

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

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5 UNITED STATES PATENT AND TRADEMARK OFFICE

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8 BEFORE THE BOARD OF PATENT APPEALS
9 AND INTERFERENCES

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12 *Ex parte* JOSE V. TRAVEZ and ITALO D. TRAVEZ

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15 Appeal No. 2006-1325
16 Application No. 10/163,610
17 Technology Center 3600

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20 Before TERRY J. OWENS, JENNIFER D. BAHR, and ROBERT E.
21 NAPPI, *Administrative Patent Judges*.

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23 BAHR, *Administrative Patent Judge*.

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25 STATEMENT OF THE CASE

26 Jose V. Travez and Italo D. Travez (Appellants) appeal under
27 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1, 4-22 and
28 24-35, the only claims pending in the application. We have jurisdiction over
29 this appeal under 35 U.S.C. § 6.

30 We AFFIRM-IN-PART and REMAND.

The Invention

Appellants' invention is a prefabricated barrier structure for installation in a hotel, cruise ship, yacht, boat, airplane, bus, recreational vehicle, room, resort, hospital, apartment building, mobile shelter unit or any other commercial or residential structure (Specification 5). The barrier structure comprises a housing, utilities preinstalled through the housing, and at least one amenity, such as a stowable desk, stowable video display, armoire, closet, mirror, refrigerator, sink, mini-bar, baby changing table, ironing board, etc., preinstalled to the housing (Specification 3, 7).

Independent claims 1 and 32 are illustrative of the claimed subject matter and read as follows:

1. A structure for installation in a hotel room, resort, hospital, apartment building or residential structure comprising:
a housing comprising a frame;
insulation attached to said housing;
a replaceable facade covering at least a portion of said housing;
at least one utility preinstalled through said housing; and
at least one amenity preinstalled to said housing.

32. A method of modifying a hotel room, resort, hospital, apartment building or residential structure comprising installing a prefabricated barrier comprising:
a housing comprising a frame;

1 and claims 24 and 30 as being unpatentable over Kelley in view of Brown
2 and Douhet.

3 The Examiner provides reasoning in support of the rejections in the
4 Examiner's Answer (mailed October 20, 2004) and the Supplemental
5 Examiner's Answer (mailed April 8, 2005). Appellants present opposing
6 arguments in Appellants' Brief (filed August 24, 2004) and Reply Brief
7 (filed December 20, 2004).

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ISSUES²

10 The first issue presented in this appeal is whether the "preinstalled"
11 utility or utilities limitation in independent claims 1, 14, 27, 32, and 35
12 distinguishes over the wiring routed through chases in Kelley's work space
13 management system (Br. 7-8). A second issue related to the first issue is
14 whether the language "for installation in a hotel room, resort, hospital,
15 apartment building or residential structure" in the preamble of Appellants'
16 claims gives life and meaning to the claim term "preinstalled" (Br. 9).

17 A third issue is whether Kelley discloses a "stowable" work surface as
18 recited in claims 14 and 32 (Br. 8, 13).

² An Examiner's decision not to enter an amendment after final rejection is a petitionable matter, not an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002.02(c) and 1201. Accordingly, we will not review the issue raised by Appellants on page 3 of the Brief.

1 A fourth issue is whether Kelley’s wiring “[extends] through said
2 frame” as called for in claim 27 notwithstanding that the wiring must be
3 connected to energy distribution block 100 (Br. 10).

4 A fifth issue is whether Kelley discloses an insulation panel attached
5 to the frame “substantially opposite said replaceable façade” as called for in
6 claim 27 (Br. 10-11).

7 A sixth issue is whether claim 32 is a method claim or an article
8 claim. Related to that issue is the significance of the preamble language “of
9 modifying a hotel room, resort, hospital, apartment building or residential
10 structure” in claim 32.

11 A seventh issue is whether the combined teachings of Kelley and
12 Swensson would have suggested forming the work space management
13 system of Kelley with either “at least one integrally molded frame,” as
14 recited in claims 7, 8, and 35, or “at least one molded unitary structure” as
15 recited in claims 19 and 25 (Br. 19-22).

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FINDINGS OF FACT

18 Appellants define the term “preinstall” as encompassing “not only the
19 attachment of a separate amenity to the wall 12 but also includes integral
20 fabrication of an amenity directly to the wall 12 itself” (Specification 7).

21 Appellants’ Specification states “the utilities 48 are preinstalled to the
22 wall 12 such that they are prewired, preplumbed, etc.” (Specification 10).

1 Appellants' Specification describes utilities 48 as "[extending]
2 substantially longitudinally within an upper portion 50 of the frame 14, from
3 an inside end 53 of the frame toward an outside end 54 of the frame 14"
4 (Specification 10).

5 Kelley discloses a work space management system comprising walls
6 that are easily constructed and changed and "wherein convenient electrical
7 and communication access channels are easily installed and movable for
8 ease of set-up and change of systems" (col. 1, ll. 5-11). Kelley's system
9 provides wire management means for enclosing communication and power
10 wiring. The wire management means includes baseline wire management
11 means and waistline wire management means and wiring extending between
12 at least some of the baseline wire management means and the waistline wire
13 management means (col. 3, ll. 39-50).

14 Each of Kelley's walls includes a frame 40 comprising a pair of
15 vertical members 42 welded to horizontal members 44, 46. Panel outserts
16 (removable panels or tiles) 48 hang on the outside surfaces of the frame, as
17 seen in Figs. 2 and 4. The panel outserts 48 can be formed from a metal pan
18 turned inwardly at the edges and covered or painted as desired and can be
19 provided with insulation 48c within the metal pan, as illustrated in Fig. 4
20 (col. 5, ll. 50-68). Additionally, panel outserts can be formed as a screen or
21 CRT display (col. 9, ll. 9-11).

22 As illustrated in Fig. 2, Kelley discloses work surfaces 20 mounted on
23 the walls 16 in cantilevered fashion on removable brackets 38.

1 Kelley's wiring arrangement is illustrated in Figs. 2-7 and includes a
2 baseline chase 72 and a waistline chase 106. Communication wiring 96 is
3 laid in chase 72 behind hinged cover 82 and is connected to communication
4 wiring in chase 106 via connectors 104, distribution blocks 100 and festoon
5 98. A convenience outlet 102 is plugged into energy distribution block 100
6 and extends out through an opening in the hinged cover 82 for direct access
7 of electricity (col. 6, l. 65 to col. 7, l. 35). Convenience outlets 102 may
8 likewise be connected to distribution block 100 in the waistline energy
9 distribution system. Power may be supplied from a monument 120 (Fig. 6)
10 via a cable 122 connected to a power block 124 positioned behind an
11 opening in an access cover 95 of hinged cover 82 (col. 8, ll. 18-25). Power
12 may also or alternatively be supplied from a ceiling mounted junction box
13 138 via electrical wire carried in a flexible conduit 140 through a power-pole
14 conduit 142 and to the energy distribution block 100 beneath chase 106 (col.
15 8, ll. 26-35). As illustrated in Fig. 5, chase 106 is disposed within the frame
16 40. Further, as shown in Fig. 8, while the electrical and communication
17 wiring extends around (outside) the frame when passing between wall
18 sections, the wiring extends within the frame in each wall section.

19 Swensson discloses pre-fabricated vanity units and nurse's station
20 modules, preferably constructed as a one piece integrally molded structure
21 (Swensson: abstract; col. 6, ll. 31-34 and 52-53). Swensson recognizes that
22 the use of integrally molded parts in such modules provides great structural
23 integrity to the module and makes it economical to manufacture and install

1 (col. 7, ll. 8-10). Swensson also discloses a modular sidewall assembly
2 made up of a plurality of pre-fabricated wall panel segments connected
3 together at the onsite location (col. 3, ll. 1-10). Swensson emphasizes that,
4 with the disclosed pre-fabricated modular system, the majority of on-site
5 skill work, such as carpentry, plumbing and electrical, is eliminated; most of
6 the work is done in a controlled factory environment (col. 9, ll. 13-19). In
7 short, Swensson recognizes that using pre-fabricated and preferably
8 integrally molded parts in modular wall structures facilitates installation and
9 improves structural integrity.

10 Brown discloses a display screen 50 adjustably mounted to a panel of
11 an office paneling system.

12 Douhet discloses a remote control for a video display system.

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ANALYSIS

15 We turn our attention first to the anticipation rejection based on
16 Kelley. Appellants' primary argument, with respect to all of the claims so
17 rejected, is that Kelley's wiring (the at least one utility) is not "preinstalled"
18 because Kelley uses chases and connects the wiring to distribution blocks
19 100. Based on Appellants' description of their preinstalled utilities 48 as
20 being prewired or preplumbed (Specification 10), the skilled artisan would
21 understand "preinstalled" utilities to be utilities, such as electrical or
22 communication wiring, laid into the wall sections prior to installation of the
23 wall systems and would not read the "preinstalled" terminology as excluding

1 the use of conduits or chases to carry such wiring or the connection of
2 wiring to distribution blocks within the wall system and behind covers.

3 Appellants argue the preamble language “for installation in a hotel
4 room, resort, hospital, apartment building or residential structure” in claim 1
5 gives meaning to the limitations requiring at least one preinstalled utility
6 (Br. 9). The preamble of a claim does not limit the scope of the claim when
7 it merely states a purpose or intended use of the invention; however, terms
8 appearing in a preamble may be deemed limitations of a claim when they
9 give meaning to the claim and properly define the invention. *See In re*
10 *Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). In
11 this instance, the preamble language in question appears to merely state a
12 purpose or intended use of the structure. Kelley’s work space management
13 system appears reasonably capable of being installed in any of the
14 environments set forth in the preamble and Appellants have not cogently
15 explained why it is unsuitable for such use. Moreover, it is not apparent, and
16 Appellants have not explained, how the preamble language in question
17 further defines or limits the structure, including the at least one
18 “preinstalled” utility, recited in the claims.

19 In light of the above, Appellants’ arguments do not demonstrate that
20 the Examiner has erred in rejecting claim 1 as being anticipated by Kelley.
21 The rejection is sustained as to claim 1, as well as claims 4-6 and 9-11 which
22 Appellants have not argued separately apart from claim 1.

1 Appellants additionally argue Kelley does not anticipate claim 14, or
2 the claims depending from claim 14, because Kelley does not disclose a
3 “stowable” desk, a video display, an armoire or a closet as called for in these
4 claims (Br. 8). The Examiner contends the desktop 20 (Kelley’s Fig. 2) is
5 “stowable” in the sense that it can be removed from the wall and stowed
6 (Answer 9). The Examiner’s position seems reasonable, as Appellants have
7 not described or defined “stowable” in any manner that would require
8 anything more than capability to be stowed or stored. Moreover, Kelley’s
9 CRT display unit (col. 9, l. 10) is a video display and thus meets the amenity
10 limitation in claim 14. Appellants’ arguments thus also fail to demonstrate
11 the Examiner erred in rejecting claims 14-18, 20-22, and 26 as being
12 anticipated by Kelley. The rejection is sustained as to these claims.

13 Appellants contend that Kelley does not anticipate claim 27 because
14 Kelley’s utilities do not “[extend] through said frame” as required by the
15 claim. Specifically, Appellants urge that claim 27 requires that the utility lie
16 completely within the framework of the prefabricated wall (Br. 10). We find
17 no such requirement in claim 27. Appellants cite the disclosure in the
18 paragraph bridging pages 10 and 11 of the Specification as making clear that
19 “extending through said frame” means the utilities lie completely within the
20 frame and are connected to an outside source (Reply 3). We find no such
21 definition of “extending through said frame” in the cited paragraph. In any
22 event, Kelley’s wiring is connected, as discussed above, via energy
23 distribution blocks 100, to an outside source. As illustrated in Kelley’s Figs.

1 3, 5 and 8, Kelley's wiring extends through and within the frame during at
2 least a portion of its run, for example, through the waistline chase 106.
3 Kelley therefore meets the "utilities extending through said frame" limitation
4 of claim 27.

5 Appellants' argument that Kelley fails to teach or suggest an
6 insulation panel attached to the frame substantially opposite a replaceable
7 façade (Br. 10), as recited in claim 27, is not well taken. While insulation
8 48c is disposed within one outsert 48, another replaceable outsert 48 is
9 attached to the frame substantially opposite the insulation 48c.

10 In light of the above, Appellants' arguments fail to demonstrate error
11 on the part of the examiner in rejecting claim 27 as being anticipated by
12 Kelley. The rejection of claim 27, as well as claims 28 and 31 which
13 Appellants have not argued separately apart from claim 27, is sustained.

14 The Examiner contends that claim 32 does not recite any method step
15 and improperly treats claim 32, as well as claims 33 and 34 depending from
16 claim 32, as article claims (Answer 10). Claim 32 recites a method of
17 modifying a hotel room, resort, hospital, apartment building or residential
18 structure comprising a step of installing a prefabricated barrier. Claims 32-
19 34 are therefore clearly method claims. Moreover, the preamble language
20 "of modifying a hotel room, resort, hospital, apartment building or
21 residential structure" is not just intended use. Rather, this language defines
22 the environment in which the method is performed and, thus, gives life and
23 meaning to claims 32-34.

1 Anticipation is established only when a single prior art reference
2 discloses, expressly or under the principles of inherency, each and every
3 element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys.,*
4 *Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

5 Kelley refers to “dividing a room” (Abstract) and to an “office
6 environment” having work stations according to Kelley’s invention (col. 5,
7 ll. 19-20) but does not specify that the office environment is any of a hotel
8 room, resort, hospital, apartment building or residential structure. Kelley
9 thus does not disclose a method of modifying a hotel room, resort, hospital,
10 apartment building or residential structure, as called for in claims 32-34 and,
11 therefore, does not anticipate claims 32-34. The anticipation rejection
12 cannot be sustained as to these claims.

13 This application is remanded, pursuant to 37 CFR § 41.50(a)(1), for
14 the Examiner to consider whether claims 32-34 should be rejected under
15 35 U.S.C. § 103(a) as being unpatentable over Kelley. In other words, in
16 response to the remand, the Examiner should consider whether Kelley would
17 have suggested to one of ordinary skill in the art installing the work
18 management system of Kelley in any of the locations referred to in the
19 preamble of claim 32.

20 We turn next to the rejection of claims 7, 8, 19, 25, and 35 as being
21 unpatentable over Kelley in view of Swensson. The Examiner contends that
22 the combined teachings of Kelley and Swensson would have suggested
23 modifying Kelley “by using integrally molded components in order to

1 increase the strength of the system” (Answer 6). Appellants contend that
2 one skilled in the art would have found no motivation to combine the
3 teachings of Kelley and Swensson and that, even if combined, they would
4 not have suggested all the elements of the claims so rejected. In particular,
5 Appellants urge that Swensson cannot have suggested an integrally molded
6 frame, because Swensson does not disclose any frame, much less an
7 integrally molded frame (Br. 18-21). Further, according to Appellants, the
8 Examiner’s stated motivation to combine “to increase the strength of the
9 system” is not well founded because Kelley’s system is designed to divide a
10 room and is not a load bearing wall (Br. 20-21).

11 The motivation to modify Kelley to use integrally molded parts, such
12 as an integrally molded frame or portions of a frame, either with or without
13 an integrally molded façade, is found in Swensson’s teaching that using pre-
14 fabricated and preferably integrally molded parts in modular wall structures
15 facilitates installation and improves structural integrity. While Kelley’s
16 divider walls may not be designed or intended to bear building loads, they
17 are substantial walls and are designed to support loads such as cantilevered
18 work surfaces, shelves and CRT video display panels. Accordingly, one of
19 ordinary skill in the art would have appreciated that ease of installation and
20 structural integrity would be desirable attributes for the wall units of
21 Kelley’s system and would have found suggestion to modify Kelley as
22 proposed by the Examiner. That Swensson may not specifically teach or
23 suggest an integrally molded frame of the type used by Appellants is of no

1 moment, as all of the features of the secondary reference need not be bodily
2 incorporated into the primary reference (*see In re Keller*, 642 F.2d at 425,
3 208 USPQ at 881) and the artisan is not compelled to blindly follow the
4 teaching of one prior art reference over the other without the exercise of
5 independent judgment (*see Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d
6 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)). The decision of which
7 components of a modular system of the type disclosed by Kelley to
8 integrally mold together and which components to form separately for
9 attachment at installation is a design consideration within the skill of the art.

10 The rejection is sustained.

11 We also sustain the rejections of claims 12, 13 and 29 as being
12 unpatentable over Kelley in view of Brown and claims 24 and 30 as being
13 unpatentable over Kelley in view of Brown and Douhet as Appellants have
14 not challenged such with any reasonable specificity (*see In re Nielson*, 816
15 F.2d 1567, 1572, 2USPQ2d 1525, 1528 (Fed. Cir. 1987)).

16
17 SUMMARY

18 The decision of the Examiner to reject claims 1, 4-22 and 24-35 is
19 affirmed as to claims 1, 4-22, 24-31 and 35 and reversed as to claims 32-34.

20 The application is remanded, pursuant to 37 CFR § 41.50(a)(1), for
21 consideration of a rejection of claims 32-34 under 35 U.S.C. § 103(a) as
22 discussed above.

Appeal No. 2006-1325
Application No. 10/163,610

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