

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROB FALKE

Appeal 2007-1558
Application 10/635,362
Technology Center 3600

Decided: June 8, 2007

Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-15 and 28-32, all the pending claims in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.

THE INVENTION

Appellant's claimed invention is directed to a method of storing/recording writings on a piece of furniture (Specification ¶ 0005). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for storing handwritten writings, said method comprising storing said handwritten writings on a piece of furniture, wherein said furniture comprises a member comprising a surface of a material used to construct said furniture that is configured to permanently receive said handwritten writings.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Beck	US 533,030	Jan. 22, 1895 ¹
McClintock	US 668,582	Feb. 19, 1901
Hardin	US 1,569,486	Jan. 12, 1926
O'Connor	US 3,238,643	Mar. 8, 1966
Greiwe	US 6,735,831	May 18, 2004
Hepplewhite Pembroke table, web listing at www.liveauctioneers.com/items/791809 .		

Merriam-Webster Online dictionary, definitions for "stamp" and "etch."

¹ The Examiner introduced Beck, O'Connor, and the web site listings in the Answer to provide evidence in support of Official Notice statements made in the Final Office Action.

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The following rejections are before us for review.

1. Claim 12 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (Answer 3).
2. Claims 1-14 and 28-32 stand rejected under 35 U.S.C. §103(a) as unpatentable over Hardin (Answer 4-5).
3. Claims 1-5, 8-15, and 28-32 stand rejected under 35 U.S.C. §103(a) as unpatentable over Greiwe (Answer 5-6).
4. Claims 1-3, 6-11, 28 and 30-32 stand rejected under 35 U.S.C. §103(a) as unpatentable over McClintock (Answer 6-7).

Appellant contends that the cited prior art references do not teach or suggest “the claimed method in which a surface of a material that is used to construct a piece of furniture is configured to permanently receive handwritten writings” because they either (1) do not teach or suggest handwritten writings or (2) only teach temporarily securing a piece of paper bearing handwriting to the furniture (Appeal Br. 6-7). The Examiner found that giving the claims their broadest reasonable interpretation, the cited art teaches storing handwritten writings on a piece of furniture comprising a member surface configured to permanently receive the writing (Answer 8-10).

ISSUES

The issues before us are:

- (1) Whether Appellant has shown that the Examiner erred in rejecting claim 12 under 35 U.S.C. 112, second paragraph.
- (2) Whether Appellant has shown that the Examiner erred in rejecting claims 1-14 and 28-32 under 35 U.S.C. §103(a) as unpatentable over Hardin.
- (3) Whether Appellant has shown that the Examiner erred in rejecting claims 1-5, 8-15, and 28-32 under 35 U.S.C. §103(a) as unpatentable over Greiwe.
- (4) Whether Appellant has shown that the Examiner erred in rejecting claims 1-3, 6-11, 28 and 30-32 under 35 U.S.C. §103(a) as unpatentable over McClintock.

FINDINGS OF FACT

The relevant facts are:

1. Claim 12 defines a method for storing handwritten writings. The claim recites “storing said handwritten writings on a piece of furniture...wherein said writings comprise a carving, wood burning, etching, brush marks, imprint or stamp.”
2. Appellant’s Specification defines writings to include “handwritten letters, words, phrases, names, initials, signatures, drawings, sketches, paintings, or any other form of markings” (Specification ¶ 0017).
3. The Specification states writings may be made using any one of: “pencil, pen, marker, paintbrush, woodburning tool, carving tool, etching tool, brush, imprint, stamp, etc.” (Specification ¶ 0017).

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4. The term handwritten is commonly defined as something that is written by hand. *Merriam-Webster's Collegiate Dictionary* 565 (11th ed. 2005).

5. The Specification does not provide any special meaning to the term handwritten nor does it utilize the term contrary to its customary meaning.

6. The term permanent is commonly defined as something that continues or endures without fundamental or marked change i.e., lasting. *Merriam-Webster's Collegiate Dictionary* 922 (11th ed. 2005).

7. The Specification does not provide any special meaning to the term permanently nor does it utilize the term contrary to its customary meaning.

8. In one embodiment disclosed in the Specification writings to be stored are written directly on the surface of a drawer with a writing instrument (Specification ¶ 0021).

9. In another embodiment, the writings are written on some medium other than the surface of the furniture and then attached to the surface of the furniture by adhesive (Specification ¶ 0022).

10. Nowhere in the Specification is there any indication or suggestion that one embodiment is more lasting than the other.

11. McClintock teaches a piece of furniture, specifically, a tablet-file case, designed for storing abstracts of deeds affecting real property (McClintock 1:8-10).

12. The tablet-file case is divided into a series of sections, each section containing a series of file-receptacles, such as drawers 4, and vertical and horizontal strips 5, 6 jointed together to form compartments 3 of the desired size (McClintock 1:57-63).

13. Each of the file drawers 4 consists of a heavy strip of cardboard or similar material and a vertical front wall 16 preferably of wood (McClintock 1:92-95).

14. The vertical front wall 16 of the drawers 4 are configured to receive markings designating groups, divisions, or sections of tracts of land (McClintock 1:39-44 and Fig. 1).

15. The drawers 4 are configured to receive/store writings, specifically abstracts of deeds affecting real property (McClintock 1:9-10).

16. The writings are secured/attached to the drawers 4 by fasteners 17 located at the rear right-hand corner of the drawer 4 (McClintock 2:1-8 and Fig. 4).

17. Each of the drawers includes a marking (i.e., fastener 17 and/or the section numbers) to facilitate placement of the writings (McClintock, 1:37-53, 2:1-5 and Fig. 4).

18. At the time of McClintock's invention, i.e., 1901, it was customary practice to hand write deeds and/or abstracts.

19. Hardin teaches a piece of furniture, specifically, a desk with a slide leaf attachment (Hardin 1:8-11).

20. The leaf 2, which is made of wood, is countersunk or recessed on its top surface in order to house a glass plate 5 (Hardin 1:63-73).

21. The leaf 2 includes a pad 6 and mat 7 to form a cushion for the glass plate 5, and a notch 4 in one of its walls for access of the thumb or finger when lifting the glass plate 5 (Hardin 1: 71-72, 79-82, and Fig. 3).

22. The leaf 2 further includes a suitable number, e.g., four, of tapered holes 9 which retain vacuum cups 10, the vacuum cups being provided to secure the glass plate 5 in place (Hardin 1:90-100).

23. Hardin teaches that sheets bearing memoranda, data, or other subject-matter are placed between the mat 7 and glass plate 5 for inspection through the plate (Hardin 1:83-87).

24. The vacuum cups 10 provide visible markings for positioning the memoranda, or other subject-matter under the glass, such that the glass plate 5 is properly secured by the vacuum cups 10 (Hardin Fig. 1).

25. Greiwe teaches a container 10 for storing cremation remains. The container 10 includes a receptacle adapted to receive the cremation remains, and a memorial plaque 70 adapted to be inscribed with an inscription of memorialization (Greiwe, col. 1, ll. 37-41).

26. The container further includes a memorabilia tray 60, and a transparent pane 52 that provides visual access to the upper part of the container and the memorabilia tray 60 (Greiwe, col. 2, l. 67 – col. 3, l. 3).

27. The memorabilia tray 60 provides storage and display space for mementos of the deceased, for example, golf ball 62, armed forces medal 64, and the like (Greiwe, col. 3, ll. 6-8 and Fig. 2).

28. The memorialization plaque 70 is slidably mounted in the base 14 of the container 10 and includes an inscription of memorialization (Greiwe, col. 3, ll. 10-12).

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29. An inscription is something that is inscribed. *Merriam-Webster's Collegiate Dictionary* 646 (11th ed. 2005)

30. To inscribe is to write, engrave, or print as a lasting record. *Merriam-Webster's Collegiate Dictionary* 646 (11th ed. 2005)

PRINCIPLES OF LAW

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

The Examiner bears the initial burden of presenting a prima facie case of obviousness in rejecting claims under 35 U.S.C. § 103. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

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 must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “there must be

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some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness' [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

Where the only difference between the claimed subject matter and the prior art resides in printed matter and the printed matter recited in the claim is not functionally related to the substrate on which it is printed, then the printed matter will not distinguish the invention from the prior art in terms of patentability. See *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (holding that an inventor could not patent known kits simply by attaching a new set of instructions to the product); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (holding that digits placed on a band patentability distinguish the band from the prior art because the claims require a particular sequence of digits to be displayed on the outside surface of a band and the digits exploit the endless nature of the band).

