

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACEK HELENOWSKI

Appeal 2008-1314
Application 10/464,303
Technology Center 2800

Decided: September 18, 2008

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI, and
CARLA M. KRIVAK, *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from a final rejection of
claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

STATEMENT OF CASE

Appellant's claimed invention is a support rod for a light source particularly an illumination source disposed in a support rod for clothing and/or other items found in a closet or supported by a rod (Spec. ¶[0001]).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A support rod comprising:

a single elongated body having a uniform thickness wall with a closed upper surface that supports a load and having a cavity in which a light source is disposed;

at least one opening in the elongated body beyond which the light source does not extend and through which light from the light source is emitted;

wherein the support rod protects and at least partially encloses the light source and has two or more risers for attaching the light source to an inner surface of the support rod.

REFERENCES

Cetrone	US 4,712,165	Dec. 8, 1987
Hartshorn	US 4,858,087	Aug. 15, 1989

The Examiner rejected claims 1-20 as follows:

Claims 1-5, 7-11, 13-18, and 20 stand rejected under 35 U.S.C. § 102(b) based upon the teachings of Hartshorn.¹

Claims 12 and 19 stand rejected under 35 U.S.C. § 102(b) based upon the teachings of Cetrone.

¹ The Examiner also rejected claim 4 under 35 U.S.C. §112, 2nd paragraph, however, this rejection was withdrawn in the Answer mailed March 20, 2007 (Ans. 15).

Claim 6 stands rejected under 35 U.S.C. § 103(a) based upon the teachings of Hartshorn.

Appellant contends that Hartshorn fails to teach or suggest the elements as claimed (App. Br. 14)

ISSUES

Did the Examiner err in rejecting claims 1-5, 7-11, 13-18, and 20 under 35 U.S.C. § 102(b) as anticipated by Hartshorn?

Did the Examiner err in rejecting claims 12 and 19 under 35 U.S.C. § 102(b) as anticipated by Cetrone?

Did the Examiner err in rejecting claim 6 under 35 U.S.C. § 103(a) as obvious over Hartshorn?

FINDINGS OF FACT

1. Appellant teaches a method and apparatus for illuminating clothing in a closet. The apparatus includes a support rod having an elongated body capable of supporting a load (Spec. ¶[0011]; cl. 1) and having a cavity with a light source therein that does not extend through the elongated body (cl. 1). An opening in the elongated body allows the light from the light source to be emitted (cl. 1). Further, the support rod has two or more risers for attaching the light source on an inner surface of the support rod (cl. 1).

2. Hartshorn teaches a fluorescent lighting enclosure system that supports and encloses a fixture in a readily adaptable form. A spline fits in a track and acts as a mount for the enclosure and the fluorescent lights therein. The enclosure may be mounted with its light emitting opening directed in

any direction (Abstract). The system can be used for handrail lighting. The splines include a pair of locking or set screws that engage an inner wall of the enclosure when tightened (col. 2, ll. 27-29).

3. Cetrone teaches a lighting system suspended beneath the ceiling of an enclosure and including fluorescent tubes as a light source (col. 1, ll. 6-8). The fluorescent tubes and their ballasts are positioned in a plastic pipe that is slotted to direct light downwardly, upwardly, or sideward (col. 1, ll. 35-38).

PRINCIPLES OF LAW

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983), it is only necessary for the claims to “‘read on’ something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or ‘fully met’ by it.” While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. *See Studiengesellschaft Kohle m.b.H. v. Dart Indus., Inc.*, 726 F.2d 724, 726-27 (Fed. Cir. 1984).

LaBounty Mfg. v. U.S. Int'l Trade Comm'n, 958 F.2d 1066, 1075 (Fed. Cir. 1992) (in quoting with approval from *Dwight & Lloyd Sintering Co. v. Greenawalt*, 27 F.2d 823, 828 (2d Cir. 1928)) stated:

The use for which the [anticipatory] apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent; the statute authorizes the patenting of machines, not of their uses. [Alteration in original.]

Obviousness

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 (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 (1966). “[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 (Fed. Cir. 1992). If the Examiner’s burden is met, the burden then shifts to the Appellants to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *Id.*

Discussing the question of obviousness of a patent that claims a combination of known elements, the Court in *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007) explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable

variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida [v. AG Pro, Inc., 425 U.S. 273 (1976)]* and *Anderson's-Black Rock [Inc. v. Pavement Salvage Co., 396 U.S. 57 (1969)]* are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740.

The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id*

ANALYSIS

Anticipation

Claims 1-5, 7-11, 13-18, and 20

The Examiner rejected claims 1-5, 7-11, 13-18, and 20 under 35 U.S.C. § 102(b) as anticipated by Hartshorn. Appellant’ arguments separately address some of the claims subject to this rejection but do not separately address claims 4, 5, 7, 8, 11, and 14-19. Thus Appellant’s arguments have effectively grouped claims 1, 4, 5, 7, 8, 11, and 14-19 together and we select independent claim 1 as representative. We first address claim 1.

Claim 1

The Examiner contends that Hartshorn teaches all the features of Appellant's claims. That is, Hartshorn clearly shows in Fig. 2, a support rod 11 having "a single elongated body 12 with a closed upper surface and a light source 24 being disposed within a cavity defined by the elongated body 12. The light source is attached to the single elongated body by a plurality of risers 50 (see Figure 3)." (Ans. 16)

Appellant asserts that Hartshorn does not support a light fixture from an upper surface of the enclosure because the light fixture of the invention is suspended from within the enclosure and Hartshorn's light source is suspended below the fixture (App. Br. 9). Appellant further asserts reference numeral 11 in Hartshorn refers generally to the light source and reference numeral 12 refers to an enclosure or body (App. Br. 9). Appellant maintains Hartshorn utilizes reference numeral 21 to refer to the fluorescent lamp as the light source; "a *standard lighting fixture* is not a light source, but rather provides electricity to a light source" (App. Br. 10). "Hartshorn *requires* a separate fixture 24 in addition to his enclosure 12." (App. Br. 10) As argued by Appellant, the claimed invention does not require a lighting fixture and does not suffer from the disadvantage of having such a lighting fixture (App. Br. 10). Appellant further maintains the support rod of the claimed invention has "two or more risers for attaching the light source to an inner surface of the support rod" (cl. 1) not a machine screw 50 that "extends through machine screw opening 42, out of the track 23 and into a lamp base or canister 51 of FIG. 3 which is held in place by machine screw 50" as does Hartshorn (App. Br. 10; col. 5, ll. 4-9).

Under 35 U.S.C. §102, the prior art must teach each and every element set forth in the claim (*Verdegaal Bros., supra*). We agree with the Examiner that Hartshorn teaches all the elements of claim 1. That is, the language in Appellant's claim 1 regarding the "upper surface that supports a load" is broad enough to read on the cover that holds the light and fixture in Hartshorn. We also agree that the light itself could be considered the load that is supported since there is no evidence to the contrary. With respect to the risers, they read on the screws in Hartshorn. Although the screws go all the way through the upper surface they do attach the light source to an inner surface of the support rod, which is what is claimed (FF2). Thus, we agree with the Examiner that Hartshorn anticipates claim 1 and sustain the rejection under 35 U.S.C. § 102(b).

As discussed above, claims 4, 5, 7, 8, 11, and 14-18 were not separately argued. Thus, for the reasons set forth above, we agree with the Examiner that claims 1, 4, 5, 7, 8, 11, and 14-19 are anticipated by Hartshorn and sustain the rejection under 35 U.S.C. § 102(b).

Claim 2

With respect to claim 2, which recites a compression fit sleeve, the Examiner contends that Hartshorn teaches this feature as evidenced by column 5, lines 5-14 (Ans. 5). The Examiner further contends the recitation of a "compression fit sleeve" is functional rather than structural (Ans. 22) and the compression fit sleeve reads on Hartshorn. We do not agree.

A compression fit sleeve is a structural limitation. Additionally, a screw is not a compression fit sleeve and there is no teaching or suggestion

in Hartshorn of using a compression fit sleeve. Thus, Hartshorn does not anticipate claim 2.

Claims 3 and 13

The Examiner contends Hartshorn shows the support rod supported from above through at least one mount disposed along the closed upper surface and wiring for the light source is routed through the mount (Ans. 5; Figs. 1 and 2).

Appellant asserts the “supports for Hartshorn’s ceiling mounts are likely only designed to support the light system, and not a load, because Hartshorn does not teach or suggest that the enclosure supports a load from above (App. Br. 15). Appellant further asserts the shelves 10 of Fig. 1 provide support from below, not from the ceiling (App. Br. 15). We do not agree.

