

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY C. VALIULIS and RANDY D. LONG

Appeal No. 98-1459
Application No. 08/309,756¹

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 9, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed September 20, 1994.

BACKGROUND

The appellants' invention relates to a shelf divider. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

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

Gold	4,595,105	June
17, 1986		
Breslow	4,712,694	Dec. 15,
1987		

Claims 1 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Breslow in view of Gold.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 12, mailed July 9, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 11, filed April 4, 1997) and reply brief

Appeal No. 98-1459
Application No. 08/309,756

Page 3

(Paper No. 13, filed September 12, 1997) 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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to claims 1 through 9. Accordingly, we will not sustain the examiner's rejection of claims 1 through 9 under 35 U.S.C.

§ 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie 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).

The appellants argue (brief, pp. 8-10) that the applied prior art does not teach or suggest the claimed subject matter, e.g., the use of a pair of upwardly opening channels on the front rail, cooperating with a downwardly facing snap clip and finger on the divider arm so that a downward movement of the divider arm locks the divider arm to the rail. We agree.

All the claims under appeal require a shelf divider comprising, inter alia, an elongated rail having a pair of upwardly opening channels or clips and an elongated divider

arm having a downwardly facing snap clip and finger so that upon downward movement of the divider arm the snap clip and finger of the divider arm engages the pair of upwardly opening channels or clips of the rail. It is our opinion that these limitations are not suggested by the applied prior art. In that regard, while Breslow does disclose a shelf divider having an elongated rail (15) having a pair of channels (24 and 26) and an elongated divider arm (35) having branches (40 and 42) which snap-fit into the channels (24 and 26), Breslow does not teach or suggest an elongated rail having a **pair of upwardly opening channels** and an elongated divider arm having a **downwardly facing snap clip** and finger so that upon downward movement of the divider arm the snap clip and finger of the divider arm engages the pair of upwardly opening channels or clips of the rail. To supply these omissions in the teachings of Breslow, the examiner made determinations (answer, pages 3-4) that these difference would have been obvious to an artisan based upon the teachings of Gold. However, it is our view that this determination of the examiner has not been supported

by any evidence that would have led an artisan to arrive at the claimed invention.

In our view, the only suggestion for modifying Breslow in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Specifically, we find that there is suggestion in Gold to modify Breslow's shelf divider to connect the divider arm (35) to the rail (15) by providing the rail (15) with two upwardly opening channels (similar to Gold's cutouts 26) and by providing the divider arm (35) with two L-shaped tabs (similar to Gold's tabs 24) to engage the two upwardly opening channels (similar to Gold's cutouts 26). However, when this modification suggested by Gold is done, the resulting device lacks the claimed snap clip. The term "snap clip" must be given the broadest reasonable interpretation

consistent with the specification.² See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). When this is done, it is our view that Gold does not teach or suggest a snap clip. That is, when an artisan would have modified Breslow by the teachings of Gold the artisan would have replaced Breslow's snap-fit connection with the sliding connection of Gold. Accordingly, the device resulting from the combined teachings of Breslow and Gold is not the claimed invention. It follows that we cannot sustain the examiner's rejection of claims 1 through 9.

² See page 5, lines 8-22, of the specification which explains how the appellants' snap clip 31 engages the upper clip 25.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 9 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 98-1459
Application No. 08/309,756

Page 10

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APPEAL NO. 98-1459 - JUDGE NASE
APPLICATION NO. 08/309,756

APJ NASE

APJ FRANKFORT

APJ COHEN

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 01 Feb 99

FINAL TYPED: