

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM D. KING and FREDERICK D. OBERHAUS

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Appeal No. 2001-0150  
Application No. 09/250,617

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ON BRIEF

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Before FRANKFORT, STAAB, and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3 through 5, which are all the claims pending in the application as claims 1 and 2 have been canceled.

The appellants claimed subject matter is a suspended shoe rack. An understanding of the claimed subject matter can be derived from a reading of exemplary claim 4 which appears in the appendix to the appellants' brief.

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The prior art

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Deaver	803,274	Oct. 31, 1905
Bisk	4,765,495	Aug. 23, 1988

The rejections

Claim 5 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 applicants regard as the invention.

Claim 4 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Deaver.

Claims 3 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Deaver in view of Bisk.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 12) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 11) for the appellants' arguments thereagainst.

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OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claim 5 under 35 U.S.C. 112, second paragraph. We initially note that the second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable

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language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

With this as background, we analyze the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal.

In the instant case, the examiner is of the opinion that:

Claim 5 is rendered indefinite since the claim fails to further limit the structure of the claim. Specifically, it should be noted that claim 4 only sets forth one shoe rack and therefore reliance on a "plurality" is improper. Moreover, since only one rack has been previously set forth, there clearly can be no antecedent basis for "said suspended shoes racks". Further, there are no structural recitations to support the functional recitation of intended use in the "wherein" clause that is in claim 5. Further, it is unclear what makes the instant rack "capable" of nesting [answer at page 5].

We will not sustain this rejection. In our view, when this claim is read in light of the specification, the metes and bounds of the claim are clear. Specifically, the specification discloses and Figure 4 depicts that the shoe racks can be nested together due to the inclined configuration and structural

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location of the shoe supports 6 so that a plurality of shoe racks can be packed and shipped together (see specification at pages 5 and 6).

We turn next to the examiner's rejection of claim 4 under 35 U.S.C. 102(b). We initially note that to support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

In support of this rejection, the examiner states:

Deaver '274 discloses a suspended rack comprising vertical side supporting rods (A) that are parallel to one another and having an upper part and a lower part; means (D), i.e., a rope (E) and pulley system, on the upper part of the side supporting rods engage a pre-existing horizontally disposed support member (F'), i.e., a ceiling; and a plurality of horizontally disposed and spaced apart supports (C) are spaced from the upper part of the vertical rods (A) and are *integrally* formed and each support is comprised of a rail, a back rail and two side rails and the side rails are *affixed* (C') generally perpendicularly to the vertical side supporting rods (A) [answer at pages 3 and 4].

We agree with the analysis of the examiner and we therefore, sustain this rejection.

The appellants argue that Deaver is a display rack and not a storage rack for suspending pairs of shoes in a closet. However,

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the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). A statement of intended use does not qualify or distinguish the structural apparatus claimed over the reference. In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. See generally Kropa v. Robie, 187 F.2d 150, 155-59, 88 USPQ 478, 483-87 (CCPA 1951) and the authority cited therein, and cases compiled in 2 Chisum, Patents § 8.06[1][d] (1991). Such statements often, although not necessarily, appear in the claim's preamble. In re Stencel, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987). Therefore, the manner in which the rack disclosed by appellants is used is not germane to the issue of patentability. The Deaver rack is capable of storing shoes.

Appellants also argue that Deaver requires the use of ropes over pulleys to achieve suspension of its rack. However, as claim 4 is set out in comprising format, the presence of ropes over pulleys is not excluded.

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Appellants also argue that Deaver does not show any means towards the upper part of the structure for engaging a pre-existing horizontally disposed support. We do not agree. In our view, the Deaver rack is disclosed as suspended from the ceiling (page 1, lines 86-87), which is a pre-existing horizontally disposed support. Thus, the Deaver rack clearly has a means toward the upper part of the side supporting rods for engaging a pre-existing horizontally disposed support. In addition, a rod, which is a horizontal support, may be placed beneath the meeting points through the openings at the top of the rack.

Appellants also argue that Deaver does not show any type of shoe supports and in fact would tend to define away from a storage type of shoe rack since Deaver discloses that the rack may be raised or lowered to different elevations. In our view, the shelves C of Deaver are capable of supporting shoes. We are at a loss to understand the relevance of the fact that the shelf of Deaver can be raised and lowered.

Appellants argue that the claims define an invention in which its shoe rack supports are disposed approximately horizontally but not fixed at a horizontal position. This argument is not persuasive because the requirement of claim 4 that the shoe supports are "disposed approximately horizontally"

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is broad enough to include within its metes and bounds supports like those of Deaver that are disposed horizontally.

In addition, we note that the term "horizontally" has a fixed and definite meaning, and that while the use of the modifier "approximately" with this term does broaden the term to some degree, it does not negate the meaning of the word it modifies. See, Arvin Industries, Inc. v. Berns Air King Corp., 525 F.2d 182, 185, 188 USPQ 49, 51 (7<sup>th</sup> Cir. 1975). Moreover, words such as "approximately" and "about" are well known in the lexicon of patent claim drafting and enjoy a well developed niche in the special vocabulary of this field. Such modifiers are almost universally used by practitioners in claims to prevent a potential infringer from avoiding literal infringement simply by making a minor/inconsequential modification that departs only slightly from the literal scope of a claim.

Thus, in light of the foregoing considerations, we conclude that the phrase "approximately horizontally" as used in the present application claims would have been seen by the person of ordinary skill in the art to merely allow for a reasonable and minor deviation from a support that is disposed exactly horizontally.

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Further, we note that although the appellants argue that the shoe supports are not fixed at a horizontal position, appellants' specification (page 7) discloses that the shoe supports may be arranged level rather than on an incline to provide better balance during usage and that the appellants' original claim 2 recited that the shoe supports are disposed horizontally.

In view of the foregoing, we will sustain the examiner's rejection of claim 4 under 35 U.S.C. § 102 as being anticipated by Deaver.

We turn next to the examiner's rejection of claims 3 and 5 under 35 U.S.C. 103 as being unpatentable over Deaver in view of Bisk. The examiner recognizes that Deaver does not disclose (1) stabilizing rods to be attached to each side rail and positioned between the front and rear rails of the supports and (2) a plurality of racks capable of being nested together. Bisk is relied on for disclosing a suspended rack comprising rods (see figure 2, element 40) and the stabilizing rods being positioned between the front and rear rails of the rack. The examiner concludes:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the rack of Deaver '274 with the vertical stabilizing rods, as taught by Bisk '495, for increased structural support and stability of the rack when items are placed therein [answer at page 4].

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Appellants argue that Bisk does not disclose or suggest furnishing stabilization to a series of vertically spaced shoe supports.

We do not agree. As Bisk discloses a grid which includes stabilizing rods, we agree with the examiner that it would have been obvious to a person of ordinary skill in the art to modify the Deaver structure so as to include stabilizing rods in view of the Bisk reference for the self evident reason of increasing the stability of the structure.

In view of the foregoing, we will sustain the examiner's rejection of claim 3 as being unpatentable over Deaver in view of Bisk.

In regard to claim 5, the examiner states that:

. . . Bisk '495 teaches that it is old in the art to have a rack that is capable of being nested together, e.g., each vertically disposed planar member (22) can be disassembled from connectors (24) and horizontally disposed planar members, i.e., shoe supports [answer at page 4].

We will not sustain the rejection as it is directed to claim 5. Claim 5 requires that the racks are capable of nesting together. In our view, the capacity of nesting after disassembly of the racks does not meet the requirements of this claim.

In summary:

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The examiner's rejection of claim 5 under 35 U.S.C. § 112, second paragraph, is not sustained.

The examiner's rejection of claim 4 under 35 U.S.C. § 102(b) is sustained.

The examiner's rejection of claim 3 under 35 U.S.C. § 103 is sustained.

The examiner's rejection of claim 5 under 35 U.S.C. § 103 is not sustained.

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

AFFIRMED-IN-PART

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
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	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

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