

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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD C. BEESON JR. et al.

Appeal No. 2001-0386
Application No. 08/614,358

ON BRIEF

Before FRANKFORT, STAAB, 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 3, 4, 6 to 9, 11, 12, 14 to 20, 23, 24 and 26 to 34. Claims 5, 13 and 25 have been objected to as depending from a non-allowed claim. Claims 1, 2, 10, 21 and 22 have been canceled.

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

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BACKGROUND

The appellants' invention relates to a system for reducing water losses from overhead irrigation of multiple plant containers by capturing overhead water falling between adjacent plant containers and directing the water into the plant containers. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Delany 1878	205,252	June 25,
Coleman, Jr. 1957	2,785,508	Mar. 19,
Weigert 1992	5,142,818	Sep. 1,
Meharg 1993	5,184,421	Feb. 9,
Schneider 1992	DE 41 07 233 A1 ¹	Sep. 10,

¹ In determining the teachings of Schneider, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellants' convenience.

Claims 3, 4, 6, 9, 11, 12, 14 to 16, 18, 20, 23, 24, 26 to 28, 30 and 32 to 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Delany in view of Coleman, Jr.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Delany in view of Coleman, Jr. as applied above, and further in view of Meharg.

Claims 19 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Delany in view of Coleman, Jr. as applied above, and further in view of Schneider.

Claims 17 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Delany in view of Coleman, Jr. as applied above, and further in view of Weigert.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 15, mailed March 30, 2000) and the answer (Paper No. 18, mailed September 15, 2000) for the examiner's complete

reasoning in support of the rejections, and to the brief (Paper No. 17, filed July 28, 2000) and reply brief (Paper No. 19, filed November 6, 2000) 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 the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 3, 4, 6 to 9, 11, 12, 14 to 20, 23, 24 and 26 to 34. 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 would have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

All the claims under appeal define a system that includes a plurality of water collection means to capture overhead water and direct the overhead water to plant containers wherein the water collection means has an outer mating perimeter having mating edges configured to abut in a continuous, contiguous manner with corresponding mating edges of other water collection means, and where the mating edges of each water collection means are abutted with mating edges of adjacent other water collection means to form a continuous water capture surface such that all overhead water is captured and directed into the plant containers such that no water falls between adjacent plant containers. However, these limitations are not suggested by the applied prior art. In fact, in the rejections before us in this appeal (final rejection, p. 3), the examiner did not even find these limitations to have been obvious at the time the invention was made to a person of ordinary skill in the art. Instead, the examiner found, at best, that it would have been obvious at

the time the invention was made to a person of ordinary skill in the art to shape the outer perimeter of Delany's saucer as a square or polygonal, and that such a modification would result in a device **capable of** abutting against other like devices in a continuous or contiguous manner. However, the claims under appeal require more than such **capability**. As set forth above, the claims under appeal require a system wherein the devices (i.e., the water collection means of each container) abut to form a continuous water capture surface such that all overhead water is captured and directed into the plant containers such that no water falls between adjacent plant containers. However, none of the applied prior art teaches or suggests these limitations. Thus, the examiner's rejections have not been supported by evidence that would have led an artisan to arrive at the claimed invention.

In our view, the only suggestion for modifying Delany to arrive at the claimed invention stems from hindsight knowledge derived from the appellants' own disclosure and not the applied prior art. 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 Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 3, 4, 6 to 9, 11, 12, 14 to 20, 23, 24 and 26 to 34 under 35 U.S.C. § 103 is reversed.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 8, 23 to 32 and 34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the

metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

Dependent claim 8 is indefinite since it depends from independent claim 33 and recites that "each said sloping surface further comprises water relief apertures positioned near said outer mating perimeter." Claim 8 is indefinite since it conflicts with claim 33. In that regard, claim 8 recitation of "water relief apertures" which would permit overhead water to fall between adjacent containers conflicts with claim 33 recitation that "all overhead water is captured and directed into said main bodies of said containers such that no water falls between adjacent said containers."

Claims 23 to 32 and 34 are indefinite since claim 34 lacks proper antecedent basis for "said main bodies." Thus, the meaning of the phrase "all overhead water is captured and directed into said main bodies of said containers such that no water falls between adjacent said containers" is not clear. This rejection would be overcome if the above-noted phrase

were amended to read -- all overhead water is captured and directed into said containers such that no water falls between adjacent said containers --.

CONCLUSION

To summarize, the decision of the examiner to reject claims 3, 4, 6 to 9, 11, 12, 14 to 20, 23, 24 and 26 to 34 under

35 U.S.C. § 103 is reversed; and a new rejection of claims 8, 23 to 32 and 34 under 35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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