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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte 500 Group, Inc.,
Appellant and Patent Owner.

Appeal 2010-010428
Reexamination Control 90/008,998
Patent 6,601,930 B2
Technology Center 3900

Before SALLY GARDNER LANE, SALLY C. MEDLEY, and
DANIEL S. SONG, *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

DECISION ON APPEAL¹

500 Group, Inc.² appeals under 35 U.S.C. §§ 134(b) and 306 from a final rejection of claims 1, 7, and 10 of United States Patent 6,601,930 (“the

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” shown on the PTOL-90A cover letter attached to this decision.

² 500 Group, Inc. is the real party in interest and the current owner of the patent under reexamination.

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‘930 patent”) in reexamination. The patentability of claim 13 has been confirmed, while claims 2-6, 8, 9, 11, 12, and 14 were not subject to reexamination. We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

We affirm.

STATEMENT OF THE CASE

This proceeding arose from a request for *ex parte* reexamination filed by ZAG Industries, Ltd. on January 24, 2008, of the ‘930 patent issued to Tiramani, Ham, and Bozak on August 5, 2003, based on United States Application 10/075,441 filed February 15, 2002.

U.S. Patent 6,347,847 (“the ‘847 patent”) is commonly assigned with the ‘930 patent and was issued from an application (09/731,780) that is a continuation of the application that resulted in the ‘930 patent. The ‘847 patent is currently under reexamination (Reexamination No. 90/008,997) and appeal (Appeal No. 2010-011923).

We have not been informed of any other concurrent or prior proceedings that would impact our decision.

Patentee’s invention relates to a rolling container that can store working tools. (‘093 patent at col. 1, 30-31).

Claim 1 recites:

An apparatus for transporting articles between working locations, comprising:
a base container having an interior space in which articles to be transported can be stored,

one or more rotatable ground engaging wheels mounted to the apparatus toward the bottom of said apparatus for rotation about an axis to provide rolling support for said apparatus;

at least one removable container having (i) a container portion with an interior space in which articles to be transported can be stored, (ii) a lid pivotally connected to said container portion; (iii) a latch arrangement constructed to secure said lid in covering relation with respect to said container portion, and (iv) a carrying handle attached to said lid and that is manually graspable to enable carriage of said removable container;

said at least one removable container being removably secured above said base container when said apparatus is at a working location to enable said at least one container to be removed from secured relation above said base container and separately carried by said carrying handle at said working location; and

a manually engageable pulling handle having a hand grip portion, said pulling handle and said one or more ground engaging wheels being arranged to enable a user to manually grasp said hand grip portion and pull said pulling handle generally rearwardly so as to tilt said apparatus rearwardly to a tilted rolling movement position, thereby enabling the user to roll said apparatus to a desired location by pushing or pulling said pulling handle in a desired direction;

said at least one removable container being secured above said base container so as to be retained in secured relation above said base container while said apparatus is in said tilted rolling movement position;

said container portion having a generally upwardly facing opening when said apparatus is standing at said working location and said at least one removable container is secured above said base container;

said lid being pivotable, when said apparatus is disposed at said working location and said at least one removable container is secured above said base container, between (i) a

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closed position wherein said lid is in covering relation with said upwardly facing opening of said container portion and (ii) an open position permitting access to the interior space of said container portion.

(App. Br. 16-17; Claims App'x).

The prior art references relied are upon by the Examiner in rejecting the claims are:

Spielhoff	DE 3510307	September 25, 1986
Kennedy	1,984,345	December 11, 1934

The Examiner rejected claims 1, 7, and 10 under 35 U.S.C. § 103(a) as unpatentable over Spielhoff and Kennedy. (Ans. 3-10). Appellant does not argue for the separate patentability of these claims. We focus on claim 1 in our review. *See* 37 C.F.R. § 41.37(c)(vii).

Appellant relied upon Exhibits 1-21, which are copies of dictionary definitions, to rebut the Examiner's rejections. (App. Br. 20-21, Evidence App'x).

ISSUES

Appellant raised the following issues:

Does Spielhoff teach an apparatus with a removable container that is "secured" above a base container, as recited in claim 1?

Did the Examiner provide sufficient reason why it would have been obvious to those in the art to combine the elements of the apparatus taught in Kennedy with the apparatus of Spielhoff?

FINDINGS OF FACT

1. Figure 27 of the '930 patent is reproduced below.

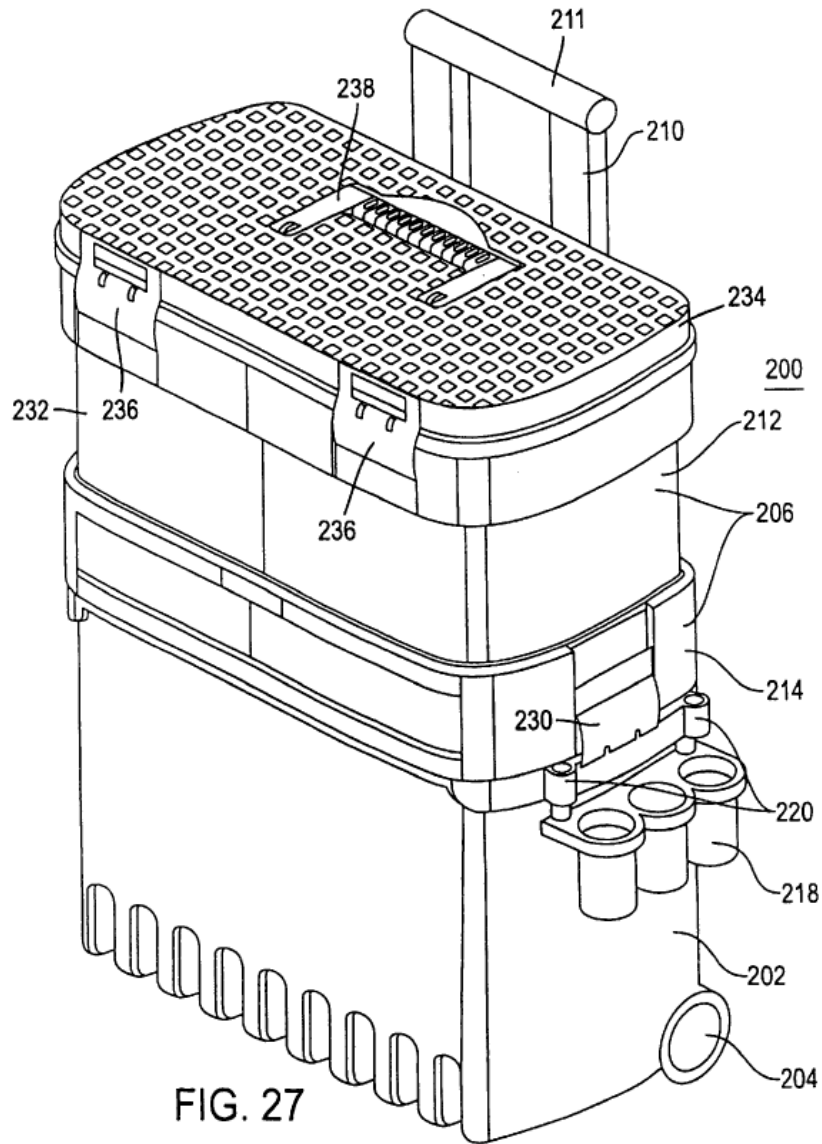


Figure 27 depicts a rolling container assembly with a removable cabinet or container (206) secured to a base cabinet or container (202). Removable

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container (206) is secured by latch (230) to base container (202) and has a lid (234), which is pivotally connected and is secured by latches (236) to container (206). ('930 patent col. 10, ll. 38-57).

2. The specification of the '930 patent provides that "the at least one cabinet **206** [is] *secured* to the base cabinet **202** by a latch or latch assembly **230** as shown. The tool case **212** is *secured* to the organizer **214** in any manner, for example, by a frictional fit as shown." ('930 patent col. 10, ll. 38-45 (emphasis added)).

3. Figure 3 of Spielhoff is reproduced below.

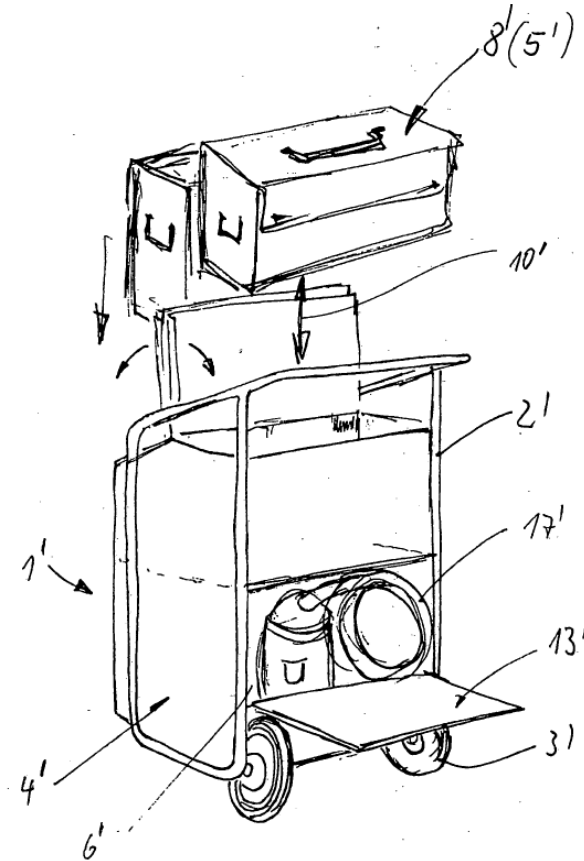


Fig. 3

Figure 3 depicts a mobile tool cart on wheels (3') with a base container (4') and a removable case for holding tools (8') that is inserted into a top compartment. (Spielhoff translation, pp. 7 and 8-9).

