

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTONIO DELEON YAP

Appeal No. 97-2725
Application 08/138,456¹

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge, and
COHEN and ABRAMS, Administrative Patent Judges.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final
rejection of claims 1 through 9 and 22. The only other claims

¹ Application for patent filed October 15, 1993.

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still pending in the application have been withdrawn from consideration as not being directed to the elected invention.

The invention disclosed in appellant's application relates to an indicator plate structure 10 which is adopted to be placed in the ground adjacent to the inlet I of a petroleum storage tank T. The indicator plate structure comprises a molded plate member 20 (defined as a molded primary mass in the appealed claims) and a plurality of exposed indicator elements 30 embedded in the plate member and arranged in a coded pattern for identifying the particular petroleum product to be stored in the associated tank. In appealed claim 1, the indicator structure is defined as a "storage tank label," and in claim 22, the only other independent claim on appeal, the indicator structure is defined as a "content identifier."

A copy of the appealed claims is appended to appellant's brief.²

² Contrary to the examiner's statement on page 3 of the answer, the copy of claim 1 in the appendix to appellant's brief is incorrect in that it recites that the inlet cover "obtrudes" the conduit, rather than reciting that the cover obturates the conduit.

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The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Matvey	3,758,999	Sep. 18, 1973
usuki et al. (Susuki)	3,908,055	Sep. 23, 1975
Ptashinski	4,915,055	Apr. 10, 1990
Turner	5,056,454	Oct. 15, 1991
Burns	5,420,797	May 30, 1995

Claims 1 through 4 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Susuki in view of Turner and Burns, claims 5 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Susuki in view of Turner, Burns and Matvey, and claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Susuki in view of Turner, Burns and Ptashinski. Claims 1 through 9 and 22 additionally 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 appellant regards as his invention. Reference is made to the examiner's answer for details of these rejections.

In traversing the final rejection of claim 1 under the second paragraph of § 112, appellant unequivocally urges on

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page 10 of the brief that the "label or indicator is recited in combination with the inlet cover and the storage tank." Appellant also contends that the scope of the preamble of claim 1 is consistent with the scope of body of the claim in the sense that both the preamble and the body of the claim are directed to the foregoing combination. Given this argument, appellant is bound by this interpretation of the claim. Indeed, the only reasonable interpretation which can be placed on the recitation that the label is "placed adjacent to an inlet . . ." (emphasis added) in the preamble of the claim and further that the primary mass is "placed adjacent an inlet cover . . ." (emphasis added) in the body of the claim is that claim 1 is directed to the combination of the label with the inlet cover and the storage tank.

In his answer (see page 10), the examiner agrees with the foregoing interpretation of claim 1 and expressly withdraws his earlier criticism concerning the lack of consistency between the preamble and the body of claim 1. The only remaining criticisms of claim 1 concern the recitation of "the surface" in lines 9 and 10 and the recitation of "a conduit" in line 11 of the claim.

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As correctly pointed out by the examiner, three different surfaces are recited in the portion of claim 1 preceding the recitation of "the surface" in lines 9 and 10. However, it is apparent from the claim language, particularly the context in which "the surface" is used, that "the surface" refers back to the vehicle support surface and not to any surfaces of the primary mass. Accordingly, the lack of strict antecedent basis in this instance does not render the claim indefinite.

With regard to the recitation of the term "a conduit" in line 11 of claim 1, the examiner has confused indefiniteness with breadth. The recitation of "a conduit" in line 11 is broad enough to read on one of the conduits recited in line 2 or, alternatively, a conduit that is separate from the conduits recited in line 2.

Given the foregoing analysis of the claim language, claim 1 is definite to comply with the requirements of § 112, second paragraph, in that it defines the metes and bounds of the invention with a reasonable degree of precision. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). Accordingly, we cannot not sustain the examiner's rejection of claims 1 through 9 under the second paragraph of § 112.

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With regard to the rejection of claim 22 under the second paragraph of § 112, we agree with the examiner that the preamble of this claim is directed to the "content identifier" per se in that the subject matter claimed as appellant's invention is recited to be "[a] content identifier," not the combination of the content identifier with other elements, such as the storage tank or the storage tank inlet. However, the examiner's cropped quotation of the claim language as set forth on page 4 of the answer conveys the erroneous impression that the body of the claim is directed to the combination of the content identifier and the storage tank. In this regard, claim 22 does not positively recite that the storage tank is located adjacent to the indicator means. Instead, the claim merely calls for an indicator means for "unequivocally [sic, uniquely?] identifying the specific type of petroleum product to be delivered to an adjacently located storage tank." This limitation does not positively define the tank as being in combination with the content identifier.

Accordingly, we cannot agree with the examiner that the scope of the body of claim 22 is inconsistent with the scope of the preamble of the claim. As compared with claim 1, claim 22 is directed to the content identifier per se, not the

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combination of the identifier with the storage tank. This interpretation of the claim language is supported by the recitation in line 6 that the primary mass is merely "attachable" (emphasis added), not actually attached, adjacent to the inlet cover.

As for the examiner's additional ground supporting his rejection of claim 22 under the second paragraph of § 112 (see page 5 of the answer), his remarks concerning the placement of the indicators in the primary mass confuses indefiniteness with breadth. Obviously, the pattern for identifying a particular petroleum product is arbitrarily selected. However, the claim is not rendered indefinite simply because it does not define that particular pattern.

Based on the foregoing analysis of the claim language, we conclude that claim 22 is also definite in that it defines the metes and bounds of the invention with a reasonable degree of precision. See Venezia, supra. Accordingly, we cannot not sustain the examiner's rejection of claim 22 under the second paragraph of § 112.

With regard to the examiner's § 103 rejections of claims 1 through 9, the applied references are devoid of any suggestion of placing Susuki's road-embedded block-shaped sign

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adjacent to an inlet cover which obturates the conduit leading to a petroleum storage tank. In the final analysis, the only way the examiner could have arrived at his conclusion of obviousness with regard to the combination claims 1 through 9 is through hindsight based on appellant's teachings. Hindsight analysis, however, is clearly improper. In re Deminski, 796 F.2d 436, 443, 230 USPQ 313, 316 (Fed. Cir. 1986). As a consequence, we also cannot sustain the examiner's § 103 rejections of claims 1 through 9.

We will, however, sustain the examiner's § 103 rejection of claim 22. Unlike claim 1, claim 22 is not directed to the combination of the content identifier with other elements such as the removable inlet cover; nor does claim 22 require the primary mass to actually be placed or attached adjacent to the inlet cover. Instead, claim 22, merely requires the primary mass to be "attachable" (emphasis added) to the inlet cover as discussed supra. When this language is given its broadest reasonable interpretation (See In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)), it merely requires the primary mass to be capable of being attached adjacent to the inlet cover. As such, this claim limitation does not

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distinguish from Susuki inasmuch as the block-shaped sign shown in Figure 2 of the Susuki drawings is also inherently capable of being attached adjacent to an inlet cover particularly since the patentee discloses that the block-shaped sign is intended to be embedded in a vehicle-supporting road surface.

The fact that Susuki may not expressly disclose the attachment of his block-shaped sign at such a location is of no moment as long as it is inherently capable of being attached at such a location. See, inter alia, Standard Havens Prods. Inc.

v. Gencor Indus. Inc., 953 F.2d 1360, 1369, 212 USPQ2d 1321, 1328 (Fed. Cir. 1991).

With further regard to claim 22, appellant does not appear to challenge the examiner's findings on page 5 of the answer that Susuki's block-shaped sign is in the form of an indicator comprising a primary molded mass 11 (see column 2, lines 3-4 of the Susuki specification) having a top surface. Appellant also does not appear to challenge the examiner's findings on page 5 of the answer that Susuki has visible indicator means in the form of elements 10 embedded in the

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primary mass and having a top wall. Appellant also does not take issue with the examiner's implicit findings that the top surface of the block-shaped sign is defined by the top surfaces of the primary mass and the indicator means in the position shown in Figure 2 of the patent drawings. Instead, the only reference to claim 22 in the argument section concerning the § 103 rejections is found on page 20 of the brief where the only argument regarding claim 22 itself, as distinguished from claim 1 (which, as noted supra, is of distinctly different scope), is that the content identifier "is mounted adjacent to the inlet conduit cover and that it supports vehicular traffic and is wear resistant." These arguments are without merit.

In the first place, claim 22 merely recites that the primary mass is "attachable" adjacent to the inlet cover. It does not, however, recite that the identifier "is mounted adjacent to the inlet conduit cover" as argued by appellant. Claim 22 also does not recite that the identifier is "wear resistant." Since these features have not been claimed in claim 22, they may not be relied upon to support patentability of that claim. See In re Self, 671 f.2d 1344, 1348, 231 USPQ

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1, 5 (CCPA 1982) and In re Richards, 187 F.2d 643, 645, 89
USPQ 64, 66 (CCPA 1951).

Furthermore, contrary to the implications of appellant's arguments on page 20 of the brief, Susuki's block-shaped sign is not only capable of supporting vehicular traffic but is obviously intended to support such traffic for the embodiment shown in Figure 2 of the patent drawings. Also, it is apparent from Figure 2 of Susuki's patent drawings that the identifier elements 10 maintain an indicating capability after the top surface of the block has worn away. It is also apparent that the illustrated number of elements 10 in Figure 2 of Susuki's patent is inherently capable of arbitrarily identifying a specific type of petroleum product, which is all that is required to meet this limitation in claim 22. Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d at 1369, 212 USPQ2d at 1328 (Fed. Cir. 1991).

Finally, the intended use statement in the preamble of claim 22 is not germane to the patentability of the identifier itself. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985), In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967) and In re Lemin, 326

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F.2d 437, 440, 140 USPQ 273, 276 (CCPA 1964). In any event, Susuki's block-shaped sign clearly is inherently capable of being used to identify a specific type of petroleum product in the manner stated in the preamble of claim 22.

Based on the foregoing analysis, we are satisfied that this Susuki expressly or inherently discloses all of the limitations in claim 22 to thus anticipate the subject matter of claim 22. See RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). The rejection of this claim under § 103 is nonetheless proper since anticipation is the epitome of obviousness. See In re May, 574 F.2d 1082, 1099, 197 USPQ 601, 607 (CCPA 1978).

In summary, the examiner's decision rejecting claims 1 through 9 and 22 under the second paragraph of § 112 is reversed, the examiner's decision rejecting claims 1 through 9 under § 103 is also reversed, and the examiner's decision rejecting claim 22 under § 103 is affirmed.

AFFIRMED-IN-PART

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