

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD T. NORDVIK

Appeal No. 2003-0601
Application No. 09/470,748

ON BRIEF

Before PAK, TIMM, and POTEATE, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-13 which are all the claims pending in the application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to a bar rail mat for supporting a wet glass. The mat captures moisture and spillage from the glass positioned thereon. The specification indicates that prior art bar rail mats typically included a compartment with pegs to support the wet glass (specification, p. 2, ll. 7-9). Appellant's bar rail mat uses a system of spaced-apart elongated members instead of pegs. Claim 1 is illustrative of the claimed structure:

1. A bar rail mat for holding a wet glass thereon comprising:
an elongated trough having a first end, a second end, a first side and a second side wherein the distance from the first side to the second side of said trough is less than the distance from the first end to the second end of the trough, and a bottom with a side wall of a first height extending therearound to form a closed fluid retention compartment to maintain a fluid therein; and
a plurality of spaced-apart, elongated, resilient members located in said fluid retention compartment to thereby form an elongated fluid chamber between each of said plurality of spaced apart elongated members, said elongated, resilient members sufficiently soft to absorb the shock of placing a glass thereon without breaking the glass, each of said spaced apart elongated resilient members integral to said elongated trough with each of said plurality of spaced apart elongated resilient members extending upward from the bottom of said elongated trough, said plurality of elongated members positioned extending from proximate said first end to proximate said second end of the elongated trough, and cooperating with each other to form a top surface for supporting a glass in a stable upright position on the top surface with each of said plurality of elongated resilient members having a length less than the length of the fluid retention compartment to allow fluid spillage into one chamber to flow into other chambers.

All of the claims stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner relies upon the following:

Kenworthy	237,983	Feb. 22, 1881
Holbert	1,045,290	Nov. 26, 1912
Gray	2,378,628	Jun. 19, 1945
Official Notice		

Specifically, claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of Kenworthy, Holbert, and Official Notice. According to the Answer, the reasoning is set forth in a prior Office Action, Paper No. 12 (Answer, p. 3). We reverse for the reasons that follow.

OPINION

The Examiner's first error is one of reading the claims too broadly. The claims are directed to a bar rail mat. While this language occurs in the preambles of the claims, it implies structure: The mat must be of a structure which will fit on a bar rail, it must be capable of supporting bar glasses and, importantly, it must be a mat. A mat is different than a dish drainer, it is of lower profile and structured to support something while protecting an underlying surface. For instance, a floor mat protects a floor from soiled shoes. The prior art references are directed to dish and tumbler drainers, not mats.

The Examiner's second error is one of using improper hindsight in making the combination. Neither Kenworthy nor Holbert supports the Examiner's proposition that it would have been obvious, in view of the teachings in those references, to modify the spacing of partitions 3 of Gray for the purpose of supporting a differently-sized object away from drained liquids (Paper no. 12, p. 2). Gray does not suggest the support of dishes and glasses on top of the partitions, Gray describes a wide spacing so that the dishes and glasses can be placed between partitions (Fig. 4). Teeth 5 of Holbert prevent sliding on the sloping surface of a conical rack.

The false bottom C of Kenworthy, while having elongated members supporting glassware, like Appellant's mat, does not serve the same purpose as the partitions of Gray. In Gray, the dishes and glasses lean against the partitions; they are not set on top. Neither reference provides a reason, suggestion, or motivation for modifying partitions 3 of Gray in the manner advanced by the Examiner.

In the Examiner's response to Appellant's arguments, the Examiner makes a further finding that a large glass with a base diameter larger than the distance between the tops of partitions 3 could be supported in a stable upright position on members 3 of Gray (Answer, p. 4). This finding seems to imply that partitions 3 are of a structure which meets the requirements of claims 1 and 13. We disagree. Again, the claims are directed to bar rail mats. The wording of the claim indicates a structure of lower profile with more closely spaced members than taught by Gray.

Lastly, we note that the Examiner cites three additional references in the Response to Argument section of the Answer. The Examiner indicates that these references are "not relied upon," but then discusses what they teach (Answer, p. 3). We fail to see why the Examiner discusses these references unless the examiner is relying upon them in some capacity. Where a reference is relied on to support a rejection, no matter how minor in capacity, there would appear to be no excuse for not positively including the reference in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Because these references

were not included in the statement of rejection, we decline to consider either the references or the comments made about what they describe in making our decision.

We conclude that the Examiner has not established a *prima facie* case of obviousness with respect to the subject matter of claims 1-13.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1-13 under 35 U.S.C. § 103(a) is reversed.

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

REVERSED

CHUNG K. PAK
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

LINDA R. POTEATE
Administrative Patent Judge

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