

1           UNITED STATES PATENT AND TRADEMARK OFFICE  
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4           BEFORE THE BOARD OF PATENT APPEALS  
5           AND INTERFERENCES  
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8           *Ex parte* GORDON WAYNE SMITH  
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11           Appeal 2007-4206  
12           Application 10/985,404  
13           Technology Center 3600  
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16           Decided: February 26, 2008  
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19        *Before* WILLIAM F. PATE, III, MURRIEL E. CRAWFORD and JOSEPH  
20        A. FISCHETTI, *Administrative Patent Judges*.  
21

22        PATE, III, *Administrative Patent Judge*.  
23

24           DECISION ON APPEAL  
25

26           STATEMENT OF CASE

27        The Appellant appeals under 35 U.S.C. § 134 (2002) from a Final  
28        Rejection of claims 1-8, 10-12 and 14-20, claims 9 and 13 having been  
29        previously canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

1       The Appellant claims a TV stand including tie bolts that extend  
2 through a top horizontal plate and a support/pillar to engage a bottom  
3 horizontal plate.

4       Representative independent claim 1 reads as follows:

5           1. A TV stand, comprising:  
6                   at least first and second vertically oriented front supports  
7                   configured for an integrated look with a TV;  
8                   at least one rear support;  
9                   a top horizontal plate and a bottom horizontal plate  
10                  sandwiching the supports; and  
11                  respective tie bolts extending through the top plate and  
12                  having a head resting thereon, through the supports, and  
13                  engaging the bottom plate either by threadably engaging  
14                  respective bosses that are disposed in the bottom plate or by  
15                  tightly fitting into recesses that are formed in the bottom plate  
16                  to minimize exposed fasteners and facilitate ease of assembling  
17                  the TV stand, whereby inversion of the TV stand to assemble it  
18                  is not necessary.

19  
20       Independent claim 7 is directed to a kit for assembly into a TV stand  
21 with tie bolts where “each pillar defines a top surface, at least a portion of  
22 which protrudes laterally beyond the top plate, at least one of the portions  
23 being formed with a protrusion configured for engaging complementarily-  
24 configured cavity in a TV.” Independent claim 12 recites a TV and TV  
25 stand assembly wherein the TV stand includes tie bolts.

26       The prior art relied upon by the Examiner in rejecting the claims is:

27	Belden	406,191	Jul. 2, 1889
28	Randall	4,886,236	Dec. 12, 1989
29	Huang	5,673,882	Oct. 7, 1997

1 Acevedo 2003/0066463A1 Apr. 10, 2003

2

3 The Examiner rejected claims 5, 11 and 17 under 35 U.S.C. § 112,  
4 first paragraph, for lacking enabling disclosure.

5 The Examiner also rejected claims 1-4, 6-8, 10, 12, 14-16, 18 and 20  
6 under 35 U.S.C. § 103(a) as unpatentable over Acevedo in view of Belden.

7 The Examiner further rejected claims 5, 11 and 17 under 35 U.S.C.  
8 § 103(a) as unpatentable over Acevedo in view of Belden and Huang.

9 The Examiner also rejected claim 19 under 35 U.S.C. § 103(a) as  
10 unpatentable over Acevedo in view of Belden and Randall.

11 We AFFIRM.

12

### 13 ISSUES

14 The following issues have been raised in the present appeal.

15 1. Whether the Appellant has shown that the Examiner erred in  
16 rejecting claims 5, 11 and 17 as not enabled.

17 2. Whether the Appellant has shown that the Examiner erred in  
18 rejecting claims 1-4, 6-8, 10, 12, 14-16, 18 and 20 as unpatentable over  
19 Acevedo in view of Belden.

20 3. Whether the Appellant has shown that the Examiner erred in  
21 rejecting claims 5, 11 and 17 as unpatentable over Acevedo in view of  
22 Belden and Huang.

1           4. Whether the Appellant has shown that the Examiner erred in  
2 rejecting claim 19 as unpatentable over Acevedo in view of Belden and  
3 Randall.

## FINDINGS OF FACT

6 The record supports the following findings of fact (FF) by a  
7 preponderance of the evidence.

8           1. Acevedo discloses a TV stand including first and second  
9 vertically oriented front supports 6, 8, a rear support 12, a top horizontal  
10 plate 10 and a bottom horizontal plate 4 that sandwich the supports, and  
11 respective tie bolts 18 (Figs. 1, 2, 11a-11c; ¶ [0043], [0047], [0048]).

12        2. Acevedo also discloses that each pillar defines a top surface 28,  
13 30, at least a portion of which protrudes laterally beyond the top plate 10, at  
14 least one of the portions being formed with a protrusion (portion of the top  
15 surface that extends rearwardly) that is configured for engaging a  
16 complementarily-configured cavity in a TV (Figs. 1, 2, 5, 8a, 8b).

17       3. Belden discloses a pedestal assembly including a vertically  
18 oriented support F, a top horizontal plate M, a bottom horizontal plate A and  
19 a tie bolt N, the tie bolt extending through the top plate with a head resting  
20 thereon, extending through the support, and threadably engaging a boss B of  
21 the bottom plate, whereby inversion of the pedestal assembly is not  
22 necessary for assembly (Fig. 2; Pg. 1, ll. 32-56; Pg. 2, ll. 13-37).

1 PRINCIPLES OF LAW

2       35 U.S.C. § 112, first paragraph, requires the specification to “contain  
3 a written description of the invention . . . in such full, clear, concise, and  
4 exact terms as to enable any person skilled in the art to which it pertains . . .  
5 to make and use the same . . .” The test for compliance with the enablement  
6 requirement of 35 U.S.C. § 112, first paragraph, is whether one skilled in the  
7 art would have to resort to undue experimentation in order to practice the  
8 invention as broadly as claimed. *In re Angstadt*, 537 F.2d 498, 503 (CCPA  
9 1976). It is Examiner’s burden to show that one skilled in the art would  
10 have to resort to undue experimentation in order to practice the invention as  
11 broadly claimed. *In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971). Undue  
12 experimentation analysis requires consideration of various factors including:  
13 (1) the quantity of experimentation necessary, (2) the amount of direction or  
14 guidance presented, (3) the presence or absence of working examples, (4)  
15 the nature of the invention, (5) the state of the prior art, (6) the relative skill  
16 of those in the art, (7) the predictability or unpredictability of the art, and (8)  
17 the breadth of the claims. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

18       In addition, “[s]ection 103 forbids issuance of a patent when ‘the  
19 differences between the subject matter sought to be patented and the prior art  
20 are such that the subject matter as a whole would have been obvious at the  
21 time the invention was made to a person having ordinary skill in the art to  
22 which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct.  
23 1727, 1734 (2007). In *KSR*, the Supreme Court emphasized “the need for  
24 caution in granting a patent based on the combination of elements found in

1 the prior art,” and reaffirmed principles based on its precedent that “[t]he  
2 combination of familiar elements according to known methods is likely to be  
3 obvious when it does no more than yield predictable results.” *Id.* at 1739.  
4 The operative question is “whether the improvement is more than the  
5 predictable use of prior art elements according to their established  
6 functions.” *Id.* at 1740.

7

8 ANALYSIS

9 Rejection of claims 5, 11 and 17 under 35 U.S.C. § 112

10 The Examiner rejected claims 5, 11, and 17 as not enabled stating that  
11 it is unclear from the originally disclosure as to how the tie bolts extend  
12 through the interlocking front and rear columns of the front support pillars  
13 (Ans. 3).

14 As the Appellant notes, there are many factors to be considered when  
15 determining whether a disclosure fails to satisfy the enablement requirement  
16 and whether any necessary experimentation is “undue” (Br. 7-8). These  
17 numerous factors are clearly set forth in the MPEP which further states that  
18 the Examiner's analysis must consider all the evidence related to each of the  
19 factors and that any conclusion of nonenablement must be based on the  
20 evidence as a whole. MPEP §2164.01(a), citing *In re Wands*, 858 F.2d at  
21 737. Moreover, it is Examiner's burden to show that one skilled in the art  
22 would have to resort to undue experimentation. *In re Marzocchi*, 439 F.2d  
23 224.

1        While the Examiner addresses various arguments set forth by the  
2    Appellant in support of finding enablement, the record before us does not  
3    show that the Examiner has considered all the evidence related to each of the  
4    factors set forth in *In re Wands* for establishing undue experimentation.  
5    Thus, because the record does not show that the Examiner has met the  
6    requisite burden, we agree with the Appellant that the Examiner erred in  
7    rejecting claims 5, 11 and 17 as not enabled.

8

9            Rejection of claims 1-4, 6-8, 10, 12, 14-16, 18 and 20 under 35 U.S.C.  
10    § 103(a)

11        Initially, the Appellant argues patentability of independent claims 1  
12    and 12 together as a group in the Appeal Brief. Correspondingly, we select  
13    representative claim 1 to decide the appeal of both of these independent  
14    claims so that claim 12 stands or falls with claim 1. *See* 37 C.F.R.  
15    § 41.37(c)(1)(vii).

16        In rejecting independent claims 1 and 12, the Examiner notes that  
17    Acevedo discloses each of the limitations of claims 1 and 12 except for tie  
18    bolts extending through the top plate with a head resting thereon, extending  
19    through the supports, and engaging bosses disposed in the bottom plate (FF 1;  
20    Ans. 3, 4 and 7). To cure the deficiency of Acevedo, the Examiner relies  
21    upon Belden that discloses a pedestal assembly having a support, a tie bolt  
22    extending through a top plate and the support column to engage a boss in a  
23    bottom plate, the tie bolt having a head resting on the top plate (FF 3; Ans. 4  
24    and 7).

1       The Appellant contends that the cited prior art does not provide  
2 motivation to combine the reference in the manner suggested by the  
3 Examiner and that the Examiner is engaging in impermissible hindsight  
4 reconstruction (App. Br. 9). The Appellant further contends that Belden is  
5 not analogous and is not reasonably pertinent to the particular problem with  
6 which the Appellant's invention was concerned because it is directed to a  
7 casket pedestal assembly (App. Br. 9 and 10). We disagree.

8       Initially, with respect to the Appellant's non-analogous art argument,  
9 it is clear that the pedestal assembly of Belden serves to support an object  
10 thereon, and thus, is a stand, regardless of the specific object supported. The  
11 Appellant's invention is also directed to a stand for supporting an object  
12 thereon. Thus, we concur with the Examiner that Belden is analogous art in  
13 that both Belden and the Appellant's invention are directed to stands for  
14 supporting an object (Ans. 8).

15       With respect to motivation, we note that the difference between the  
16 manner in which the support/pillar of the Appellant's invention and Acevedo  
17 is secured is that Acevedo utilizes a multi-component tension bar/cam  
18 casting combination instead of a single component tie bolt as used by the  
19 Appellant's invention. However, the use of such tie bolts for securing a  
20 support/pillar between a top plate and a bottom plate is known as evidenced  
21 by Belden (FF 3). The Examiner states that one of ordinary skill in the art  
22 would be motivated to modify the TV stand of Acevedo to utilize tie bolts  
23 taught by Belden in view of the benefits that using a single component tie  
24 bolt would provide, including convenience and simplicity of assembly (Ans.

1    3, 4 and 8). We agree and find that the Examiner has articulated a reason  
2    with rational underpinnings to support the Examiner’s conclusion of  
3    obviousness. *KSR*, 127 S.Ct. at 1740-41. Moreover, we also note that the  
4    Appellant’s claimed invention merely substitutes one known fastener (tie  
5    bolt) for another known multi-component fastener (tension bars and cam  
6    castings). Such “predictable use of prior art elements according to their  
7    established function” that yields a predictable result is likely to be obvious.  
8    *Id.* at 1740.

