

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOWARD GRABHORN

Appeal No. 1999-2446
Application No. 08/705,592¹

ON BRIEF

Before CALVERT, FRANKFORT, 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 6, 7, 9 to 17 and 19 to 25, which are all of the claims pending in this application.

¹ Application for patent filed August 29, 1996. According to the appellant, the application is a continuation of Application No. 08/269,051, filed June 29, 1994, now U.S. Patent No. 5,595,458.

Appeal No. 1999-2446
Application No. 08/705,592

We AFFIRM.

BACKGROUND

The appellant's invention relates to erosion control, specifically the use of recycled log and stump waste to prevent loss of topsoil in locations where soil is temporarily disturbed by human activity (specification, p. 1). A copy of the claims under appeal appears in the appendix to the appellant's brief.

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

Stacy 1921	1,371,451	Mar. 15,
Scott 1927	1,629,315	May 17,
Grabhorn 1997	5,595,458	Jan. 21,

Claims 6, 7, 9 to 17 and 19 to 25 stand rejected under the judicially created doctrine of double patenting over the claims in U.S. Patent No. 5,595,458 to Grabhorn.

Claims 6, 7, 9 to 17 and 19 to 25 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 the appellant regards as the invention.

Claims 6, 7, 9 to 17 and 19 to 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stacy or Scott.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 10, mailed June 23, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 9, filed April 23, 1998) and reply brief (Paper No. 11, filed August 26, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the

examiner. As a consequence of our review, we make the determinations which follow.

The double patenting rejection

We sustain the rejection of claims 6, 7, 9 to 17 and 19 to 25 under the judicially created doctrine of double patenting over the claims in U.S. Patent No. 5,595,458 to Grabhorn.

The appellant has not argued this rejection of claims 6, 7, 9 to 17 and 19 to 25 under the judicially created doctrine of double patenting. Instead, the appellant has stated that he has offered to file a Terminal Disclaimer once allowable subject matter has been indicated in the present case (brief, p. 5). Since no Terminal Disclaimer has yet been submitted to overcome this rejection, we summarily sustain the rejection of claims 6, 7, 9 to 17 and 19 to 25 under the judicially created doctrine of double patenting.

The indefiniteness rejection

We will not sustain the rejection of claims 6, 7, 9 to 17 and 19 to 25 under 35 U.S.C. § 112, second paragraph.

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 making this determination, 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.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as

precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Thus, the appellant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we turn to the specific rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. With respect to independent claim 6, the examiner stated (answer, pp. 4-5) that there was insufficient structure recited in the claim to support the limitation that the wood fragments "do not have smooth

surfaces that tend to stick together when wet and form a mass of fragments that prevents flow of water through the bag, and the wood fragments resist adhering to other wood fragments within the container without becoming clogged with sediment carried by the water." With respect to the other independent claims on appeal (i.e., claims 14, 17, 23 and 25) the examiner stated (answer, p. 5) that these claims were indefinite for the same reason as set forth above for claim 6.

The appellant argues (brief, pp. 7-8) that there is nothing inherently ambiguous about the above-noted limitation of claim 6 and that the examiner has not provided any explanation as to why one skilled in the art would not understand the meaning of the above-noted limitation of claim 6 when read in light of the specification. We agree. We have fully reviewed the examiner's rejection and response to the appellant's argument (answer, pp. 4-5 & 7-8) but fail to see any reasoning as to why the claimed language fails to make clear the boundaries of the subject matter for which protection is sought. The appellant's specification (p. 3) makes clear that hammer-milled wood fragments are preferred

because wood fragments produced by a chipper have smooth surfaces that tend to stick together and prevent the necessary flow of water through the bag. Accordingly, we understand the claims as encompassing wood fragments having a roughness similar to that produced by a hammer-mill process and excluding wood fragments having a surface smoothness similar to that produced by a chipping process. Thus, we conclude that the claims under appeal do set out and circumscribe a particular area with a reasonable degree of precision and particularity as required by the second paragraph of 35 U.S.C. § 112.²

For the reasons set forth above, the decision of the examiner to reject claims 6, 7, 9 to 17 and 19 to 25 under 35 U.S.C. § 112, second paragraph, is reversed.

The obviousness rejection based upon Stacy

² With regard to claim 9, we note that the term "smaller" should be "larger" for consistency with the original disclosure and the earlier recitation in claim 9 that the wood fragments are "large enough not to pass through a separation screen."

We will not sustain the examiner's rejection of claims 6, 7, 9 to 17 and 19 to 25 under 35 U.S.C. § 103 as being unpatentable over Stacy.

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).

All the claims under appeal recite wood fragments within a mesh-type container. Stacy teaches only the use of straw within a mesh-type container. Thus, Stacy does not teach or suggest the wood fragments as set forth in each of the

independent claims under appeal.³ In fact, the advantages of utilizing wood fragments as set forth in the claims under appeal are not appreciated by Stacy.

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the

³ The examiner references other prior art (i.e., Pine Bark Mulch) on page 6 of the answer. We note that no rejection utilizing that prior art is before us in this appeal.

references, and who is normally guided by the then-accepted wisdom in the art." Id. Since the wood fragments limitations as set forth in the claims under appeal are not taught or suggested by Stacy, we will not sustain the 35 U.S.C. § 103 rejection of claims 6, 7, 9 to 17 and 19 to 25 as being unpatentable over Stacy.

The obviousness rejection based upon Scott

We sustain the examiner's rejection of claims 6, 7, 9, 13, 14, 17, 21 and 22 under 35 U.S.C. § 103 as being unpatentable over Scott, but not the rejection of claims 10 to 12, 15, 16, 19, 20 and 23 to 25 under 35 U.S.C. § 103 as being unpatentable over Scott.

Scott's invention relates to mats for use in the "revetment of river banks and the like" (page 1, lines 1-2). Scott states that one of his objects is to produce an "improved mat of combined woven wire and willow or other suitable tree growths or brush" in which the willow and wire are intertwined so that the latter reliably maintains the former in position and the mat as a whole is as effective as a

strictly willow woven mat (page 1, lines 3-10). Figures 1-7 illustrate the steps employed by Scott in weaving his mats. Scott teaches (page 1, lines 56-76) that (1) each row of willows or the like are packed into position and that the wire mesh is drawn tight to hold each row of willows or the like in a tightly compacted mass; and (2) that practically all sizes of material (i.e., willows or the like) may be used without special cutting.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Claim 6

Based on our analysis and review of Scott and claim 6, it is our opinion that there is no difference. In our view, Scott anticipates claim 6. 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)).

Contrary to the appellant's argument (brief, p. 9), it is our view that Scott does disclose discrete wood fragments (i.e., Scott's pieces of willow or other suitable tree growths or brush) loose within a container (i.e., Scott's woven wire). Furthermore, while Scott teaches that each row of wood material is held in a tightly compacted mass, it is our

opinion that such a mass would still be readable on the claimed wood fragments. In that regard, we find that the broadest reasonable interpretation of loose⁴ as used in claim 6 is that the wood fragments while confined within the container are not fastened to each other. Accordingly, it is our view that each of Scott's rows consists of wood fragments which are loose since the wood fragments are not fastened to each other within the wire mesh surrounding each row.

Furthermore, it is our determination that the wood fragments disclosed by Scott (i.e., willow or other suitable tree growths or brush) would inherently not have smooth surfaces that tend to stick together when wet and form a mass of fragments that prevents flow of water through the bag, and the wood fragments resist adhering to other wood fragments

⁴ The Patent and Trademark Office (PTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). In this case, we note that the term "loose" does not appear in the original disclosure.

within the container without becoming clogged with sediment carried by the water. In that regard, we note that while each row of wood material is held in a tightly compacted mass, Figures 1-7 disclose that there remain spaces between the wood fragments.

