

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD E. DEAL JR.

Appeal No. 97-1088
Application 08/518,957¹

ON BRIEF

Before MEISTER, FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1, 3, 4, 6, 10 through 13 and 19 through 25, all of the claims pending in the application.

¹ Application for patent filed August 24, 1995. According to appellant, the application is a continuation of Application 08/269,915, filed June 30, 1994, now abandoned.

Appeal No. 97-1088
Application 08/518,957

Reference is made to the appellant's main and reply briefs (Paper Nos. 18 and 20) and to the examiner's answer (Paper No. 19) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

West discloses a label for containers, bottles or the like wherein the symbols and/or lettering on the label "are made pronounced and luminous so as to afford a signal or warning of the character of the contents of such container, bottle or the like . . . to prevent a person from mistaking the nature of the contents, particularly where the same be of a poisonous kind" (column 1, lines 6 through 12). As described by West,

[t]he label comprises an outer body section 5, preferably made from sheet material, for example, celluloid, having transparence and this section has outstruck therefrom letters 6, these being selective and in this instance spell the word "Poison" the character of the letters 6 being of no consequence excepting that such letters shall be raised from the outer face of the section 5 and contain within the hollows 7 of such letters as created by the outstruck formation thereof a compound 8 of self-luminous substance or radio active substances, the same being held in the hollows by a backing 9 in the form of a sheet of material carrying a coat of black paint 10 the latter extending over the body section and functioning to secure the backing to the body section and the label in its entirety upon the body of the bottle A [column 2, lines 4 through 21].

With regard to the standing 35 U.S.C. § 102(b) rejection of claims 1, 3, 4, 11 through 13, 19 and 22 through 25, anticipation

Appeal No. 97-1088
Application 08/518,957

is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). In this regard, during patent prosecution claims are given their broadest reasonable interpretation consistent with the underlying specification without reading limitations from the specification into the claims. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

In light of these principles, the examiner's determination that West meets all of the limitations in appealed claim 1 (see page 3 in the answer) is well founded. More particularly, the limitations in this claim relating to the container, the panel member and the plurality of elongated solid beads read on West's bottle A, outer body section 5 and self-luminous compound 8, respectively.

Appeal No. 97-1088
Application 08/518,957

The appellant's arguments to the contrary rest on a purported failure of West to meet the elongated solid bead limitations. In this regard, the appellant submits that "West does not have a 'bead' which is a separate element from the panel section 5" (main brief, page 7), that West's compound 8 "is shown in the drawings to be a particulate, which is not elongated and which does not form a solid bead" (main brief, page 8), and that "[t]he raised lettering of West is not intended to be a gripping surface" (main brief, page 9). None of these arguments is persuasive.

To begin with, claim 1 does not actually call for the beads to be "separate" from the panel member. In any event, however, West's compound 8 and panel member or body section 5 are certainly "separate" under the ordinary and accustomed meaning of this term.³ The compound 8 as it exists in the West label also forms elements which can reasonably be described as being "solid beads" under the ordinary and accustomed meanings of these

³ Webster's New Collegiate Dictionary (G. & C. Merriam Co. 1977) defines the term "separate" as meaning "existing by itself" or "dissimilar in nature or identity."

Appeal No. 97-1088
Application 08/518,957

terms.⁴ Moreover, there is nothing in West's drawings, or in any other part of the West disclosure, which supports the appellant's assertion that the compound 8 is a particulate. Finally, although West does not expressly describe the raised lettering, which is formed in part by the compound 8, as a gripping surface, it is not apparent, nor has the appellant pointed out, why such raised lettering is not inherently capable of being used to grip the bottle A to which it is applied.

Thus, the appellant's position that the subject matter recited in claim 1 is not anticipated by West is not convincing. Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of this claim.

We also shall sustain the standing 35 U.S.C. § 102(b) rejection of claims 4, 22, 24 and 25, which depend from claim 1, as being anticipated by West since the appellant has not argued such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 1 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

⁴ Webster's New Collegiate Dictionary (G. & C. Merriam Co. 1977) defines the term "solid" as meaning "being without an internal cavity" or "not interrupted by a break or opening," and the term "bead" as meaning "a projecting rim, band, or molding."

Appeal No. 97-1088
Application 08/518,957

We shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 3, 11 through 13, 19 and 23 as being anticipated by West.

Claim 3 depends from claim 1 and requires the panel member to engage the container between adjacent beads. Claim 23 also depends from claim 1 and requires the beads to have a rear surface engageable with the exterior surface of the container. West's outer body section/panel member 5 and compound/beads 8 do not engage the bottle or container A associated therewith. In this regard, the examiner's finding that the backing component 9 of West's label forms the exterior of the bottle A (see page 3 in the answer) is inconsistent with the express teachings of West and is completely unreasonable. Independent claim 11 requires that the beads be "formed separately from the . . . panel member." As is evident from the passages from the West disclosure reproduced above, the compound 8 as it exists in the West label is not formed separately from the outer body section 5. Thus, West does not meet all of the limitations in claim 11, or in claims 12, 13 and 19 which depend therefrom.

We shall not sustain the standing 35 U.S.C. § 103 rejection of claim 6, or of claim 10 which depends therefrom, as being unpatentable over West. In short, West does not teach and would

Appeal No. 97-1088
Application 08/518,957

not have suggested a method meeting the limitations in claim 6 requiring the steps of placing a plurality of solid beads adjacent the exterior surface of an object and applying a label over the beads and to the object so as to provide a horizontally ribbed label surface. Although West's label does include a ribbed surface, such is formed via a method which differs substantially from that recited in claim 6.

Nor shall we sustain the standing 35 U.S.C. § 103 rejection of claim 20 as being unpatentable over West. Claim 20 depends from claim 1 and requires the beads to be made of plastic or paper. The West reference would not have suggested, and indeed appears to teach away from, replacing the compound/beads 8 of self-luminous or radio active substances disclosed therein with plastic or paper.

Finally, we shall sustain the standing 35 U.S.C. § 103 rejection of claim 21 as being unpatentable over West. Claim 21 depends from claim 1 and requires the beads to be made of non-particulate material. The examiner's conclusion that it would have been obvious to make West's compound/beads 8 of a non-particulate material (see page 3 in the answer) is reasonable on its face. As discussed above, the appellant's assertion that West teaches the compound 8 to be made of a particulate material

Appeal No. 97-1088
Application 08/518,957

lacks any factual support.

In summary, the decision of the examiner to reject claims 1, 3, 4, 6, 10 through 13 and 19 through 25 is affirmed with respect to claims 1, 4, 21, 22, 24 and 25, and reversed with respect to claims 3, 6, 10 through 13, 19, 20 and 23.

AFFIRMED-IN-PART

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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Appeal No. 97-1088
Application 08/518,957

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