

**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(2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ALBERT BECKER

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Appeal No. 98-1233  
Application 08/612,045<sup>1</sup>

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ON BRIEF

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Before MEISTER, STAAB, and CRAWFORD, Administrative Patent  
Judges.

MEISTER, Administrative Patent Judge.

***DECISION ON APPEAL***

Albert Becker (the appellant) appeals from the final  
rejection of claims 1-9, the only claims present in the  
application.

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<sup>1</sup>Application for patent filed March 7, 1996.

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We REVERSE and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), we will enter new rejections of claims 1-3 and 5-7.

The appellant's invention pertains to a plaster guard for a concealed sanitary valve which can be controlled by a valve element. Independent claim 1 is further illustrative of the appealed subject matter and copy thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

Carlson	942,541	Dec. 7, 1909
Bergmann	5,497,584	Mar. 12, 1996

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergmann in view of Carlson.

According to the examiner:

Bergmann discloses the claimed "plaster guard" invention except for the recitation of a coating tool. Carlson teaches that it is known to provide a "reversible" valve "tool" including a lower "guard" portion 23 and a reversible "tool" portion 24 as set forth at column 2, lines 62+. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the "plaster guard" of Bergmann to include a coating tool portion, as taught by Carlson in order to provide means to test actuation of the valve following completion of plastering the wall.  
[Answer, page 3.]

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We will not support the examiner's position. While the examiner opines that it would have been obvious to provide the plaster guard of Bergmann with a coating tool "in order to provide means to test actuation of the valve," we must point out the mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. **See In re Fritch**, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) and **In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, there is no such suggestion. As the examiner recognizes, the plaster guard of Bergmann has no tool whatsoever. In order to overcome this deficiency the examiner has relied upon the teachings of Carlson, contending that Carlson teaches a "guard" portion at 23 and a tool portion at 24. We observe, however, that while the element 23 of Carlson may have the capability of being used as a guard, there is no teaching or suggestion in Carlson of doing so. To the contrary, Carlson describes the element 23 as a "threaded stud" which is used to engage the threads on collar 17 for the purpose of removing it from the valve in order that the valve

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may be repaired and, upon the completion of repairs, repositioning the collar in the valve (see page 1, lines 62-78). In short, Carlson teaches providing two tools 23, 24 on opposite sides of a "master key" 22 (see Fig. 4). There is absolutely nothing in the combined teachings of Bergmann and Carlson which would fairly suggest providing the plaster guard of Bergmann with a tool portion in view of the teachings of Carlson as the examiner proposes. Accordingly, we will not sustain the rejection of claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over Bergmann in view of Carlson.

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

Claims 1-3, 5 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Carlson. Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See *Verdegaal Bros., Inc. v. Union Oil Co.***, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987), ***cert. denied***, 484 U.S. 827 (1987). Additionally, the

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law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed 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). Moreover, it is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists regardless of whether there was a recognition that it could be used to perform the claimed function. **See, e.g., *In re Schreiber***, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). **See also *LaBounty Mfg. v. Int'l Trade Comm'n***, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992) (in quoting with approval from ***Dwight & Lloyd Sintering Co. v. Greenawalt***, 27 F.2d 823, 828 (2d Cir. 1928)):

The use for which the [anticipatory] apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent; the statute authorizes the patenting of machines, not of their uses. So far as we can see, the disclosed apparatus could be used for "sintering" without any change whatever, except to reverse the fans, a matter of operation. [Alteration in original.]

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Here, Carlson discloses a valve 5 which includes a concealed part 6, a part (the remainder of the valve) which projects from a wall (note page 1, lines 34-39) and a control element 12. The appellant's specification provides no particularly definition of "sanitary" and, giving this term its broadest reasonable interpretation (*see In re Morris*, 127 F.3d 1048, 1055, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d, 1320, 1322 (Fed. Cir. 1989)), Carlson's valve may be considered to be a "sanitary" valve as claimed. Carlson also discloses an element 22 which has the **capability** of functioning as a plaster guard as claimed. More specifically, element 22 includes (1) a threaded stud 23 that will act as a protective cover section for the internal threads on collar 17 when the studs are engaged in these threads and (2) a tool bearing section with a tool 24 (see Fig. 4).

Claims 5 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Carlson. With respect to claim 5, the tool 24 and the end 21 of control element 12 of Carlson appear to be square-shaped as claimed. In any event, the provision

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of a square shaped end vis-à-vis other polygonally shaped ends solves no stated problem insofar as the record is concerned, leading us to conclude that such a provision is an obvious matter of design choice. **See In re Kuhle**, 526 F.2d 553, 555, 188 USPQ 7, 8-9 (CCPA 1975). Similarly, with respect to claim 7, the provision of the tool being "bonded"<sup>2</sup> to the guard 22 vis-à-vis the one-piece construction arrangement of Carlson also solves no stated problem insofar as the record is concerned, once again leading us to conclude that such a provision is an obvious matter of design choice.

In summary:

The examiner's rejection of claims 1-9 under 35 U.S.C. § 103(a) is reversed.

New rejections of claims 1-3 and 5-7 have been made.

This decision contains a new ground 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

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<sup>2</sup> The provision of the tool being "bonded" to the plaster guard is not mentioned in the specification. If such a provision a vital part of the appellant's invention, it seems strange to us that all mention of its importance was omitted from the original description. **See Graham v. John Deere Co.**, 383 U.S. 1, 24-26, 148 USPQ 459, 469-470 (1966).

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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."

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 ground of rejection to avoid termination of proceedings (§ 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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	James M. Meister	)	
	Administrative Patent Judge	)	
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	Lawrence J. Staab	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	Murriel E. Crawford	)	
	Administrative Patent Judge	)	

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