

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(2) is not binding precedent of the Board.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 FRANO LUBURIC
and
ROBERT R. ROPER

Appeal No. 97-2712
Application 08/285,349¹

ON BRIEF

Before CALVERT, COHEN and MEISTER, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

¹ Application for patent filed August 3, 1994.

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DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 14, 16, 17, and 19 through 24. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to a container, a plastic injection-molded bucket, and to a method of storage of materials. An understanding of the invention can be derived from a reading of exemplary claims 1, 9, and 24, copies of which appear in the APPENDIX to appellants' brief (pages 15 through 18 of Paper No. 16).

As evidence of obviousness, the examiner has applied the documents listed below:

Chadwick	1,436,754	Nov. 28, 1922
Koefeldt et al. (Koefeldt)	5,292,024	Mar. 8, 1994
French Patent Application (French Patent) ²	73.27848	Mar. 8, 1974

² Our understanding of this document is derived from a reading of a translation thereof prepared in the United States Patent and Trademark Office. A copy of the translation is appended to this opinion.

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The following rejections are before us for review.

Claims 1 through 14, 16, 17, 19 through 22, and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over the French Patent in view of Chadwick.

Claim 23 stands rejected under 35 U.S.C. § 103 as being unpatentable over the French Patent in view of Chadwick, as applied above, further in view of Koefeldt.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 17), while the complete statement of appellants' argument can be found in the brief (Paper No. 16).

OPINION

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In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims,³ the applied teachings,⁴ and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We reverse each of the examiner's respective rejections of appellants' claims under 35 U.S.C. § 103.

In our opinion, the combined teachings of the French Patent and the Chadwick reference would not have been suggestive to one having ordinary skill in the art of the modification proposed by the examiner. Simply stated, we perceive no reason for

³ Claim 24 sets forth a "generally rectangular external shape" for the external ring means (specification, page 9). However, we note that the appearance of the ring means in the drawing (Figure 1) is generally square.

⁴ In our evaluation of the applied teachings, we have considered all of the disclosure of each teaching for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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altering the shape of the packaging (container) of the French Patent on the basis of the Chadwick disclosure, as proposed. In particular, it appears to us that such a modification would not have been undertaken by an artisan since a conically shaped

side wall would not permit the packaging to maintain disclosed significant relationships between the internal casing and the external casing, i.e., the interface between pull tabs 10 and ribs and guides 15, 16, and the interface between flexible and elastic projection tabs 17N that catch in breaking lines 7.

While the patent to Koefeldt clearly teaches a plastic pail with flat surfaces thereon for mating with flat surfaces of adjacent pails to prevent relative movement therebetween, and a draft angle for the sidewalls of the pails to allow the pails to be easily empty nested for more compact storage and transport, this document nevertheless does not overcome the deficiency discussed above relative to the teachings of the French Patent and the Chadwick document.

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NEW GROUNDS OF REJECTION

Under the authority of 37 CFR § 1.196(b), this panel of the board introduces the following new grounds of rejection.

Claims 4 and 24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.⁵ The language "two or more" in its context of usage in claim 4, line 3, is not understood, rendering the claim indefinite in meaning. As to claim 24, the preamble indicates a "method of storage of materials," however, the body of the claim fails to include a step providing material to the specified containers. Thus, what is being claimed is in doubt. We also note an inconsistency in claim 24 in the recital of "external ring means" (line 6) and "said shoulder means" (lines 7, 8, and 10).

⁵ 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).

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by the Chadwick patent.⁶ More specifically, the claimed container reads on the protector disclosed by Chadwick (Fig. 3), which protector is clearly capable of being nestable with other containers of the same size.

Claims 2 through 5 and 9 through 11 are rejected under 35 U.S.C. § 103 as being unpatentable over Chadwick in view of the French Patent.⁷ In our opinion, it would have been obvious

⁶ Anticipation under 35 U.S.C. 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Paulsen, 30 F.3d 1475, 1478-1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims "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); cert. denied, 465 U.S. 1026 (1984).

⁷ The test for obviousness is what the combined teachings of references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). However, it must also be kept in mind that an obviousness question cannot be approached on the basis that an artisan having ordinary skill would have known only what they read in references, because such artisan must be presumed to know
(continued...)

to one having ordinary skill in the art to replace the tearable single strip configuration of Chadwick (Figure 3) with a known alternative tearable multiple strip configuration, as disclosed by the French Patent. As we see it, the motivation for this

modification on the part of one having ordinary skill in the art would have simply been to obtain the self-evident benefit of being able to selectively remove one strip at a time rather than having a single strip dangling down as it is progressively torn from the remaining portion thereof. The subject matter of dependent claims 2, 4,⁸ and 5 would be addressed by the modified nestable protector of Chadwick. As to the recitation of injection molding (claims 3 and 9) and plastic (claim 9), we view

⁷(...continued)
something about the art apart from what the references disclose. See In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). Further, a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

⁸ While we have determined that claim 4 is indefinite, supra, we apply prior art thereto since we understand the claim to the extent that it does require one or more supplementary scoreline means, a feature clearly shown in the French Patent.

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the choice of a known synthetic material, such as plastic, and the selection of the common fabrication technique of injection molding, as being a basic and routine matter of design choice for one having ordinary skill in the art, particularly in light of the selection of a synthetic material in the French Patent. Read in light of appellants' disclosure of "containers or buckets" (specification, page 6),⁹ we consider the recitation of a

"bucket" (claim 9) as broadly denoting an alternative expression for the term "container"; this view is buttressed by the underlying disclosure which fails to include any defining aspects of a bucket relative to a container. Based upon our above analysis, we also determine that the content of claims 9 through 11 would have been suggested by the applied evidence of obviousness.

In summary, this panel of the board has:

⁹ In proceedings before the Patent and Trademark Office, claims in an application are given their broadest reasonable interpretation consistent with the specification. Additionally, claim language is read in light of the specification as it would be interpreted by one of ordinary skill in the art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

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reversed the rejection of claims 1 through 14, 16, 17, 19 through 22, and 24 under 35 U.S.C. § 103 as being unpatentable over the French Patent in view of Chadwick; and

reversed the rejection of claim 23 under 35 U.S.C. § 103 as being unpatentable over the French Patent in view of Chadwick and Koefeldt.

Additionally, we have introduced NEW GROUNDS OF REJECTION.

The decision of the examiner is reversed.

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

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37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 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)

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IAN A. CALVERT)
Administrative Patent Judge)
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IRWIN CHARLES COHEN)
Administrative Patent Judge)
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JAMES M. MEISTER)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
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