

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

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 J. EDWARDS and DONALD V. EDWARDS

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Appeal No. 98-1922  
Application No. 08/253,721<sup>1</sup>

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ON BRIEF

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Before MEISTER, NASE, and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2 through 13 and 16. Claims 15 and 17 have been allowed. Claims 1 and 14 have been canceled. On page 2 of the substitute brief (Paper No. 8, filed August 19, 1997), the appellants canceled claim 13. Accordingly, this

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<sup>1</sup> Application for patent filed June 3, 1994.

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appeal with respect to claim 13 is dismissed. Claims 2  
through 12 and 16 remain on appeal.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a furniture slide. An understanding of the invention can be derived from a reading of exemplary claim 16, which appears in the opinion section below.

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

Ewell 1965	3,169,652	Feb. 16,
Maeda	60-218204 <sup>2</sup> (Japan)	Oct. 31, 1985

Claims 10 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Maeda.

Claims 2-4, 6-9, 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Maeda.

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<sup>2</sup> In determining the teachings of Maeda, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellants' convenience.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Maeda in view of Ewell.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 11, mailed November 28, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' substitute brief ("brief") for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The anticipation issues**

We sustain the rejection of claims 10 and 16 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

*Claim 16*

Claim 16 reads as follows:

A slide for placement between an object to be moved and the flooring over which it is to be moved which comprises:

a. an elongated sheet of flexible material having opposing ends and side walls joining said opposing ends when viewed in plan;

b. said sheet having opposing faces when viewed in side with one of said faces for abutting support and sliding contact with a floor surface and the other face having a compressible material fixed thereon with an abutting support contact surface for an object to be moved, said contact surface being the uppermost surface of said slide;

c. means formed on said elongate sheet of material for applying force for movement of said slide.

Maeda discloses a slider device. As shown in Figures 2-3, the slider device 3 includes a bottom-surface component 5 that is made of fluoro-resin, a top-surface component 4 that is made of synthetic rubber, and a pull string 10 to slide the device over a floor surface. The top-surface component 4 has a raised rim 6, thereby forming a dish shape, and has many projections 7 inside the sunken surface.

The appellants argue (brief, p. 6) that Maeda shows the furniture (i.e., object 11 shown in Figure 5) having contact on the inner surface of the surface member 4, not on the uppermost surface 6. The appellants state that

claim 16 requires that its uppermost surface be the contact surface for the body being moved which is a surface not shown or suggested by Maeda.

The examiner responded to this argument (answer, pp. 6-7) by (1) pointing out the furniture itself is not part of the claimed combination; (2) noting that in the appellants Figures 14 and 17 the furniture shown is not in contact with the

uppermost surface of the slide<sup>3</sup>; and (3) submitting that the claim is met by Maeda's slide since it is capable of performing the function, that is the claimed contact surface is readable on Maeda's raised rim.<sup>4</sup> We agree. In that regard, the slider device 3 of Maeda is fully capable of receiving an object which overlies the raised rim 6. As such, it is our determination that the claimed contact surface being the uppermost surface of the slide reads on<sup>5</sup> the raised rim 6.

Since all the limitations of claim 16 are found in Maeda, the decision of the examiner to reject claim 16 under 35 U.S.C. § 102(b) is affirmed.

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<sup>3</sup> The specie depicted in the appellants Figures 14 and 17 is recited in dependent claim 12.

<sup>4</sup> The appellants did not reply to the examiner's response to the appellants' argument.

<sup>5</sup> As set forth by the court in Kalman, it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

*Claim 10*

The decision of the examiner to reject claim 10 under 35 U.S.C. § 102(b) is also affirmed since the appellants have not challenged this rejection with any reasonable specificity, thereby allowing claim 10 to fall with claim 16 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

**The obviousness issues**

We sustain the rejection of claims 2-6, 8, 9, 11 and 12 under 35 U.S.C. § 103, but not the rejection of claim 7.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the

conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

*Claim 2*

Claim 2 reads as follows:

The slide according to Claim 16 which further comprises said ends being substantially arcuate in configuration from side wall to side wall.

The appellants argue (brief, p. 7) that the examiner has not shown any prior art that discloses or even suggests the requirements of claim 2 and therefore provides no basis that limitations of claim 2 are "an obvious design choice."

The examiner responded to this argument (answer, pp. 4 and 7) by citing and applying Figure 1 of Maeda which shows a

furniture slide having arcuate ends. The examiner then determined that it would have been obvious to a skilled artisan to configure Maeda's slide (i.e., the slider device shown in Figures 2-4) with arcuate ends.<sup>6</sup>

We agree with the examiner that the combined teachings of Maeda's Figures 2-4 and Maeda's Figure 1 would have suggested to one of ordinary skill in the art at the time the invention was made to provide arcuate ends on the slider device 3 for self-evident reasons as pointed out by the examiner. In that regard, we observe that an artisan must be presumed to know something about the art apart from what the references disclose (see In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)).

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<sup>6</sup> The appellants did not reply to the examiner's application of Figure 1 of Maeda.

For the reasons stated above, the decision of the examiner to reject claim 2 under 35 U.S.C. § 103 is affirmed.

*Claims 3, 4 and 6*

The appellants have grouped claims 2-4 and 6 as standing or falling together.<sup>7</sup> Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 3, 4 and 6 fall with claim 2. Thus, it follows that the decision of the examiner to reject claims 3, 4 and 6 under 35 U.S.C. § 103 is also affirmed.

*Claim 7*

Claim 7 reads as follows:

The slide according to Claim 16 in which said sheet has a concave configuration toward said furniture to be moved.

The appellants argue (brief, p. 8) that Maeda does not teach or suggest the claimed sheet having "a concave configuration toward said furniture to be moved."

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<sup>7</sup> See page 5 of the brief.

The examiner responded to this argument (answer, pp. 4 and 7) by arguing that it is common to have some arc to the lower surface and the leading edge and therefore an arcuate cross-section would have been obvious to a skilled artisan.

It is our opinion that the examiner has not presented any evidence that would have led a skilled artisan to arrive at the claimed invention. Specifically, there is no evidence in the rejection before us that would have suggested modifying Maeda's sheet (i.e., bottom-surface component 5) to have a **concave** configuration toward the furniture to be moved.

For the reasons stated above, the decision of the examiner to reject claim 7 under 35 U.S.C. § 103 is reversed.

*Claims 8 and 9*

Claim 8 reads as follows:

The slide according to Claim 4 in which said rubber material comprises a closed foam construction with a hardness greater than 75 durometers on the shore 00 scale.

Claim 9 reads as follows:

The slide according to Claim 16 in which the thickness of the compressible material is a minimum of  $\frac{1}{2}$  inch thick.

The examiner determined (answer, p. 5) that it would have been obvious to make Maeda's synthetic rubber top-surface component 5 of a closed foam construction, which is an extremely common inexpensive compressible material, and relatively hard, in order to avoid abrasion during use. The examiner also determined (answer, pp. 4 and 5) that, the hardness as well as the thickness of Maeda's synthetic rubber top-surface component 5 were obvious matters of design choice.

The appellants argue (brief, pp. 8-9) that Maeda does not teach or suggest the claimed limitations and that the examiner has not provided any support as to why the claimed limitations would have been obvious matters of design choice.

We agree with the examiner that the limitations set forth in claims 8 and 9 would have been obvious to one of ordinary skill in the art at the time the invention was made since skill is presumed on the part of those practicing in the art. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). In this regard, we note that Maeda does not disclose either the specific material and hardness of Maeda's synthetic rubber top-surface component 5 or its thickness. Thus, Maeda left it up to the artisan to select an appropriate material, hardness and thickness. In our view, the selection of a closed foam construction with a hardness greater than 75 durometers on the shore 00 scale as Maeda's synthetic rubber top-surface component 5 would have been obvious to an artisan. Likewise, the selection of the thickness of Maeda's synthetic rubber top-surface component 5 to be a minimum of ½ inch thick would have been obvious to an artisan.

This accords with the general rule that discovery of an optimum value of a result effective variable (in this case, the optimum material or thickness) is ordinarily within the skill of the art. See In re Boesch, 617 F.2d 272, 276, 205

USPQ 215, 219 (CCPA 1980) and In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). As stated in In re Huang, 100 F.3d 135, 139, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996):

This court and its predecessors have long held, however, that even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art, unless the claimed ranges "produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art."

Additionally, as stated in In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990):

The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range [citations omitted].

In the present case, however, the appellants have not even alleged, much less established, that the claimed material or thickness produces unexpected results. Accordingly, the

decision of the examiner to reject claims 8 and 9 under 35  
U.S.C. § 103 is affirmed.

*Claim 11*

Claim 11 reads as follows:

The slide according to Claim 10 which further  
comprises grommets reenforcing said perforations.

The examiner took (answer, p. 5) official notice that  
it is old and well known to provide grommets in order to  
protect the edges of sheet material at the holes.

The examiner then determined that

it would have been obvious to a skilled artisan to  
provide grommets at the holes of Maeda, as is old and  
well known, in order to protect the material at the  
holes, where the slide is subject to the greated [sic,  
greater] stress from pulling.

The appellants argue (brief, p. 9) that the examiner  
shows no relevant art that would have suggested providing  
grommets as claimed. We do not agree. While the examiner has  
not shown any art suggesting the use of grommets, the  
appellants have not contested the examiner's use of official  
notice that it is old and well known to provide grommets in

order to protect the edges of sheet material at the holes. Since the appellants have not seasonably challenged the examiner's reliance on official notice, it is appropriate for the examiner to continue to rely on official notice. In our view, the combined teachings of Maeda and the official notice taken by the examiner would have suggested to one of ordinary skill in the art at the time the invention was made to provide grommets in the openings of the slider device 3 through which the pull string 10 passes.

For the reasons stated above, the decision of the examiner to reject claim 11 under 35 U.S.C. § 103 is affirmed.

*Claim 12*

Claim 12 reads as follows:

The slide according to Claim 9 which further comprises a blind hole in said compressible material for engagement with the furniture to be moved.

The appellants argue (brief, p. 9) that the examiner has not cited any reference where a hole as recited in claim 12

has been provided in equipment or structure similar to that of the appellants.

The examiner responded to this argument (answer, pp. 5 and 9) by arguing that the claimed blind hole reads on the recess formed by the raised rim 6 of Maeda.<sup>8</sup> We agree. Thus, it is our view that Maeda teaches all the limitations of claim 12.

For the reasons stated above, the decision of the examiner to reject claim 12 under 35 U.S.C. § 103 is affirmed.

Claim 5

Claim 5 reads as follows:

The slide according to Claim 3 in which said plastic material comprises a high density polyethylene material.

The examiner found (answer, pp. 5 and 8) that Ewell teaches a high density polyethylene sheet material 25 as an

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<sup>8</sup> The appellants did not reply to the examiner's response to the appellants' argument.

inexpensive, low friction material between a moving slide and the ground. The examiner then determined (answer, p. 6) that

[i]t would have been obvious to one of ordinary skill in the art to form the Maeda low friction material out of a high density polyethylene material, as taught by Ewell, in order to provide an appropriate low friction surface.

The appellants state (brief, pp. 7-8) that they

do not understand how it would have been obvious to select something out of the Ewell reference, which is structure nowhere near or resembling that of the Applicants and is unrelated, in order to combine it with Maeda in such a way that it would anticipate or render obvious the claim.

In applying the above-noted test for obviousness, we reach the conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made Maeda's bottom-surface component 5 from a low friction material such as high density polyethylene, as suggested by Ewell. In that regard, while Maeda teaches the use of fluroresin as the low friction material for the bottom-surface component 5, Ewell would have taught (see column 5, lines 20-32) one skill in the art that high density polyethylene material is an inexpensive, durable low friction material. Accordingly, it is our view that it would have been

obvious to an artisan to have replaced Maeda's fluroresin with high density polyethylene material to provide an inexpensive, durable low friction bottom-surface component.

For the reasons stated above, the decision of the examiner to reject claim 5 under 35 U.S.C. § 103 is affirmed.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 2 through 6, 8 through 12 and 16 is affirmed and the decision of the examiner to reject claim 7 is reversed.

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

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

JVN/gjh

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APPEAL NO. 98-1922 - JUDGE NASE  
APPLICATION NO. 08/253,721

APJ NASE

APJ GONZALES

APJ MEISTER

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 16 Feb 99

**FINAL TYPED:**