

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAWREN CHARLES CARY

Appeal No. 2001-0401
Application No. 09/019,451

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3, 5 to 7, 9 and 13 to 27. Claims 11 and 28 are pending but the rejection thereof was withdrawn by the examiner (answer, p. 6). Claims 4, 8, 10, 12 and 29 have been canceled.¹

¹ Claims 5, 11, 13, 17 and 25 were amended subsequent to the final rejection.

Appeal No. 2001-0401
Application No. 09/019,451

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a mobile storage unit adapted for use in transporting and stowing selected implements, such as a workman's tools, and the like (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Bovenzi 1947	2,429,797	Oct. 28,
Labrum 1991	5,013,055	May 7,
Gonzalez 1992	5,159,777	Nov. 3,
Wise 1, 1997	5,642,898	July

The following rejections under 35 U.S.C. § 103 are before us in this appeal:

- (1) Claims 1, 2, 5 and 13 to 27 as being unpatentable over Gonzalez in view of Bovenzi,
- (2) Claim 3 as being unpatentable over Gonzalez in view of Bovenzi and Wise, and

(3) Claims 6, 7 and 9 as being unpatentable over Gonzalez in view of Bovenzi and Labrum.²

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 15, mailed October 24, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed September 13, 2000) and reply brief (Paper No. 17, filed November 14, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims³, to the applied prior art references, and to the

² As noted above, the rejections of claims 11 and 28 were withdrawn by the examiner on page 6 of the answer.

³ We note that the phrases "said first framework" in claim 11 and "the first container" in claim 24 lack proper antecedent basis. In addition, "a plurality of brackets mounted to said first storage compartment for receivably holding a level" as recited in claim 7 is not shown in the drawings as required by 37 CFR § 1.83 (Figure 12 shows only a
(continued...))

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellant. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellant's invention. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellant's structure as a template and selecting elements from references to fill the gaps. The

³(...continued)
single bracket 142 mounted to the first storage compartment 60).

references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). In determining obviousness/nonobviousness, an invention must be considered "as a whole," 35 U.S.C. § 103, and claims must be considered in their entirety. Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

Claims 1, 17 and 25

We sustain the rejection of claims 1, 17 and 25 under 35 U.S.C. § 103.

Gonzales discloses a fishing cart. As shown in Figures 1-2, the fishing cart includes spaced parallel supporting

posts 11, 12, a cross brace 22, a wheel 14, 15 at each lower distal end of each post, and a rearwardly extending handle 20, 21 relative to an upper distal end of each post for ease of transport and positioning of the cart. The cart includes a lower work table 16 pivotally mounted from a first position orthogonally oriented relative to the supporting posts to a second position in parallel relationship relative to the supporting posts. A tool box tray 23 is pivotally mounted at upper ends of the supporting posts adjacent the handles. A tool box 24 is secured to the tool box tray 23 by elastomeric tool box straps 29. Underlying the tool box tray 23 is a pivotally mounted mesh basket 30. Below the mesh basket 30 and above the work table 16 is a cooler tray plate 35, which is pivotally mounted to the supporting posts. A cooler housing and lid 38 are secured to the cooler tray plate 35 by elastomeric bands 37. The pivotal mounting of the tool box tray 23, the mesh basket 30, and the cooler tray plate 35 permits their use in a vertical transport position and in a horizontal operative position.

Bovenzi discloses a hand truck. As shown in Figures 1-2, the hand truck includes a platform 1, a shelf 2 at the lower end of the platform 1, a lip 3 at the upper end of the platform 1, wheels 4 near the upper and lower ends of the platform 1, and an extensible handle 5. In the vertical position shown in Figure 1, the hand truck is movable on the lower wheels 4. In the horizontal position shown in Figure 2, the hand truck is movable on the lower and upper wheels 4 so as to be used as a push cart (see column 2, lines 31-36).

With respect to claims 1, 17 and 25, the examiner ascertained⁴ (answer, p. 3) that the only difference is that Gonzalez lacks an auxiliary wheel assembly as set forth in claims 1, 17 and 25.

With regard to this difference, the examiner then determined (answer, p. 4) that

⁴ After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the fishing cart of Gonzalez to include the auxiliary wheel assembly of Bovenzi so as to allow the fishing cart [to] be used alternately as a push cart.

We agree.

The appellant's argument (brief, pp. 7-11) that one of ordinary skill in the art would not have been inclined to modify the fishing cart of Gonzalez to incorporate an auxiliary wheel assembly as recited in claims 1, 17 and 25 is unpersuasive for the reasons that follow.

First, it is our view that the combined teachings of Gonzalez and Bovenzi provide the necessary teaching, reason, suggestion, or motivation to have modified Gonzalez to include an auxiliary wheel assembly as suggested by Bovenzi so as to allow the fishing cart to be used as a push cart. In that regard, it is our view that the Bovenzi's teachings of making a hand truck that is moveable in its vertical position (see Figure 1) to be also moveable when in the horizontal position (see Figure 2) so as to useable as a push cart would have provided a person of ordinary skill in the art at the time the

invention was made with sufficient motivation to have modified the fishing cart of Gonzalez to include an auxiliary wheel assembly near the handles 20, 21 of Gonzalez so as to allow the fishing cart to be used as a push cart.

Second, the appellant has not supplied any evidence⁵ that (1) the fishing cart of Gonzalez is not intended to be moveable in the horizontal position shown in Figure 2, and (2) the convenience of transport in a horizontal orientation would not be a desirable feature to incorporate into the fishing cart of Gonzalez.

For the reasons set forth above, the decision of the examiner to reject claims 1, 17 and 25 under 35 U.S.C. § 103 is affirmed.

Claims 5 to 7, 13, 15, 16, 18, 19, 21, 26 and 27

⁵ Attorney's argument in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

In the reply brief (p. 2), the appellant stated that (1) if claim 1 falls, then claims 5 to 7, 13, 15 and 16 should also fall; (2) if claim 17 falls, then claims 18, 19 and 21 should also fall; and (3) if claim 25 falls, then claims 26 and 27 should also fall.

In accordance with the appellant's above-noted grouping of claims, claims 5 to 7, 13, 15, 16, 18, 19, 21, 26 and 27 fall with claims 1, 17 and 25. Thus, it follows that the decision of the examiner to reject claims 5 to 7, 13, 15, 16, 18, 19, 21, 26 and 27 under 35 U.S.C. § 103 is also affirmed.

Claims 2 and 3

We will not sustain the rejection of claims 2 and 3 under 35 U.S.C. § 103.

The appellant acknowledges (brief, p. 18) that the work table 16 of Gonzalez satisfies the recitation in claim 1 of a first storage shelf.⁶ The appellant then argues (brief, pp. 18-19) that the cooler tray plate 35 of Gonzalez is not readable on the second storage shelf recited in claim 2.⁷ We

⁶ Claim 1 includes the limitation "a first storage shelf pivotally disposed on said support frame between said first and second ends, said first storage shelf selectively movable between a stowed position wherein said first storage shelf is oriented alongside a longitudinal axis of said support frame and an extended position wherein said first storage shelf is oriented at an angle relative to the longitudinal axis such that said first storage shelf may receivably support a first container for said implements."

⁷ Claim 2 reads as follows:

A mobile storage unit according to claim 1 including a second storage shelf pivotally disposed on said support frame between said first and second ends, said second storage shelf selectively movable between a stowed position wherein said second storage shelf is oriented alongside the longitudinal axis and an extended position wherein said second storage shelf is oriented at an angle relative to the longitudinal axis such that said second storage shelf may receivably support a second container for said implements.

agree. In that regard, the appellant's argument is tantamount to an argument that Gonzalez does not disclose the first and second storage shelves as recited in claims 1 and 2. In our view, the cooler tray plate 35 of Gonzalez is not **selectively movable** between a stowed position wherein the cooler tray plate is oriented alongside a longitudinal axis of the support fram and an extended position wherein the cooler tray plate is oriented at an angle relative to the longitudinal axis such that the cooler tray plate may **receivably support** a container for implements when in its extended position (shown in Figure 1) due to the pivotal mounting thereof. The examiner has failed to provide any explanation as to how the cooler tray plate 35 of Gonzalez is readable on either the first storage shelf of claim 1⁸ or the second storage shelf of claim 2.

⁸ We agree with the appellant that the first storage shelf limitation of claim 1 is readable on the work table 16 of Gonzalez.

For the reasons set forth above, the decision of the examiner to reject claim 2, and claim 3 dependent thereon, under 35 U.S.C. § 103 is reversed.⁹

Claim 20

We sustain the rejection of claim 20 under 35 U.S.C. § 103.

The appellant presents the same argument with respect to claim 20 as was presented with respect to claim 2. However, such argument is not persuasive with respect to claim 20 since the claimed "first storage shelf" is not recited in the same detail as in claim 1. In our view, the examiner is correct that the claimed "first storage shelf" (recited in parent claim 18) is readable on the cooler tray plate 35 of Gonzalez and the claimed "second storage shelf" (recited in claim 20) is readable on the work table 16 of Gonzalez. Thus, the

⁹ We have also reviewed the reference to Wise additionally applied in the rejection of claim 3 but find nothing therein which makes up for the deficiencies of Gonzalez and Bovenzi discussed above with respect to claim 2. Moreover, it is our opinion that the counterbalance limitation of claim 3 would not have been obvious at the time the invention was made to a person of ordinary skill in the art from the teachings of the applied prior art.

appellant's argument that the claimed "second storage shelf" is not readable on the cooler tray plate 35 of Gonzalez, while true, does not point out any error in the examiner's application of the applied prior art to the subject matter of claim 20.

For the reasons set forth above, the decision of the examiner to reject claim 20 is affirmed.

Claims 9, 14, 22 and 23

We sustain the rejection of claims 9, 14, 22 and 23 under 35 U.S.C. § 103.

The appellant argues (brief, pp. 16-17) that the subject matter recited in claims 9, 14, 22 and 23 are not disclosed in Gonzalez. We do not agree.

The limitation of claims 9, 22 and 23 that the first storage compartment includes "an access door selectively movable between an opened position to permit access to said implements and a closed position to prevent inadvertent spillage of said

implements when said support frame is oriented upright on the transport surface" is readable on the lid 38 of the cooler housing of Gonzalez since the lid is selectively movable between an opened position to permit access to any implements within the cooler housing and a closed position that prevents inadvertent spillage of any implements within the cooler housing when the support frame (i.e., support posts 11, 12) is oriented upright on a transport surface as shown in Figure 1 of Gonzalez. We note that claims 9, 22 and 23 do not exclude the use of elastomeric bands to ensure the lid of the cooler housing stays closed when the support frame (i.e., support posts 11, 12) is oriented upright on a transport surface.

The limitation of claim 14 that each of the storage compartments includes "an access door selectively movable between an opened position to permit access to said implements and a closed position to prevent inadvertent spillage of said implements when said support frame is oriented upright on the transport surface" is readable on the lid 38 of the cooler housing of Gonzalez and the tool box 24 of Gonzalez which as shown in Figure 2 includes a closable lid. We note that claim

14 does not exclude the use of elastomeric bands to ensure the lid of the tool box stays closed when the support frame (i.e., support posts 11, 12) is oriented upright on a transport surface.

For the reasons set forth above, the decision of the examiner to reject claims 9, 14, 22 and 23 under 35 U.S.C. § 103 is affirmed.

Claim 24

In the reply brief (p. 2), the appellant stated that if claim 23 falls, then claim 24 should also fall. In accordance with this grouping of claims, claim 24 falls with claim 23. Thus, it follows that the decision of the examiner to reject claim 24 under 35 U.S.C. § 103 is also affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 5 to 7, 9 and 13 to 27 under 35 U.S.C. § 103 is affirmed with respect to claims 1, 5 to 7, 9 and 13 to 27 and reversed with respect to claims 2 and 3.

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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