

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK F. McATARIAN

Appeal No. 1998-0030
Application No. 08/151,960¹

ON BRIEF

Before KRASS, NASE, and DIXON, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3, 8 and 9. Claims 13 to 20 have been allowed. Claims 4 to 7 and 10-12, the remaining claims pending in this application, have been objected to as depending from a non-allowed claim.

¹ Application for patent filed November 15, 1993.

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We REVERSE.

BACKGROUND

The appellant's invention relates to a land-based spill-containment tank for receiving spilled liquids. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

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

Frost 1939	2,150,620	Mar. 14,
Van Romer 31, 1994 ²	5,316,175	May

Claims 1 to 3, 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Van Romer in view of Frost.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

² The effective filing date of this patent is November 5, 1992. Accordingly, this patent is prior art under 35 U.S.C. § 102(e).

rejection, we make reference to the answer (Paper No. 20, mailed June 19, 1997) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 19, filed April 7, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification³ and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us,⁴ it is our conclusion that the evidence adduced by the examiner is

³ We note that AMENDMENT PRIOR TO FIRST OFFICE ACTION, filed July 11, 1994 (attached to a Request for Reconsideration of Petition to Obtain Filing Date, Paper No. 5) has not been entered as of the date of this decision. The August 11, 1994 Decision on Request for Reconsideration (Paper No. 6) states that this amendment "will be entered in due course." The examiner is requested to take appropriate steps to ensure that this amendment is entered.

⁴ The product brochure on band-type folding referred to on page 4 of the brief and page 5 of the amendment, filed January 26, 1995 (Paper No. 8) has not been considered since a copy thereof is not located in the application's filewrapper.

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 1 to 3, 8 and 9 under 35 U.S.C. § 103. 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). Additionally, as set forth in Manual of Patent Examining Procedure (MPEP) § 2141 "Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case" and that Office policy has consistently been to follow Graham v.

John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) in the consideration and determination of obviousness under 35 U.S.C. § 103. The four factual inquires enunciated therein as a background for determining obviousness are briefly as follows: (A) Determining of the scope and contents of the prior art; (B) Ascertaining the differences between the prior art and the claims in issue; (C) Resolving the level of ordinary skill in the pertinent art; and (D) Evaluating evidence of secondary considerations.

The examiner in this case did not follow the factual inquires enunciated in Deere. Specifically, the examiner did not determine the scope and content of the prior art and did not ascertain the differences between the prior art and the claims at issue.⁵

⁵ A specific finding of a particular level of skill is not always necessary where, as here, the prior art itself reflects an appropriate level. Chore-Time Equip., Inc. v. Cumberland, 919 F.2d 1575, 1578 n.2, 218 USPQ 673, 676 n.2 (Fed. Cir. 1983). Thus, the examiner did resolve the level of ordinary skill in the pertinent art.

Accordingly, we will determine the scope and content of the prior art applied by the examiner in the rejection of the claims on appeal and then ascertain the differences between the prior art and the claims at issue.

Van Romer's invention relates to a portable, foldable containment device for hazardous chemicals such as petrochemicals, and the like, and the prevention of environmental contamination by the chemicals. As shown in Figures 1-6, the portable containment device 10 includes a floor 14 composed of sheet material and a foldable wall 12 extending around a periphery of the floor 14 for containing spilled material such as petrochemicals to prevent environmental contact and ground water contamination. The foldable wall 12 is composed of sheet material integrally connected to the floor for containing spilled material in cooperation with the floor. Preferably, the sheet material which the floor and wall is comprised of includes a modified vinyl or polyurethane coated woven synthetic fabric. The sheet material may be folded up at the sides to provide the wall or the wall may be integrally

attached to a separate floor material such as by thermal welding or R.F. welding. Van Romer teaches that preferably foldable wall 12 comprises a rectangular wall consisting of individual upstanding walls 16, 18, 20, 22 but that it is to be understood, of course, that other wall configurations such as triangular, oval, circular, may also be used.

Van Romer's containment device also includes brace means for bracing the walls in an upstanding position while allowing the walls to fold horizontally include rigid side braces A, internal braces B and wall bracing elements C. Rigid side braces A extend vertically and are attached to upstanding walls 16, 18, 20, 22. Internal braces B support the upstanding walls and retain them upright. Wall bracing elements C also support the upstanding walls and retain them upright.

Frost discloses a collapsible container 14 which may be used for any desired purpose (page 2, left column, lines 51-52). As shown in Figures 1-7, the container 14 includes a rubber flat sheet 19 that forms the bottom of the container

and a cylindrical rubber body portion 20. The container 14 also includes endless resilient wire rings 15 and 16 and intermediate spring metal or other stays 17 interconnecting the rings 15 and 16. Frost teaches (page 2, left column, lines 28-49) that the resilience of the stays 17 and the pivotal connections thereof with the rings 15 and 16, and the flexibility of the body portion 20, the container 14 may be collapsed until the rings are adjacent each other.⁶ Normally, the stays are substantially straight to maintain the container 14 distended with the rings 15 and 16 fully spaced apart and the body portion taut.

Based on our analysis and review of Van Romer and the claims under appeal, it is our opinion that the differences are (1) the "pocket formed in said wall . . ." limitation; and (2) the "spring truss fitted within said pocket . . ." limitation.

⁶ We do not consider this to be a band-type fold as this phrase is defined on page 10 of the appellant's specification.

The examiner determined (answer, pp. 3-4) that

[i]t would have been obvious to one of ordinary skill in the art to have employed the collapsible sidewall teaching set forth in Frost in the construction of the device of Van Romer, motivated by the unobstructed interior space provided thereby.

We will not sustain this rejection since even if the references were combined together as set forth by the examiner, the combination would not arrive at the claimed invention. In that regard, we note that neither Van Romer or Frost disclose the claimed pocket formed in the wall (the wall arising from the base) with the claimed spring truss fitted within the pocket. Van Romer's upstanding walls 16, 18, 20, 22 do not include a pocket as recited in claims 1 and 8. While Frost does disclose a spring truss (i.e., rings 15 and 16 and stays 17), the spring truss is not fitted within a pocket formed in his wall (i.e., body portion 20).⁷

⁷ Contrary to the examiner's view (answer, p. 4), fabric strips 29 of Frost do not form a pocket as recited in claims 1 and 8 since the fabric strips 29 cover the stays 17 and thus do not form a pocket in the body portion 20.

For the reasons stated above the combined teachings of the applied prior art would not have made the subject matter of the claims under appeal obvious to one of ordinary skill in the art at the time the invention was made, the decision of the examiner to reject claims 1 to 3, 8 and 9 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 8 and 9 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

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APPLICATION NO. 08/151,960

APJ NASE

APJ DIXON

APJ KRASS

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 14 Sep 99

FINAL TYPED: