

Ex parte Damato

File

94-4242

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GINGER L. DAMATO

MAILED
DEC 18 1995
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 94-4242
Application 07/917,400¹

ON BRIEF

Before MEISTER, FRANKFORT and McQUADE, *Administrative Patent Judges.*

MEISTER, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 27-34 and 44-48, the only claims remaining in the application.

¹ Application for patent filed July 23, 1992. According to applicant, the application is a continuation of Application 07/585,520, filed September 20, 1990, now abandoned.

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At the outset we note that in the reply brief (Paper No. 16) the appellant made a request for an oral hearing; however, the appropriate fee of \$115 was not provided as required by 37 CFR 1.194(b). This being the case, the appellant's request for oral hearing is denied.

The appellant's invention pertains to a disposable plate having a means for receiving a beverage container. Independent claim 1 is further illustrative of the appealed subject matter and reads as follows:

1. A food support device with beverage support fixture comprising:

a plate means for supporting foodstuffs wherein said plate means is planar surface having a raised lip on an exterior circumference of said planar surface; and

said plate means formed of a rigid material having a stiffness sufficient enough to support a plurality of foodstuffs; and

a cavity defined within said plate means; and

a beverage container removable[sic, removably] inserted there within said cavity; and

wherein said beverage container is selected from the group consisting of a glass, a bottle, a cup and a can; and

said cavity further includes fingers extending in the plane of the plate means from an exterior perimeter of said cavity inward to the center of said cavity; and

said planar surface having a raised lip at said exterior perimeter of said cavity for preventing said foodstuffs from running down the sides of the beverage container; and

whereby when said beverage container is inserted into said cavity, said fingers deform into a second position to exert

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pressure on and resiliently grip said beverage container, thereby supporting said plate means on said beverage container, so that the beverage container provides sole support of said plate means via contact with said fingers of said cavity; and

wherein said cavity is defined adaptable to receive one of a plurality of containers of varying diameter; such that once said beverage container having a first diameter is inserted therein and removed, a second container having a second diameter different than said first diameter may be inserted while still supporting said plate means.

The reference of record relied on by the examiner is:

Morrow et al. (Morrow) 4,863,094 Sep. 5, 1989

The appealed claims stand rejected in the following manner.²

Claims 44-48 stand rejected under 35 U.S.C. 112, first paragraph, as being based upon an original disclosure which fails to provide descriptive support for the invention now being

² On page 3 of the answer examiner stated that the grounds of rejection "applicable" to the appealed claims are (1) claims 27-33 and 47 under 35 U.S.C. 103 based on the reference to Morrow as set forth in the final rejection and (2) a new ground of rejection of claims 1, 34, 44-46 and 48 (also under 35 U.S.C. 103 based on the reference to Morrow), but made no reference to the rejection of claims 44-48 under 35 U.S.C. 112, first paragraph, as set forth in paragraph 2 of the final rejection or to the rejection of claims 27-48 under 35 U.S.C. 112, second paragraph, as set forth in paragraph 4 of the final rejection. The examiner, however, did respond to the appellant's arguments concerning the § 112 rejections (see answer, pages 5-8) and we therefore presume that they are maintained and the examiner's lack of mention thereof under the heading of rejections "applicable" to the appealed claims in the answer to be an inadvertent oversight. On pages 1 and 2 of the answer the examiner has also expressly withdrawn "all" of the rejections based on the reference to Patterson as well, as the rejection of claims 1, 34, 44-46 and 48 under 35 U.S.C. 102(b) as being anticipated by Morrow.

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claimed. According to the examiner, the specification as originally filed does not provide support for the recitation that the fingers resiliently "snap back" into their original or first position when a beverage container is removed from the cavity.

Claims 1, 27-34 and 44-48 stand 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 appellant regards as the invention.³ The rationale for this rejection is set forth on page 3 of final rejection and clarified in the paragraph bridging pages 7 and 8 of the answer.

Claims 1, 27-34 and 44-48 stand rejected under 35 U.S.C. 103 as being unpatentable over Morrow. According to the examiner

Morrow et al shows all of the structural features of the claims but for the plate being circular (as may be implied from the use of the word "circumference" in line 5 of claim 1 for example, and as expressly stated in line 5 of claim 46), for the raised lip at the exterior perimeter of the cavity and for the partition of claim 34. However, it would have been obvious to construct the plate 11 of Morrow et al in various

³ In setting forth this ground of rejection in paragraph 4 of the final rejection the examiner made reference to claims "27-48," however, it is readily apparent from the remainder of this paragraph that the rationale for the rejection was in part bottomed on language appearing in claim 1 and, accordingly, claim 1 was intended to be included. Indeed, on page 4 of the brief the appellant states that she "assumes" this to be the case and thus is not prejudiced by this interpretation. We also observe that claims 35-43 had been cancelled prior to the final rejection (see the amendment filed on April 23, 1993 (Paper No. 8)).

