

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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EMANUELA FRATTINI

Appeal No. 2000-1661
Application No. 08/964,460

HEARD: August 14, 2001

Before ABRAMS, FRANKFORT, and PATE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21-23, 26-33, 36, 37 and 39-43, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to an article of furniture. An understanding of the invention can be derived from a reading of exemplary claim 21, which appears 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:

Amey <u>et al.</u> (Amey)	5,435,254	Jul. 25, 1995
Reuter <u>et al.</u> (Reuter)	5,685,113	Nov. 11, 1997

Claims 21-23, 26-33, 36, 37 and 39-43 stand rejected under 35 U.S.C. § 103 as being unpatentable over Amey in view of Reuter.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 16) for the examiner's complete reasoning in support of the rejections, and to the Supplemental Brief (Paper No. 15) and Reply Brief (Paper No. 18) 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.

Independent claim 39 is the broadest claim, so we shall consider it first. This claim reads as follows:

A leg for an article of furniture comprising:

said leg including¹ a single extrusion comprising two vertical channels being integral portions of said leg and providing vertical structural support for said furniture, each channel adjacent the other channel and separated by a wall member;

each of said channels including a vertical opening along the axial length of each channel, the opening of each channel covered by a flexible member to insert wires into each said channel.

This claim stands rejected as being unpatentable over Amey in view of Reuter. Using the language of the claim as a guide, in Figure 9 Amey discloses a leg 2 for an article of office furniture comprising a single extrusion comprising two vertical channels being integral portions of the leg and providing vertical structural support for the furniture, each channel adjacent the other channel and being separated by a wall member, each channel including a vertical opening along the axial length of the channel, with the opening to each channel being covered by a flexible member to insert wires in each channel. We regard Amey's members 18 to be flexible because, although such is not explicitly stated in the reference, they are described as being "releasably engaged" (column 4, line 67), and it is clear from the description in column 5 and the structure of the invention as illustrated in the drawings

¹The phrase "said leg including" merely repeats the preamble of the claim, which reads "[a] leg . . . comprising." This should be corrected.

that they must be flexed in order to permit them to be installed in notches 17 and held in place therein. In this regard, the hatching of members 18 shown in Figure 9 indicates that they are plastic. With regard to the functional phrase “to insert wires into each said channel,” it is our view that this is satisfied by Amey’s members 18, for they are removable in order to allow wires to be inserted into each channel. It should be recognized that claim 39 does not require that the flexible members remain fixed to the extrusion as wires are inserted into the channels.

The appellant has argued that members 18 cannot be flexible because “Amey also discloses installing electrical outlets in this same manner” (Brief, page 5). This is not the case, for it is clear from Figure 10 and the description relating to it in column 4, lines 7 and 8 (“showing one of the cover hoods removed”), that the electrical outlets are not installed on members 18, but are located behind them, apparently in the unnumbered vertical slots shown in Figure 9 at the open ends of the channels.

It is our conclusion that all of the subject matter recited in independent claim 39 is disclosed by Amey. Such being the case, this reference anticipates the claim and, anticipation being the epitome of obviousness,² we therefore will sustain the rejection of claim 39. Since the appellant has chosen to group dependent claims 40-43 with claim 39 (Brief, page 3), we also shall sustain the rejection of these claims.

²In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

We reach the opposite conclusion, however, with regard to independent claim 21 and those claims depending therefrom. Claim 21 recites a first channel having a vertical slot at one end, and a flexible member having a first side fixedly attached to a first edge of the slot and a second side abutting the second edge of the slot. Such structure clearly is not shown by Amey. It is the examiner's position, however, that one of ordinary skill in the art would have found it obvious to modify the Amey construction in such a manner as to meet the terms of the claim in view of the teachings of Reuter. In particular, the examiner focuses on flexible seal 116 in the horizontal wireways of Reuter's Figure 11, opining that the Amey and Reuter seals are but "alternate conventional electrical wiring channel structure" but the Reuter seal "facilitates insertion and removal" of the wires (Answer, page 4). The appellant argues in rebuttal that one of ordinary skill in the art would have been taught by Reuter that for vertical wireways lay-in slotted liners should be used, as is shown and described with regard to element 124 of Figure 12.

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). In the present case, Reuter discloses one construction for horizontal wireways and another for vertical wireways. This being the case, in the absence of evidence to the contrary, which has not been provided by the examiner, we agree with the appellant that one of ordinary skill in the

art would not have found suggestion in Reuter to utilize the structure shown in Figure 11 for vertical applications. From our perspective, the only suggestion for modifying Amey in the manner proposed by the examiner is found in the hindsight afforded one who first viewed the appellant's disclosure which, of course, is not a proper basis for a rejection under Section 103.³ Thus, the combined teachings of Amey and Reuter fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 21, and we will not sustain the rejection of this claim or, it follows, of dependent claims 22, 23, 26-33, 36 and 37.

SUMMARY

The rejection of claims 21-23, 26-33, 36 and 37 as being unpatentable over Amey in view of Reuter is not sustained.

The rejection of claims 39-43 as being unpatentable over Amey in view of Reuters is sustained.

The decision of the examiner is affirmed-in-part.

³ In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

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

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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WILLIAM F. PATE, III)	
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APPLICATION NO. 08/964,460

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DECISION: AFFIRMED-IN-PART

Prepared By:

DRAFT TYPED: 24 Jun 02

FINAL TYPED: