

1 The opinion in support of the decision being entered
2 today is *not* binding precedent of the Board
3

4 UNITED STATES PATENT AND TRADEMARK OFFICE
5

6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
9

10
11 *Ex parte* FORREST F. WING, JOHN J. PINK, ERIC S. SVENBY,
12 MICHAEL J. EVELAND, TODD E. KNIFFEN, RAVI K. SAWHNEY,
13 TIMOTHY MARK NUGENT, and JOHN FRANK ZINNI
14

15
16 Appeal 2006-3342
17 Application 10/195,217
18 Technology Center 3600
19

20
21 Decided: September 26, 2007
22

23
24 *Before:* TERRY J. OWENS, MURRIEL E. CRAWFORD, and LINDA E.
25 HORNER, *Administrative Patent Judges.*
26
27 CRAWFORD, *Administrative Patent Judge.*
28

29
30 DECISION ON APPEAL
31

32 STATEMENT OF CASE

33 Appellants appeal under 35 U.S.C. § 134 (2002) from a rejection of
34 claims 1-8, 10-17, and 19-23. We have jurisdiction under 35 U.S.C. § 6(b)
35 (2002).

36 Appellants invented a shelf (Specification 1).

37 Claim 1 under appeal reads as follows:

1 1. A shelf for use in a refrigerator having a refrigerated
2 compartment with opposite side walls, a rear wall, a top wall, and a
3 bottom wall, the shelf comprising:
4 a pair of support brackets extending forwardly from the rear wall;
5 a shelf member slidably mounted on the brackets for forward and
6 rearward movement between extended and retracted positions;
7 the shelf member having a molded perimeter edge with a pair of
8 sockets in a rear portion of the perimeter edge; and
9 a rear wall member having a pair of legs adapted for receipt in the
10 sockets such that the wall member extends upwardly from the
11 rear portion of the shelf member.

12
13 The Examiner rejected claims 7, 8, 11, 12, 14-17, 20 and
14 22 under 35 U.S.C. § 102(e) as anticipated by Mahone.

15 The Examiner rejected claims 15-17, 22 and 23 under 35 U.S.C. §
16 102(e) as being anticipated by Di Girolamo.

17 The Examiner rejected claims 1-6 under 35 U.S.C. § 103(a) as
18 unpatentable over Fish in view of Mahone.

19 The Examiner rejected claims 10, 13, 19 and 21 under 35 U.S.C. §
20 103(a) as being unpatentable over Mahone.

21 The Examiner rejected claims 19 and 21 under 35 U.S.C. § 103 as
22 being unpatentable over Di Girolamo.

23 The prior art relied upon by the Examiner in rejecting the claims on
24 appeal is:

25 Fish	US 5,813,741	Sep. 29, 1998
26 Mahone	US 6,138,583	Oct. 31, 2000
27 Di Girolamo	US 6,310,294 B1	Oct. 30, 2001

28
29 Appellants contend that Mahone does not disclose a refrigerator shelf
30 and that Mahone does not disclose a rear wall member but rather a front wall

1 member. Appellants also contend that Mahone does not disclose a shelf
2 member that is slidably mounted on brackets.

3 Appellants contend that Di Girolamo does not disclose a shelf adapted
4 to be mounted within the refrigerator.

5 Appellants further contend that there is no motivation to provide Fish
6 with a pair of removable legs as disclosed in Mahone because one never
7 wants to remove the shelf in Fish. According to Appellants, Mahone is not
8 analogous art as Mahone does not relate to a refrigerator shelf.

9 Appellants also contend that it would not have been obvious to form
10 the rear wall member of the Fish/Mahone shelf by molding and so as to be
11 1½ inches tall.

12

13

ISSUES

14 The first issue is whether Appellants have shown that the Examiner
15 erred in that finding that Mahone discloses a shelf that is capable of use in a
16 refrigerator.

17 The second issue is whether the Appellants have shown that the
18 Examiner erred in finding that Mahone discloses a rear wall member that is
19 slidably mounted on brackets.

20 The third issue is whether Appellants have shown that the Examiner
21 erred in finding that Di Girolamo discloses a shelf adapted to be mounted
22 within the refrigerator.

23 The fourth issue is whether the Appellants have shown that the
24 Examiner erred in holding that there would be a reason for providing the
25 Fish shelf with a pair of removable legs as disclosed in Mahone.

1 The fifth issue is whether the Appellants have shown that the
2 Examiner erred in holding that Mahone is analogous art.

3 The last issue is whether the Appellants have shown that the Examiner
4 erred in holding that it would have been obvious to form the rear wall
5 member of the Fish/Mahone shelf by molding and so as to be 1½ inches tall.

6
7

FINDINGS OF FACT

8 Mahone discloses a shelf which includes a pair of support brackets 70
9 and a shelf member 90 mounted on the support brackets 70 (Figs. 1 and 1A).
10 A wall member 95 has a pair of legs which are mounted in a socket 94 in
11 shelf member 90 (Fig. 14). The Mahone shelf is capable of being placed in a
12 refrigerator in any orientation including one in which the wall member 95 is
13 in the rear of the refrigerator and therefore forms a rear wall. During
14 assembly of the shelf system disclosed in Mahone the shelf member is slid
15 into place on the brackets 70 (Fig. 1A). Mahone is reasonably pertinent to
16 the problem of keeping items from falling off a shelf (Mahone, col. 19, ll. 8-
17 17).

18 Di Girolamo discloses a rack for cable management. While the Di
19 Girolamo rack may be placed within a refrigerator, the rack is not adapted to
20 be mounted within a refrigerator.

21 Fish discloses refrigerator shelf 46 including a pair of support brackets
22 50 extending forwardly from the rear wall of the refrigerator (Fig. 1). The
23 shelf 46 is slidably mounted on the brackets for forward and rearward
24 movement between an extended position and a retracted position. The shelf
25 46 has a molded perimeter edge and a rear wall member 138 which extends
26 upwardly from the rear portion of the shelf 46 to keep items placed on the

1 shelf member from being pushed rearwardly off the shelf (Fish, col. 5, ll. 1-
2 10; Fig. 1).

3 PRINCIPLES OF LAW

4 *Anticipation*

5 It is well settled that apparatus claims must distinguish over prior art
6 apparatus by the structure defined by the claims, and not by a process or
7 function performed by the apparatus. A prior art apparatus having the same
8 structure as a claimed apparatus renders a claimed apparatus unpatentable
9 under § 102 as long as it is capable of performing the claimed process or
10 function. *In re Yanush*, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA
11 1973); *Ex Parte Masham*, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int.
12 1987).

13 *Obviousness*

14 An invention is not patentable under 35 U.S.C. § 103 if it is obvious.
15 *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1745-46, 82 USPQ2d 1385,
16 1400 (2007). The facts underlying an obviousness inquiry include: Under §
17 103, the scope and content of the prior art are to be determined; differences
18 between the prior art and the claims at issue are to be ascertained; and the
19 level of ordinary skill in the pertinent art resolved. Against this background
20 the obviousness or nonobviousness of the subject matter is determined. Such
21 secondary considerations as commercial success, long felt but unsolved
22 needs, failure of others, etc., might be utilized to give light to the
23 circumstances surrounding the origin of the subject matter sought to be
24 patented. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459,
25 467 (1966). In addressing the findings of fact, “[t]he combination of

1 familiar elements according to known methods is likely to be obvious when
2 it does no more than yield predictable results.” *KSR*, 127 S.Ct. at 1739, 82
3 USPQ2d at 1395. As explained in *KSR*: If a person of ordinary skill can
4 implement a predictable variation, § 103 likely bars its patentability. For the
5 same reason, if a technique has been used to improve one device, and a
6 person of ordinary skill in the art would recognize that it would improve
7 similar devices in the same way, using the technique is obvious unless its
8 actual application is beyond his or her skill. *Sakraida and Anderson's-Black*
9 *Rock* is illustrative - a court must ask whether the improvement is more than
10 the predictable use of prior art elements according to their established
11 functions. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1395.

