

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 WANJA BELLANDER

Appeal No. 2006-3002
Application No. 10/399,820
Technology Center 3700

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5-8, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a refrigerator with a separate, heat insulating compartment having a drain pipe (specification, page 1).

Claim 5 is representative of the invention, and is reproduced as follows:

5. A refrigerator comprising:
 - a cooled interior food storage space;
 - at least one separate, thermally insulated compartment which is cooled to approximately a same temperature as the food storage space, and which is smaller than the food storage space; and
 - a drain pipe provided in the separate, thermally insulated compartment to drain condensation water which forms when a heated food storage container cools in the compartment.

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

Shueh et al.	4,207,753	Jun. 17, 1980
Wilson	4,627,246	Dec. 9, 1986
Jones	5,216,900	Jun. 8, 1993

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shueh.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shueh in view of Wilson.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shueh in view of Jones.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Shueh in view of Wilson and Jones.

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 October 19, 2005) for the examiner's complete reasoning in support of the

Appeal No. 2006-3002
Application No. 10/399,820

rejections, and to the brief (filed August 1, 2005) and reply brief (filed November 21, 2005) for the appellant's arguments thereagainst.

Only those arguments actually made by appellant has 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 briefs 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 claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Shueh.

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. 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,

Appeal No. 2006-3002
Application No. 10/399,820

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 3) is that

It is considered to have been an obvious matter of product design as to how big each compartment was relative to the other and whether they are operated at about the same temperature since the two compartments are well-insulated from each and can be sized accordingly to the intended use of each compartment.

Appellant's position (brief, page 5) is that the examiner's assertions are unsupported by any objective evidence and that the modifications suggested by the examiner would result in at least one of the two compartments being inoperative for its intended purpose. It is argued (brief, page 6) that the modifications of Shueh suggested by the examiner would result in the freezer compartment and the fresh food compartment being cooled to the same temperature, and the freezer compartment being larger than the fresh food compartment. Appellant further argues (*id.*) that by definition, the freezer compartment is not set to the same temperature as the fresh food compartment.

The examiner responds (answer, page 5) that modifying Shueh such that there are two fresh food compartments and no freezer would not have been an unobvious modification because the size and the temperature of the compartment has no effect on how the drain pipe functions.

Appeal No. 2006-3002
Application No. 10/399,820

In the reply brief, appellant asserts (page 2) that it is not the purpose of the freezer compartment to serve as a fresh food compartment, and that “[t]hus, to modify a freezer compartment to have a temperature unsuitable for freezing food would render the freezer compartment unsuitable for its intended use as a freezer.”

From our review of the record, we find, for the reasons which follow, that the teachings and suggestions of Shueh would not have suggested the invention of claim 5.

Shueh is directed to a top mount refrigerator (figure 1) having a lower, fresh food compartment 12 including drain tube 56, and an upper freezer compartment 14 (col. 1, lines 9-12, col. 2, lines 30-32 and col. 3, line 21).

From the disclosure of Shueh, we find no description of a separate, thermally insulated compartment which is separated from the cooled interior food storage space, and which is the same temperature as the cooled interior food storage space and which is smaller than the cooled interior food storage space, as recited in claim 5. We agree with the examiner to the extent that the relative size and temperature of the freezer and cooled interior food storage spaces would have been adjustable by an artisan. However, it is at this point that we part company with the examiner.

As correctly noted by appellant (brief, page 6) there is no motivation or suggestion to have made the freezer of Shueh larger than the fresh food compartment. Nor is there any motivation or suggestion to make the freezer and the fresh food compartments the same temperature. Shueh discloses (col. 1, lines 12-19) that

The freezer compartment has an evaporator disposed in conjunction with the walls thereof to provide below freezing temperature to the freezer compartment. A portion of the evaporator passes through the walls of the fresh food compartment and is disposed within the fresh food compartment to provide cooling temperatures above the freezing point.

From the disclosure of Shueh, we find a teaching of the freezer being set below freezing temperature and having the fresh food storage areas cooled to temperatures above the freezing point. We therefore find no support for having the freezer space

Appeal No. 2006-3002
Application No. 10/399,820

smaller than the cooled interior storage space and having the separate insulated compartment at the same temperature as the freezer, other than from using appellant's invention as a template for modifying the prior art.

In sum, because Shueh does not disclose a separate, thermally insulated compartment that is smaller than the cooled interior food storage space, and is about the same temperature as the cooled interior food storage space, we find that the examiner has failed to establish a *prima facie* case of obviousness of claim 5. Accordingly, we cannot sustain the rejection of claim 5 under 35 U.S.C. § 103(a).

With respect to claims 6-8, we cannot sustain the rejections of these claims because the references to Wilson and Jones fail to make up for the deficiencies of Shueh.

CONCLUSION

To summarize, the decision of the examiner to reject claims 5-8 under 35 U.S.C. § 103 is reversed.

Appeal No. 2006-3002
Application No. 10/399,820

REVERSED

JENNIFER D. BAHR)
Administrative Patent Judge)
)
)
)
)
) BOARD OF PATENT
STUART S. LEVY) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
)
)
)
ANTON W. FETTING)
Administrative Patent Judge)

Appeal No. 2006-3002
Application No. 10/399,820

Frishauf, Holtz, Goodman & Chick, PC
220 Fifth Avenue
16th Floor
New York, NY 10001-7708