Claims 8, 14, 15 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Coglin in view of Borgen.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellant and the examiner concerning the issues before us on this appeal.

OPINION

Having carefully considered each of appellant's arguments set forth in the brief and reply brief, appellant has not persuaded us of reversible error on the part of the examiner. Accordingly, we will affirm the examiner's rejections for substantially the reasons set forth by the examiner in the answer. We add the following for emphasis and completeness.

§ 102(b) Rejection

At the outset, we note that appellant has stated that claims 1-7, 9, 16 and 20 (Group I) stand or fall together as a group and that claims 21, 22, 25, 26, 31 and 32 (Group II) stand or fall together as a group insofar as those claims are rejected as anticipated by Coglein (brief, page 3)¹ Claim 23 is grouped and argued separately. Consequently, we select claim 1 as the

¹ Claims 8, 14, 15 and 28-30 stand rejected under § 103(a). In this regard, rejected claims 8, 14 and 15 are asserted by appellant as not being presented for review at page 2 of the brief notwithstanding that those claims remain rejected under § 103(a) by the examiner and are listed as rejected claims at page 2 of the brief. Thus, along with claims 28-30, we shall consider claims 8, 14 and 15 as standing or falling together with the third grouping of claims in the portion of this decision directed to the examiner's § 103(a) rejection because all of those claims are subject to that common ground of rejection and are not separately argued.

representative claim for the first claim grouping and claim 21 as the representative claim for the second claim grouping.

We observe that anticipation by a prior art reference does not require that reference to recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)). However, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Anticipation under this section is a factual determination. See In re Baxter Travenol Labs., 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing In re Bond, 910 F.2d 831,

833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). In the case before us, the examiner has determined that Coglin discloses, either expressly or inherently, a storage space meeting every limitation of the invention set forth in representative claims 1 and 21, and separately argued claim 23.

Starting with representative claim 1, appellant argues that the wine rack and wine cradle features of representative claim 1 are not met by the wall mounted cabinet disclosed by Coglin. We disagree with that argument because representative claim 1 is not limited to any particular wine rack configuration or wine cradle configuration that structurally distinguishes representative claim 1 from the wall mounted storage cabinet, including shelves, as shown and described in Coglin. In this regard, we note that representative claim 1 does not require that the wine rack or wine cradle be configured to hold any particularly sized bottle or to be shaped in any particular fashion that distinguishes over the shelf-containing storage cabinet of Coglin. Indeed, at page 4, lines 29-31 of appellant's specification, it is made clear that appellant does not limit the terms "wine rack" and "wine cradle" as requiring any particular type of rack or cradle so long as the configuration selected allows for storage of a bottle (of no particularly specified size) thereon in a position such

that a bottle cork can remain in contact with a stored liquid (wine) within the bottle. Here, the examiner has reasonably determined that the shelved storage cabinet of Coglin presents a structure that the claim 1 language reads on. See, e.g., column 2, lines 27-30, column 3, lines 20-50 and column 4, lines 17-61 of Coglin.

Appellant argues that the shelves of the Coglin cabinet are flat and would not provide a cradling function. However, representative claim 1 is not limited to a "non-flat" wine cradle.² As our reviewing court stated in In re Bigio, ___ F.3d ___; 72 USPQ2d 209, 211 (Fed. Cir. 2004), "Nevertheless, this court counsels the PTO to avoid the temptation to limit broad claim terms solely on the basis of specification passages. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader

² See pages 323 and 968 of Webster's II New Riverside University Dictionary (New York, Houghton Mifflin Co., 1984) and the dictionary page referred to by appellants at page 1 of the reply brief for definitions of cradle and rack that are consonant with the examiner's view that the shelved storage cabinet of Coglin meets the structure (framework or stand) for supporting a wine bottle as required by representative claim 1.

definition." See, e.g., Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 906-09, 69 USPQ2d 1801, 1806-09 (Fed. Cir. 2004) (explaining requirement for an express disclaimer in either the specification or prosecution history).

Concerning the separately argued Group II claims and the representative claim 21 of that claim grouping, appellant makes substantially similar arguments, as those discussed above with respect to representative claim 1. In particular and with regard to the "bottle rack" required by representative claim 21, appellant basically maintains that the shelf-containing cabinet of Coglin does not include "the distinct features of bottle racks." However, appellant has not acted as a lexicographer by providing a restrictive definition of the claim term "bottle rack" in their specification that structurally differentiates representative claim 21 from Coglin's cabinet structure. In this regard, the wall recessed cabinet of Coglin is of a size and shape such that the cabinet could function to store a bottle in a horizontal position thereon. For example, Coglin teaches that the cabinet depth exceeds the wall cavity depth (typically about four inches) and the width of the cabinet can be such as to fit between studs about 16-64 inches on center such that general household items can be stored therein. See column 2, line 27

through column 3, line 50 and column 4, line 11 through column 5, line 50 of Coglin.

Consequently, we agree with the examiner's determination that representative claims 1 and 21 are prima facie anticipated by Coglin, and with the examiner's view that the arguments furnished in the briefs do not persuasively refute that determination of the examiner.

Regarding claim 23, appellant again argues that the asserted flat shelves of Coglin do not meet the wine cradle requirement of claim 23. However, for reasons discussed above, we disagree with appellant's viewpoint because claim 23 is not so limited as to exclude a shelf structure as disclosed in Coglin based on the wine cradle language.

It follows that we will affirm the examiner's § 102(b) rejection on this record.

§ 103(a) Rejection

Concerning the examiner's obviousness rejection over Coglin in view of Borgen, we select claim 28 as the representative claim. See footnote 1 above. Representative claim 28 is drawn to a method that requires the step of storing a bottle in a bottle rack with the long axis [of the bottle]

substantially parallel to a wall plane in which the rack is at least partially recessed.

Coglin shows a prior art partially recessed storage cabinet (rack) for storing household items thereon. In addition, Borgen evidences that it was known prior to the time of the present invention to store bottles on a rack or shelf in vertical or horizontal positions. Moreover, appellant acknowledges at page 1 of the specification that it was well known to store a bottle of wine on the side thereof to keep the cork in contact with the wine. Based on those facts, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a recessed cabinet, such as disclosed by Coglin for storing a bottle on the side thereof in a position as called for in representative claim 28. This is especially so because Coglin (column 2, lines 27-31) teaches that the recessed cabinet can be located in a kitchen, garage, dining room, etc. for storing household items. That disclosure coupled with the known storing of sealed bottles on the side thereof would have reasonably suggested the claim 28 bottle storage method to one of ordinary skill in the art with a reasonable expectation of success in so doing.

Appellant's arguments regarding a lack of a description of the claimed method in either Coglein or Borgen is noted. However, a finding of anticipation is not required for sustaining the examiner's obviousness rejection. Here, based on the facts of record discussed above, there is ample motivation for one of ordinary skill in the art to employ the shelves of the storage cabinet of Coglein for supporting a bottle with the long axis thereof in a horizontal position thereon. As such, we will sustain the examiner's obviousness rejection, on this record.

CONCLUSION

The decision of the examiner to reject claims 1-7, 9, 16, 20-23, 25, 26, 31 and 32 under 35 U.S.C. § 102(b) as being anticipated by Coglein and to reject claims 8, 14, 15 and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over Coglein in view of Borgen is affirmed.

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

AFFIRMED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
CATHERINE TIMM)	
Administrative Patent Judge)	

PFK/sld

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DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER, CO 80202-5647