

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHARON A. RITCHEY

Appeal No. 99-0179
Application 08/612,385¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge,
FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Sharon A. Ritchey appeals from the final rejection of claims 1 through 13 and 21, all of the claims pending in the application. We reverse and enter a new ground of rejection.

¹ Application for patent filed March 7, 1996.

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The invention relates to "a stuffed toy having a sealable opening that facilitates the addition and removal of stuffing material" (specification, page 1). Claim 1 is illustrative and reads as follows:

1. An apparatus for holding a quantity of stuffing material, said apparatus comprising:

a pliable shell having a perimeter and an interior cavity formed therein;

a seam partially formed around said perimeter of said shell and displaced from said perimeter, said seam having first and second ends configured to define an opening formed within said shell, said opening providing access to said interior cavity; and

means for releasably sealing said opening, said means for sealing being coupled to said shell proximate said opening; wherein

said first and second seam ends have an increased displacement from said perimeter at said opening.

The references relied upon by the examiner as evidence of anticipation and obviousness are:

Schradermeier	2,591,379	Apr. 1, 1952
Gullace	4,950,194	Aug. 21, 1990

Claims 1 through 8 and 10 through 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, and in the alternative under 35 U.S.C. § 103(a) as being obvious over, Schradermeier.

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Claims 9 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, and in the alternative under 35 U.S.C. § 103(a) as being obvious over, Gullace.

Reference is made to the appellant's brief (Paper No. 10) and to the examiner's answer (Paper No. 11) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

As indicated above, independent claim 1 recites an apparatus for holding a quantity of stuffing material comprising, inter alia, a pliable shell having a perimeter and a seam partially formed around the perimeter and having first and second ends configured to define an opening in the shell. Claim 1 further defines the seam as being "displaced from said perimeter," with the first and second ends of the seam having "an increased displacement from said perimeter at said opening." Claim 8, the other independent claim on appeal, contains identical limitations. The appellant's specification discloses that this seam structure "reduces puckering and kinking of shell 12 during assembly, packaging, and while

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fabric toy 10 is displayed" (page 10).

Although both Schradermeier and Gullace disclose an "apparatus" comprising a shell, seams and an opening, neither teaches or would have suggested an "apparatus" having the particular seam construction required by claims 1 and 8, i.e., a seam which is displaced from the perimeter of the apparatus shell with its ends having an increased displacement from the perimeter at the opening. The examiner's findings and conclusions to the contrary (see pages 4 and 5 in the answer) are predicated on speculation, conjecture and unfounded assumptions lacking any factual support in the applied references.²

Accordingly, we shall not sustain any of the standing 35 U.S.C. § 102(b) or § 103(a) rejections of independent claims 1 and 8 or of dependent claims 2 through 7, 9 through 13 and 21.

The following rejection is entered pursuant to 37 CFR

² To the extent that the examiner's reliance on the Butterick reference on page 5 of the answer "in the interests of showing what is well known in the art" is proper (see In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970)), such reliance does nothing to cure the above noted deficiencies of Schradermeier and Gullace.

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§ 1.196(b).

Claims 1 and 8, and claims 2 through 7, 9 through 13 and 21 by virtue of their dependency therefrom, are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. Under this analysis, claims which appear to be indefinite on their face may become definite when read in light of the specification disclosure or prior art teachings. By the same token, claims which appear to be definite on their face may take on an unreasonable degree of uncertainty when read in light of the specification disclosure

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or prior art teachings. See In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971); and In re Moore, 439 F.2d 1232, 1235 n.2, 169 USPQ 236, 238 n.2 (CCPA 1971).

As discussed above, claims 1 and 8 recite an apparatus wherein the seam is displaced from the perimeter of the shell, with the first and second ends of the seam having an increased displacement from the perimeter at the opening. Specification pages 8 through 10 and Figures 3 and 4 of the appellant's disclosure indicate, however, that the seam is actually displaced from the perimeter of the pattern used to make the shell rather than from the perimeter of the shell itself.³ Indeed, the appellant's disclosure of the seam and the manner in which it is made indicates that the seam is on, rather than displaced from, the perimeter, i.e., the outer surface, of the shell. This inconsistency between the disclosure and claims 1 and 8 renders the scope of the appealed claims indefinite.

In summary:

³ Although specification page 9 contains a statement that the first and second seam ends are formed with an increased displacement from the perimeter of the "shell" at the opening (see lines 25 through 27), this statement is at odds with the rest of the relevant disclosure which mentions the "perimeter" only in the context of the pattern.

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a) the decision of the examiner to reject claims 1 through 13 and 21 is reversed; and

b) a new rejection of claims 1 through 13 and 21 is entered pursuant to 37 CFR § 1.196(b).

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 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

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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)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge))
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)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
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