

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT L. TUTTLE,
BRYAN R. GINGRICH,
RONNA T. JACOBS
and RONALD L. LAMER

Appeal No. 1999-1502
Application 08/600,060¹

ON BRIEF

Before CALVERT, FRANKFORT, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 3, 6 and 7. Of the other claims in the application, claims 9

¹ Application for patent filed February 12, 1996.

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to 21 have been allowed, and claims 4, 5 and 8 have been indicated as allowable if rewritten in independent form.

The appealed claims are drawn to a free-standing cabinet unit, and are reproduced in the appendix of appellants' brief.

The reference applied in the final rejection is:

De Lisle	2,404,949	Jul. 30, 1946
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A reference, of record,² applied herein in a rejection pursuant to 37 CFR 1.196(b) is:

Harman	1,889,783	Dec. 6,
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1932

Claims 1 to 3, 6 and 7 stand finally rejected as anticipated by De Lisle, under 35 U.S.C. § 102(b).

The issue involved here is whether the pivot axis of De Lisle's pivots 24 is "upright-oriented", as recited in independent claim 1. If it is not, then the rejection cannot stand, because a reference does not anticipate unless it discloses "every limitation of the claimed invention, either

² This reference was cited by appellants in an Information Disclosure Statement filed on March 17, 1997 (Paper No. 5).

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explicitly or inherently". In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

The axis of the pivots 24 of De Lisle is shown as being horizontal (i.e., parallel to the floor). However, the examiner

takes the position that the De Lisle axis is "upright-oriented" because (answer, pages 5 and 6):

the upright-oriented pivot axis is considered to perpendicular to the paper. In a 3-dimensional plane, the examiner has defined the upright-oriented pivot axis [of De Lisle] to be the Z-axis which comes out of the paper and toward the reader. The Y-axis is vertical and the X-axis is horizontal [sic] from left to right of the paper. Therefore, the examiner has interpreted the pivot means (24) to enable drawing board 11 to pivot in a substantially horizontal direction with respect to the Z-axis or upright-oriented axis (see Figure 1).

Since the Appellant [sic] has not positively defined the upright-oriented pivot axis with respect to the other structural elements in the claim limitations, the examiner can

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interpret the axis in a broad
manner.

We do not agree with the examiner. A limitation in a claim cannot be read in a vacuum, but rather all elements of a claim must be read together as a whole, in relation to each other. In the present case, the "upright-oriented pivot axis" is an element of the overall combination of elements which together comprise the claimed free-standing cabinet unit. Thus, in construing

claim 1, the term "upright-oriented" (i.e., vertically oriented) must be read in conjunction with the claimed "upward facing first work surface" and "upward facing second work surface"; since these surfaces are defined as "upward facing", the "upright-oriented pivot axis" must be construed as extending in the direction in which those surfaces face, in other words, in a direction perpendicular to those surfaces. Such an arrangement is not disclosed by De Lisle. If one were to accept the examiner's interpretation of the pivot axis of De Lisle as "upright-oriented", then, as appellants point out on page 2 of their reply brief, De Lisle's first and second

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work surfaces 12, 11 would face sideways, rather than being "upward facing" as required by claim 1.

Accordingly, the rejection of claim 1, and therefore of dependent claims 2, 3, 6 and 7, will not be sustained.

Rejection Pursuant to 37 CFR 1.196(b)

Pursuant to 37 CFR 1.196(b), claims 1 to 3 are rejected under 35 U.S.C. § 102(b) as anticipated by Harman, which discloses a base unit with first upright end portion 12, 13, 16, 22, 46, 47, and second upright end portion 11, 14, 18; an upward facing work surface 25; and a pivoting table top 34.

There is

also a vertically elongate support 35, 80 depending from table top 34, a pivot means 38, 39 permitting top 34 to pivot horizontally around an upright-oriented axis, and height adjustable means in support 35 (page 2, lines 54 to 104). As for claim 2, there is an actuator 63 mounted on table top 34, and as for claim 3, support 35 includes telescoping members 36, 37.

Remand to the Examiner

Harman does not disclose the height adjustment means recited in claim 4 or the locking means recited in claims 6 to

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8. However, we will remand the application to the examiner pursuant to 37 CFR 1.196(e) to determine whether claims 4 and 6 and 8, or any other claims in the application, should be rejected under 35 U.S.C. § 103 as unpatentable over Harman in view of other prior art.

Conclusion

The examiner's decision to reject claims 1 to 3, 6 and 7 is reversed. Claims 1 to 3 are rejected pursuant to 37 CFR 1.196(b), and the application is remanded to the examiner under 37 CFR 1.196(e).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) and a remand pursuant to 37 CFR § 1.196(e).

37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purpose of judicial review." 37 CFR § 1.196(e) provides that

When a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the

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Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED 1.196(b)

& REMANDED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
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