

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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7
8 *Ex parte* SCOTT CLARE and NEIL G. LONG
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11 Appeal 2008-0339
12 Application 09/083,422
13 Technology Center 3600
14

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16 Decided: May 16, 2008
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19 *Before* WILLIAM F. PATE, III, MURRIEL E. CRAWFORD and JOSEPH
20 A. FISCHETTI, *Administrative Patent Judges*.

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22 PATE, III, *Administrative Patent Judge*.

23
24 DECISION ON APPEAL

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26 STATEMENT OF CASE

27 The Appellants appeal under 35 U.S.C. § 134 (2002) from a Final
28 Rejection of claims 49-56, 58-62, 64-73, 85, 86, 88, 89, 91, 92, 98, 99, 101,
29 105, 106, 108, 109, 111 and 113. Claims 94, 96, 97, 126 and 127 have been
30 allowed and claims 57, 74 and 87 have been indicated to be allowable if

1 rewritten in independent form. All remaining claims have been previously
2 canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

3 The Appellants claim a storage system for a vehicle that is accessible
4 through an exterior side panel of the vehicle.

5 Independent claim 49 reads as follows:

6 49. A storage system for a vehicle having a driver
7 compartment and a passenger compartment rearward of the
8 driver compartment and within a single enclosure, wherein the
9 enclosure is defined by a floor, a roof, two opposing side walls
10 which each connect the roof to the floor, and exterior side
11 panels, wherein the passenger compartment includes opposing
12 rear wheel wells extending into the passenger compartment
13 from the bottom edges of the side panels,
14 the storage system comprising at least one storage area
15 adjacent to and separated from the passenger compartment, the
16 storage area being defined by at least a portion of an exterior
17 side panel, an inner panel, a top and bottom which connect the
18 inner panel to the exterior side panel, and wherein the storage
19 area extends into the passenger compartment no further than the
20 wheel well extends into the passenger compartment,
21 wherein at least one section of the exterior side panel is
22 hinged to provide access to the storage area therein.

23
24 Independent claim 61 recites a similar storage area in a vehicle having
25 forward and rear compartments, the separation width and cross sectional
26 contour of the side panels of the enclosure being substantially the same as
27 the separation width and cross sectional contour of the forward
28 compartment.

29 Independent claim 85 also recites a similar storage area in a vehicle
30 with at least two rows of seats where the width of the storage area is not

1 greater than the width of the wheel well, and the storage area includes a latch
2 and a strut for retaining the hinged section in the open position.

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

4 Hawkins	2,159,022	May 23, 1939
5 Stahl	2,192,207	Oct. 13, 1937
6 Sparling	4,315,653	Feb. 16, 1982
7 Gallagher	5,709,309	Jan. 20, 1998
8 Powers	Des. 143,990	Apr. 28, 1945
9 Hamel	Des. 230,351	Feb. 12, 1974

10 The Examiner rejected claims 49-55, 58, 60, 98, 99, 101, 106, 108 and
11 109 under 35 U.S.C. § 103(a) as unpatentable over Sparling in view of
12 Hawkins and Stahl¹.

13 The Examiner rejected claims 61, 62, 64-68, 70-72, 111 and 113
14 under 35 U.S.C. § 103(a) as unpatentable over Stahl in view of Hawkins.

15 The Examiner rejected claims 85, 86, 89, 91 and 92 under 35 U.S.C.
16 § 103(a) as unpatentable over Stahl or Sparling in view of Hawkins and
17 Hamel.

18 The Examiner rejected claims 56 and 73 under 35 U.S.C. § 103(a) as
19 unpatentable over Sparling or Stahl in view of Hawkins and Hamel.

¹ The Examiner cites Stahl in this rejection for the first time in the Examiner's Answer (Ans. 3). The Appellants note that this is a new ground of rejection but request the appeal be maintained (Reply Br. 3).

1 the wheel well (Fig. 4). Hawkins further specifically teaches that such a
2 truck allows carrying of a large variety of tools and equipment while
3 facilitating access to the tools and increasing the carrying capacity of the
4 truck (Pg. 1, Col. 1, ll. 8-13).

5 3. Stahl discloses a vehicle having a driver compartment and a
6 passenger compartment rearward of the driver compartment that is within a
7 single enclosure (Figs. 1 and 4; Pg. 1, Col. 2, l. 45-Pg. 2, Col. 1, l. 2). Stahl
8 also discloses a storage system comprising a storage area adjacent to, and
9 separated from, the passenger compartment, the storage area extending into
10 the passenger compartment (Figs. 1-4; Pg. 2, Col. 1, ll. 25-54). Stahl teaches
11 the desirability for providing within the vehicle, a seating arrangement for
12 numerous men as well as adequate storage space (Figs. 1-4; Pg. 1, Col. 1, ll.
13 7-44). The separation width and cross sectional contour of the side panels of
14 the enclosure in Stahl is substantially the same as the separation width and
15 cross sectional contour of the forward compartment where it adjoins the side
16 panels (Figs. 4 and 5).

17 4. Hamel discloses a vehicle including at least one hinged section
18 in the exterior surface of a side panel, at least one storage area located
19 adjacent the hinged section, a latch for retaining the hinged section in the
20 closed position, and a strut for retaining the hinged section in the open
21 position (Figs. 1 and 4).

22 5. Powers discloses a vehicle having a storage area defined by a
23 portion of an exterior side panel that is hinged, the width of the storage area
24 being approximately the same as the width of the wheel well (Figs. 1-5).

1 PRINCIPLES OF LAW

2 “Section 103 forbids issuance of a patent when ‘the differences
3 between the subject matter sought to be patented and the prior art are such
4 that the subject matter as a whole would have been obvious at the time the
5 invention was made to a person having ordinary skill in the art to which said
6 subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727,
7 1734 (2007). The question of obviousness is resolved on the basis of
8 underlying factual determinations including (1) the scope and content of the
9 prior art, (2) any differences between the claimed subject matter and the
10 prior art, (3) the level of skill in the art, and (4) where in evidence, so-called
11 secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18
12 (1966). In *KSR*, the Supreme Court reaffirmed principles based on its
13 precedent that “[t]he combination of familiar elements according to known
14 methods is likely to be obvious when it does no more than yield predictable
15 results.” *KSR*, 127 S.Ct. at 1739. The Court also explained that “[w]hen a
16 work is available in one field of endeavor, design incentives and other
17 market forces can prompt variations of it” and that “[i]f a person of ordinary
18 skill can implement a predictable variation, §103 likely bars its
19 patentability.” *Id.* at 1740. The Court noted that “[t]o facilitate review, this
20 analysis should be made explicit,” but “the analysis need not seek out
21 precise teachings directed to the specific subject matter of the challenged
22 claim” *Id.* at 1741, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

23

ANALYSIS

Claims 49-55, 58, 60, 98, 99, 101, 106, 108 and 109

The Examiner rejected these claims as unpatentable over Sparling, Hawkins and Stahl (Ans. 3). The Appellants argue these claims as a group (App. Br. 4-6). Thus, we select independent claim 49 to decide the appeal with respect to this group of claims, claims 50-55, 58, 60, 98, 99, 101, 106, 108 and 109 standing or falling with claim 49. *See* 37 C.F.R. § 41.37(c)(1) (vii) (2007).

The Appellants argue that the vehicles of Hawkins and Stahl are commercial utility trucks and should not be combined with Sparling which is a pick-up truck with a camper top that does not disclose any storage system or problems associated thereto (App. Br. 5 and 6; Reply Br. 4). Thus, the Appellants argue that the Examiner has failed to establish *a prima facie* case of obviousness because the Examiner has not identified any suggestion to combine the references within the references themselves and has also failed to provide an objective reason for combining the references (App. Br. 5). The Appellants further argue that the vehicle of Sparling also cannot be combined with the storage systems of Hawkins because such a combination would destroy the additional passenger seating function of Sparling (App. Br. 10).

However, we note that the Examiner is not required to seek out precise teachings directed to the specific subject matter of the claim. *KSR*, 127 S.Ct. at 1741. We also disagree with the Appellants contention that the applicable prior art is limited to non-commercial vehicles. Hawkins teaches

1 the desirability of providing storage area in a vehicle that is accessed from
2 the exterior side panel for carrying tools and equipment, for facilitating
3 access to such tools, and for increasing the carrying capacity of the truck (FF
4 2). Stahl similarly teaches the desirability for providing a seating
5 arrangement for numerous men and adequate storage space in a vehicle that
6 includes a storage area accessible from the exterior side panel (FF 3).

7 In contrast to the Appellants' assertion that the Examiner has not
8 articulated a motivation to combine these references, the Examiner stated
9 that "it would have been obvious to one of ordinary skill to provide in
10 Sparling a storage compartment . . . in order to store tools, spare parts, etc.
11 away from the passenger compartment" (Final Office Action 2). Thus, the
12 Examiner has articulated a rational reason for providing the storage
13 compartment of Hawkins in the vehicle of Sparling based on the teachings
14 of Hawkins. Similar analysis applies with respect to Stahl which teaches the
15 desirability of adequate storage space and seating (FF 3). With respect to
16 the Appellants' argument that the passenger seating function of Sparling
17 would be destroyed, we note that the storage area in the vehicle of Stahl is
18 provided without destroying the passenger seating function thereof (Stahl:
19 Figs. 1, 3 and 4).

20 In view of the above, we agree with the Examiner that independent
21 claim 49 is unpatentable over Sparling in view of Hawkins and Stahl. Thus,
22 we find that the Appellants have failed to show that the Examiner erred in
23 rejecting claims 49-55, 58, 60, 98, 99, 101, 106, 108 and 109 as
24 unpatentable.

1

2 Claims 61, 62, 64-68, 70-72, 111 and 113

3 The Appellants argue these claims as a group (App. Br. 6 and 7).

4 Thus, we select independent claim 61 to decide the appeal with respect to
5 this group of claims, claims 62, 64-68, 70-72, 111 and 113 standing or
6 falling with claim 61. *See* 37 C.F.R. § 41.37(c)(1)(vii).

7 The Appellants traverse this rejection asserting that Stahl cannot be
8 properly combined with Hawkins, that the Examiner has failed to establish
9 motivation for combining these references, and that the combination still
10 fails to result in the invention claimed (App. Br. 6). The Appellants argue
11 that Stahl is a utility truck where the storage area is separated from the driver
12 and passenger compartments by partition 8 (App. Br. 6). Thus, the
13 Appellants assert that combining the storage system of Hawkins with the
14 vehicle of Stahl does not result in limiting the storage to a width not greater
15 than the wheel well and that the Examiner has failed to establish a *prima*
16 *facie* case of obviousness (App. Br. 6 and 7).

17 The Appellants' arguments are not persuasive because Stahl discloses
18 side members 11 with storage spaces and doors 12 that permit access to the
19 storage spaces from the exterior of the vehicle (Pg. 2, Col. 2, ll. 25-31). It is
20 these storage spaces to which the Examiner applies the teachings of
21 Hawkins, not the compartment defined by the partition 8 (Final Office
22 Action 4). As can be clearly seen by the cross sectional view of Figure 4,
23 the storage area of Hawkins extends into the enclosure less than the wheel
24 well (FF 2). The Examiner has further articulated that it would have been

1 obvious to one of ordinary skill in the art to extend the storage spaces of
2 Stahl into the enclosure less than the wheel well as shown in Hawkins so as
3 to maximize the interior space of the larger compartment that is defined by
4 the partition (Final Office Action 4). The Examiner's articulated rationale is
5 reasonable in view of the competing interest in providing the maximum
6 interior space of the larger compartment defined by the partition while also
7 providing a usable storage space that is accessible from the exterior of the
8 vehicle.

9 Therefore, in view of the above, we agree with the Examiner that
10 independent claim 61 is unpatentable over Stahl in view of Hawkins. Thus,
11 we find that the Appellants have failed to show that the Examiner erred in
12 rejecting claims 61, 62, 64-68, 70-72, 111 and 113 as unpatentable.

13

14 Claims 85, 86, 89, 91 and 92

15 The Examiner rejected these claims as unpatentable over Sparling or
16 Stahl in view of Hawkins and Hamel (Final Office Action 4). The
17 Appellants argue these claims as a group (App. Br. 7 and 8). Thus, we select
18 independent claim 85 to decide the appeal with respect to this group of
19 claims, claims 86, 89, 91 and 92 standing or falling with claim 85. *See* 37
20 C.F.R. § 41.37(c)(1)(vii).

21 The Appellants argue that the Examiner failed to establish
22 motivation for combining Sparling or Stahl with Hawkins, and also failed to
23 establish a motivation for combining Hamel as well (App. Br. 7). With
24 respect to the combination of Sparling or Stahl with Hawkins, we disagree

1 with the Appellants for the same reason discussed *supra* regarding the
2 rejection of independent claim 49. Moreover, the Examiner stated that it
3 would have been “obvious to hinge the side panel section at top and support
4 with strut as taught by Hamel as a shelter from rain, for example” (Final
5 Office Action 4). Hence, in contrast to the Appellants’ assertion, the
6 Examiner has articulated a reason with a rational basis as to why one of
7 ordinary skill in the art would utilize the strut for supporting the side panel
8 section in the manner disclosed in Hamel.

9 Therefore, in view of the above, we agree with the Examiner that
10 independent claim 85 is unpatentable over Sparling or Stahl in view of
11 Hawkins and Hamel. Thus, we find that the Appellants have failed to show
12 that the Examiner erred in rejecting claims 85-86, 89, 91 and 92 as
13 unpatentable.

14

15 Claims 56 and 73

16 These claims ultimately depend from independent claims 49 and 61,
17 respectively, and are directed to the inclusion of at least one strut assembly
18 for retaining the hinged section of the side panel in an open position. These
19 claims stand rejected as unpatentable over Sparling or Stahl in view of
20 Hawkins and Hamel (Final Office Action 5). The Appellants contend that
21 this rejection is improper and has been “previously addressed”, presumably
22 in the arguments against the rejection of independent claim 85 which also
23 recites such a strut (App. Br. 8). However, we disagree with the Appellants
24 for the same reason discussed *supra* relative to claim 85. Therefore, the

1 Appellants have not shown that the Examiner erred in rejecting claims 56
2 and 73 as unpatentable.

3

4 Claims 59 and 88

5 These claims stand rejected as unpatentable over Sparling or Stahl in
6 view of Hawkins, optionally in view of Hamel, and further in view of
7 Gallagher (Final Office Action 5). The Appellants merely rely on
8 previously discussed arguments asserting that motivation for combining
9 Sparling, Stahl, Hawkins and/or Hamel has not been established, and further
10 argue that Gallagher does not remedy this deficiency (App. Br. 8).
11 However, we disagree with the Appellants for the reason discussed *supra*
12 relative to independent claims 49 and 85. Therefore, the Appellants have
13 not shown that the Examiner erred in rejecting claims 59 and 88.

14

15 Claims 69 and 73

16 Claim 69 relates to positioning of the hinged section while claim 73
17 relates to a strut assembly. The Examiner rejected these claims as
18 unpatentable over Stahl in view of Hawkins and further in view of Hamel
19 (Final Office Action 5). The Appellants merely rely on previously discussed
20 arguments asserting that motivation for combining Stahl, Hawkins and
21 Hamel has not been established (App. Br. 9). However, we disagree with
22 the Appellants for the reason discussed *supra* and find that the Appellants
23 have not shown that the Examiner erred in rejecting claims 69 and 73.

24

1 Claim 105

2 Claim 105 which recites that the width of the storage area is
3 approximately the same as the width of the wheel well stands rejected as
4 unpatentable over Sparling in view of Hawkins and Powers (Final Office
5 Action 5). The Appellants contend that claim 105 is not directed to a vehicle
6 with modified wheel wells and that the Examiner has not established
7 motivation to combine Sparling and Hawkins (App. Br. 9; Reply Br. 6).

8 We again agree with the Examiner that Sparling and Hawkins can be
9 properly combined as discussed *supra* relative to the Examiner's rejection of
10 independent claim 49 from which claim 105 ultimately depends. In
11 addition, the basis of the Appellants' argument regarding the wheel well is
12 not well founded or fully understood. The Examiner is not suggesting
13 modification of the wheel well so that it extends into the passenger
14 compartment as Sparling already discloses such a feature (FF 1). Instead,
15 the Examiner is stating that it would have been obvious to one of skill in the
16 art that the storage area of the combination of Sparling and Hawkins can be
17 implemented in view of Powers to result in the invention of claim 105
18 because Powers specifically shows a storage area having a width that is
19 approximately the same as the width of the wheel well (Final Office Action
20 5; FF 5). The Examiner states the reason for providing such a combination
21 is for increasing the storage volume of the vehicle (Final Office Action 5).
22 We agree with the Examiner's and find that the claimed invention is merely
23 a predictable variation of the storage area that is likely unpatentable. *See*

1 *KSR*, 127 S.Ct. at 1740. Thus, the Appellants have not shown that the
2 Examiner erred in rejecting claim 105.

3

4

CONCLUSION

5 On the record before us, Appellants have not shown that the Examiner
6 erred in rejecting claims 49-56, 58-62, 64-73, 85, 86, 88, 89, 91, 92, 98, 99,
7 101, 105, 106, 108, 109, 111 and 113 as unpatentable over the prior art of
8 record.

9

10

ORDER

11

The Examiner's rejections of claims 49-56, 58-62, 64-73, 85, 86, 88,
12 89, 91, 92, 98, 99, 101, 105, 106, 108, 109, 111 and 113 are AFFIRMED.

13

No time period for taking any subsequent action in connection with
14 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
15 § 1.136(a)(1)(iv) (2007).

16

17

AFFIRMED

18

19 JRG

20

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