

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-2626
Application No. 10/315,175
Technology Center 3600

ON BRIEF

Before FRANKFORT, BAHR, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12, 14-19 and 21, which are all of the claims pending in this application.

We REVERSE, and enter a New Ground of Rejection under the provisions of 37 CFR § 41.50(b).

BACKGROUND

The appellant's invention relates to a modular organizing system (specification, page 1). Specifically, each modular storage unit includes an interlocking system enabling the storage units to be stacked. The interlocking system may include a mating depression and a mating rib (specification, page 3). Claim 1 is representative of the invention, and is reproduced as follows:

1. A modular organizing system for storing and displaying objects, the modular organizing system comprising:

a first modular storage unit comprising a top wall, a bottom wall, a back wall, and a pair of opposing sidewalls coupled to the top wall and the bottom wall, with a mating depression on the top wall or the bottom wall and a mating rib on the top wall or bottom wall without the mating depression, wherein the back wall comprises at least one hanging device and is adapted to enclose at least a portion of the area formed by the top wall, bottom wall, and opposing sidewalls; and

a second modular storage unit comprising a top wall, a bottom wall and a pair of opposing side wall coupled to the top wall and bottom wall, with a mating depression on the top wall or bottom wall and a mating rib on the top wall or bottom wall without the mating depression,

wherein the mating depressions and the mating ribs are adapted to interact thereby allowing the modular storage units to be stacked.

Appeal No. 2006-2626
Application No. 10/315,175

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

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| Blowers | 3,529,878 | Sep. 22, 1970 |
| Roderick | 3,999,475 | Dec. 28, 1976 |
| Keffer | 5,551,772 | Sep. 3, 1996 |
| Dunn | 5,800,027 | Sep. 1, 1998 |
| Ovadia | 5,826,711 | Oct. 27, 1998 |
| Lin et al. (Lin) | 6,348,864 | Feb. 19, 2002 |

Claims 1-3, 6-9, 15, 16 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Keffer in view of Blowers.

Claims 4, 5, 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Keffer in view of Blowers and Roderick.

Claims 10 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Keffer in view of Blowers and Lin.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Keffer in view of Blowers and Ovadia.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Keffer in view of Blowers and Dunn¹.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed March 17, 2006 for the examiner's complete reasoning in support

¹ The rejection of claims 1-12, 14-19 and 21 under 35 U.S.C. § 112, first paragraph, has been withdrawn by the examiner (answer, page 3).

Appeal No. 2006-2626
Application No. 10/315,175

of the rejections, and to the brief (filed January 17, 2006) for the appellant's arguments there against.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 C.F.R. § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claims 1-3, 6-9, 15, 16 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Keffer in view of Blowers. We note at the outset that appellant argues the claims as a group. Accordingly, we select claim 1 as representative of the group. By way of background, we note that in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v.*

Appeal No. 2006-2626
Application No. 10/315,175

John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, page 6) is that Keffer lacks mating depressions and ribs. To overcome this deficiency of Keffer, the examiner turns to Blowers for a teaching of stackable storage units having mating depressions and ribs. Appellant's position (brief, pages 4 and 5) is that Blowers does not teach or suggest the mating ribs recited in claim 1, and that the pins 20 of Blowers are used for stacking the sleeves 5 (storage units), but are external to the sleeves. It is

Appeal No. 2006-2626
Application No. 10/315,175

argued (*id.*) that because Keffer's storage units are "free standing," Keffer teaches away from the units being stackable.

From our review of Keffer, we are not persuaded that the reference teaches away from the units being stackable. The fact that the storage units are free standing means that they are capable of supporting themselves, e.g., on a floor or table, without external support. We find no convincing reason why an artisan would be led away from stacking "free standing" storage units.

From our review of Blowers, we agree with the examiner (answer, page 13) that the mating sockets and pins of Blowers are used to ensure alignment of the units when stacked. However, we do not agree with the examiner (*id.*) that "the pins disclosed by Blowers are ribs."

Blowers discloses locating pin or pins 20 (e.g., col. 2, lines 42 and 50). However, claim 1 requires ribs, not pins. A pin is not a rib because their structures differ. From appellant's specification, we find references to ribs (see e.g., pages 3 and 7). However, we find no specific definition of a rib. Nor do we find any specific description of the structure of the ribs. Turning to a dictionary definition of a rib, we find from the American Heritage Dictionary of the English Language ©1976², that a rib is defined, *inter alia*, as "some part or piece similar to a rib and serving to shape or support: the rib of an umbrella." We additionally find that a "pin" is defined, *inter alia*, as "a slender, cylindrical piece of wood or metal for holding or fastening parts together, or serving as a support for suspending, one thing from another." From the definition of these terms, we find that the pins 20

² A copy of the pertinent pages of the document is enclosed with our Decision.

Appeal No. 2006-2626
Application No. 10/315,175

of Blowers are generally consistent with the definition of a pin because of the pins short, pointed shape and a head portion. We similarly find that the pin 20 of Blowers is not consistent with the definition of a rib for the same reasons; i.e., the short, pointed shape and head portion. Because Blowers does not describe a rib as recited in claim 1, we find that upon combining the teachings of Keffer and Blowers, that the prior art as a whole fails to establish a *prima facie* case of obviousness of claim 1. In addition because each of the additional independent claims 8, 15 and 21 also require ribs, we cannot sustain the rejection of claims 1-3, 6-9, 15, 16 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Keffer in view of Blowers.

We are also unable to sustain the rejections of dependent claims 4, 5, 10-12, 14, and 17-19 because even though the additional references relied upon by the examiner would have suggested to an artisan the features relied upon in those claims, the additional references to Roderick, Lin, Ovadia and Dunn fail to make up for the deficiencies of the basic combination of Keffer and Blowers.

New Ground of Rejection

Under the provisions of 37 CFR § 41.50 (b) we enter a new Ground of Rejection of independent claims 1, 8, 15 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Keffer in view of Hickson, USP 3,627,393, issued December 14, 1971. This reference was located by the Board.

As noted, *supra*, Keffer fails to disclose the claimed ribs and depressions. Hickson discloses a series of stacked containers 1, labeled as A-G in figure 4. As shown in figure 1, each container has a tongue 2 which engages groove 3 (col. 2,

Appeal No. 2006-2626
Application No. 10/315,175

lines 72-75). From the disclosure of Hickson of having a tongue and groove connection for use in stacking the containers, and the broadly described and shown ribs and depressions disclosed by appellant, we find that the tongue 2 and groove 3 on each container meets the claimed rib and depression. From the disclosure of using a tongue and groove arrangement to provide for stacking of containers, we find that it would have been obvious to one of ordinary skill in the art to stack containers like those of Keffer, if so desired, using a mating tongue or rib and depression arrangement like that taught in Hickson

We are not persuaded by appellant's assertion that the free standing container of Keffer teaches away from making the container stackable for the reasons advanced, *supra*, and because the bottom container of Hickman has a flat bottom 24, which we find will make the free standing containers stackable.

Observations and Remarks

Because we are primarily a Board of review, we have only applied the newly located prior art against the independent claims. We leave it to the examiner to determine whether the references to Keffer and Hickson, alone or in combination with Roderick, Lin, Ovadia and Dunn, or any other prior art, would have suggested to an artisan the language of any, or all, of the remaining claims.

This decision contains a new ground of rejection pursuant to 37 CFR ' 41.50(b) (effective September 13, 2004). 37 CFR ' 41.50(b) provides "[a] new

Appeal No. 2006-2626
Application No. 10/315,175

ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR ' 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under ' 41.52 by the Board upon the same record. . . .

Appeal No. 2006-2626
Application No. 10/315,175

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-12, 14-19, and 21 under 35 U.S.C. § 103(a) is reversed. In addition, under the provisions of 37 CFR § 41.50(b), we enter a new ground of rejection of independent claims 1, 8, 15 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Keffer in view of Hickson. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 CFR § 41.50(B).

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| CHARLES E. FRANKFORT |) |
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| JENNIFER D. BAHR |) BOARD OF PATENT |
| Administrative Patent Judge |) APPEALS |
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| STUART S. LEVY |) |
| Administrative Patent Judge |) |

Appeal No. 2006-2626
Application No. 10/315,175

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