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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ENRIQUE RAMIREZ MAGAÑA

Appeal 2018-008702
Application 15/185,798
Technology Center 3600

Before STEFAN STAICOVICI, JAMES P. CALVE, and
WILLIAM A. CAPP, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge*,
JAMES P. CALVE

Opinion Dissenting-in-part filed by *Administrative Patent Judge*,
STEFAN STAICOVICI

CALVE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the decision of the Examiner to reject claims 1–4. Appeal Br. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

¹ “Appellant” refers to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Mr. Enrique Ramirez Magaña. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The Specification describes a seating system comprising two modular components: (1) a reclining theater seat assembly and (2) a comfort divider. Spec. ¶ 8. The reclining theater seat assembly comprises a seating surface, reclining back, armrests, and support base. *Id.* The comfort divider includes foot rest assemblies and recliner backstop assemblies arranged in alternating manner. *Id.* In use, a row of comfort dividers is placed between the rows of theater seat assemblies. *Id.* Figs. 1, 2. Foot rest assembly 8 includes shelf-like structure 10, which is open and rear-facing, so a person sitting directly behind it can rest their feet. *Id.* ¶ 19. Recliner backstop assembly 9 largely comprises a wall that limits the maximum amount of recline of the seat directly in front of it and thus prevents too much recline from interfering with patrons behind the seat. *Id.* ¶ 20.

Claim 1, the sole independent claim, is reproduced below.

1. A comfort divider comprising a plurality of foot rest assemblies and a plurality of backstop assemblies, one or more of said foot rest assemblies further comprising wiring adapted to provide electricity for lighting or for electrical outlets, wherein said foot rest assemblies and said backstop assemblies are arranged in alternating fashion and adjacent to one another.

REJECTIONS

Claims 1–4 are rejected under 35 U.S.C. § 103(a) as unpatentable over Johnson (US 6,739,670 B2, iss. May 25, 2004) and Wilson, Jr. (US 2012/0200129 A1, pub. Aug. 9, 2012) (hereinafter “Wilson”).

Claims 1–4 are rejected under 35 U.S.C. § 103(a) as unpatentable over Johnson and Locke (US 2,267,158, iss. Dec. 23, 1941).

ANALYSIS

Claims 1–4 Rejected over Johnson and Wilson

Claims 1 and 2

Regarding claim 1, the Examiner finds that Johnson teaches all of the claimed features including plural foot rest assemblies (chair/ottoman 14) and backstop assemblies (arms 22) arranged in alternating fashion and adjacent to one another but lacks wiring adapted to provide electricity for lighting or for electrical outlets. Final Act. 2–3. The Examiner cites Wilson to teach a furniture assembly with storage compartment 12 including wiring adapted to provide electricity to outlets 14. *Id.* at 3. The Examiner determines it would have been obvious to a person of ordinary skill in the art to add a storage compartment 30, electrical outlets, and associated wiring taught by Wilson to configure one or more foot rest assemblies with wiring provide electricity for lighting or for electrical outlets and serve as a source of electricity for articles used with the assembly such as lamps and computers. *Id.* at 3–4.

Appellant argues that Johnson describes a table separable into four separate ottomans/chairs and an adjustable height table rather than a divider, foot rest, or backstop. Appeal Br. 11. Appellant argues that item 22 is a “table arm” that functions as a guide to combine the ottomans into an assembly, but the Specification discloses the claimed “backstop” as limiting the maximum amount of recline of the seat directly in front of it to prevent too much recline to interfere with patrons behind it. *Id.* (citing Spec. ¶ 20).

This argument is not persuasive because claim 1 recites “a plurality of backstop assemblies” without reciting any other structure or function. The Examiner interprets “backstop” as a wall or screen and finds that Johnson’s arm is clearly a wall or screen. Final Act. 6; Ans. 6.

“During examination, ‘claims [in an application] are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (alteration in original) (quoting *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)); see *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1259–60 (Fed. Cir. 2010) (same). “Giving claims their broadest reasonable construction ‘serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.’” *Am. Acad. Of Sci. Tech.*, 367 F.3d at 1364 (quoting *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984)); see *In re Zletz*, 893 F.2d 319, 322 (Fed.Cir.1989) (“An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”). “Construing claims broadly during prosecution is not unfair to the applicant . . . , because the applicant has the opportunity to amend the claims to obtain more precise claim coverage.” *Am. Acad. Of Sci. Tech.*, 367 F.3d at 1364; see *Yamamoto*, 740 F.2d at 1571–72 (“Applicants’ interests are not impaired since they are not foreclosed from obtaining appropriate coverage for their invention with express claim language.”). “[T]he patent examiner and the applicant work together to determine the scope of the claimed invention.” *PPC Broadband Inc. v. Corning Optical Commc’ns RF, LLC*, 815 F.3d 734, (Fed. Cir. 2016); see *In re Buszard*, 504 F.3d 1364, 1366–67 (Fed. Cir. 2007) (“The patent examiner and the applicant, in the give and take of rejection and response, work toward defining the metes and bounds of the invention”).

Although the claims are interpreted in light of the Specification, it is well-settled that “limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). “Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (“[T]his court counsels the PTO to avoid the temptation to limit broad claim terms solely on the basis of specification passages.”); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 1323 (Fed. Cir. 2005) (en banc) (absent lexicographic definition or disclaimer, the claims are not limited to embodiments disclosed in the specification even if the specification describes only a single embodiment).

The Specification describes the “backstop assembly” as “primarily composed of a wall that is optionally slanted to correspond to the angle of recline of the seat assembly’s back 4.” Spec. ¶ 20. Appellant’s Figure 2, reproduced below, illustrates backstop assembly 9 as a wall.

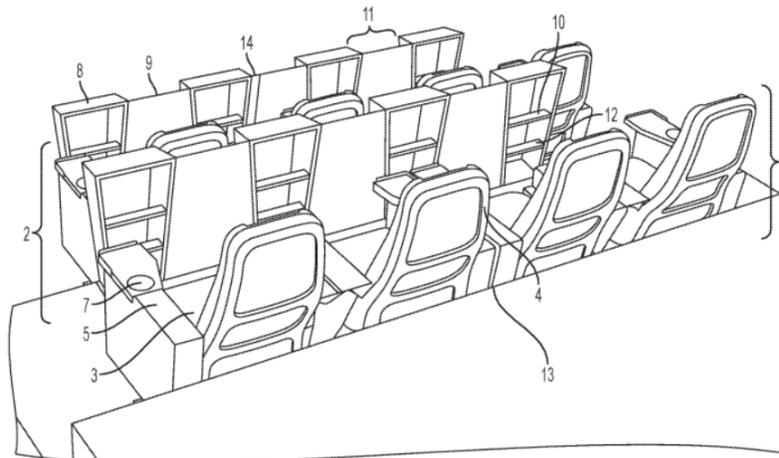


FIG. 2

Figure 2 above illustrates comfort divider 2 comprising foot rest assemblies 8 with shelves 10 and backstop assemblies 9. Spec. ¶¶ 19, 20.

The Examiner interprets this limitation to mean “a wall or screen.” Final Act. 5; Ans. 6. This interpretation is consistent with the Specification. It also is consistent with the claims. Claim 3 recites “wherein each of said backstop assemblies comprises a wall that is slanted to form an open recess.” Under the doctrine of claim differentiation, reciting these features in claim 3, which depends from claim 1, creates a presumption that claim 1 is broader than these features. *See Phillips*, 415 F.3d at 1315 (“the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.”).

Under a broadest reasonable interpretation, we construe “backstop assembly” as “a substantially planar element” consistent with the claims and Specification. The Examiner finds that “[t]he backstop (22) of Johnson is clearly a wall or a screen, just as the backstop (9) of the instant application is a wall or screen. Note Figure 2 of the instant application.” Ans. 6.

In response, Appellant argues the purpose of the backstop is to limit the maximum amount of recline of the seat directly in front of it to prevent too much recline that interferes with patrons behind it. Appeal Br. 11 (citing Spec. ¶ 20); Reply Br. 2 (same). Appellant argues that there is no teaching that Johnson’s table arm 22 can be used as a backstop to prevent recline of chair/ottoman 14. Reply Br. 2. Essentially, Appellant argues that the term “backstop” connotes a function as well as having a particular structure.

An ordinary meaning of “backstop” is “something at the back serving as a stop: such as a screen or fence for keeping a ball from leaving the field of play [or] a stop (such as a pawl) that prevents a backward movement (as of a wheel).” Merriam-Webster.com at “<https://www.merriam-webster.com/dictionary/backstop>” (accessed Oct. 24, 2019).

This meaning is consistent with Appellant’s usage of that term in the Specification to mean a recliner backstop assembly 9 “primarily composed of a wall” that “limits the maximum amount of recline of the seat directly in front of it to prevent too much recline to interfere with the patrons behind it.” Spec. ¶ 20. However, claim 1 does not recite any of these features of the backstop. As discussed above, we do not read unclaimed features from the Specification into the claim. Nor do we limit the claims to embodiments that are disclosed in the Specification even if the embodiment is a preferred embodiment. *E.g., Howmedica Osteonics Corp. v. Wright Med. Tech., Inc.*, 540 F.3d 1337, (Fed. Cir. 2008) (“[W]e have repeatedly held that the fact that the specification describes only a single embodiment, standing alone, is insufficient to limit otherwise broad claim language.”).

The issue is whether the term “backstop” recites any structural or functional feature to define over the planar table arm 22 of Johnson. “It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Thus, “[t]he patentability of an apparatus claim ‘depends on the claimed structure, not on the use or purpose of that structure.’” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002); *see also In re Hiniker Co.*, 150 F.3d 1362, 1368 (Fed. Cir. 1998) (“Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims.”); *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (“[A]ppellant’s arguments respecting functional differences between its valve and Toth’s filter lack foundation in the limitations appearing in the claims.”).

The Examiner has the better position. “[T]he name of the game is the claim.” *Hiniker*, 150 F.3d at 1369. Claim 1 recites “backstop assemblies,” which we interpret to mean a substantially planar elements capable of preventing movement of another element. This interpretation is consistent with the claim language and the Specification.

In light of the limitations of claim 1, the fact that Johnson’s planar table arm 22 is used to stop the movement of chair/ottoman 14 rather than reclining theater seats is not relevant to our analysis. As discussed above, a different intended use does not impart patentability to an apparatus claim.

Appellant’s arguments are directed exclusively to the different *use* or “*purpose*” of the backstop assemblies compared to Johnson’s table arms 22. *See* Appeal Br. 11 (“the instant specification specifically discloses that the purpose of the backstop is to ‘limit[] the maximum amount of recline of the seat directly in front of it to prevent too much recline to interfere with the patrons behind it’” and “‘prevent[s] the user’s seat assembly 1 from reclining too far back’”) (citing Spec. ¶ 20). Indeed, Appellant argues that “[t]he structure of table arm (22) in *Johnson* is incapable of performing this *intended use* as described in the instant invention. There is no suggestion that table arm (22) can be used as a backstop, and furthermore, it would be unusual for a person to sit under a table and to use a ‘table arm’ to rest their back on.” *Id.* (emphasis added).

Even considering this use/purpose, Johnson describes table arms 22 as defining spaces that limit movement of each chair/ottoman 14 when the unit is assembled. Johnson, 3:65–4:2. The Examiner finds that table arms 22 are at the back of a footrest and stop movement of a footrest beyond the backstop to prevent engagement with an adjacent footrest. Ans. 6.

Essentially, the Examiner has taken the position that Johnson's table arms are capable of functioning as or serving the intended use of a backstop because they have the structure described in the Specification for a backstop. The Examiner had a sound reason for making this determination because the Specification discloses the claimed backstop as primarily composed of a wall, and Johnson discloses table arm 22 as a wall that stops movement of chair/ottoman 14 components. Spec. ¶ 20; see *Schreiber*, 128 F.3d at 1478 ("where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.") (quoting *In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971)).

In rebuttal, Appellant argues that table arm 22 "is not located at the back of item (14) [but] rather the table arm (22) is located adjacent to the sides of chair/ottoman 14 where door(s) (34) are positioned. This evidences a clear functional difference between *Johnson* and the instant application" in which the backstop "prevent[s] the user's seat assembly 1 from reclining too far back." Reply Br. 2 (quoting Spec. ¶ 20). Appellant also argues that Johnson's table arms do not prevent reclining of chair/ottoman 14 because chairs/ottomans 14 are unable to recline and the backs of chairs/ottomans 14 do not contact table arms 22 thereby "providing further support that the table arm (22) does not mimic the *intended use* of the backstop in the instant application." *Id* at 2-3. (emphasis added). Thus, Appellant again asks us to read an intended use into the limitation "backstop." Even if we do so, such intended use cannot impart patentability to an apparatus claim like claim 1.

The Specification describes the claimed comfort divider as comprising “foot rest assemblies” and “*recliner* backstop assemblies” or a “*recliner* backstop.” Spec. ¶¶ 8–10, 19–21, 23, 24 with emphasis added. However, claim 1 recites “backstop assemblies” not “*recliner* backstop assemblies.” Therefore, claim 1 is broader in scope than the recliner backstop assembly embodiment. We have no basis in the claim language to require the prior art to have wall structure sufficient to stop a reclining theater seat or chair.

Notably, claim 1 does not recite a seating system comprising a theater seating arrangement used in conjunction with the claimed comfort divider. It recites only elements of the comfort divider, i.e., a backstop and foot rest. Thus, the backstop does not necessarily have to stop the back of a reclining chair. It can stop the back of door 34 of Johnson’s chair/ottomans 14.

Thus, even if “backstop” conveys a function, Johnson’s arm 22 can function as a backstop as claimed under a broadest reasonable interpretation.

Next, Appellant argues that item 14 of Johnson does not teach a foot rest because it is a chair and there is no suggestion of its use as a foot rest. Appeal Br. 11–12. Appellant’s Specification discloses the foot rests as a shelf-like structure 10, which is illustrated in Figure 2 above. Spec. ¶ 19.

We agree with the Examiner that Johnson teaches an ottoman being used to support the feet and legs of a person sitting in close proximity. *See* Johnson, 1:27–30. More particularly, Johnson teaches that chair/ottoman 14, which the Examiner treats as the claimed footrest assembly, includes areas 18 that may be used as foot/leg rests. *Id.* at 3:12–16, 4:8–10; *see* Ans. 7. Figure 1 of Johnson illustrates the cushioned area 18 as a curved, shelf-like element. Therefore, Johnson teaches structure that corresponds to the claimed foot rest assembly and is used for that function and purpose.

We also agree with the Examiner that Johnson arranges table arms 22 and chair/ottoman 14 elements “in alternating fashion and adjacent to one another” in Figure 1 as claimed. Final Act. 3, 6; Ans. 8; Johnson, 3:64–4:2.

Appellant admits that table arm 22 and chair/ottoman 14 are adjacent to one another when the furniture is assembled but argues that table arm 22 is unusable in this scenario. Appeal Br. 12. We disagree because Johnson arranges table arms 22 and chair/ottomans 14 in this alternating, adjacent manner to create assembly 10. Johnson, 2:50–61, 3:64–4:13, Fig. 1. The Examiner relies on this embodiment. Final Act. 3 (citing Johnson, Fig. 1). In this configuration, arm 22 acts as a backstop to limit movement of chair/ottoman 14 and its side door 34 as discussed above. Ans. 6–7.

Appellant’s further argument that these elements are not horizontally arranged in alternating fashion because they are designed to fit together in a circular arrangement (Reply Br. 3–4) is not commensurate with the scope of claim 1 and therefore is not persuasive. The Specification illustrates the backstops and foot rests in a linear arrangement, but claim 1 does not recite such structural arrangement or relationship. Even so, Johnson teaches that other geometrical configurations can be used. Johnson, 2:61–66.

Accordingly, we sustain the rejection of claim 1 and claim 2, which is not argued separately by Appellant. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claim 3

Claim 3 depends from claim 1 and recites that “each of said backstop assemblies comprises a wall that is slanted to form an open recess.” The Examiner finds that Johnson’s table arm 22 provides a wall that is slanted relative to a center point of member 26 to form an open recess with another table arm and is perpendicular to the floor. Final Act. 3; Ans. 8–9.

Appellant argues that Johnson's arm 22 is perpendicular to the floor whereas the Specification describes the backstop as "slanted to correspond to the angle of recline of the seat assembly's back" and "[i]t is envisioned that a wall having a slant angle of 0–30 degrees is suitable to accomplish that purpose." Appeal Br. 12–13 (quoting Spec. ¶ 20); Reply Br. 4.

Appellant argues that arm 22 of Johnson cannot perform this intended use because chairs/ottomans 14 have no angle of recline. Reply Br. 4.

The term "slanted" is a relative term, but claim 3 does not require the wall to be slanted in relation to a seat or any particular feature. Appellant's arguments in this regard are not commensurate with the scope of claim 1.

Per the Specification, the wall can have a slant angle of 0° and "can be perpendicular to the floor and still serve this purpose" as a backstop. Spec. ¶ 20. Johnson's arm 22 is perpendicular to the floor, as Appellant admits. A perpendicular arm 22 has a slant angle of 0 degrees. Appeal Br. 12. Thus, it is "slanted" *as claimed*. Accordingly, we sustain the rejection of claim 3.

Claim 4

Claim 4 depends from claim 1 and recites "one or more spacers" that are "located between one of said backstop assemblies and an adjacent one of said foot rest assemblies [for] increasing the distance between said backstop assembly and said adjacent foot rest assembly." Appeal Br. 17 (Claims App.). The Examiner finds that side doors 34 on Johnson's chair/ottoman 14 are located between a chair/ottoman unit and an adjacent table arm 22 as claimed. Final Act 3. The Examiner reasons that door 34 is capable of increasing the space between the backstop (table arm 22) and an adjacent foot rest (chair/ottoman 14) when it is opened slightly. Ans. 10. The Examiner finds that such space is shown in Figure 7 and other drawings. *Id.*

We agree with Appellant that Johnson discloses side door 34 as flush with the side surface of chair/ottoman 14 when it is closed and, therefore, it does not function as a spacer or provide a spacing function to increase “the distance between said backstop and said adjacent foot assembly” as recited in claim 4. Appeal Br. 13; Reply Br. 5. The bottom view of Figure 2 and the top view of Figure 3 of Johnson illustrate door 34 as flush with the side surface of chair/ottoman 14 when closed. Indeed, hinges 36 that support doors 34 are illustrated as flush with the side surface in Figures 2 and 3 of Johnson. This configuration allows chair/ottoman 14 and table arm 22 to fit tightly against one another in an adjacent relationship to form assembly 10 without any intervening space between these elements. Johnson positions arm 22 and chair/ottoman 14 with no space between these elements when they are adjacent to one another as in Figure 1. We find no teaching to use door 34 as a spacer between arms 22 and chair/ottoman 14. An alternate embodiment in Figure 7 has a very small space between chairs/ottomans 112 and adjacent arms 122, but Figure 8 illustrates chair/ottoman 112 without doors. Even if chair/ottoman 112 had a door, placing it adjacent to arm 122 as in Figure 7 eliminates any space for a door to open. Indeed, Johnson also teaches that a lock 38 may be used to secure doors 34 in a closed position. Johnson, 3:41–63. Thus, the door is designed to remain closed for a tight fit.

Accordingly, we do not sustain the rejection of claim 4.

Claims 1–4 Rejected over Johnson and Locke

Regarding claim 1, the Examiner finds that Johnson teaches all of the features recited in claim 1, as in the previous rejection, except the foot rest assemblies lack wiring adapted to provide electricity for lighting or electrical outlets. Final Act. 4.

The Examiner finds that Locke teaches a furniture assembly with a storage compartment (casing 11) including wiring (leads 41) adapted to provide electricity for lighting 40. *Id.* at 5. The Examiner determines that it would have been obvious to a person of ordinary skill in the art to modify Johnson by adding such wiring adapted to provide electricity for lighting to Johnson's storage compartment 30 to enhance the use of the assembly in darkness. *Id.*

We agree with Appellant that a skilled artisan would not have been motivated to add wiring adapted to provide electricity for lighting in storage compartment 30 of a chair/ottoman 14 of Johnson based on Locke's teaching to use a light in a shoe fitting stool to indicate whether foot drying unit 12 in stool 10 is turned on or off. Appeal Br. 14–15; Reply Br. 7–8; *see* Locke, 2:1:20² (“The light **40** provides a visible means for determining whether or not the device is on or off.”).

Even if adding lighting to Johnson's storage compartment 30 of chair/ottoman 14 would provide illumination and enhance use of the device as the Examiner finds (Ans. 11–12; Final Act. 5), Locke's use of light 40 in stool 11 would not provide that motivation. Locke's stool 10 is used to dry damp feet of persons buying shoes. Locke, 1:1:1–5. Toward this end, drying unit 12, electric fan 38, and light 40 are placed inside casing 11 of stool 10. *Id.* at 1:2:1–45, Fig. 3. Contrary to the Examiner's finding, stool 10 is not used for storage. Instead, casing 11 is filled with electrical devices and wiring and sealed by grill 24. *Id.* at 1:2:1–45, Fig. 3. Light 40 indicates whether the heater and fan are operating. *Id.* 2:1:20–22. Locke does not teach light 40 as capable of providing illumination for “whatever reason.” Ans. 11–12.

² Refers to Page:Column:Line where Column 1 is left and Column 2 is right.

“The articulated reasoning and factual underpinnings of an examiner’s rejection are, thus, essential elements of any stated ground of rejection.” *In re Biedermann*, 733 F.3d 329, 336 (Fed. Cir. 2013). The Examiner must make the necessary findings supported by an adequate evidentiary basis with a satisfactory explanation for his actions including a rational connection between the facts found and conclusion of obviousness. *See In re Nuvasive*, 842 F.3d 1376, 1382 (Fed. Cir. 2016). Because “rejections on obviousness grounds cannot be sustained by mere conclusory statements, . . . *there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“To facilitate review, this analysis should be made explicit.”) (citing *id.*).

Here, the Examiner’s reason to combine the teachings of Locke and Johnson is based on faulty fact findings, namely, “[t]he secondary reference [Locke] teaches providing a furniture assembly with a *storage compartment (11)* that has wiring (41) adapted to provide electricity *for lighting (40)*” (Final Act. 5 (emphasis added)), “[e]ach of Johnson and Locke discloses a device in which a user can place the feet for support, *wherein the device includes access to an interior of the device*” (Ans. 11 (emphasis added)), and “Locke teaches *providing a lighting device to the accessible interior of a footrest*” (*id.* at 12 (emphasis added)). Thus, it lacks the evidentiary basis to provide a rational underpinning needed to combine Locke and Johnson.

Locke’s casing 11 contains electronics. The electronics and wiring are sealed inside by metal grille 24. The inside is not accessible for storage. Locke, 1:2:5–45. Light 40 indicates whether the electronics are on or off. *Id.* 2:1:21–23. It does not illuminate an accessible area used as storage.

