

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GORDON LYON

Appeal No. 97-4211¹
Application 08/614,844

ON BRIEF

Before COHEN, FRANKFORT and STAAB, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1, 2, 5 and 6 as amended subsequent to the final rejection in a paper filed April 21, 1997. Claim 3, the

¹Application for patent filed March 8, 1996. According to appellant, this application is a continuation of application 08/287,962, filed August 9, 1994.

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only

other claim remaining in the application, has been indicated to contain allowable subject matter, but is objected to as being dependent from a rejected base claim. Claims 4 and 7 have been canceled.

Appellant's invention relates to a storage receptacle installation for a covered pick-up truck bed. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim appears in the Appendix to appellant's brief.

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

Brady 1988	4,752,095	Jun. 21,
Peters et al. (Peters) 1989	4,824,158	Apr. 25,
MAN ²	EP 309,692	Apr. 05, 1989

² While the examiner and appellant have referred to this patent as "MAN" it is clear from the enclosed translation that the inventors are actually Schmidt et al.. However, for consistency, we will continue to refer to this

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(European Patent)

Claims 1, 2 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Peters in view of Brady.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Peters in view of Brady as applied to claims 1 and 2 above, and further in view of MAN.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 18, mailed June 24, 1997) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 16, filed April 21, 1997) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given

document as "MAN."

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careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of claims 1, 2 and 5 under 35 U.S.C. § 103, we note that Peters discloses a combi-nation cargo box and bed liner for a truck bed wherein the box/liner is substantially of the same size as the pick-up truck bed, and the track system supporting the box is of a length substantially equal to the length of the truck bed. Recognizing

the shortcomings of Peters, the examiner (final rejection, pages 3-4), takes the position that

[s]ize is not deemed to be a patentable distinction, but an obvious choice of the designer as evidenced by the receptacle of Brady occupying only a limited length. While not holding as much, the receptacle's smaller size means less cost for materials and labor, an engineering trade-off. Forming the tracks to have a concomitant length is deemed to be an obvious expedient in order to save cost of

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manufacture. Brady teaches a cover hinged to the receptacle at a rear wall thereof that closes onto locking means as seen in the hasp in figure 4. The means for removably mounting of Peters et al. are a substantial equivalent to that disclosed by applicant and the receptacle locking means of Brady, while not equivalent, are simpler and hence less costly than that disclosed by applicant. It would have been obvious to provide in Peters et al. an enclosed covered and lockable receptacle of small dimensions as taught by Brady in order to carry smaller items and for the ease of manual movement of same.

Contrary to the examiner's position, we do not believe that the collective teachings of the applied references to Peters and Brady would have in any way been suggestive of a storage receptacle of the type set forth in appellant's claim 1 on appeal mounted to the bed of a covered pick-up truck in a rear portion thereof immediately adjacent the tailgate of the truck and so that the receptacle occupies only said rear portion of the truck bed at the rear thereof when in its retracted (stowed) position.

Given the clear disclosure in Brady of the disadvantages of having a storage receptacle mounted immediately adjacent the

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rear tailgate area of a truck bed (e.g., col. 1, lines 9-47) and the clear statement that it is an objective of the invention in Brady to "maintain the rearward portion of the truck bed free from obstructions while the storage box is in the forwardmost stowed position" (col. 1, lines 61-65), we find it to be almost incomprehensible that one of ordinary skill in the art would have contemplated sizing and positioning the receptacle and mounting rails of the combined storage box and bed liner of Peters in the manner urged by the examiner. If anything, Brady clearly teaches away from a storage receptacle positioned in the specific manner set forth in appellant's claims on appeal.

In our opinion, the examiner's stated position is based on impermissible hindsight gleaned from appellant's own disclosure and not from any fair teaching or suggestion found in the applied Peters and Brady patents themselves. Absent the disclosure of the present application, it is our opinion that one of ordinary skill in the art would not have been motivated to modify the

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storage box and bed liner of Peters in the manner urged by the examiner so as to arrive at the subject matter set forth in appellants' independent claim 1 on appeal. If anything, it is our opinion that the collective teachings of Peters and Brady as applied by the examiner would have been suggestive of a storage receptacle essentially like that of Brady, wherein a smaller/shorter storage receptacle would be mounted on rails so as to be stowed at the forward end of the truck bed immediately adjacent the cab of the truck as seen in Figures 1 through 3 of Brady. Thus, based on the foregoing, the examiner's rejection of appellant's claim 1, and claims 2 and 5 which depend therefrom, under 35 U.S.C. § 103 based on Peters and Brady will not be sustained.

We have also reviewed the patent to MAN applied by the examiner in the § 103 rejection of dependent claim 6. However, we find nothing in this reference which would supply that which we have noted above to be lacking in the basic combination of Peters and Brady. Accordingly, the examiner's rejection of claim 6 on appeal under 35 U.S.C. § 103 will

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likewise not be sustained.

As should be apparent from the foregoing, the decision of the examiner rejecting claims 1, 2, 5 and 6 of the present application under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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LAWRENCE J. STAAB)	
Administrative Patent Judge)	

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John R. Benefiel
280 Daines Street
Suite 100 B
Birmingham, MI 48009