

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte DONALD NEVIN

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Appeal No. 2002-0161  
Application No. 09/348,615

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ON BRIEF

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Before STONER, Chief Administrative Patent Judge, STAAB 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 2-6 and 13. Claim 12 stands allowed and claim 7 stands objected to as depending from a rejected base claim. Claims 8-11, the only other claims pending in this application, stand withdrawn as being directed to a non-elected species.

We REVERSE.

### BACKGROUND

The appellant's invention relates to a computer desk or table having a built-in, concealable, position adjustable solid state display which, in the storage position, forms a portion of the work surface of the desk or table (specification, page 1). Claim 13, which is reproduced in the Opinion section of this decision, is illustrative of the invention.

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

Lechman	5,651,594	Jul. 29, 1997
Yamaguchi (Japanese Kokai)	404063739	Feb. 28, 1992 <sup>1</sup>

The following rejections are before us for review.

Claims 2-5 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lechman.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lechman in view of Yamaguchi.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection and answer (Paper Nos. 12 and 15) for the examiner's complete reasoning in

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<sup>1</sup> An English language translation of this reference, prepared by the Patent and Trademark Office, is appended hereto.

support of the rejections and to the brief (Paper No. 14) 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 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.

Claim 13, the sole independent claim on appeal, reads as follows:

13. An article of furniture comprising a base, a work surface fixedly mounted to said base, having a recess with given length and width dimensions, a solid state computer display with a viewing screen, said display having a front surface comprising the screen and a substantially planar rear surface having substantially said given length and width dimensions and *means for mounting said display for movement relative to said work surface between a storage position, wherein said display is within said recess and said rear display surface is substantially co-planar with said work surface, and a viewing position, wherein said display is inclined relative to and situated at least partially above said work surface.*

Appellant contends that the means limitation, which we have italicized above for emphasis, is not met by Lechman and that the subject matter of claim 13 is therefore not anticipated<sup>2</sup> by Lechman. On page 3 of the answer, the examiner, referring to the

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<sup>2</sup> Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d

Figure 4 embodiment of Lechman, notes that Lechman discloses a display (monitor 60) mounted in a recess (bore 52A) flush with a desk top (top surface 14 of work table or platform 12), with “a ledge 58A extending around the periphery of the bore just beneath the work table 12 for supporting the monitor” (see column 4, lines 1-5, of Lechman).

According to the examiner (answer, page 3),

[a]nyone using the desk could easily lift the display and slide it along the supporting peripheral walls and by resting the display partly in the recess and against the ledge 56A. Thus providing a inclined viewing position. Therefore the structure shown in Figure 4 meets the Appellant’s claims. The ability of a person using the desk to move the display to an inclined position and an upside down position is inherent to the structure shown in Figure 4.

We presume that the examiner means that the monitor 60 can be maintained in an inclined position and situated at least partly above the top surface 14 of the work table or platform 12 at one end, with top and bottom edges of the opposite end of the display supported, respectively, by a first of the peripheral walls 56A and a portion of the ledge 58A and with the rear surface of the monitor 60 supported by the edge at the intersection of the top surface 14 of the work table or platform 12 and the peripheral wall 56A opposite the first of the peripheral walls 56A. We interpret the examiner’s remarks on page 2 of the final rejection as a determination that the monitor 60 is

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<sup>2</sup> (...continued)  
1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

capable of being mounted, in an upside-down orientation, such that the rear display surface thereof is co-planar with the top surface 14 of the work table or platform 12.

Notwithstanding that Lechman does not teach positioning of the monitor 60 either in the upside-down orientation with its rear surface being co-planar with the top surface 14 of the work table or platform 12 or in the inclined position at least partially above the top surface 14 of the work table or platform, it does appear that the structure pointed out by the examiner is capable of performing the function set forth in the “means for ...” clause of appellant’s claim 13. This, however, is not the end of the inquiry, as the “means for ...” clause which we have italicized in the reproduction of claim 13, supra, is an expression of a means for performing a specified function (i.e., “mounting said display for movement relative to said work surface between a storage position, wherein said display is within said recess and said rear display surface is substantially co-planar with said work surface, and a viewing position, wherein said display is inclined relative to and situated at least partially above said work surface”).

The sixth paragraph of 35 U.S.C. § 112 states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

In order to meet a "means-plus-function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc.

v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989). The examiner has addressed the first requirement but has not addressed the second requirement, namely, whether Lechman performs the recited function using the structure disclosed in appellant's specification or an equivalent thereof. For the reasons which follow, it is our opinion that Lechman does not meet this second requirement.

The structure disclosed in appellant's specification for performing the function recited in claim 13 includes the brackets 30, 32, slots 34, pins 36 and 40 and the floor or bottom surface 46 of the recess 22, with its spaced grooves 48 for receiving the lower rear corner 50 of the display B. As illustrated in Figures 3 and 4 of appellant's application, the display B and brackets 30, 32 can be rotated or pivoted such that the display B is moved between a stored position (Figure 3) with the rear surface thereof co-planar with the top surface (veneer layer 24) of the work surface 10 and a viewing position (Figure 4) with the display inclined and at least partially above the work surface 10. The Figure 4 embodiment of Lechman relied upon by the examiner does not contain brackets with pins and slots or a recess floor having spaced grooves for

receiving the lower rear corner of the monitor<sup>3</sup>. Accordingly, Lechman does not perform the recited function using the structure disclosed in appellant's specification.

The structure of the Figure 4 embodiment of Lechman alluded to by the examiner (i.e., the ledge 58A and peripheral walls 56A), which at best merely serves as a static support for the monitor, achieves the recited function in a much different manner than the corresponding structure in appellant's specification (i.e., the brackets, slots, pins and floor structure), which provides a pivotable, movable support for the display that supports the display throughout its movement between the stored and viewing positions. Thus, we find no indication that the Lechman structure for performing the recited function is an equivalent of the structure disclosed in appellant's specification<sup>4</sup> and the examiner has offered no rationale as to why the Lechman structure is an equivalent within the meaning of 35 U.S.C. § 112, sixth paragraph.

For the foregoing reasons, we agree with appellant that Lechman does not meet the means limitation of claim 13 and thus cannot anticipate claim 13 or claims 2-5 which depend from claim 13.

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<sup>3</sup> We have not overlooked other Lechman embodiments (e.g., Figures 7-10), not relied upon by the examiner, which comprise arms or levers and brackets for supporting a pivotable and movable monitor support member. None of these arrangements are designed to permit movement of the monitor to either the inverted storage position or a viewing position wherein the display is inclined and situated at least partially above the work surface, as called for in claim 13. In each of Lechman's disclosed embodiments, the monitor 60 is designed to remain beneath the top surface of the work table or platform.

<sup>4</sup> See, e.g., Kemco Sales Inc. v. Control Papers Co., 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315-16 (Fed. Cir. 2000) (In order for an accused structure to be a section 112, paragraph 6 "equivalent," it must (1) perform the identical function and (2) be otherwise insubstantially different with respect to structure. Two structures may be "equivalent" for purposes of section 112, paragraph 6 if they perform the identical function, in substantially the same way, with substantially the same result.)

We turn now to the examiner's rejection of claim 6, which depends from claim 13 and further recites that the mounting means comprises a bracket having a means for pivotally connecting the bracket to the article of furniture and means for pivotally connecting the bracket to the display, as being unpatentable over Lechman in view of Yamaguchi. The examiner cites Yamaguchi for its teaching of the use of pivotal brackets for providing multiple positions for a monitor (television receiver 9), including a "normal" position (Figure 3) in which the display surface of the television receiver faces downward and a position (Figure 1) in which the display surface of the television receiver is upright or inclined and visible either from the front or rear seats, as desired. According to the examiner (final rejection, page 4), it would have been obvious to one having ordinary skill in the art "to have modified Lechman with pivotal brackets in a furniture recess for the purpose of providing multiple positions of the monitor in view of Yamaguchi." We do not agree.

As mentioned above, Lechman provides no teaching or suggestion to position the monitor 60 in either a stored position with the display surface facing downward and the rear surface co-planar with the work surface or a viewing position wherein the monitor is at least partially above the work surface. Rather, Lechman's work station is designed to have the monitor positioned either below or flush with the top surface of the work station (column 2, lines 23-25). Thus, we find no suggestion in the applied references to provide a pivotal bracket support structure of the type disclosed by

Yamaguchi for movably mounting Lechman's monitor for movement between such positions<sup>5</sup>. Accordingly, we shall not sustain the examiner's rejection of claim 6.

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<sup>5</sup> The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

CONCLUSION

To summarize, the decision of the examiner to reject claims 2-5 and 13 under 35 U.S.C. § 102 and claim 6 under 35 U.S.C. § 103 is reversed.

REVERSED

BRUCE H. STONER, JR.  
Chief Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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