

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM R. HENEVELD, SR.

Appeal 2008-0400
Application 10/979,973
Technology Center 3600

Decided: April 8, 2008

Before JAMESON LEE, RICHARD TORCZON, and DAVID B.
WALKER, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON APPEAL

A. Statement of the Case

This is a decision on appeal by an Appellant under 35 U.S.C. § 134(a) from a final rejection of claims 2, 4-7, 10, 16-19, and 21-26. We have jurisdiction under 35 U.S.C. § 6(b).

Reference Relied on by the Examiner

Barnes US 5,230,282 Jul. 27, 1993

The Rejections on Appeal

The Examiner rejected claims 2, 5-7, 16, 17, and 22-26 under 35 U.S.C. § 102(b) as anticipated by Barnes.

The Examiner rejected claims 4, 10, 18, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Barnes.

B. Issues

Has the Appellant shown error in the rejection of claims 2, 4-7, 10, 16-19, and 21-26?

C. Summary of the Decision

The Appellant has shown error in the rejection of claims 2, 4-7, 10, 16-19, and 21-26.

D. Findings of Fact (Referenced as FF. ¶ No.)

1. The invention relates to a storage organizer that is adapted for positioning between and attachment to studs of a building wall for creating storage in and along the building wall. (Spec. 2:23-25.)

2. Claims 16, 25, and 26 are independent claims and are reproduced below:¹

¹ We have reproduced claims 16, 25, and 26 in a manner that complies with 37 C.F.R. § 1.75 (i) which provides that; “[w]here a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.”

16. A storage organizer comprising:

a storage unit having a bottom and sides;

the sides each having a downwardly facing notch that is shaped and adapted to interlockingly capture and engage a shaft extending laterally into the side to thus prevent fore-aft movement on the shaft, the notch terminating in an [sic, in an] area spaced above the bottom, whereby the storage unit can be lowered onto a pair of opposing shafts that extend inwardly from opposing directions, with the shafts extending into the notches on the sides to support a weight of the storage unit and items stored thereon.

25. A storage organizer comprising:

a storage unit having a bottom and sides;

the sides each having a downwardly facing notch that is shaped and adapted to matingly engage a shaft extending laterally into the side, each of the sides including material with inner and outer surfaces defining inner and outer planes, and the notch on each side being integrally formed in the material and lying between the respective inner and outer planes, each notch terminating in an area spaced above the bottom, whereby the storage unit can be lowered onto a pair of opposing shafts that extend inwardly from opposing directions, with the shafts extending into the notches on the sides to support a weight of the storage unit and items stored thereon.

26. A storage organizer comprising:

a storage unit having a bottom and sides;

the sides each having at least one downwardly facing notch with a narrowed upper end that is shaped and adapted to interlockingly capture and engage a shaft extending laterally into the respective side in a manner that prevents fore-aft movement of the storage unit, the sides each including material

defining boundaries of the respective sides, and the notch on each side being integrally formed in the material and lying within the boundaries of the respective sides, each notch terminating in an area spaced above the bottom, whereby the storage unit can be lowered onto opposing shafts that extend inwardly from opposing directions, with the shafts extending into the notches on the sides to support a weight of the storage unit and items stored thereon.

3. In Appellant's specification, when the term "side" is used, it refers to opposing peripheral components of the disclosed organizer separated by a bottom structure. (Spec. 2:28-30, 3:9-12, 11:6-7.)

4. In Appellant's specification, when the term "side" is used, it does not include any portion of a "bottom" of the organizer.

5. Barnes discloses a packaging system for bundlable material that includes a rack. (Barnes 1:43-45.)

6. In Barnes, the rack includes the elements of a rear upstanding barrier 16 and a pair of tongues 12 that extend forwardly from the base of barrier 16 and form a trough for retaining paper or cardboard garbage. (Barnes 3:20-21, 34-46.)

7. In Barnes, the rack is fixed to a rear vertical wall surface by screws 19 that extend through hooks 18 in the rear barrier 16. (Barnes 3:21-24, 5:40-41, Fig. 1.)

8. In Barnes, when the term "side" is used, it refers to opposing peripheral portions of the rack separated by a base. (Barnes 6:22-35, 56-60.)

E. Principles of Law

To establish anticipation under 35 U.S.C. § 102, each and every element in a claim, arranged as is recited in the claim, must be found in a

single prior art reference. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001).

In proceedings before the U.S. Patent and Trademark Office, claims are properly construed according to their broadest reasonable interpretation consistent with the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1990); *In re Prater*, 415 F.2d 1393, 1404 (CCPA 1969). The broadest reasonable interpretation of a claim is “reasonable” only if it is consistent with the specification. *In re Royka*, 490 F.2d 981, 984-85 (CCPA 1974).

F. Analysis

The Appellant must show error in the decision of the Examiner rejecting claims 2, 4-7, 10, 16-19, and 21-26.²

The Appellant argues that Barnes does not disclose a storage unit where “each side” has a downwardly facing notch. (Br. 5:19-20.) The Appellant contends that the bent wire sections 18 which the Examiner regarded as the notches in Barnes are instead positioned on the rear of the storage unit and spaced inwardly from the sides. (Br. 5:22-24.)

We agree with the Appellant.

Claims 16, 25, and 26 are independent claims and each call for a storage unit having a “bottom” and “sides.” As claimed, each side includes a downwardly facing notch that is shaped to engage with a shaft extending

² The Appellant incorrectly characterizes the Examiner’s objection to claim 17 as a rejection under 35 U.S.C. § 112. (Br. 4:16.) However, the Examiner did not reject the claim. The Examiner raised only an objection for imprecise claim terminology (Final Rejection 2:9, March 2, 2006). An objection is reviewable by petition to the Director and is not appealable to the Board. See *In re Hengehold*, 440 F.2d 1395, 1403-1404 (CCPA 1971). Accordingly, we do not reach the issue.

laterally into the side. Limitations of the structure of the sides are essentially the same in each claim and are reproduced below:

In claim 16:

the sides each having a downwardly facing notch that is shaped and adapted to interlockingly capture and engage a shaft extending laterally into the side to thus prevent fore-aft movement on the shaft.

In claim 25:

the sides each having a downwardly facing notch that is shaped and adapted to matingly engage a shaft extending laterally into the side.

In claim 26:

the sides each having at least one downwardly facing notch with a narrowed upper end that is shaped and adapted to interlockingly capture and engage a shaft extending laterally into the respective side in a manner that prevents fore-aft movement of the storage unit.

In Barnes, the rack includes a rear barrier 16 that attaches the rack to a rear vertical wall and forwardly extending tongues 12 that form a trough for retaining paper or cardboard. (FF ¶ 6.) In the context of both the Appellant's specification (FF ¶ 3) and Barnes (FF ¶ 8), the terms "side" and "bottom" or "base" are used to identify particular and distinct structural elements, and the term "side" is used to designate opposing peripheral portions of the rack separated by the bottom or base. The Appellant's specification and the disclosure of Barnes reflect the ordinary meaning of a "side" or "sides" in the pertinent art and the meaning of "sides" relative to a "bottom" of a rack or organizer. In proceedings before the U.S. Patent and Trademark Office, claims are properly construed according to their broadest reasonable interpretation consistent with the specification. *In re Zletz*, 893 F.2d at 321;

In re Prater, 415 F.2d at 1404. The broadest reasonable interpretation of a claim is “reasonable” only if it is consistent with the specification. *In re Royka*, 490 F.2d at 984-85.

The Examiner has taken the position that Barnes includes left and right sides such that “half of the structure shown in Figure 1 could be viewed as a ‘side.’” (Ans. 6:6-15.) However, interpreting “side” in that manner is inconsistent with the meaning of “side” in the Appellant’s specification and the ordinary meaning of that term in the art of record when used in connection with a separate or distinct bottom structure as is claimed. It is unreasonable to regard the opposing peripheral portions in Barnes (i.e. tongues 12 and barrier 16) that lie across a bottom (element 22) as constituting the same side. Moreover, even if half of the structure of Figure 1 of Barnes is viewed as a “side,” that same “side” cannot now also reasonably include a “bottom” of the rack which is distinct from the side. It is also unreasonable and arbitrary to pick half of the structure in Barnes to form the claimed “side” (Ans. 3:11), to the exclusion of element 22 in the same half, so that it can constitute a separate bottom (Ans. 3:10).

Adopting the broadest reasonable interpretation consistent with the specification, we conclude that Barnes cannot properly be regarded as satisfying the limitation that the sides of the rack each have a downwardly facing notch that is shaped and adapted to capture or otherwise engage a shaft extending laterally into each side of the rack. In Barnes, the hooks 18, which have been construed as the claimed notches, are not on different sides of the rack 10 but instead reside on the same side 16. The Examiner has not identified more than one “side” which includes a downwardly facing notch to engage any shaft extending into the side.

To establish anticipation under 35 U.S.C. § 102, each and every element in a claim, arranged as is recited in the claim, must be found in a single prior art reference. *Karsten Mfg. Corp.*, 242 F.3d at 1383. The Examiner erred in finding that Barnes satisfies each limitation of Appellant's claims 16, 25, and 26.

Therefore, we do not sustain the rejection of claims 2, 5-7, 16, 17, and 22-26 under 35 U.S.C. § 102(b) as anticipated by Barnes.

With regard to claims 4, 10, 18, 19, and 21, these claims depend from independent claim 16 and were rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes. The Examiner's analysis under 35 U.S.C. § 103(a) is directed to limitations added in the dependent claims. (Ans. 4:15 to 6:2.) The deficiencies of Barnes with respect to claim 16 are not made up by the Examiner's analysis. Accordingly, we do not sustain the rejection of claims 4, 10, 18, 19, and 21 under 35 U.S.C. § 103(a) over Barnes.

G. Conclusion

The rejection of claims 2, 5-7, 16, 17, and 22-26 under 35 U.S.C. § 102(b) as anticipated by Barnes is reversed.

The rejection of claims 4, 10, 18, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Barnes is reversed.

REVERSED

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