

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 GERALD R. KOEFELDA, WILLIAM P. APPS,
ROGER S. HSU and CYRIL J. BALFE

Appeal No. 2005-1557
Application 09/954,604

ON BRIEF

Before WARREN. OWENS and JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 14 through 18, 20 through 25 and 28 through 43, all of the claims in the application.

Claims 14 and 38 illustrates appellants' invention of a nestable pallet, and are representative of the claims on appeal:

14. A nestable pallet comprising:

a deck member having an upper surface;

a plurality of integrally formed peripheral foot portions extending downwardly from the deck member and disposed about the periphery of the deck member, wherein each of the peripheral foot portions has an outwardly directed recess extending to the upper surface of the deck member for receiving a corresponding foot portion of a like pallet disposed thereabove when in a nested orientation; and

a non-peripheral foot portion extending downwardly from the deck member.

38. A nestable pallet comprising:

a top deck having an upper surface and a peripheral edge including side edges and corners, and at least one foot member extending downwardly from one of the corners of the top deck, the at least one foot member having an exterior surface and an interior surface, the exterior surface having a cutout formed therein, the cutout extending vertically to the upper surface of the top deck and directed outwardly from the corner of the top deck such that the cutout is substantially symmetrical about a diagonal extending from a centerpoint of the top deck to the one corner of the top deck, the cutout defining a projection on the interior surface of the foot member, wherein the cutout is arranged to receive a corresponding projection of an other [*sic*, another] pallet positioned thereabove when in a nested orientation.

The references relied on by the examiner are:

Mathieu	1,408,114	Feb. 28, 1922
Elder et al. (Elder)	5,606,921	Mar. 4, 1997
Bredal et al. (Bredal)	6,234,088	May 22, 2001

(continuation of application 09/101,745, filed Aug. 8, 1996)

The examiner has rejected appealed claims 14 through 18, 20 through 25, 28 through 37, 42 and 43 under 35 U.S.C. § 103(a) as being unpatentable over Bredal in view of Elder (answer, pages 4-5); and claims 38 through 41 under 35 U.S.C. § 103(a) as being unpatentable over Bredal as applied to claims 14 through 18, 20 through 25, 28 through 37, 42 and 43, further in view of Mathieu (answer, page 5).

Appellants state that appealed claims 14 through 18, 20 through 25 and 28 through 37, 42 and 43 “do not stand or fall together” (brief, page 3). With respect to certain of these claims, appellants point to a claim limitation(s) as distinguishing these claims from other claims, and make the bare assertion that the prior art does not show, teach or suggest the limitation(s) (*id.*, pages 3-4). We find that the assertions are not substantive arguments for separate patentability, and indeed, none of the claims are so separately argued by appellants (brief, pages 4-5; reply brief, page 2). Appellants further state that appealed claims 38 through 41 “stand or fall together.” Thus, we decide this appeal based on appealed claims 14 and 38 as representative of the respective grounds of rejection. 37 CFR § 1.192(c)(7) (2003); *see In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (“*See* 37 CFR 1.192(c)(7) (2001). If the brief fails to meet either requirement, the Board is free to select a single claim for each group of claims subject to a common ground of rejection as representative of all claims in that group and

to decide the appeal of the rejection based solely on the selected representative claim.”); *see also* 37 CFR § 41.37(c)(1)(vii) (September 2004).

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the answer and to the brief and reply brief for a complete exposition thereof.

Opinion

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported position advanced by the examiner that, *prima facie*, the claimed nestable pallet encompassed by appealed claim 14 would have been obvious over the combined teachings of Bredal and Elder and the claimed nestable pallet encompassed by appealed claim 38 would have been obvious over the combined teachings of Bredal and Mathieu to one of ordinary skill in this art at the time the claimed invention was made. Thus, we again consider the record as a whole with respect to these grounds of rejection in light of appellants’ rebuttal arguments in the brief and reply brief. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

With respect to the ground of rejection of claim 14, appellants point out that the pallet of Bredal is one-quarter the size of a standard pallet as disclosed at col. 2, ll. 46-49, contending that four of the pallets must be arranged as shown in Bredal **FIG. 12** to support a load (brief, page 4). Appellants submit that “four Bredal quarter-sized pallets used together in the manner intended already have the same arrangement of feet as the full-size pallet of Elder,” and thus, “in Bredal, the four feet together in the center correspond to a single center foot in Elder” (*id.*, page 4). Thus, appellants argue that in view of the size and use of the Bredal quarter-pallets, “there is no motivation for adding a non-peripheral foot . . . to the Bredal pallet” (*id.*, page 5).

The examiner responds that Bredal relates to a single pallet which can be used in an assembly of four such pallets, and the addition of a non-peripheral foot to a single pallet “does not prevent or destroy any of the teachings of Bredal” (answer, pages 5-6). Appellants reply that Bredal teaches the assembly of four quarter-size pallets as an alternative to a full-sized pallet, and thus, there is no need for an additional non-peripheral foot which would add four unnecessary foot portions to the four quarter-sized pallet assembly (reply brief, page 2).

On this record, we agree with the examiner. The issue in this ground of rejection is whether one of ordinary skill in this art would have been led by the combined teaching of Bredal and Elder to add a non-peripheral foot portion to one of the quarter-sized pallets of Bredal in the manner shown by Elder. We find that Bredal in fact would have disclosed to this person “a single sheet pallet” with a “loadbearing surface” that can be and is intended by Bredal to be used alone (e.g., col. 1, ll. 11-16, 20-59 and 63-67; col. 2, ll. 50-52; and col. 2, l. 65, to col. 3, l. 5). We find that Elder would have disclosed a pallet that has peripheral feet and a non-peripheral foot that, among other purposes, provides support without respect to the size of the pallet because Elder specifically discloses that “it can be appreciated that many pallet sizes may be used with the present invention” (e.g., Elder **FIGs. 1-3** and **8-10**; cols. 1-3; and col. 3, ll. 26-28).

Thus, we find in the combined teachings of Bredal and Elder substantial evidence supporting the examiner’s position, and particularly the teaching of Elder that the nestable pallet configuration which includes a non-peripheral foot disclosed therein is not limited by the size of the pallet. Accordingly, we are of the opinion that one of ordinary skill in the art routinely following the applied prior art would have reasonably arrived at the claimed nestable pallet encompassed by appealed claim 14, including every limitation thereof arranged as required therein, without recourse to appellants’ specification. *See generally, In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)(“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”).

Appellants submit, with respect to the ground of rejection of claim 38, that the examiner admits that the legs of Bredal are not symmetrical about a diagonal extending from a centerpoint of the top deck to one corner of the top deck, and there is no motivation to arrive at this structural “because the quarter-pallets of Bredal are already stackable and nestable, as shown in Figure 9 of Bredal” and thus, “the cutouts do not need to be symmetrical about the diagonal in order to stack or nest” (brief, page 6). The examiner responds that the cutout or leg configuration disclosed by Bredal and by Mathieu are “alternative structures” and either can be used without destroying the structure of Bredal (answer, pages 6-7). Appellants reply that the

cutout or leg structures are not alternative because “Bredal teaches the use of four quarter-sized pallets, while Mathieu discloses ‘a chair, table or the like,’ not a pallet,” pointing out that Mathieu makes the chair legs from metal tubes which does not apply to Bredal’s plastic quarter-pallets (reply brief, page 3).

On this record, we agree with the examiner. The issue in this ground of rejection is whether one of ordinary skill in this art would have been led by the combined teaching of Bredal and Mathieu to modify the pallets of Bredal by forming the legs along the diagonal required by claim 38 as taught by Mathieu. We find that Bredal in fact would have disclosed to this person that the “legs . . . arranged at a respective corner” can be in any configuration, as long as each is connected to a sideflange, as the “S-shaped” legs shown in the Bredal Figures are preferred embodiments, which are not controlling in considering the teachings of the reference (e.g., col. 1, ll. 14-16, and col. 2, ll. 1-28). *See generally, In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976) (“[T]he fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.”). Bredal further would taught that the pallets therein can be manufactured from any sheet material, including metals (e.g., col. 1, ll. 11-66, and Bredal claims 8 and 9). We find that Mathieu would have disclosed nestable articles, including weight bearing chairs and tables as well as “other articles with legs which it is desired to pack up for dispatch or for storing,” wherein the legs are formed along diagonals as specified in claim 38 as shown in the Mathieu Figures, including **Figs. 12 and 18**, and can be made of, e.g., metals and moulded materials (e.g., page 2, ll. 34-82). We further find that the legs disclosed by Mathieu are not tubular in shape as one of ordinary skill in the art would have observed from the reference figures.

Therefore, the combined teachings of Bredal and Mathieu provide substantial evidence supporting the examiner’s position, and particularly the absence of a limitation of leg configuration and positioning in the corners of the pallets of Bredal and the teachings of Mathieu with respect to leg positioning in weight bearing, nestable articles, the articles of the two references prepared using the same and similar materials. Accordingly, we are of the opinion that one of ordinary skill in the art routinely following the applied prior art would have reasonably arrived at the claimed nestable pallet encompassed by appealed claim 38, including

every limitation thereof arranged as required therein, without recourse to appellants' specification. *See generally, Keller*, 642 F.2d at 425, 208 USPQ at 881.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of Bredal and Elder and the combined teachings of Bredal and Mathieu with appellants' countervailing evidence of and argument for nonobviousness with respect to each ground of rejection and conclude that the claimed invention encompassed by appealed claims 14 through 18, 20 through 25 and 28 through 43 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (September 2004).

AFFIRMED