The claims are written so broadly they read on Figs. 1 and 2 of Hartshorn. We also agree with the Examiner that the feature of the support rod supporting a load from above is not recited in the claims. Thus, Hartshorn anticipates claims 3 and 13.

Claim 9

With respect to claim 9, the Examiner contends the language “the load comprising a plurality of hangers” lacks patentable weight as it is functional and “the claimed invention is the support rod; the load is not part of the claimed invention” (Ans. 26). We do not agree.

Claim 9 further recites the load is a plurality of hangers. This language is structural. Hartshorn does not teach or even suggest hanging a

load that comprises hangers on the support rod. Hartshorn is merely a light fixture. Thus, Hartshorn does not anticipate claim 9.

Claim 10

The Examiner contends that Hartshorn teaches a rack incorporating the support rod (Ans. 28; Fig. 1). The Examiner further contends that the shelves and the support rod correspond to the recited rack.

Appellant asserts that shelves are not a rack and the Examiner's interpretation is overly broad (Reply Br. 7). We do not agree. The Examiner's interpretation is reasonable in view of the definition of rack provided (Ans. 28). Thus, Hartshorn anticipates claim 10.

Claim 20

The Examiner contends Hartshorn shows that a mounting assembly supporting a support rod is below the support rod (App. Br. 10).

Appellant asserts the shelves, which the Examiner stated correspond to the "mounting assembly" of Fig. 1 of Hartshorn, do not support the support rod and do not touch the enclosure 12 that the Examiner contends is a support rod. We do not agree. Claim 20 does not recite the support rod touching the enclosure as asserted by Appellant. Even if it did, claim 20 is broad enough to read on Fig.1 of Hartshorn as Fig. 1 shows the tube 13, although attached to the top of the enclosure body 12, supports the rod at a location below the support rod (e.g., the floor). Thus, Hartshorn anticipates claim 20.

Claims 12 and 19

The Examiner rejected claims 12 and 19 under 35 U.S.C. § 102(b) as anticipated by Cetrone. The Examiner contends that Cetrone teaches all the elements in claim 12 (Ans. 10-12).

Appellant asserts Cetrone teaches an inexpensive, lightweight, overhead lighting system where the fittings are supported by rods or tubes from the ceiling (App. Br. 17). Appellant further asserts that Cetrone does not teach or suggest a mounting assembly capable of mounting two open ends of a support rod to one or more walls, that power for the light source is provided through one end of the support rod, and that the support rod also supports a load along a closed upper surface as recited in claim 12 (App. Br. 18). We do not agree.

Cetrone teaches all the elements recited in claim 12. Anticipation under 35 U.S.C. § 102(b) requires only that the claim reads on the cited art. In this case, the Examiner has correctly pointed out that claim 12 as written is broad enough to read on Cetrone (Ans. 10-12, 31-33). It should be further noted that claim 1 of Cetrone recites a tubular light source including an electric circuit for energizing the tubular light source.

Thus, for the reasons set forth by the Examiner, we find claim 12, and thus, claim 19, which depends therefrom, anticipated by Cetrone.

Obviousness
Claim 6

The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as obvious over Hartshorn. The Examiner contends that rings at the ends of the support rod are an obvious variation (Ans. 34).

Appellant contends that Hartshorn does not teach a continuous slot along the length of the support rod nor does it teach rings at the end of support rod that provide additional structure (App. Br. 19; Reply Br. 9). We do not agree.

Hartshorn shows a continuous slot covered by a lens (15) (Figs. 2, 3). Further, one ordinarily skilled in the art would know to put rings at first and second ends of the support rod so the support rod can be attached to walls for additional stability and “structure.” This would be no more than a predictable variation.

Thus, for the above reasons, we sustain the Examiner’s rejection of claim 6.

CONCLUSION

We therefore conclude that the Examiner did not err in rejecting claims 1, 3-5, 7, 8, 10, 11, 13-18, and 20 under 35 U.S.C. § 102(b) but did err in rejecting claims 2 and 9 under 35 U.S.C. § 102(b) as anticipated by Hartshorn. The Examiner also did not err in rejecting claims 12 and 19 under 35 U.S.C. § 102(b) as anticipated by Cetrone. Lastly, the Examiner did not err in rejecting claim 6 under 35 U.S.C. § 103(a) as obvious over Hartshorn.

DECISION

The decision of the Examiner rejecting claims 1, 3-8, and 10-20 is affirmed and the decision of the Examiner rejecting claims 2 and 9 is reversed.

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

AFFIRMED-IN-PART

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