

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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

Appeal No. 2005-2163
Application 10/166,002

ON BRIEF

Before OWENS, JEFFREY T. SMITH, and FRANKLIN, Administrative Patent Judges.

FRANKLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-12. Claims 13-23 have been allowed.

Claims 1, 2, 5, 6, and 9 are representative of the subject matter on appeal and are set forth below:

1. A shelf unit for use with a wire rack, said wire rack having at least two parallel, spaced-apart support rods and a plurality of parallel, spaced-apart, support wires fastened at right angles to said support rods with adjacent, parallel, spaced-apart support rods and adjacent, transverse, parallel, spaced-apart wires forming rectangular openings in said wire rack; said shelf unit comprising:

a) a substantially flat, elongated member capable of transversely contacting said support wires of said wire rack; and

b) a cleat;

1) attached transversely to said substantially flat, elongated member;

2) sized to fit within one of the said rectangular openings formed by said adjacent, parallel, spaced-apart support rods and said adjacent, transverse, parallel spaced-apart wires of said wire rack when said cleat is placed over said one of said rectangular openings and moved directly downward within said one of said rectangular openings; and

3) extendable downward within said one of said rectangular openings sufficiently to bring said elongated flat member in a resting position on said support wires.

2. The shelf unit according to claim 1 further comprising a second cleat, said second cleat;

1) attached transversely to said substantially flat, elongated member;

2) sized to fit within a second one of said rectangular openings formed by said adjacent, parallel, spaced-apart support rods and said adjacent, transverse, parallel spaced-apart wires of said wire rack when said second cleat is placed over said second one of said rectangular openings and moved directly downward within said second one of said rectangular openings; and

3) extendable downward within said second one of said rectangular openings sufficiently to bring said elongated flat member in a resting position on said support wires.

5. The shelf unit according to claim 1 wherein said cleat is capable of frictionally engaging said support wires.

6. The shelf unit according to claim 1 wherein said essentially flat elongated member is formed from at least two slats.

8. The shelf unit according to claim 6, wherein said slats are in substantial contact with each other.

9. The shelf unit according to claim 1 wherein at least a portion of one of a) said flat elongated member and b) said cleat comprise an insect repellent material.

11. The shelf unit according to claim 1 wherein at least a portion of one of a) said flat elongated member and b) said cleat comprise cedar wood.

The examiner relies upon by the following references as evidence of unpatentability:

Biggs et al. (Biggs)	4,567,701	Feb. 4, 1986
Storti	4,768,686	Sep. 6, 1988
Conforti	5,282,595	Feb. 1, 1994

On page 5 of the brief, appellant indicates that the claims do not stand or fall together. Appellant groups the claims according to the respective rejection. Our consideration of a particular claim is made evident in the respective Sections, infra. See 37 CFR § 41.37(c)(1)(vii) (September 2004); formerly 37 CFR § 1.192(c)(7) (2003). Also see Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991).

Claims 1-12 stand rejected under 35 U.S.C. § 112, second paragraph (indefiniteness).

Claims 1, 2, and 5-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Conforti.

Claims 6, 8, and 11 stand rejected under 35 U.S.C. § 103 as being obvious over Conforti in view of Biggs.

Claims 9-11 stand rejected under 35 U.S.C. § 103 as being obvious over Conforti in view of Storti.

We have carefully reviewed appellant's brief and reply brief, the examiner's answer, and the evidence of record. This

review has led us to the following determinations.

OPINION

I. The 35 U.S.C. § 112, second paragraph (indefiniteness) rejection

On page 3 of the answer, the examiner refers to the Office action of March 7, 2003 regarding her position for this rejection. The examiner states that claim 1 is indefinite because it is unclear if appellant is attempting to claim the subcombination of a "shelf unit with use of a wire rack", recited in the preamble, or the combination of a shelf unit and a wire rack. The examiner also asserts that each claim "attempts to define a claimed structure, the cleat or cleat section, by an unclaimed structure, the elements and spacing of wire rack, which is improper". Office Action of March 7, 2003, page 2.

Appellant responds to this rejection on pages 6-12 of the brief, and also in the reply brief. In the reply brief, appellant indicates that he has filed an amendment in which all positive recitations have been changed to functional recitations. The examiner entered this amendment. See the Advisory Action mailed January 3, 2005.

Upon our review of claim 1, we agree with appellant's statement made on page 7 of the brief that he is claiming a shelf unit for use with a wire rack. The functional relationships are self-evident (and therefore are not indefinite), as discussed below.

Claim 1 recites that the shelf unit is for use with a wire rack. The shelf unit comprises two components. Component a) is an elongated member capable of transversely contacting the support wires of a wire rack. Component b) is a cleat and the cleat is sized to fit within one of the rectangular openings of a wire rack when the cleat is placed over the rectangular opening.

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The cleat is also extendable downward within the rectangular opening sufficiently to bring the elongated member in a resting position on the support wires.

In view of the above, we therefore reverse the 35 U.S.C. § 112, second paragraph (indefiniteness) rejection.

II. The 35 U.S.C. § 102(b) rejection of claims 1, 2, and 5-7 as being anticipated by Conforti

We consider claims 1, 2 and 5 in this rejection, according to appellant's aforementioned grouping.

We are in full agreement with the examiner's position regarding this rejection, as set forth on page 3 of the Office Action mailed March 7, 2003. We add the following for emphasis only.

As an initial matter, as determined above, claim 1 is definite regarding the functional relationships recited. That is, the claimed shelf unit for use with a wire rack comprises components a) and b) that have a functional relationship with a wire rack. This does not mean that a wire rack is a component of the claim.¹ In this light, we provide the following discussion.

As correctly stated by the examiner on page 4 of the Answer, the courts have established that a prior art structure that is capable of performing the intended use recited in the claim, meets the claim. That is, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claimed. See Ex parte Masham, 2 USPQ 1647, 1648 (Bd. Pat. App. & Int.

¹ We have fully reviewed appellant's comments made on pages 8-12 of the brief. Appellant argues that the wire rack is a required element of the claims, but we are not so persuaded. As discussed, *supra*, the recitations regarding the wire rack give functional meaning to the claims.

1987). Also see In re Yanush, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973); In re Finsterwalder, 436 F.2d 1028, 1032, 168 USPQ 530, 534 (CCPA 1971); In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); and In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Hence, the issue before us is whether the structure of Conforti is capable of performing the function as recited in appellant's claims 1, 2, and 5.

With regard to claims 1 and 2, Figure 2A of Conforti shows member **1** (which the examiners equates with appellant's elongated member of component a) of claim 1) having multiple cleats **2**. The issue is whether this configuration is capable of transversely contacting support wires of a wire rack, and whether the cleats can fit into rectangular openings of a wire rack and are extendable downward within the rectangular opening. We agree with the examiner that it is capable of such function. Appellant has not provided arguments convincing us otherwise.

We regard to claim 5, claim 5 recites that the cleat must be capable of frictionally engaging the support wires. We also agree with the examiner that the configuration set forth in Conforti is capable of such a function. Appellant has not provided arguments convincing us otherwise.

In view of the above, we therefore affirm the 35 U.S.C. § 102(b) rejection of claims 1, 2, and 5-7 as being anticipated by Conforti.

III. The 35 U.S.C. § 103 of claims 6, 8, and 11 as being obvious over Conforti in view of Biggs

We consider claims 6, 8, and 11 in this rejection. Claim 6 recites that the elongated member is formed of at least two slats. Claim 8 recites that the slats are in substantial contact with each other. Claim 11 recites that the cleat is made of

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cedar wood.

The examiner's position for this rejection is set forth on pages 3-4 of the Office action mailed March 7, 2003, which we incorporate as our own.

Appellant's position for this rejection is set forth on pages 22-28 of the brief. Appellant again argues that his shelving unit is for use with a wire rack. It is true that the claimed shelf unit is for use with a wire rack, but the issue is whether the structure of Conforti is capable of performing the recited function. As discussed above, the structure of Conforti is so capable.

The examiner relies upon Biggs for teaching use of a plurality of cedar wood slats, in contact with each other. March 7, 2003 Office Action, pages 3-4.

On page 23 of the brief, appellant argues that Biggs provides no teaching of the use of contacting members as a shelf unit. We are unpersuaded by this argument because Biggs teaches the making of a prefabricated panel and Conforti teaches the specific use of a similar panel for a shelving system.

Appellant also argues that Biggs does not use vertical wall panels as a horizontal shelf unit that is capable of intermeshing with a wire rack. We are not convinced by this line of argument and refer to our discussion regarding Conforti in this regard, *supra*.

In view of the above, we therefore affirm the 35 U.S.C. § 103 rejection of claims 6, 8, and 11 as being obvious over Conforti in view of Biggs.

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IV. The 35 U.S.C. § 103 rejection of claims 9-11 as being obvious over Conforti in view of Storti

We consider claim 9 in this rejection.

The examiner's position for this rejection is set forth on page 4 of the Office action of March 7, 2003. The examiner relies upon Conforti for disclosing all the elements of the claims except with regard to the components being comprised of either an insect repellent material, an air freshening material, or cedar wood. The examiner relies upon Storti for teaching cedar wood is aromatic and is also known to repel moths and silver fish. The examiner concludes therefore it would have been obvious to have made the flat elongated member of Conforti of cedar wood.

On page 30 of the brief, appellant simply repeats similar arguments that neither Storti or Biggs or Conforti alone or in combination, mention wire racks or the use of an elongated member combined with a cleat, in a fashion as to form a shelf unit. For the reasons discussed supra, we are not convinced by this line of argument.

In view of the above, we therefore affirm the 35 U.S.C. § 103 rejection of claims 9-11 as being obvious over Conforti in view of Storti.

V. Conclusion

The 35 U.S.C. § 112, second paragraph (indefiniteness) rejection of claims 1-12 is reversed.

Each of the prior art rejections is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(iv) (effective e Sept. 13, 2004); 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)).

AFFIRMED-IN-PART

Terry J. Owens)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Jeffrey T. Smith)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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