4. Kennedy teaches a tool kit as depicted in Figure 1, which is reproduced below.

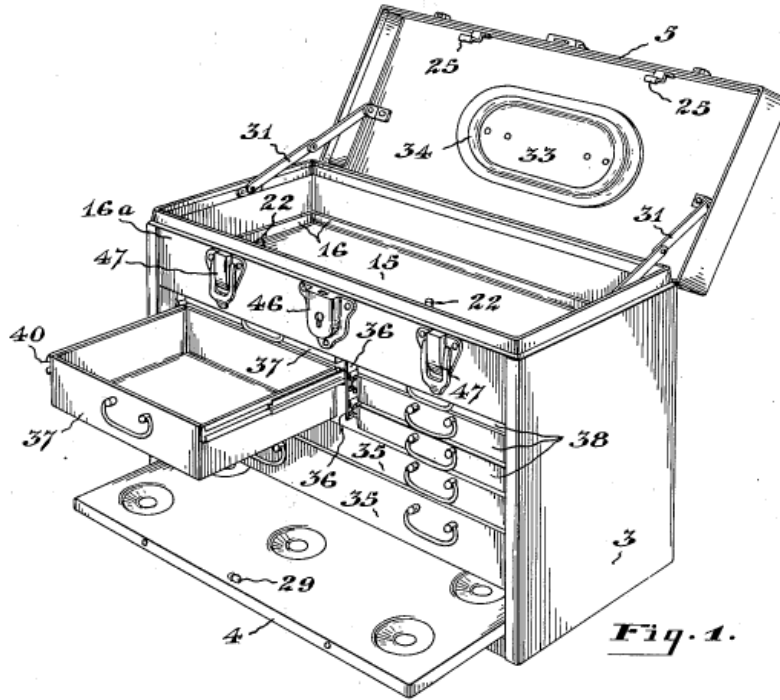


Figure 1 depicts a tool kit with a lid (5) pivotally connected to a container portion and including latches (46 and 47) between the lid and container. (Kennedy p. 1, right col., ll. 13-15, and p. 3, left col., ll. 29-31).

5. Kennedy teaches that the lid (5) depicted in Figure 1 can include a handle attached to the cover. (Kennedy, p. 2, l. 35).

PRINCIPLES OF LAW

“[W]hen a [claim] ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

ANALYSIS

Claim 1

Appellant's claim 1 recites an apparatus for transporting articles that has elements including a base container, wheels, a removable container with a pivotally connected lid, and a handle. (App. Br., Claims App'x 16). The removable container is "removably secured above said base container" (*Id.*).

Combination of the Prior Art

Spielhoff teaches a rolling tool cart with a base container and a removable case inserted into a top compartment (FF 3, Spielhoff Fig. 3), while Kennedy teaches a tool kit with a lid pivotally attached to the container, latches to lock the lid, and an attached handle. (FF 4; Kennedy Fig. 1). According to the Examiner, it would have been obvious to those of skill in the art to modify the rolling container of Spielhoff with elements taught in Kennedy to increase protection of the contents of the removable container with a locking lid. (Ans. 5).

"Secured above the base container"

Appellant argues that Spielhoff does not teach a removable container that is "secured above the base container," as claimed. (App. Br. 10). Appellant argues that the removable case (8') of Spielhoff is "inserted" (*see* Spielhoff translation p. 9, ll. 4-6) into a compartment, but is not "secured" because it is not "fixed," "attached," or "fastened" to the lower portion of the device by any kind of latch, lock, or securing device. (App. Br. 11; Reply

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Br. 3).

“During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification.” *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007)(citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

Appellant points to the specification of the ‘930 patent to support the construction of the term “secured” (App. Br. 9-10), but does not point to an express definition of “secured” or use of the terms “fixed,” “attached,” or “fastened” to describe the relationship of the removable container and the base container in the specification. The specification does use the term “secured” to describe an embodiment of the apparatus in which the removable cabinet is attached to the base cabinet with latches or with a snapping mechanism. (FF 2; ‘930 patent col. 10, ll. 38-42; *see also* ‘930 col. 5, l. 66, through col. 6, l. 3). As Appellant notes, though, such latches or snaps are not recited in the claim and do not limit the claim term “secured.” (App. Br. 9: “It is noted that Appellants are not attempting to read the words ‘snapping mechanisms’ or ‘latch assembly’ into that claim, but is merely demonstrating the types of coupling devices that are capable of ‘securing’ the tool case to the base cabinet.”). *See In re Prater*, 415 F.2d 1393, 1396 (CCPA 1969) (“an applicant should [not] have limitations of the specifications read into a claim where no express statement of the limitation is included in the claim.”).

In fact, the specification of the '930 patent provides for any mechanism of securing the container to the apparatus, by stating that it can be accomplished "in any manner, for example, by a frictional fit." (FF 2; '930 patent col. 10, ll. 42-44). Thus, the specification of the '930 does not limit the term "secured" to any specific mechanism, but rather, makes it clear that the term is being used, and should be construed, broadly.

Appellant also points to several dictionary definitions of the terms "enclosed" and "secured." (App. Br. 7-9). Appellant asserts that every definition of the term "secure" provided uses the words "fast" or "fasten," and implies that a "secured" item is only one that is "fastened" to something. (App. Br. 8-9). At least some of the definitions, though, encompass a broader meaning. For example, one of the definitions of "secured" relied upon by Appellant is "firmly fixed: firmly fixed or *placed in position* and unlikely to come loose or give way." (App. Br. 8, Ex. 9 (emphasis added)). Thus, a container that is "inserted" into a compartment, as in Spielhoff, would be "secured" in the compartment because it had to be placed in the compartment and would be unlikely to come loose or give way. In this respect, we further note the provision of a lid (not numbered) for the compartment in the tool cart of Spielhoff, which furthers securing of the removable case. We decline to construe the claim term "secured" as narrowly as Appellant asserts so as to require fastening. The arrangement in Spielhoff, where the container is inserted into the top compartment, is encompassed by Appellant's claims.

Motivation to combine

Appellant also argues that there would not have been any reason for those in the art to combine the teachings of Spielhoff and Kennedy. (App. Br. 13-14). According to Appellant, the tool box of Kennedy must have an unobstructed face for latches 47 to be released and the enclosed space of the top compartment of Spielhoff would render it unsatisfactory for its intended use. (App. Br. 13; Reply Br. 6-7).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

In re Keller, 642 F.2d 413, 425 (CCPA 1981). Kennedy would have taught those in the art that a removable container such as that taught in Spielhoff could have been modified to have a pivotally connected lid and a latch for the purpose of providing a locking means to increase protection of the contents of the removable container. (*See* Ans. 5; Kennedy p. 3, ll. 16-20). Clearly, the Appellant cannot be asserting that use of hinged lids and latches are not well known in the art of containers. Moreover, Appellant's assertion that enclosed space of the top compartment of Spielhoff would render Kennedy unsatisfactory is unpersuasive. Spielhoff clearly teaches that the case is removable, and further discloses a lid thereon (not numbered) with a handle and a frontal flap so that frontal access to the case would be required,

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much like the tool kit of Kennedy. Hence, it would have been obvious to one of ordinary skill in the art that the tool kit of Kennedy would have been entirely suitable for use with mobile tool cart of Spielhoff, and vice versa, without rendering either device unsatisfactory for their respective intended uses. Thus, it would have been obvious to one skilled in the art to make the modification suggested by the Examiner for the reason articulated.

Finally, Appellant argues that the Examiner's reason for combining Spielhoff and Kennedy, to "increase protection of the contents of the removable container" (Ans. 5), was erroneous because it is not the same as the goal of the claims, to secure a base to a container. (App. Br. 13-14). "Under the correct analysis [of whether a combination would have been obvious], any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR*, 550 U.S. at 420. The Examiner's reason for combining elements of Kennedy with the apparatus of Spielhoff are reasonable, regardless of how concisely expressed. (See App. Br. 14 "as the Examiner has only provided a single sentence in support of the proposed, combination, the Examiner has failed to present an articulated reasoning in support of the rejection."). Thus, there was no error in the Examiner's *prima facie* case of obviousness.

CONCLUSIONS

Spielhoff teaches an apparatus with a removable container that is "secured" above a base container.

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The Examiner provided an appropriate reason why it would have been obvious to those in the art to combine the elements of the apparatus taught in Kennedy with the apparatus of Spielhoff.

DECISION

The rejection of claims 1, 7, and 10 under 35 U.S.C. § 103(a) over Spielhoff and Kennedy is AFFIRMED.

Requests for extensions of time in this *ex parte* reexamination proceeding are governed by 37 C.F.R. § 1.550(c). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

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