

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENJAMIN L. GARFINKLE

Appeal No. 99-0618
Application No. 08/797,496¹

ON BRIEF

Before COHEN, ABRAMS, and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2, 3, 5, 6 and 15, which are all of the claims pending in this application.²

¹ Application for patent filed February 7, 1997. According to the appellant, the application is a continuation of Application 08/462,953, filed June 5, 1995, now abandoned.

² Claims 1, 4 and 7 through 14 have been canceled.

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Application No. 08/797,496

We REVERSE.

BACKGROUND

The appellant's invention relates to a detachable shelf extender for extending forward from the front edge of a display shelf used to store and display merchandise in a supermarket or similar environment. The shelf is a perf-board shelf provided with a regular array of holes and a display channel for accepting pricing and identifying information of products displayed on the shelf. The shelf extender includes a horizontally extending top surface provided with at least one slot for receiving a fastener which passes through a hole in the perf-board shelf to fasten the extender to the shelf. This fastening arrangement provides a shelf extender which is easily removable from the shelf and can be accepted by a variety of shelves. An understanding of the invention can be derived from a reading of exemplary claim 15, which appears in the appendix to the appellant's brief.³

³ The copies of claims 2 and 3 in the appendix to the appellant's brief contain minor errors relative to the claims as they appear in the file. In claim 2, lines 2 and 3, "in the vicinity of" should be "proximate." In claim 3, line 3, "a" should be deleted.

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

Celeste	4,140,224	Feb. 20, 1979
Garfinkle	5,199,199	Apr. 6,
1993		
Gebka et al. (Gebka)	5,394,632	Mar. 7, 1995

The following rejections are before us for review.

Claims 2, 5, 6 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Celeste in view of Gebka.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Celeste in view of Gebka, as applied above, and further in view of Garfinkle.

The complete text of the examiner's rejections and response to the argument presented by the appellant appears in the answer (Paper No. 21, mailed August 12, 1998), while the complete statement of the appellant's argument can be found in the brief (Paper No. 20, filed June 29, 1998).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and

claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We shall not sustain the rejection of claims 2, 5, 6 and 15 under 35 U.S.C. § 103 as being unpatentable over Celeste in view of Gebka.

Celeste discloses a shelf protector (9) having a top surface (9a) and an overhanging lip (10) extending downwardly from the front edge of the top surface supporting a tag assembly (33) (Figure 5). The disclosed purpose of the shelf protector is to protect a merchandise-supporting shelf (13), which is provided with a merchandise information tag strip (17) (column 1, lines 23 through 32). As seen in the Figure 5 embodiment, the tag assembly comprises an elongated strip (32) provided with upper and lower supporting lips (32a, 32b) for retaining a merchandise information tag (31). Celeste discloses that the shelf protector "is removable and may be secured in place by fastening members 5 such as screws" (column 2, lines 14 and 15).

Gebka discloses a price channel (10') for placement in the C-channel (18) of a steel merchandise shelf. As illustrated in Figures 7 and 8, the merchandise shelf is provided with a regular array of holes.

In rejecting the claims, the examiner concedes that Celeste does not disclose at least one slot in the shelf protector (9) or a regular array of holes in the shelf (13) (answer, page 5). The examiner's position is that shelves having an array of holes provided therein were well known in the art at the time of appellant's invention, as illustrated by Gebka, and that, in view of the teachings of Gebka, it would have been obvious to modify the shelf of Celeste by placing an array of holes in the shelf to allow for easy attachment of the protector and other articles to

the shelf (answer, page 5). Further, the examiner asserts:

The idea of making openings in the form of slots for the purpose [of allowing] an article to be adjusted is well known in the art. It would have been obvious to one in the art to modify Celeste by making the openings in the form of slots since this would allow the extender (9) to be adjusted

relative to the shelf in an easier manner
[answer, page 5].

We have carefully reviewed the prior art (Celeste and Gebka) relied upon by the examiner as evidence of obviousness and we find therein neither a teaching to provide a slot within the top surface of the shelf protector of Celeste nor any suggestion to use one of the holes in a regular array of holes in a shelf in association with a fastener and a slot in the protector, to fasten the shelf protector to the shelf. Further, we do not find that either Celeste or Gebka appreciated any advantage in providing an adjustable connection of the shelf protector to the shelf.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967).

The examiner has not supplied the factual basis for the conclusion that it would have been obvious to provide a slot in the top surface of the shelf protector of Celeste for receiving a fastener passing through the slot and a hole in the shelf. Accordingly, while we fully appreciate the examiner's reasoning and the manner in which the teachings of Celeste and Gebka have been combined in rejecting the claims, we are constrained to reverse the examiner's decision rejecting independent claim 15, and claims 2, 5 and 6 which depend therefrom, as being unpatentable over Celeste in view of Gebka.

Further, with regard to claim 3, we have reviewed the teachings of Garfinkle, but find nothing therein which alters our view with regard to the basic combination of Celeste and Gebka. In other words, Garfinkle does not overcome the deficiencies of the combination of Celeste and Gebka noted above.

Accordingly, we must likewise reverse the examiner's decision rejecting claim 3 as being unpatentable in view of Celeste in view of Gebka and Garfinkle.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 2, 3, 5, 6 and 15 under 35 U.S.C. § 103 is REVERSED.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER BAHR)	
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APPLICATION NO. 08/797,496

APJ BAHR

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APJ BAHR

DECISION: **REVERSED**

Prepared By: Kimberly Inabinet

DRAFT TYPED: 12 Jan 00

FINAL TYPED: