

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 ALLAN S. LAS and JOSEPH T. MARES

Appeal No. 1998-3004
Application No. 08/290,590¹

ON BRIEF

Before CALVERT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5 to 8 and 17. Claims 1 to 4, 11 to 16 and 18 have been allowed. Claims 9 and 10 have been objected to as depending from a non-allowed claim. No claim has been canceled.

¹ Application for patent filed August 15, 1994.

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We REVERSE.

BACKGROUND

The appellants' invention relates to an insect bait station. An understanding of the invention can be derived from a reading of exemplary claim 17, which appears in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Schlesinger	1,573,278	Feb. 16,
1926		

Claims 5 to 8 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schlesinger.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the second Office action (Paper No. 5, mailed February 1, 1996) and the examiner's answer (Paper No. 16, mailed February 26, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 15, filed November 14,

1996) and reply brief (Paper No. 19, filed August 4, 1997) for the appellants' arguments thereagainst.

OPINION

Initially we note that on pages 9-12 of the brief the appellants seek our review of the decision by the examiner (Paper No. 10) refusing entry of the amendment (Paper No. 9) after final filed August 2, 1996. However, the refusal by the examiner to enter the appellants' amendment after final rejection relates to a petitionable matter and not to an appealable matter. See In re Schneider, 481 F.2d 1350, 1356-57, 179 USPQ 46, 51 (CCPA 1973) and In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). See also Manual of Patent Examining Procedure (MPEP) (7th Ed., July 1998) § 1002(c), item 3(b) and § 1201. Thus, the relief sought by the appellants would have been properly presented by a petition to the Commissioner under 37 CFR §§ 1.127 and 1.181 instead of by appeal to this Board. Accordingly, we will not further consider this issue.

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we will not sustain the examiner's rejection of claims 5 to 8 and 17 under 35 U.S.C. § 102(b). Our reasoning for this determination follows.

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.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) 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 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)).

Schlesinger discloses a poison liquid container. As shown in Figures 1 and 2, the poison liquid container includes a base 1 having an upstanding annular wall 2, a cylindrical wick 5 disposed in a recess 4 formed in the base 1, a fringe 6 extending from an intermediate portion of the wick 1 and lying on the conical upper surface of the base 1, and a cover 7. Schlesinger teaches that poison liquid is poured into the cylindrical wick 5 and thereafter trapped between the base 1, the cover 7 and the wick 5.

All the claims under appeal recite an insect bait station including a "selectively breakable reservoir" for a toxicant.

The appellants argue (brief, pp. 5-8, and reply brief, pp. 1-2) that Schlesinger does not disclose a **breakable** reservoir as set forth in the claims under appeal. Specifically, the appellants maintain (brief, p. 7) that a **breakable** reservoir is "clearly a part in which liquid is held until it is broken whereupon the liquid is released therefrom."

The examiner asserts (answer, pp. 2-3) that "inherently, the reservoir (wick) of Schlesinger is breakable by manual means."

Thus, the issue presented in this appeal by the appellants and the examiner is whether the claimed "selectively breakable reservoir" is readable on the reservoir in which Schlesinger's

liquid poison is kept (i.e., the chamber formed by Schlesinger's wick 5, base 1, and cover 7).

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

The specification sets forth on page 14 that sharp point 52 of post 48 punctures a hole (not shown) in a breakable reservoir 50 which permits the liquid toxicant therein to leak out of the reservoir 50 onto a toxicant applicator 46. Thus, the toxicant applicator 46 is not treated with the toxicant until the insect bait station is ready to use. This feature provides the insect bait station with greater safety and longer shelf life.

In applying the above-noted guidance to the claimed phrase "selectively breakable reservoir," we reach the conclusion that the broadest reasonable interpretation of

"selectively breakable reservoir" is that the reservoir is designed to be broken in the

operation of the insect bait station such that toxicant therein leaks out of the reservoir.

With this definition of "selectively breakable reservoir" in mind, it is clear that such element is not explicitly or inherently disclosed by Schlesinger. Since all the limitations of the claims under appeal are not disclosed by Schlesinger, the decision of the examiner to reject claims 5 to 8 and 17 under 35 U.S.C. § 102 (b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 5 to 8 and 17 under 35 U.S.C. § 102(b) is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/290,590

APJ NASE

APJ CALVERT

APJ STAAB

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 20 May 99

FINAL TYPED: