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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHIRLPOOL CORPORATION
Requester, Cross-Appellant, Respondent

v.

LG ELECTRONICS, INC.
Patent Owner, Appellant, Cross-Respondent

Appeal 2013-003110
Reexamination Control No. 95/001,563
Patent 7,430,873 B2
Technology Center 3900

Before JOSIAH C. COCKS, WILLIAM V. SAINDON, and
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

KAMHOLZ, *Administrative Patent Judge*.

DECISION ON APPEAL

Appeal 2013-003110
Reexamination Control 95/001,563
Patent 7,430,873 B2

STATEMENT OF THE CASE

This proceeding arose from a request by Respondent Whirlpool Corporation for an *inter partes* reexamination of U. S. Patent 7,430,873 B2 (hereinafter, the '873 patent), entitled "Refrigerator," and issued to LG Electronics, Inc. (Oct. 7, 2008).¹

Claims 1-28 are the subject of the present appeal and cross-appeal. Original patent claims 1-12, as well as new claims 13-28 presented during the reexamination, have all been rejected. RAN² PTOL-2066.

Appellant, patent owner LG Electronics, Inc., appeals under 35 U.S.C. §§ 134(b) and 315(a) (2002) from a decision of the primary examiner finally rejecting claims 1-28 as discussed below under the heading "APPEAL OF PATENT OWNER." We have jurisdiction under 35 U.S.C. §§ 134(b) and

¹ The '873 patent was also the subject of a co-pending litigation styled *LG Electronics U.S.A., Inc., et al. v. Whirlpool Corp., et al.*, no. 1:10-cv-00311-GMS (D. Del.). We understand that this litigation was dismissed with prejudice on Oct. 3, 2012. See "Joint Stipulation and Order of Dismissal *With Prejudice*" (paper no. 147). We will therefore not consider any findings, conclusions, or judgments from that litigation. We find no indication in the record of the present proceeding that Patent Owner brought this result of the litigation to the attention of the Office or the Board. Patent Owner is reminded of its continuing obligation under 37 C.F.R. § 1.985(a) to notify the Office of concurrent proceedings, including litigation "and the *results of such proceedings*" (emphasis added).

² While we have considered the entire appeal record, we refer to and address only specific portions of the record directly relevant to the disposition of the appeal and cross-appeal, abbreviating the documents therein as follows:

Right of Appeal Notice: RAN

Appeal Brief of Patent Owner: ABPO

Cross-Appeal Brief of Requester: CABR

Respondent Brief of Requester in response to ABPO: RBR

Non-Final Office Action: NFOA

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315(a).

Cross-Appellant, requester Whirlpool Corporation, appeals under §§ 134(c) and 315(b) (2002) from a final decision of the primary examiner not to enter certain proposed rejections of claims 1-12 as discussed below under the heading “CROSS-APPEAL OF REQUESTER.” We have jurisdiction under 35 U.S.C. §§ 134(c) and 315(b).

We REVERSE with respect to the Appeal of Patent Owner. We AFFIRM with respect to the Cross-Appeal of Requester. We limit our discussion of the issues argued to those necessary for the disposition of the appeal and cross-appeal.

THE CLAIMED SUBJECT MATTER

The '873 patent describes refrigerators having ice-making structures (col. 1, ll. 5-10). Claim 1 on appeal is illustrative and reads as follows:

1. A refrigerator comprising:
 - a refrigerating compartment and a freezing compartment being configured to maintain operating temperatures that differ, with the freezing compartment having an operating temperature that is lower than an operating temperature of the refrigerating compartment;
 - an ice compartment located within the refrigerating compartment and defined by insulating walls, the insulating walls being configured to facilitate maintenance of an operating temperature of the ice compartment that is lower than the operating temperature of the refrigerating compartment;
 - an ice maker located within the ice compartment and configured to freeze liquid water into ice;
 - a first refrigerator door configured to open and close a first portion of the refrigerating

compartment, the first refrigerator door covering at least a portion of the ice compartment when the first refrigerator door is in a closed position and exposing the ice compartment when the first refrigerator door is in an open position;

a second refrigerator door configured to open and close a second portion of the refrigerating compartment, the second portion of the refrigerating compartment including a portion of the refrigerating compartment other than the portion covered by the first refrigerator door when the first refrigerator door is in the closed position;

a dispenser, at least a portion of which being located on the first refrigerator door, configured to dispense ice made by the ice maker;

an ice storage bin located within the ice compartment and configured to store ice made by the ice maker;

an outlet that is provided in at least one of the insulating walls that define the ice compartment and that is configured to enable passage of ice from the ice storage bin through the at least one of the insulating walls; and

an ice transporting mechanism located within the ice compartment and configured to promote movement of ice stored in the ice storage bin through the outlet and along a path from the ice storage bin to the dispenser,

wherein the first refrigerator door, the second refrigerator door, and the ice compartment have a relative orientation that enables removal of at least a portion of the ice compartment from the refrigerating compartment when the first refrigerator door is in the open position and the second refrigerator door is in a closed position, the portion of the ice compartment including at least the ice storage bin and the at least one of the insulating walls in which the outlet is provided.

REFERENCES

The Examiner relies on the following prior art references:

Grimes	US 3,146,606	Sep. 1, 1964
Swaneck	US 3,466,804	Sep. 16, 1969
Fisher	US 5,272,888	Dec. 28, 1993
Cur	US 5,375,432	Dec. 27, 1994
Jackovin	US 6,019,447	Feb. 1, 2000
Najewicz	US 6,735,959 B1	May 18, 2004
Yasuzo	JP 2000-9372A	Jan. 14, 2000

OTHER EVIDENCE

Declaration of Norman L. Beck (“Beck Decl.”) (submitted by Appellant).

APPEAL OF PATENT OWNER

Examiner’s Rejections

Patent Owner seeks our review of the following rejections under 35 U.S.C. § 103(a) for obviousness set forth by the Examiner in the Right of Appeal Notice, which was incorporated by reference into the Examiner’s Answer:

1. Claims 1-12, 14, and 15 over Yasuzo and Fisher. RAN 7.³
2. Claims 13 and 19-21 over Yasuzo, Fisher and Swaneck. RAN 12.
3. Claims 16-18 and 22 over Yasuzo, Fisher, and Jackovin.
RAN 15.
4. Claims 23-28 over Yasuzo, Fisher, and Grimes. RAN 19.

³ This rejection addresses claims 14 and 15 at RAN 11, though the heading for this rejection does not list them.

5. Claims 1-4, 6-14, and 19-21 over Cur, Fisher, and Swaneck.
RAN 22.⁴
6. Claims 5, 15-18, and 22 over Cur, Fisher, Swaneck, and Jackovin.
RAN 30, 37.
7. Claims 23-28 over Cur, Fisher, Swaneck, and Grimes. RAN 34.

Analysis

We focus our analysis on the rejection of claim 1 over Yasuzo and Fisher. The Examiner found that Yasuzo discloses all elements of claim 1 in the claimed arrangement, except as follows:

Yasuzo is silent as to an outlet that is provided in at least one of the insulating walls that define the ice compartment and that is configured to enable passage of ice from the ice storage bin through the at least one of the insulating walls; and an ice transporting mechanism located within the ice compartment and configured to promote movement of ice stored in the ice storage bin through the outlet and along a path from the ice storage bin to the dispenser, wherein the first refrigerator door, the second refrigerator door, and the ice compartment have a relative orientation that enables removal of at least a portion of the ice compartment from the refrigerating compartment when the first refrigerator door is in the open position and the second refrigerator door is in a closed position, the portion of the ice compartment including at least the ice storage bin and the at least one of the insulating walls in which the outlet is provided.

RAN 8. The Examiner further found that Fisher discloses these limitations. *Id.* at 8-9. In particular, the Examiner found that Fisher's platform assembly 58, through which is defined chute 72, meets the "at least one of

⁴ This rejection addresses claim 14 at RAN 29, though the heading for this rejection does not list it.

the insulating walls in which the outlet is provided,” *id.* at 8, and “Fisher discloses that the ice compartment is detachable to allow for mounting the ice compartment at different locations depending on the arrangement of the refrigerator (Fisher, col. 5, lines 62-68),”⁵ *id.* at 9. Thus, the Examiner relies on Fisher’s teaching that platform 58 can be mounted in various locations as a disclosure that the “relative orientation of the ice compartment enables removal of ... the at least one of the insulating walls in which the outlet is provided.”⁶

Appellant argues that Fisher’s platform 58 is not removable because it is disclosed as being “secured” by “fasteners.” ABPO 10 (citing Beck Decl. paras. 11-12). Appellant refers to Fisher, col. 5, ll. 2-6 in support of this argument.⁷

Respondent argues that Fisher is relied upon for disclosing “a removable wall with an outlet that facilitates passage of ice to the dispenser” and that Appellant’s argument “points to nothing in Fisher that specifies

⁵ Fisher col. 5, ll. 62-68 reads: “As is apparent, the platform 58 could also be used for shelf mounting the container assembly 30 on any shelf in freezer compartment of any known form. Similarly, the support wall 44 can be used for mounting a conventional ice making apparatus 28 to a right side of a freezer compartment of any known form provided with exterior door service on the right side.”

⁶ The parties and the Examiner appear to assume that the claim limitation “that enables removal of ... the at least one of the insulating walls in which the outlet is provided” is properly construed as requiring that the insulating wall be removable. We will adopt this construction for purposes of the present appeal and cross-appeal.

⁷ Fisher col. 5, ll. 2-6 reads: “[A]n auger motor bracket 88 ... is secured to the rear wall 42 using fasteners 90 and to the platform 58 using fasteners 92, see FIG. 3. Thus, the bracket 88 secures the platform 58, and thus also the support wall 44, in the freezer compartment 16.”

non-detachably securing or non-detachable fasteners.” RBR 2 (some emphases omitted). Respondent further argues that a person having ordinary skill in the art would have understood that “conventional fasteners may be used [in Fisher], which would encompass those fasteners that allow for unfastening, thereby allowing for removal.” *Id.* Respondent cites Fisher’s Fig. 2 as “depict[ing] the components removed,” characterizes Fisher’s disclosure as a “teaching of removable installation with fasteners,” and argues that a person having ordinary skill in the art would have been “motivated to use unfastenable fasteners in view of Fisher’s teachings.” *Id.* at 2-3.

The Examiner argues in response to Appellant that “the teaching of Fisher of being removable with fasteners is an equivalent teaching as disclosed in the ’873 patent” because the ’873 patent “does not indicate that the ice-making compartment is removable once the manufacturing is completed and delivered to the user.” RAN 39. The Examiner also argues that Fisher’s ice storage bin 74 and front insulating wall 80 must be removable, otherwise Fisher would not have needed to include lip 100 and post 96 on ice storage bin 74 to prevent movement of the bin during auger 82 operation. *Id.* at 40-41.

We agree with Appellant that Fisher does not disclose that platform 58 is removable and, consequently (in the words of Respondent) “a removable wall with an outlet that facilitates passage of ice to the dispenser.” The Examiner relied on Fisher for the teaching that “the ice compartment is detachable” (*see* RAN 9), but a preponderance of evidence of record does not support this interpretation. Fisher does not describe that platform 58 is movable, removable, detachably installed, or anything of the

kind. The most that can be said of Fisher's disclosure that platform 58 may be installed in various places in the freezer compartment is that it is *not inconsistent* with removability. That is not enough to show that Fisher discloses removability. *Cf. Rowe v. Dror*, 112 F.3d 473, 480 (Fed. Cir. 1997) (finding no anticipation where the reference merely did "not explicitly describe anything inconsistent" with the claim).

Fisher's disclosure that platform 58 is "secured" by "fasteners" similarly does not amount to a disclosure that the platform is *removably* secured by *unfastenable* fasteners. Respondent offers little evidence, beyond Fisher itself, to support its contention or to refute Mr. Beck's declaration evidence. The term "secured" in Fisher's context means simply that one object is attached firmly to another; it implies nothing about whether the object is secured in a removable manner. Again, while Fisher might not be *inconsistent* with removability, it fails to disclose expressly that platform 58 is removable; Fisher therefore does not disclose what it is relied upon for disclosing.

Respondent's argument that Fisher's Fig. 2 shows the platform removed fails to take into account the fact that Fig. 2 is an "exploded" view of Fisher's ice dispensing system. Fisher, col. 3, ll. 39-40. Exploded views are used simply "to show the relationship or order of assembly" of the constituent parts. 37 C.F.R. § 1.84(h)(1). They do not by themselves indicate or imply that the constituent parts are removable.

The Examiner's responsive arguments similarly do not persuade us of the propriety of the rejections. The Examiner cites no authority for the proposition that Appellant's sparse disclosure concerning removability justifies embellishing the supposedly sparse disclosure of the prior art. The

Examiner is interpreting the prior art through the lens of Appellant's disclosure; this amounts to little more than impermissible hindsight.

The Examiner's observations concerning removability of "the front insulating wall (80)" (RAN 40-41) are inapposite, because it was platform 58, not "the front insulating wall (80)," that was relied upon to meet the "at least one of the insulating walls in which the outlet is provided." See RAN 8.⁸

For these reasons, we determine that a preponderance of evidence of record does not establish that Fisher discloses a removable insulating wall defining the ice compartment and in which an outlet is defined. Because each appealed rejection depends on Fisher for this disclosure, we reverse each of them.

CROSS-APPEAL OF REQUESTER

Examiner's Rejections

Requester seeks our review of the Examiner's final decision not to adopt the following rejections under 35 U.S.C. § 103(a) for obviousness, as set forth by the Examiner in the RAN:

1. Claims 1-4 and 6-12 over Najewicz, Fisher and Swaneck.
RAN 38.
2. Claim 5 over Najewicz, Fisher, Swaneck, and Jackovin. RAN 38.

⁸ We also fail to understand on what basis the Examiner finds that Fisher's element 80 is an insulating wall of the ice compartment. Element 80 is merely described as a "discharge opening" of housing 78. Fisher, col. 4, ll. 57-60.

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Analysis

Requester's argument that the above-identified grounds of rejection should have been maintained rests entirely on attacking the sufficiency of Patent Owner's efforts to establish invention prior to the effective date of Najewicz. CABR 4-9. Those rejections, however, both depend on Fisher for disclosure of a removable insulating wall defining the ice compartment and in which an outlet is defined. *See* NFOA 22-25. A preponderance of the evidence of record does not support this finding, as discussed above. We therefore affirm the Examiner's decision not to adopt these rejections without reaching the question of whether Patent Owner established invention prior to Najewicz.

DECISION

The Examiner's rejections of claims 1-28 are REVERSED. The Examiner's decision not to reject claims 1-12 for obviousness over Najewicz in combination with other references is AFFIRMED.

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. §§ 1.956, 41.77(g), and 41.79(e).

AFFIRMED-IN-PART

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