

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIRK L. ZEHNDER

Appeal No. 2000-0204
Application No. 08/512,068

ON BRIEF

Before CALVERT, FRANKFORT, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 13. Claims 14 and 15, which were substituted for finally rejected claims 11 and 12, have been

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indicated by the examiner to be allowable (See Paper No. 24, mailed May 3, 1999), hence the appeal as to these claims is dismissed. Claim 6, the only other claim remaining in this application, has been withdrawn from further consideration under 37 CFR § 1.142(b) as being directed to a non-elected invention. Claims 1 through 5 have been canceled and newly presented claims 7 through 10 were refused entry by the examiner (See Paper No. 13, mailed December 19, 1996).

Appellant's invention as defined in claim 13 on appeal relates to a wick holding grate, for example, like that seen in Figure 3 of the application drawings. Claim 13 reads as follows:

13. A wick holding grate comprising:

A base member with apertures which permit each candle wick to be passed therethrough and notches on the apertures in the base member which hold the candle wicks in place during the entire wax cooling process of the manufacture of the candle whereby the wick holding grate can be shipped along with the candles as part of the shipping container.

The sole prior art reference of record relied upon by the examiner is:

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Bolinger

3,721,419

Mar. 20, 1973

Claim 13 stands rejected under 35 U.S.C. § 102(b) as anticipated by Bolinger. More particularly, the examiner has relied upon the embodiment of the wick holding element seen in Figure 8 of Bolinger, urging that element (36) is a candle wick holding grate comprising a base member (plate 42 and flange portions 58) with a plurality of apertures (60) formed in the base member and through each of which apertures a candle wick can be passed, and a plurality of grooves or notches (62) each of which can hold a candle wick after the wick has been passed through an aperture in the base member. The examiner further indicates with regard to the "whereby" clause of claim 13 that element (36) of Bolinger is inherently capable of being shipped with candles as a part of a shipping container.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we refer to the examiner's answer (Paper No. 26, mailed July 19, 1999) and to appellant's brief (Paper No. 25,

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filed June 18, 1999) for a full exposition thereof.

OPINION

Having carefully reviewed the anticipation issue raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejection of appealed claim 13 under 35 U.S.C. § 102(b) will be sustained. Our reasoning in support of this determination follows.

The only argument raised by appellant in this appeal (brief, pages 6-10) is that Bolinger does not anticipate appellant's presently claimed wick holding grate because the wording of claim 13 "with the addition of a whereby clause which narrows claim 13 down to a candle wick holding grate that-'can be shipped along with the candles as part of the shipping container' distinguishes the present invention over all prior art" (brief, page 8). In this regard, appellant recognizes (brief, pages 7-8) that the Bolinger element or grate (36) and the grate of claim 13 on appeal are similar, but urges that Bolinger does not recognize or teach that

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candles can be manufactured in glass candle containers or suggest that glass candle containers could be placed inside of his candle mold.

We find appellant's argument to be unpersuasive of any error on the examiner's part. Claim 13 on appeal is directed to a wick holding grate per se and not to candles manufactured in glass candle containers or to any combination of a wick holding grate and candles in glass candle containers arranged in a particular relationship in a shipping container. Like the examiner, it is our view that the wick holding element (36) of Bolinger Figure 8 is fully responsive to, and thus anticipatory of, the wick holding grate set forth in claim 13 on appeal. We also observe that the wick holding elements seen in Figures 9 and 16 of Bolinger appear to be fully responsive to the wick holding grate defined in appellant's claim 13. Like the examiner, we additionally find that the wick holding element (36) of Bolinger is clearly capable of being shipped along with the candles of Bolinger as part of a shipping container. In this regard, we note that the language of appellant's claim 13 requires no more than that the wick

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holding grate be in the same shipping container as the candles and does not require that the wick holding grate be oriented in any particular relationship to the candles.

An anticipation under 35 U.S.C. § 102(b) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element or limitation of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, we observe that the law of anticipation does not require that the reference teach what the appellant has disclosed but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983). While it is true that there is nothing in the Bolinger reference which expressly indicates that the wick holding element (36) may be used in the manner set forth in appellant's claim 13, i.e., shipped in a shipping container along with the candles, as we

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noted above, we agree with the examiner that element (36) disclosed by Bolinger is fully responsive to that set forth in claim 13 on appeal and is inherently capable of being used in the manner required in the whereby clause of appellant's claim 13, as are the wick holding elements seen Figures 9 and 16 of Bolinger also.

As was made clear in In re Schreiber, 128 F.3d at 1477, 44 USPQ2d at 1431, by choosing to define an element functionally as in appellant's whereby clause in claim 13 on appeal, appellant assumes a risk, that risk being that where the Patent and Trademark 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 upon. In the present case, appellant has provided no evidence to prove that the wick holding member of Bolinger lacks the functionally defined limitation set forth in claim 13 on appeal. We therefore agree with the

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examiner that the differences in the intended use of the wick holding element disclosed in Bolinger and appellant's wick holding grate do not patentably distinguish the claimed wick holding grate from the wick holding element of Bolinger.

For the above reasons, we will sustain the examiner's rejection of claim 13 under 35 U.S.C. § 102(b) as being anticipated by Bolinger, and the decision of the examiner is, accordingly, affirmed.

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

AFFIRMED

IAN A. CALVERT

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Administrative Patent Judge)	
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CHARLES E. FRANKFORT)	
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)	INTERFERENCES
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