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shapes such as round for aesthetic reasons, or to better conform the plate to round items such as some pies and cakes. It would also have been obvious to provide a raised lip at the perimeter of cavity 26 in order to prevent food on the plate from becoming lodged in or falling through the cavity, especially since as evidenced from rais[ed] lip 17 of Morrow et al (shown in Fig 1 at the exterior perimeter of the plate), the use of raised lips on edges of plates to confine foods and other items thereon is conventional. Finally, it would have been obvious in order to conveniently separate food items thereon to provide the tray of Morrow et al with a partition. (see answer, page 4)

Rather than reiterate the arguments of the appellant and examiner in support of their respective positions, reference is made to the brief, reply brief, answer and supplemental answer for the full exposition thereof.

OPINION

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and reply brief, and by the examiner in the answer and supplement answer. As a consequence of this review, we will sustain the rejection of claims 44-48 under 35 U.S.C. 112, first paragraph. We will not, however, sustain the rejections of claims 1, 27-34 and 44-48 under 35 U.S.C. 112, second paragraph, (for the reasons stated by the examiner) or under 35 U.S.C. 103. Additionally, pursuant to our authority under the provisions of 37 CFR 1.196(b) we will enter a

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new rejection of claims 1, 27-34 and 44-48 under the second paragraph of § 112. Our reasons for these determination follow.

Considering first the rejection of claims 44-48 under 35 U.S.C. 112, first paragraph, as being based upon a disclosure which fails to satisfy the description requirement of that paragraph, we initially note that the description requirement found in the first paragraph of 35 U.S.C. 112 is separate from the enablement requirement of that provision. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991) and *In re Barker*, 559 F.2d 588, 194 USPQ 470 (CCPA 1977). As the court stated in *Vas-Cath Inc. v. Mahurkar* at 19 USPQ2d 1117

35 U.S.C. 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the "written description" inquiry, *whatever is now claimed*.

...drawings alone *may* be sufficient to provide the "written description of the invention" required by §112, first paragraph. (emphasis in original)

Although the claimed invention does not necessarily have to be expressed in *ipsis verbis* in order to satisfy the description requirement (*see In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976)), it is nonetheless necessary that the disclosed apparatus inherently perform the functions now claimed. Note *In re Smythe*,

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480 F.2d 1376, 178 USPQ 279 (CCPA 1973). The fact one skilled in the art might realize from reading a disclosure that something is possible is not a sufficient indication to that person that the something is a part of an appellant's disclosure. *See In re Barker, supra*. Precisely how close the original description must come to comply with the description requirement must be determined on a case-by-case basis. The primary consideration is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure. *See Vas-Cath Inc. v. Mahurkar, supra*.

Here, independent claims 44 and 46 each expressly set forth "resilient fingers" which extend **in the plane** of either a "plate means" (which is defined as having a "planar surface") in the case of claim 44 or a "horizontal planar circular surface" in the case of claim 46 while in a first position and thereafter further specify that the fingers "deform" (to a second position) to grip a beverage container, but "snap back" into the first position upon removal of the beverage container. In other words, claims 44 and 46 each expressly require that fingers "snap back" into the **plane** of a planar surface.

The appellant does not dispute the examiner's position that there is no literal support in the original disclosure for the "snap back" limitation but, instead, argues that adequate support for this limitation may be found in the original disclosure by

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virtue of the fact that the fingers were described therein as being "resilient" (i.e., by virtue of being resilient they will "snap back" in the claimed manner). This argument is nonpersuasive. We recognize it has been held that the written description requirement may be satisfied when the later claimed subject matter constitutes an **inherent** property of the subject matter described in the originally filed disclosure (*see, for example, In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971)); however, as the court stated in *Langer v. Kaufman*, 465 F.2d 915, 918, 175 USPQ 172, 174 (CCPA 1972)⁴, when inherency is argued

the burden is on appellants to show that the "**necessary and only** reasonable construction to be given the disclosure by one skilled in the art is one which will lend clear support to ... [the claimed] positive limitation..." (emphasis ours).

Here, the appellant has not satisfied this burden. It does not follow that just because the fingers are characterized as "resilient," that the **necessary and only** reasonable construction is they will "snap back" into a position in the plane of the planar surface as the claims set forth. In an attempt to support her position, the appellant on page 3 of the brief sets forth a dictionary definition of "resilient" as being "tending to recover

⁴ While the issue in *Langer* was entitlement to the benefit of constructive reduction to practice in an interference proceeding, the "concept" regarding "written description" in *ex parte* cases is the same. *See Vas-Cath Inc. v. Mahurkar, supra*, at 19 USPQ2d 1116, 1117.

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from or adjust easily to misfortune or change" (emphasis in original). We must point out, however, "tending to recover" is not synonymous with "full recovery." For example, the fingers could only go part way back, or even go back very slowly to their original position, and thus satisfy the appellant's dictionary definition, but yet not "snap back" as claimed. Particularly in view of the fact the appellant has set forth in the original specification that her food support device "may be formed from ordinary materials such as fiberboard, paper, styrofoam, or various plastics of whatever is adaptable to providing rigid support" (see specification, page 5), we are not of the opinion that the **necessary and only** reasonable interpretation to be derived from the recitation that the fingers are "resilient," is that they will "snap back" in the claimed manner. This being the case, we will sustain the examiner's rejection of claims 44-48 under 35 U.S.C. 112, first paragraph.

Turning to the rejection of claims 1, 27-34 and 44-48 under 35 U.S.C. 112, second paragraph, it is the examiner's position that

[c]laim 1 explicitly recites that structurally the fingers are in the plane of the plate means, while also implicitly stating that the fingers are bent out of the plane of the plate means (by virtue of the recitation in the claim that the beverage container is removably inserted within the cavity). Either the fingers are in the plane of the plate means or bent out of the plane of the plate means, but it does not appear that the fingers could assume both configurations

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simultaneously, as the claims seem to suggest. (see answer, pages 7 and 8)

Presumably, the examiner intended the above-noted criticism to also apply to independent claims 44 and 46. In any event, we do not support the examiner's position. The claims do not require that the fingers "simultaneously assume both configurations" as the examiner contends. Instead, each of the independent claims make it very clear that it is only when the beverage container is inserted or received in the cavity that the fingers go from the first configuration to the second configuration (see claim 1, lines 20 and 21; claim 44, lines 14-16; claim 46, lines 14-17). This being the case, we will not sustain the examiner's rejection of claims 1, 27-34 and 44-48 under 35 U.S.C. 112, second paragraph.

Turning to the rejection of claims 1, 27-34 and 44-48 under 35 U.S.C. 103 as being unpatentable over Morrow, we have carefully considered the subject matter defined by these claims. However, for reasons stated *infra* in our new rejections entered under the provisions of 37 CFR 1.196(b), no reasonably definite meaning can be ascribed to certain language appearing in the claims. In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection on prior art cannot be based

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on speculations and assumptions (*see In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970)), we are constrained to reverse the examiner's rejections of claims 1, 27-34 and 44-48 under 35 U.S.C. 103. We hasten to add that this is a technical reversal rather than one based upon the merits of the Section 103 rejection.

Under the provisions of 37 CFR 1.196(b) we make the following new rejection.

Claims 1, 27-34 and 44-48 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject which the appellant regards as the invention. In order to satisfy the second paragraph of Section 112, a claim must accurately define the claim in the technical sense. *See In re Knowlton*, 481 F.2d 1357, 178 USPQ 486 (CCPA 1973). Moreover, while the claim language of claims 1, 27-34 and 44-48 may appear, for the most part, to be understandable when read in abstract, no claim may be read apart from and independent of the supporting disclosure on which it is based. *See In re Cohn*, 438 F.2d 989, 169 USPQ 95 (CCPA 1971). Applying these principles to the present case, we do not believe that the metes and bounds of these claims can be accurately determined. *See In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) and *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970).

Each of the independent claims set forth either (1) a plate means having a planar surface (claims 1 and 44) or a single horizontal planar surface (claim 46) and (2) "fingers extending **in the plane**" (emphasis ours) of either the plate means (claims 1 and 44) or horizontal planar surface (claim 46), which fingers are further specified as extending "inward to the center of said cavity" (claims 1, 44 and 46; emphasis ours). According to the appellant's disclosure the fingers are deployed in two different arrangements or embodiments, i.e., the embodiment of Figs. 1-4 or the embodiment of Figs. 14-16. In the embodiment of Figs. 1-4 there is a cavity, but the fingers neither extend **in the plane of the planar surface** nor do they extend **to the center** of anything (much less to the center of the cavity as required by each of the independent claims). In the embodiment of Figs 14-16, the fingers extend **to the center** of the plate, but there is no cavity. While, of course, a cavity is created when the perforations are broken and a beverage container is inserted, when the cavity is created the fingers would not extend **to the center** of the cavity as claimed. Thus, it does not appear that the independent claims read on **any** of the disclosed embodiments. Moreover, it is not apparent how a planar surface can be considered to **have** a "raised lip" as each of the independent claims set forth since, by definition, a planar surface is flat. Still further, a **cavity** cannot be considered to "include" fingers as

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independent claims 1 and 44 set forth since a cavity is a "space" (compare to claim 46 wherein it is correctly set forth that the cavity is **defined by** the fingers). Accordingly, the language of each of the independent claims, when read in light of the specification, results in an inexplicable inconsistency that renders them indefinite.

In summary:

The examiner's rejection of claims 44-48 under 35 U.S.C. 112, first paragraph, is affirmed.

The examiner's rejections of claims 1, 27-34 and 44-48 under 35 U.S.C. 112, second paragraph, and 35 U.S.C. 103 are reversed.

A new rejection of claims 1, 27-34 and 44-48 is made under 35 U.S.C. 112, second paragraph.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 CFR 1.197).

With respect to the new rejection under 37 CFR 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, in order to preserve the

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