12 A prior art reference is analyzed from the vantage point of all that it
13 teaches one of ordinary skill in the art. *In re Lemelson*, 397 F.2d 1006, 1009,
14 158 USPQ 276, 277 (1968)(“The use of patents as references is not limited
15 to what the patentees describe as their own inventions or to the problems
16 with which they are concerned. They are part of the literature of the art,
17 relevant for all they contain”). Furthermore, “[a] person of ordinary skill is
18 also a person of ordinary creativity, not an automaton.” *KSR*, 127 S.Ct. at
19 1742, 82 USPQ2d at 1397.

20 On appeal, Applicants bear the burden of showing that the Examiner
21 has not established a legally sufficient basis for combining the teachings of
22 the prior art. Applicants may sustain their burden by showing that where the
23 Examiner relies on a combination of disclosures, the Examiner failed to

1 provide sufficient evidence to show that one having ordinary skill in the art
2 would have done what Applicants did. *United States v. Adams*, 383 U.S. 39,
3 48, 148 USPQ 479, 482-83 (1966).

4

5 *Analogous Art*

6 The analogous-art test requires that the Board show that a reference is
7 either in the field of the applicant's endeavor or is reasonably pertinent to the
8 problem with which the inventor was concerned in order to rely on that
9 reference as a basis for rejection. *In re Oetiker*, 977 F.2d 1443, 1447, 24
10 USPQ2d 1443, 1445-46 (Fed. Cir. 1992). References are selected as being
11 reasonably pertinent to the problem based on the judgment of a person
12 having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality
13 of the circumstances,’ . . . -in other words, common sense-in deciding in
14 which fields a person of ordinary skill would reasonably be expected to look
15 for a solution to the problem facing the inventor.” (*Id.* quoting *In re Wood*,
16 599 F.2d 1032, 1036 202 USPQ 171, 174 (CCPA 1979)). *In re Kahn*, 441
17 F.3d 977, 986-87, 78 USPQ2d 1329, 1335-36 (Fed. Cir. 2006). *See also In*
18 *re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992) (“[a]
19 reference is reasonably pertinent if, even though it may be in a different field
20 from that of the inventor's endeavor, it is one which, because of the matter
21 with which it deals, logically would have commended itself to an inventor's
22 attention in considering his problem”).

23 In view of *KSR's* holding that “*any* need or problem known in the
24 field of endeavor at the time of invention and addressed by the patent can
25 provide a reason for combining the elements in the manner claimed,” *KSR*,

1 127 S.Ct. at 1742, 82 USPQ2d at 1397 (emphasis added), it is clear that the
2 second part of the analogous-art test as stated in *Clay, supra*, must be
3 expanded to require a determination of whether the reference, even though it
4 may be in a different field from that of the inventor's endeavor, is one which,
5 because of the matter with which it deals, logically would have commended
6 itself to an artisan's (not necessarily the inventor's) attention in considering
7 *any* need or problem known in the field of endeavor. Furthermore, under
8 *KSR* it is not always necessary to identify a known need or problem as a
9 motivation for modifying or combining the prior art. *See KSR*, 127 S.Ct. at
10 1740, 82 USPQ2d at 1395 (“The Court [in *United States v. Adams*, 383 U.S.
11 39, 40 (1966)] recognized that when a patent claims a structure already
12 known in the prior art that is altered by the mere substitution of one element
13 for another *known in the field*, the combination must do more than yield a
14 predictable result.”) (emphasis added). *See also Sakraida*, 425 U.S. at 280,
15 189 USPQ at 452 (“Our independent examination of that evidence persuades
16 us of its sufficiency to support the District Court's finding ‘as a fact that each
17 and all of the component parts of this patent ... were old and well-known
18 throughout the dairy industry long prior to the date of the filing of the
19 application for the Gribble patent”).