ANALYSIS

REJECTION OF CLAIM 12 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 12, directed to a method of storing handwritten writings, requires that the “writings comprise a carving, wood burning, etching, brush marks, imprint or stamp” (Finding of Fact 1). The Examiner held that “it is unclear how carving, wood burning, etching, brush marks, imprints and stamps can be considered handwritten writings” (Answer 3). Appellant argues that “[i]n carving, wood burning, etching, etc. a human uses an instrument, such as a knife, wood burner, etc., to produce writing” thereby producing a handwritten writing “in the same sense as if the writer were holding a pen or pencil” (Appeal Br. 5). We agree with Appellant.

The term handwritten is commonly defined as something written by hand (Finding of Fact 4). Appellant’s specification does not provide any special meaning to the term handwritten nor does it use the term contrary to its customary meaning (Finding of Fact 5). Appellant’s specification describes that writings may be made using any one of: “pencil, pen, marker, paintbrush, woodburning tool, carving tool, etching tool, brush, imprint, stamp, etc.” (Finding of Fact 3). Accordingly, when claim 12 is read in light of the specification, one skilled in the art would understand that the term “handwritten” to be any mark which is created by use of one of the listed hand tools clearly defined in claim 12. As such, we do not sustain the Examiner’s rejection of claim 12 under 35 U.S.C. § 112, second paragraph.

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REJECTION OF CLAIMS 1-15 AND 28-32 UNDER 35 U.S.C. § 103(A)

Appellant argues claims 1, 3-5, 7-9, 11-13, 15, 29, 31 and 32 as a first group (Appeal Br. 6-8). We consider claim 1 as the representative claim from this group. 37 C.F.R. § 41.37(c)(1)(vii) (2006).

Appellant argues that the furniture pieces of Hardin and McClintock are not configured to permanently receive handwritten writings because the sheets of paper attached to the surfaces may be removed (Reply Br. 4). The Examiner found that giving the claims their broadest reasonable interpretation, the cited art taught storing handwritten writings on a piece of furniture comprising a member surface configured to permanently receive the writing (Answer 8-10). We agree with the Examiner's interpretation.

Appellant's Specification discloses two embodiments, one where the writings are stored by writing directly on the surface of the furniture, and one where a sheet or some other medium containing the writing is attached to the surface of the furniture by adhesive (Finding of Fact 8-9). Furthermore, the Specification does not provide any specific guidance in determining when a writing is considered permanent i.e., the Specification does not provide any special meaning to the term permanently nor does it utilize the term contrary to its customary meaning (Finding of Fact 7). Appellant appears to argue that the phrase "to permanently receive" requires the writing to be applied directly to the surface of the furniture such that it cannot be removed (Appeal Br. 6-8). However, this is not consistent with the Specification. The Specification does not disclose or suggest that the embodiment wherein the writings are applied directly to the

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surface of the furniture is the only embodiment in which the surface is configured to permanently receive the writings (Finding of Fact 10). Therefore, the broadest reasonable interpretation of the phrase "...configured to permanently receive said handwritten writings" requires only that a surface of the furniture be capable of having a writing applied or attached thereto in a lasting manner, whether directly applied to the furniture or indirectly attached to the furniture via a sheet of paper or other material.

Hardin teaches that the slide leaf 2 is countersunk or recessed in order to store sheets bearing memoranda, data, or other subject matter (Finding of Fact 20 and 23). The sheets are secured/attached to the surface of the slide leaf 2 by the glass plate 5, which is placed on top thereof (Finding of Fact 23). Although Hardin describes the sheets as being removable, they still satisfy the "permanent" limitation of claim 1 in as much as the glass, which is placed on top of the writing, makes the writing lasting (i.e., absent some user interaction, the writing will endure without fundamental or marked change). Furthermore, the claim requires only that the surface "is configured" to permanently receive handwritten writings. Hardin's slide leaf 2 is certainly configured to permanently receive handwritten writings because the slide leaf 2 is made from a material, for example wood, which is capable of being carved, etc. and because the slide leaf 2 is capable of having a sheet attached to it by adhesive. Thus, Hardin's desk has a surface that meets the structural limitations of claim 1. As such we sustain the Examiner's rejection of claims 1, 3-5, 8, 9, 11-13, 15, 29, 31 and 32 under 35 U.S.C. § 103(a) as unpatentable over Hardin.

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McClintock teaches a piece of furniture, specifically, a tablet-file case, designed to store abstracts of deeds affecting real property (Finding of Fact 11). The table-file case is divided into a series of sections, each section containing a series of file-receptacles, such as drawers 4, and vertical and horizontal strips 5, 6, joined together to form compartments 3 of the desired size (Finding of Fact 12). McClintock teaches the abstracts (i.e., writings) are attached to the drawers 4 with the fasteners 17 (Finding of Fact 16). Although it appears that the abstracts may be removed from the drawers, McClintock still satisfies the “permanent” limitation of claim 1 in as much as the fasteners, which secure the abstracts in place, make the abstracts lasting (i.e., absent some user interaction, the writing will endure without fundamental or marked change). As such, we sustain the Examiner’s rejection of claims 1, 3, 7-9, 11, 31 and 32 under 35 U.S.C. § 103(a) as unpatentable over McClintock.

Appellant further argues that the writings of McClintock and Greiwe are not handwritten (Appeal Br. 7-8). More specifically, Appellant argues that Greiwe does not teach “that the plaque can be handwritten” and that “McClintock, similar to Hardin, merely teaches a method of securing printed paper forms to [a] structure” (Appeal Br. 7-8). We disagree.

At the time of McClintock’s invention (i.e., 1901) it was customary practice to hand write deeds and/or abstracts (Finding of Fact 18). As such, McClintock’s disclosure of deeds and abstracts would have at least suggested to one of ordinary skill in the art that handwritten papers could be secured to the drawers. Accordingly, we find Appellant’s argument that McClintock only discloses

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securing *printed* paper forms to the drawers unpersuasive.

Greiwe teaches that the plaque 70 is inscribed with an inscription of memorialization (Finding of Fact 25). By definition, an inscription is a writing that is written, engraved, or printed as a lasting record (Finding of Fact 29-30). The broadest reasonable interpretation of handwritten, in view of the specification, is any writing which is created by use of a hand tool (see discussion *supra*). It is well known that inscriptions can be formed by writing or engraving with a hand tool. As such, Greiwe's disclosure of an inscription would have suggested to one of ordinary skill in the art that the inscription could be inscribed with a hand tool. Accordingly, the inscribed plaque of Greiwe renders obvious the limitations of claim 1. As such, we sustain the Examiner's rejection of claims 1, 3-5, 8, 9, 11-13, 15, 29, 31 and 32 under 35 U.S.C. §103(a) as unpatentable over Greiwe.

Appellant appears to separately argue claims 2, 6, 10, 14, 28 and 30 in as much as Appellant states that prior to filing the appeal they requested "the Office cite prior art teaching" the elements of each of these claims (Appeal Br. 9-10). Despite Appellant's lack of clarity, we interpret Appellant's statement to be an argument that the subject matter of claims 2, 6, 10, 14, 28 and 30 is not taught in the cited prior art, and therefore address Appellant's implied arguments below.

Claim 2, which depends from claim 1, further requires preparing said member with markings to facilitate placement of the writings on the member.

The Examiner found that Hardin satisfies the limitations of claim 2 in as much as the "[s]uction cups in grooves/markings (10) are located inside the plank and inherently provide visual features helpful in the placement of the writings

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(e.g., the writing[s] are located there between, see Fig. 1)” (Answer 4). See also Finding of Fact 24. Appellant has not provided any argument or evidence challenging the Examiner’s finding. As such, we sustain the Examiner’s rejection of claim 2 under 35 U.S.C. § 103(a) as unpatentable over Hardin.

The Examiner also found that “the use of lines on members to aid in adding written material thereon (so that the words/letters are written in a straight line) is well known in the art” and held that it “would have been an obvious design consideration” to etch grooves in the plaque of Greiwe in order to provide a guide for inscribing the plaque in a straight line (Answer 6). The Examiner further bolstered his finding by citing O’Connor (Answer 10). Appellant has not provided any argument or evidence challenging the Examiner’s holding. As such, we sustain the Examiner’s rejection of claim 2 under 35 U.S.C. § 103(a) as unpatentable over Greiwe.