9                 Therefore, in view of the above, the Appellant has not established that  
10   the Examiner erred in rejecting independent claims 1 and 12 as unpatentable  
11   over the Acevedo in view of Belden.

12                 With respect to independent claim 7, the Appellant separately argues  
13   that Acevedo does not disclose supports/pillars having the recited top  
14   surface, “at least a portion of which protrudes laterally beyond the top plate,  
15   at least one of the portions being formed with a protrusion configured for  
16   engaging a complementarily-configured cavity in a TV” (Br. 10).

17                 However, in contrast to the Appellant’s assertion, Acevedo does  
18   disclose supports/pillars with top surfaces that protrude laterally beyond the  
19   top plate and includes a protrusion (extending rearwardly) that is received in  
20   a corresponding cavity provided at the lower front peripheral portion of the  
21   TV (FF 2; Final Office Action, 3 and 6). In arguing that Acevedo discloses  
22   smooth surfaces and does not disclose a protrusion at all, the Appellant  
23   appears to be arguing that the recited protrusions must extend vertically from  
24   the top surface (Br. 10). However, the Appellant’s argument fails because it

1 is not based on limitations appearing in independent claim 7. *In re Self*, 671  
2 F.2d 1344, 1348 (CCPA 1982). Therefore, the Appellant has also failed to  
3 establish that the Examiner erred in rejecting independent claim 7 as  
4 unpatentable over Acevedo in view of Belden.

5 The remaining dependent claims 2-4, 6, 8, 10, 14-16, 18 and 20 were  
6 not argued separately, and thus, fall with their corresponding independent  
7 claims 1, 7 or 12 discussed *supra*. See 37 C.F.R. § 41.37(c)(1)(vii). Thus,  
8 the Appellant has failed to show that the Examiner erred in rejecting these  
9 remaining dependent claims as well.

10

11       Rejection of claims 5, 11 and 17 under 35 U.S.C. § 103(a)

12       Dependent claims 5, 11 and 17 were not argued separately on appeal,  
13 the Appellant merely relying on dependency from corresponding  
14 independent claims for patentability. Thus, dependent claims 5, 11 and 17,  
15 fall with their corresponding independent claims, and the Appellant has not  
16 shown that the Examiner erred in rejecting these dependent claims.

17

18       Rejection of claim 19 under 35 U.S.C. § 103(a)

19       Dependent claim 19 was not argued separately on appeal, the  
20 Appellant merely relying on dependency from independent claim 12 for  
21 patentability. Thus, dependent claim 19 falls with independent claim 12,  
22 and the Appellant has not shown that the Examiner erred in rejecting  
23 dependent claim 19.

24

## CONCLUSIONS

2           1. The Appellant has shown that the Examiner erred in rejecting  
3 claims 5, 11 and 17 as not enabled.

4           2. The Appellant has not shown that the Examiner erred in  
5 rejecting claims 1-4, 6-8, 10, 12, 14-16, 18 and 20 as unpatentable over  
6 Acevedo in view of Belden.

7           3.     The Appellant has not shown that the Examiner erred in  
8 rejecting claims 5, 11 and 17 as unpatentable over Acevedo in view of  
9 Belden and Huang.

10           4.     The Appellant has not shown that the Examiner erred in  
11 rejecting claim 19 as unpatentable over Acevedo in view of Belden and  
12 Randall.

## ORDER

15           1. The Examiner's rejection of claims 5, 11 and 17 under  
16 35 U.S.C. § 112 is REVERSED.

17           2. The Examiner's rejections of claims 1-8, 10-12 and 14-20  
18 under 35 U.S.C. § 103(a) is AFFIRMED.

19 No time period for taking any subsequent action in connection with  
20 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
21 § 1.136(a)(1)(iv) (2007).

**AFFIRMED**

Appeal 2007-4206  
Application 10/985,404

1 JRG

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