Because the Examiner's findings lacks an adequate evidentiary basis, his reasoning and conclusion of obviousness are not supported by a rational underpinning. Accordingly, we do not sustain the rejection of claim 1. The Examiner's findings regarding claims 2-4 do not cure the deficiency noted above as to claim 1. Thus, we do not sustain the rejection of these claims.

CONCLUSION

We affirm the rejection of claims 1-3, and we reverse the rejection of claim 4 as unpatentable over Johnson and Wilson.

We reverse the rejection of claims 1-4 as unpatentable over Johnson and Locke.

Claims Rejected	Basis 35 U.S.C. §	Basis	Affirmed	Reversed
1-4	103(a)	Johnson, Wilson	1-3	4
1-4	103(a)	Johnson, Locke		1-4
Overall Outcome			1-3	4

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED IN PART

STAICOVICI, *Administrative Patent Judge*, Dissenting-in-part.

I concur with the Majority's decision regarding the rejection of claims 1–4 under U.S.C. § 103(a) as unpatentable over Johnson and Wilson. However, I respectfully dissent from the Majority's decision to reverse the Examiner's rejection of claims 1–4 as unpatentable over Johnson and Locke.³ Specifically, I disagree with the Majority's view that the Examiner has not provided an adequate reasoning with rational underpinnings to combine the teachings of Johnson and Locke.

The Examiner finds that Johnson fails to disclose a foot-rest assembly including wiring adapted to provide electricity for lighting or electrical outlets. Final Act. 4. Thus, the Examiner relies on Locke to disclose illuminating the interior of casing 11 of stool 10 using wiring 41 and light 40. *Id.* at 5; *see also* Locke, Fig. 3. The Examiner then reasons that it would have been obvious to a skilled artisan to add a lighting device and appropriate wiring, such as light 40 and wiring 41 of Locke, to Johnson's storage compartment 30 of chair/ottoman 14, to provide illumination, and, thus, to enhance use of Johnson's storage compartment in darkness. Final Act. 5.

Locke discloses stool 10 for drying damp feet of persons buying shoes having a casing 11 holding drying unit 12 including heater 39 and electric fan 38, wiring 41, and light 40. Locke, Fig. 3. Locke further discloses using

³ Appellant does not separately argue dependent claims 2–4. *See* Appeal Br. 15.

light 40 as a visual indicator for determining whether heater 39 and fan 38 are operational. *Id.* 2:1:20–22.

Appellant argues that a skilled artisan would not have been motivated to add wiring adapted to provide electricity for lighting in storage compartment 30 of Johnson’s chair/ottoman 14 based on Locke’s teaching to use a light in a shoe-fitting stool to indicate whether foot-drying unit 12 in stool 10 is turned either ON or OFF. Appeal Br. 14–15

Even though Locke discloses that the purpose of light 40 is to indicate whether heater 39 and fan 38 are operational, a skilled artisan would readily understand that Locke’s light 40, nonetheless, provides illumination to the interior of casing 11. What a reference teaches a person of ordinary skill is not limited to what a reference specifically “talks about” or what is specifically “mentioned” or “written” in the reference, but should be examined in the context of the knowledge, skill, and reasoning ability of a skilled artisan. *Syntex (U.S.A.) LLC v. Apotex, Inc.* 407 F.3d 1371, 1380 (Fed. Cir. 2005). Here, the Examiner is correct that illumination “is necessarily true of lighting.” Ans. 12. As such, the fact that Locke’s light 40 is used for a different purpose, i.e., a visual operational indicator, does not mean that light 40 does not illuminate the interior of Locke’s casing 11.

Thus, it seems logical to add wiring and a lighting device, such as wiring 41 and light 40 of Locke, to Johnson’s storage compartment 30 of chair/ottoman 14, to provide illumination to its interior, and, hence, to enhance use of Johnson’s storage compartment in darkness. *See, e.g., KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.”). The Examiner is correct that such illumination would “provide

enhancement for seeing when . . . [Johnson’s] device is used in the darkness.” Ans. 12. Moreover, adding Locke’s wiring 41 and light 40 to Johnson’s storage compartment 30 of chair/ottoman 14, is so simple as to belie any notion that this would be beyond the technical grasp of a person of ordinary skill in the art.

Furthermore, Appellant’s argument that a skilled artisan would not have been motivated to modify Johnson’s chair/ottoman 14 based on Locke’s teaching to use a light to indicate whether foot-drying unit 12 in stool 10 is turned either ON or OFF appears to be holding the Examiner to the old TSM standard; such a standard is not required. *KSR*, 550 U.S. at 415. The proper inquiry is whether the Examiner has articulated adequate reasoning based on a rational underpinning to explain why a person of ordinary skill in the art would have combined the teachings of Johnson and Locke. The fact that Locke’s wiring 41 and light 40 are used as a visual operational indicator does not, without more, establish that the Examiner erred by concluding that adding wiring and a light source to Johnson’s storage compartment would have been obvious to a person of ordinary skill in the art. Here, the Examiner is correct that as Locke’s wiring 41 and light 40 provide illumination to the interior of casing 11, it would have been obvious to a skilled artisan to include wiring and a light source to Johnson’s storage compartment to likewise provide illumination to its interior, and, thus, to “provide enhancement for seeing when . . . [Johnson’s] device is used in the darkness.” Ans. 12.

Finally, I do not agree with the Majority’s position that the Examiner’s reasoning to combine the teachings of Locke and Johnson is based on faulty fact findings. First, I do not agree with the Majority that just

because Locke's casing 11 contains electronics, casing 11 does not constitute a "storage compartment." As a "storage compartment" is used for storing, just because Locke's casing 11 stores electronics does not make casing 11 any less of a "storage compartment." Second, I do not agree that casing 11 is not accessible for storage. Although Locke discloses the use of grilles 20, 24, Locke also discloses the use of screws 26, 21 respectively, that provide access to the interior of casing 11. Moreover, a skilled artisan would readily acknowledge that Locke's casing 11 is accessible in order to make repairs to heater 39, electric fan 38, wiring 41, and light 40. *See In re Jacoby*, 309 F.2d 513, 516 (CCPA 1962) (An artisan must be presumed to know something about the art apart from what the reference discloses.).

For the foregoing reasons, I am not persuaded of Examiner error and would sustain the rejection of claims 1–4 as unpatentable over Johnson and Locke.

Notice of References Cited	Application/Control No. 15/185,798	Applicant(s)/Patent Under Patent Appeal No. 2018-008702	
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U.S. PATENT DOCUMENTS

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*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
U	Definition of 'backstop' in M-W Online Dictionary
V	
W	
X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

 [noun](#)back·stop | \ 'bak-, stäp 
plural backstops

Definition of *backstop*

(Entry 1 of 2)

- 1 : something at the back serving as a stop: such as
a : a screen or fence for keeping a ball from leaving the field of play
b : a stop (such as a pawl) that prevents a [backward](#) movement (as of a wheel)
2 : a player (such as the catcher) positioned behind the batter
3 : something or someone that provides dependable support or protection against failure or loss As the cold war heated up, Hoover became the country's backstop against subversion.— David M. Oshinsky

backstop

[verb](#)

backstopped; backstopping; backstops

Definition of *backstop* (Entry 2 of 2)[transitive verb](#)

- 1 : [support](#), [bolster](#)
2 : to serve as a backstop to
3 : to play the position of goalkeeper for backstop a hockey team

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Synonyms & Antonyms for *backstop*

Synonyms: Verb

[abet](#), [aid](#), [assist](#), [back](#), [help](#), [prop](#) (up), [support](#)

Antonyms: Verb

[hinder](#)[Visit the Thesaurus for More](#) 

Examples of *backstop* in a Sentence

Noun

The pitch got past the catcher and rolled all the way to the *backstop*. kept some gold as a *backstop* in case the value of the local currency collapsed

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