

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** JACK W. JETER

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Appeal No. 1997-4250  
Application No. 08/405,366<sup>1</sup>

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HEARD: October 6, 1999

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Before McCANDLISH, ***Senior Administrative Patent Judge***, ABRAMS  
and GONZALES, ***Administrative Patent Judges***.

ABRAMS, ***Administrative Patent Judge***.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 1-16, which constitute all of the claims of record. Subsequently, the examiner has indicated

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<sup>1</sup> Application for patent filed March 16, 1995.

Appeal No. 1997-4250  
Application No. 08/405,366

that claims 5, 6, 12, 13, 15 and 16 contain allowable subject matter (Answer, page 2), which leaves claims 1-4, 7-11 and 14 before us on appeal.

The appellant's invention is directed to a file holder for holding a plurality of files. The claims on appeal have been reproduced in an appendix to the Brief.

#### **THE REFERENCES**

The following references were relied upon by the examiner to support the final rejection:

Starkweather 1982	4,331,335	May 25,
Hicinbothem <i>et al.</i> 1993 (Hicinbothem)	5,197,764	Mar. 30,

#### **THE REJECTION**

Claims 1-4, 7-11 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hicinbothem in view of Starkweather.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and the

Appeal No. 1997-4250  
Application No. 08/405,366

appellant regarding the rejection, we make reference to the Examiner's Answers (Paper Nos. 7 and 10) for the reasoning in support of the rejections, and to the appellant's Briefs (Paper Nos. 6 and 9), for the arguments thereagainst.

#### OPINION

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. V. Rudkin-Wiley Corp.*, 837

Appeal No. 1997-4250  
Application No. 08/405,366

F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

In order to solve several problems associated with the retrieval of files from a file holder containing a plurality of files, the appellant's invention establishes a plurality of file receiving openings, each of which is defined by a slanted support surface and a pair of parallel side panels that are substantially perpendicular to the slanted support surface and are themselves slanted with respect to the front face of the file holder at an angle other than a right angle. Limitations establishing these relationships are present in all of the claims. The invention, as illustrated in the drawings, comprises a plurality of parallel upright panels (38) which are slanted to the side and a plurality of support surfaces (11) which are slanted downwardly. A file placed in these file receiving openings is slanted to one side and downwardly, thus exposing its upper corner as viewed from the side and the top.

The examiner cites Hicinbothem for its showing of a file holder defined by (see Figure 6) a support surface (430) and a

Appeal No. 1997-4250  
Application No. 08/405,366

pair of parallel side surfaces (424), the latter being perpendicular to the support surface and slanted at an angle other than a right angle to the front face of the structure. In the Hicinbothem system, however, the support surface is horizontally oriented, and therefore is not slanted, as is required by all of the appellant's claims. The examiner recognizes this deficiency, and takes the position that it would have been obvious to one of ordinary skill in the art to modify Hicinbothem by slanting the support surfaces, in view of the teachings of Starkweather.

Starkweather discloses a storage dispenser for metallic objects having magnetic properties. It comprises a plurality of bins, each of which is defined by a pair of upstanding parallel side panels which are perpendicular to the front face of the dispenser and a downwardly slanted support surface that has a strip of magnetic material at its lower edge. When articles having magnetic properties are placed in the bins, they flow downwardly toward the lower edge of the bin under the influence of their own weight until acted upon by the magnetic strip, which holds them at the edge until they are removed by the user (see column 5).

Appeal No. 1997-4250  
Application No. 08/405,366

Of course, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). According to the examiner, one of ordinary skill in the art would have found it obvious to slant the support surfaces of the Hicinbothem file holder downwardly "in order to cause articles positioned on the support surface to move outwardly toward the open ends of the file folder, thereby [to] facilitate removal" (Answer, page 4). However, Hicinbothem already has provided for facilitated removal of the files in the holder by slanting the upstanding walls, so that problem has been solved. Moreover, Starkweather slants the support surface so that the small articles that are stored therein gravitate toward the front edges of the bins, where they can easily be grasped and are then replaced by others located behind them, a situation that does not exist in Hicinbothem. We therefore fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to modify the Hicinbothem file holder in the manner proposed by the

Appeal No. 1997-4250  
Application No. 08/405,366

examiner, that is, to slant the support surfaces downwardly. From our perspective, the only suggestion for doing so is found in the hindsight accorded one who first viewed the appellant's disclosure, which is not a proper basis for a rejection. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

It is our conclusion that the teachings of the applied references fail to establish a *prima facie* case of obviousness with regard to any of the independent claims or, it follows, of those claims depending therefrom. This being the case, we will not sustain the rejection.

Appeal No. 1997-4250  
Application No. 08/405,366

The decision of the examiner is reversed.

**REVERSED**

HARRISON E. McCANDLISH	)	
Senior Administrative Patent Judge	)	
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	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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Appeal No. 1997-4250  
Application No. 08/405,366

Ray L. Weber  
Renner, Kenner, Greive, Bobak,  
Taylor & Weber  
1610 First National Tower  
Akron, OH 44308