20

21

ANALYSIS

22 We will sustain the Examiner's rejection of claims 7, 8, 11, 12, 14,
23 15-17, 20 and 22 under 35 U.S.C. § 102(e). We are not persuaded by the
24 Appellants' argument that Mahone does not disclose a refrigerator shelf
25 because it is not necessary for Mahone to disclose a refrigerator shelf to

1 establish the anticipation of the claims. All that is required is that the
2 Mahone shelf system is capable of being placed in a refrigerator. We have
3 found that the Mahone shelf system is capable of being placed in a
4 refrigerator and therefore is a shelf “for use” in a refrigerator. In addition,
5 we have found that the Mahone shelf system can be placed in a refrigerator
6 in an orientation such that the wall 95 is in the rear of the refrigerator. In
7 regard to claim 8, we have found that during assembly the shelf 90 is slid
8 into place on the bracket 70 and therefore is slidably mounted on the
9 brackets.

10 We will not sustain the Examiner’s rejection of claims 15-17, 22 and
11 23 under 35 U.S.C. § 102(e) because Di Girolamo does not disclose a shelf
12 member adapted to be mounted within a refrigerator.

13 We will sustain the Examiner’s rejection of claims 1-6 under 35
14 U.S.C. § 103 as being unpatentable over Mahone. Firstly, we hold that
15 Mahone is analogous art because it is reasonably pertinent to the problem of
16 the Appellants of keeping items on a shelf from falling off. Further, even
17 though not in the field of refrigerator shelves per se, the teachings of
18 Mahone would have commanded the attention of an artisan when addressing
19 the problem of maintaining items on a shelf such as a refrigerator shelf.

20 In addition, we agree with the Examiner that a person of ordinary skill
21 in the art would have found it obvious to modify the rear wall of Fish so as
22 to comprise a pair of legs as taught by Mahone and so as to provide a
23 molded wall. Mahone teaches that a pair of legs is an alternative way of
24 mounting a wall. In addition, the modification of a pair of legs and a molded
25 wall would have been no more than the combination of familiar elements

1 according to known methods to achieve a predictable result. We note that
2 the Appellants admit that molded vertical walls are known (Specification 1).

3 We will sustain the Examiner's rejection of claims 10, 13, 19 and 21
4 under 35 U.S.C. § 103. As stated above, we are not persuaded by the
5 Appellants' arguments that Mahone does not disclose a molded rear wall.

6 We will not sustain the Examiner's rejection of claims 19 and 21
7 under 35 U.S.C. § 103 as being unpatentable over Di Girolamo because Di
8 Girolamo does not disclose a shelf adapted to be mounted within a
9 refrigerator.

10 In summary:

11 We will sustain the Examiner's rejection of claims 7, 8, 11, 12, 14, 15
12 to 17, 20 and 22 under 35 U.S.C. § 102(e) as anticipated by Mahone.

13 We will also sustain the Examiner's rejection of claims 1-6 under 35
14 U.S.C. § 103 as being unpatentable over Fish in view of Mahone.

15 We will further sustain the Examiner's rejection of claims 10, 13, 19,
16 and 21 under 35 U.S.C. § 103 as being unpatentable over Mahone.

17 We will not sustain the Examiner's rejection of claims 15-17, 22 and
18 23 under 35 U.S.C. § 102(e) as anticipated by Di Girolamo or the rejection
19 of claims 19 and 21 under 35 U.S.C. § 103 as being unpatentable over
20 DiGirolamo.

21 No time period for taking any subsequent action in connection with
22 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

23 AFFIRMED-IN-PART

24

Appeal 2006-3342
Application 10/195,217

1 hh

2

3

4 MCKEE, VOORHEES & SEASE, P.L.C.

5 ATTN: MAYTAG

6 801 GRAND AVENUE, SUITE 3200

7 DES MOINES, IA 50309-2721

8