The Examiner found that the fasteners 17 of McClintock are the claimed markings that provide guidance for attaching/storing the writings (Answer 6). Appellant has not provided any argument or evidence challenging the Examiner’s finding. Furthermore, we note that McClintock’s vertical front walls 16 include markings (i.e., the section indications) which provide guidance for storing the writings (Finding of Fact 17). As such, we sustain the Examiner’s rejection of claim 2 under 35 U.S.C. § 103(a) as unpatentable over McClintock.

Claim 6, which depends from claim 3, further requires that the member comprises a drawer.

The Examiner found that Hardin satisfies the limitation of claim 6 in as

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much as Hardin discloses a shelf 2 with recesses designed to store writings so that the shelf can also be considered a drawer (Answer 4). Appellant has not provided any argument or evidence challenging the Examiner's finding. As such, we sustain the Examiner's rejection of claim 6 under 35 U.S.C. § 103(a) as unpatentable over Hardin.

The Examiner also found that McClintock satisfies the limitations of claim 6 in as much as McClintock teaches a piece of furniture that includes drawers 4 which are configured to receive writings (Answer 6). Appellant has not provided any argument or evidence challenging the Examiner's finding. As such, we sustain the Examiner's rejection of claim 6 under 35 U.S.C. § 103(a) as unpatentable over McClintock.

Claim 10, which depends from claim 9, further requires that the writing comprise a signature. The Examiner held that it "would have been an obvious consideration to one of ordinary skill in the art" to add a "family tree, pedigree chart, signature, date(s), stamps, specific historical event, time etc." to the furniture of Hardin, McClintock, and/or Greiwe (Answer 4-7). Appellant (1) states that his request for a prior art teaching a handwritten signature on a surface of a material used to construct a piece of furniture was ignored and (2) argues "[n]one of the cited prior art references even mention a signature" (Appeal Br. 9). We sustain the Examiner.

To adequately traverse Official Notice Appellant must specifically point out the supposed errors in the examiner's assertions, which includes stating why the noticed fact is not considered to be common knowledge or well-known in the art.

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Compare In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961) (considering challenge to taking of judicial notice by Trademark Trial and Appeal Board), *see also* 37 C.F.R. § 1.111(b). Appellant merely requests the Examiner to provide a prior art reference without presenting any arguments or evidence as to why the Examiner's notice was incorrect.

Furthermore, where the only difference between the claimed subject matter and the prior art resides in printed matter and the printed matter recited in the claim is not functionally related to the substrate on which it is printed, then the printed matter will not distinguish the invention from the prior art in terms of patentability. *See In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). In the present case, the only difference between the applied prior art and the subject matter of claim 10 is the specific content of the writing to be stored (i.e., the printed matter to be stored). The claimed invention requires storing a writing on a piece of furniture, where the furniture comprises a surface configured to permanently receive the writings. There is no interrelationship between the printed matter and specific piece of furniture on which it is to be stored, i.e., the printed matter does not depend on the furniture nor does the furniture depend on the printed matter. In this respect, the present case is distinguishable from the situation in *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983), where the claimed invention was directed to a device comprising “three key elements: (1) a band, ring, or set of concentric rings; (2) a plurality of individual digits imprinted on the band or ring at regularly spaced intervals; and (3) an algorithm by which the

appropriate digits are developed.” *Id.* at 1382, 217 USPQ at 402. The *Gulack* court found the claimed invention “require[d] a particular sequence of digits to be displayed on the outside surface of a band,” and that “[t]hese digits are related to the band in two ways: (1) the band supports the digits; and (2) there is an endless sequence of digits – each digit residing in a unique position with respect to every other digit in an endless loop. Thus, the digits exploit the endless nature of the band.” *Id.* at 1386-87, 217 USPQ at 405. In the present case, there is no such interrelationship between the content of the writing to be stored and the specific piece of furniture on which they are to be stored. Nowhere in the Specification is there any suggestion that the content of the writing is in any way dependent on the piece of furniture on which it is to be stored. The applied prior art, i.e., Hardin, McClintock, and Greiwe, discloses storing a writing on a surface of a piece of furniture. Specific differences in the content of the writing, e.g., a signature, will not render the claimed invention nonobvious where storing a writing is already known in the art. As such, we sustain the Examiner’s rejection of claim 10 under 35 U.S.C. § 103(a) as unpatentable over Hardin, McClintock, or Greiwe.

Claims 14 and 30, which depend from claim 2, further require that the markings include grooves (claim 14) or a genealogical form (claim 30). Claims 14 and 30 are directed to methods for storing handwritten writings. The specific steps recited include storing the handwritten writings on a piece of furniture, and preparing a member of the furniture with markings to facilitate placement of the writings. Both Hardin and McClintock teach some form of marking that facilitates placement of a writing i.e., the vacuum cups 10 of Hardin, and the fasteners 17 of

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McClintock (Finding of Fact 17 and 24). Furthermore, the Examiner held that it would have been obvious to include markings, in the form of grooves or lines, on the memorialization plaque 70 of Greiwe. As such, the only difference between the subject matter of claims 14 and 30 and the applied prior art is the specific form of the marking, i.e., whether it is a groove, writing, or genealogical form.

Appellant's Specification does not disclose or suggest that there is any relationship between the specific markings used and the surface of the furniture on which the markings are to be made. To the contrary, the Specification suggests that the specific marking used is based on the content of the writing to be stored, for example, a form for recording familial relationships or a business organization or hierarchy (Specification ¶ 31). However, these markings are not functionally related to the substrate, i.e., the surface of the furniture configured to store the writing (see discussion *supra*). Therefore, mere differences in the specific form of the markings cannot render the invention nonobvious, where the use of markings is already known in the art. As such, we sustain the Examiner's rejection of claims 14 and 30 under 35 U.S.C. § 103(a) as unpatentable over Hardin, McClintock, and Greiwe.

Claim 28, which depends from claim 1, further requires designating the member as being intended to receive said handwritten writings in materials presented with the furniture when the furniture is offered for sale and has not yet received the handwritten writings. Appellant argues that “[n]othing in the prior art teaches or suggests this business method in which materials are presented with a piece of furniture for sale, where those materials specifically designate a member

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of that furniture as being intended to permanently receive *handwritten* writings” (Reply Br. 4-5).

The only difference between the applied prior art and the subject matter of claim 28 is the presentation of materials specifically designating a member of the furniture as being intended to permanently receive the writings, i.e., “instructions (130) that explain the intended use of the plank” (Specification ¶ 22). In this respect, the present case is similar to the situation in *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004), where the claimed invention was directed to a kit comprising instructions and a premeasured portion of a reagent. *Id.*, 367 F.3d at 1337, 70 USPQ at 1863. The *Ngai* court found that “[a]ll the printed matter [i.e., the instructions] does is teach a new use for an existing product” and that *Ngai* was not “entitled to patent a known product by simply attaching a set of instructions to that product.” *Id.* at 1339, 70 USPQ at 1864. Accordingly, Appellant’s argument that the claimed method is patentable over the applied prior art because it recites presenting materials which specifically designate the intended use of a surface of a known product is not persuasive. As such, we sustain the Examiner’s rejection of claim 28 under 35 U.S.C. § 103(a) in view of *Hardin*, *McClintock*, or *Greiwe*.

CONCLUSIONS OF LAW

We conclude:

1. The Examiner erred in rejecting claim 12 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention.

2. Appellant has not shown that the Examiner erred in rejecting claims 1-14 and 28-32 under 35 U.S.C. § 103(a) as unpatentable over Hardin.
3. Appellant has not shown that the Examiner erred in rejecting claims 1-5, 8-15, and 28-32 under 35 U.S.C. § 103(a) as unpatentable over Greiwe.
4. Appellant has not shown that the Examiner erred in rejecting claims 1-3, 6-11, 28 and 30-32 under 35 U.S.C. § 103(a) as unpatentable over McClintock.

DECISION

The Examiner's rejection of claim 12 under 35 U.S.C. § 112, second paragraph, is not sustained. The Examiner's rejections under 35 U.S.C. § 103(a) of claims 1-14 and 28-32 as unpatentable over Hardin, of claims 1-5, 8-15, and 28-32 as unpatentable over Greiwe, and of claims 1-3, 6-11, 28, and 30-32 as unpatentable over McClintock are sustained.

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

AFFIRMED-IN-PART

JRG

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