

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ERIC A. WARD

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Appeal No. 2001-1803  
Application No. 09/087,775

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ON BRIEF

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Before CALVERT, STAAB and McQUADE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the rejection<sup>1</sup> of claims 1 to 29, all the claims in the application.

The claims on appeal are drawn to a stackable step stool (claims 1 to 27), a stack of step stools (claim 28), and a method of stacking step stools (claims 29). They are reproduced in the appendix of the appellant's brief.

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<sup>1</sup> Paper No. 12, Dec., 7, 1999, the third rejection in the application.

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The references applied by the examiner in rejecting the appealed claims are:

Hamilton	2,656,881	Oct. 27, 1953
Goldman et al. (Goldman)	Des. 176,183	Nov. 29, 1955
Good	3,271,075	Sep. 06, 1966
Jakobsen	3,326,148	Jun. 20, 1967
Borichevsky	Des. 278,864	May 21, 1985
Ruda et al. (Ruda)	4,548,294	Oct. 22, 1985
Lyons	Des. 363,824	Nov. 07, 1995
Muller-Deisig et al. (Muller-Deisig)	Des. 379,887	Jun. 17, 1997

The appealed claims stand rejected on the following grounds:

(1) Claim 28, unpatentable for failure to comply with 35 U.S.C. § 112, second paragraph;<sup>2</sup>

(2) Claims 1, 3, 5, 11 to 13 and 18, anticipated by Borichevsky under 35 U.S.C. § 102(b);

(3) Claims 2, 4, 6 to 17 and 19 to 29, unpatentable under 35 U.S.C. § 103(a) as follows:

(a) Claims 4, 6, 7 and 9, unpatentable over Borichevsky;

(b) Claims 2, 8, and 10, unpatentable over Borichevsky in view of Hamilton;

(c) Claims 12 to 14, unpatentable over Borichevsky in view of Good or Ruda;

(d) Claims 15 and 16, unpatentable over Borichevsky in view of Lyons;

(e) Claim 19, unpatentable over Borichevsky in view of Muller-Deisig;

(f) Claims 6, 7, 9, 11, 15 and 17, unpatentable over Goldman in view of Borichevsky;

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<sup>2</sup> A rejection of claims 1 to 27 under this section of the statute is not repeated in the examiner's answer, claims 1 and 20 having been amended subsequent to Paper No. 12.

(g) Claims 12 to 14, unpatentable over Goldman in view of Borichevsky and either of Good or Ruda;

(h) Claims 15, 16 and 19, unpatentable over Goldman in view of Borichevsky and Lyons;

(i) Claims 2, 8, 10, 20, 24 and 26, unpatentable over Goldman in view of Borichevsky or Hamilton;<sup>3</sup>

(j) Claims 21 to 23, unpatentable over Goldman in view of Borichevsky, Hamilton, and either of Good or Ruda;

(k) Claims 24 and 25, unpatentable over Goldman in view of Borichevsky, Hamilton, and Lyons;

(l) Claim 27, unpatentable over Goldman in view of Borichevsky, Hamilton and Muller-Deisig;

(m) Claims 28 and 29, unpatentable over Borichevsky in view of Jakobsen;

(n) Claims 28 and 29, unpatentable over Borichevsky.

#### Rejection (1)

The examiner considers claim 28 to be indefinite because in its last two lines, it recites “wherein the plurality of stackable step stools are offset in a sequentially alternating manner.” According to the examiner, “the claimed offset is vague as it does [not] specify any specific relationship of the stools” (answer, page 3).

We will not sustain this rejection. Reading claim 28 in light of the disclosure, we consider that one of ordinary skill would understand what is meant by the term “offset.”

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<sup>3</sup> In stating this rejection on page 6 of the answer, the examiner inadvertently substituted claim 18 for claim 10.

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As appellant argues on page 7 of the brief, “the offset limitation is not vague, merely broad.” Breadth of a claim is not be equated with indefiniteness. In re Miller, 441 F2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

Rejection (2)

Considering the ottoman (stool) disclosed by Borichevsky in relation to the language of claim 1, the Borichevsky stool has a platform comprising a substantially rectangular support surface with four edges, there being a side at each edge, and a support frame with two U-shaped supports, each support having a center portion between a front and a rear leg, and the center portions being attached to opposite sides of the platform. Borichevsky, a design patent, does not disclose that the stool illustrated is securely stackable so that it is free to be offset, etc., as recited in the last four lines of claim 1, but the examiner takes the position, in effect, that it would have be capable of being stacked in the manner claimed. Appellant argues that (brief, page 9):

Importantly, *Borichevsky* does not disclose a structural arrangement that would accomplish this functionality [of being stackable, as recited in claim 1]. The claimed first through fourth sides disposed at respective first through fourth edges of the substantially rectangular support surface help to achieve this claimed functionality. In contrast, the support surface of *Borichevsky* has at most four edges, but no sides extending from those edges.

After fully considering the record in light of the arguments presented in appellant’s brief and reply brief, and in the examiner’s answer, we conclude that the rejection is well taken.

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In the present case, Borichevsky, a design patent, does not expressly disclose that the stool shown therein is stackable as claimed, but we conclude that it would be inherently capable of being so stacked. In the first place, as appellant states at page 7 of the brief, “the word stack is intended to have its ordinary meaning wherein individual items are piled in layers or on top of one another.” Certainly, the stool of Borichevsky is capable of being piled on top of other such stools, and, as so stacked, would be “free to be offset” as recited in the last three lines of claim 1. Moreover, the structure of the Borichevsky stool appears to be so similar to that of the stool disclosed by appellant that it appears that the Borichevsky stool would be inherently capable of being stacked in the same offset manner as appellant’s. The recitation in claim 1 that the stool is stackable is simply the recitation of a new intended use for an old product, which does not make a claim to that old product patentable. In re Schreiber, *supra*.

On page 2 of the reply brief, appellant asserts that he discloses an enabling structure that provides a stool which is securely stackable, while Borichevsky does not. However, whatever that disclosed structure may be, the structure claimed in claim 1 is readable on Borichevsky.

Appellant’s argument, quoted *supra*, concerning the sides of the support surface, is

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not persuasive. Before the PTO, claims are given their broadest reasonable interpretation, and limitations are not be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993). Here, Borichevsky's support surface, having a finite thickness, of necessity has a side at each of its four edges; appellant's argument that Borichevsky does not have sides extending from the four edges is not commensurate with the scope of claim 1, which only recites that the sides are disposed at the edges, and not that the sides extend from the edges.

Accordingly, we will sustain rejection (2) as to claim 1, and as to claims 3, 5, 11 to 13 and 18 , which appellant has not argued separately.

Rejections (3)(a) to (3)(e)

For each of these rejections, appellant does not contend that the modification of Borichevsky proposed by the examiner would not have been obvious, but rather that there is no suggestion to modify the stool of Borichevsky to be stackable as recited in the last four lines of claim 1 (brief, Issue C, pages 9 to 13). However, inasmuch as we have concluded above in connection with rejection (2) that the stool of Borichevsky is inherently capable of being so stacked, appellant's contentions are not persuasive that rejections (3)(a) to (3)(e) should not be sustained.

Rejections (3)(f) to 3(l)

Each of these rejections is fundamentally based on the combination of Goldman and Borichevsky. Goldman (like Borichevsky, a design patent), shows a stool with a rectangular platform and two trapezoidally-shaped legs, each leg being attached at its top edge to the bottom of the platform. The basis of the rejection is (examiner's answer, page 5):

Goldman shows the claimed stool with the exception of the claimed legs. Borichevsky shows U-shaped legs connected to the side of a platform enabling peripheral support of the platform. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldman to comprise U-shaped legs attached as claimed or to modify his leg structure to be of a width and to be connected at the sides of his platform to enable peripheral support of his platform.

We do not consider this rejection to be well taken, since we agree with the appellant that the references provide no suggestion or motivation for modifying the Goldman stool. In particular, Borichevsky does not furnish a teaching that peripheral support of a platform should be provided. Any such modification of Goldman would appear to be based on impermissible hindsight gleaned from appellant's own disclosure.

We therefore will not sustain rejection (3)(f). We also will not sustain rejections (3)(g) to (3)(l), since the additional references applied therein do not overcome the above-noted deficiency of the Goldman/Borichevsky combination.

#### Rejection (3)(m)

Claim 28 recites a stack of step stools of a certain structure, "wherein the plurality of

stackable step stools are offset in a sequentially alternating manner.” Claim 29 is drawn to a method of stacking step stools in which the stools are alternatively left offset stacked and right offset stacked, “whereby a stack of step stools is formed so that the step stools are offset from one another in a sequentially alternating manner.”

We note initially that we interpret the “plurality of stackable step stools” recited in claim 28 as meaning at least three step stools. While two stools would normally also be considered a plurality, it would require at least three stools in order to offset the plurality of stools “in a sequentially alternating manner” as recited in the last two lines of the claim; at least three stools are required because merely offsetting one stool relative to another would not constitute “sequentially alternating.”

The Jacobsen reference discloses tables which can be stacked as shown in Fig. 2 and disclosed at col. 2, line 14 to 39. The tables are so constructed that they fit together as shown in Fig. 2, but instead of being alternately offset stacked as recited in claims 28 and 29, they must be continuously stacked in one direction (to the right in Fig. 2). We therefore do not consider the rejection to be well taken, for even if the Borichevsky stools were stacked as taught by Jakobsen, they would not meet the alternate offset stacking requirement of claims 28 and 29.

#### Rejection (3)(n)

The examiner stated this rejection as follows in the rejection appealed from (Paper

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No. 12, page 6) (emphasis added):

Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borichevsky. Borichevsky shows the claimed platform [sic: stool] with the claimed structure to allow offset stacking. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide additional of [sic] Borichevsky's platform and to stack same as claimed, would have been an obvious mechanical expedient, as the examiner takes official notice that such alternate stacking of articles to minimize space and prevent tipping is a conventional practice.

In a footnote on page 4 of the reply brief, appellant contends that the taking of official notice was presented for the first time in the reply brief. This contention is incorrect, as is evident from the foregoing quotation from Paper No. 12.

As for claim 28, appellant argues on pages 4 and 5 of the reply brief (under "Issue E") that claim 28 is patentable over Borichevsky notwithstanding the official notice because:

claim 28 is directed to a stack of step stools that are stacked with an offset in a sequentially alternating manner. Step stools with this particular stackability property are a much narrower concept than [sic: than] the Examiner's broad statement about a method of stacking articles.

We agree with this argument. Even though the broad idea of an alternatively stacked stack of articles may be conventional, as per the official notice taken by the

examiner, we do not consider that it would have been obvious therefrom to create a stack of the Borichevsky stools "offset in a sequentially alternating manner," as claimed.

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Turning to claim 29, appellant discussed in his brief the rejections of that claim in the section "Issue F" (pages 20 and 21). With regard to the rejection on Borichevsky alone, appellant argued only that (brief, page 20):

As discussed above in regard to Issue C, the *Borichevsky* reference does not describe stacking, nor does it suggest stacking. *Borichevsky* shows only an ornamental design of an ottoman. No stack is shown. Thus, *Borichevsky* alone is insufficient to establish obviousness of the stacking method recited in claim 29.

The official notice taken by the examiner was not mentioned. Moreover, in his reply brief, where appellant for the first time discussed the official notice in connection with Issue E (claim 28), he did not do so as to Issue F, but rather said (page 5): "Appellant has no further comments on Issue F besides those already set forth in the Brief on Appeal filed May 1, 2000." Accordingly, since appellant has presented no reasons as to why he believes the rejection of claim 29 as unpatentable over Borichevsky in view of the official notice taken by the examiner to be incorrect, the rejection will be sustained.

Pursuant to the above, rejection (3)(n) will not be sustained as to claim 28, but will be sustained as to claim 29.

### Conclusion

The examiner's decision to reject:

- (i) Claim 28 under 35 U.S.C. § 112, second paragraph is reversed;

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(ii) Claims 1, 3, 5, 11 to 13 and 18 under 35 U.S.C. § 102(b) is affirmed.

(iii) Claims 2, 4, 6 to 10, 12 to 16, 19 and 29 under 35 U.S.C. § 103(a) is affirmed.

(iv) Claims 11, 17 and 20 to 28 under 35 U.S.C. § 103(a) is reversed.

The examiner's decision is affirmed-in-part.

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

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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