After the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, appellant's burden before the PTO is to prove that Scott does not perform the functions defined in claim 6. The appellant has not come forward with evidence that satisfies this burden.⁵ In that regard, the appellant's declaration under 37 CFR § 1.132 (Paper No. 4, filed March 20, 1997) does not satisfy this

⁵ Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971).

burden since the declarant's statements that "the woven willows of Scott are smooth enough to adhere together when wet" and that "[t]hey form a confluent mass that will block water flow instead of filtering it" are conclusions unsupported by any factual evidence. Affidavits and declarations fail in their purpose when they recite conclusions with few facts to buttress the conclusions. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973), In re Thompson, 545 F.2d 1290, 1295, 192 USPQ 275, 277-78 (CCPA 1976) and In re DeBlauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

As noted above, Scott does teach all the limitations of claim 6. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, we sustain the examiner's

rejection of appealed claim 6 under 35 U.S.C. § 103 as being unpatentable over Scott.

Claims 11 and 14

The appellant has grouped claims 6, 11 and 14 as standing or falling together.⁶ Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 11 and 14 fall with claim 6. Thus, it follows that the decision of the examiner to reject claims 11 and 14 under 35 U.S.C. § 103 as being unpatentable over Scott is also affirmed.

Claim 7

In our view, the limitations of claim 7 are readable on Scott. In that regard, the wire mesh wall of Scott is inherently flexible, and therefore the wood fragments therein would inherently conform to some degree to the surface on which Scott's mat sits. While Scott's mat may not conform to the surface on which it sits to the same extent as the appellant's disclosed bag, it is axiomatic that, in

⁶ See page 5 of the appellant's brief.

proceedings before the PTO, that limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Thus, it is our opinion that when claim 7 is given its broadest reasonable interpretation it is readable on Scott's mat. Since anticipation is the epitome of obviousness, we sustain the examiner's rejection of appealed claim 7 under 35 U.S.C. § 103 as being unpatentable over Scott.

Claim 9

In our view, the limitations of claim 9 are readable on Scott. In that regard, the wood fragments of Scott are inherently larger than 3/8 inch and thus are large enough not to pass through a separation screen having 3/8 inch openings. Thus, it is our opinion that claim 9 is readable on Scott's mat. Since anticipation is the epitome of obviousness, we sustain the examiner's rejection of appealed claim 9 under 35 U.S.C. § 103 as being unpatentable over Scott.

Claim 10

Claim 10 recites that the mesh openings "have a dimension of about ½ inch." The examiner has not provided any **evidence**⁷

⁷ Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual **evidence**. That is, the showing must be clear and

(continued...)

as to why it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the mesh opening size of Scott to be about ½ inch. In fact, the examiner has not even alleged that such a modification of the wire mesh in Scott would have been obvious at the time the invention was made to a person having ordinary skill in the art.⁸ Since the examiner has not established that the subject matter of claim 10 would have been obvious under 35 U.S.C. § 103, the decision of the examiner to reject claim 10 under 35 U.S.C. § 103 as being unpatentable over Scott is reversed.

Claim 12

⁷(...continued)
particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

⁸ See page 7 of the answer.

Claim 12 recites that the wood fragments are "not retained by a separation screen having a screen opening of about 1½ inch, so that the wood fragments within the container are smaller than 1½ inch." Once again the examiner has not provided any **evidence** as to why it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the size of the wood fragments to be smaller than 1½ inch. Since the examiner has not established that the subject matter of claim 12 would have been obvious under 35 U.S.C. § 103, the decision of the examiner to reject claim 12 under 35 U.S.C. § 103 as being unpatentable over Scott is reversed.

Claim 13

Claim 13 adds to parent claim 6 the limitation that the container comprises a plastic mesh. Since this limitation is clearly not met by Scott, the examiner determined (answer, p. 7) that "the particular material from which the mesh is made is considered to be a matter of obvious choice because one skilled in the art would have knowledge of the use of plastic

mesh as a container from [sic, for] various granular materials."

The only argument set forth by the appellant with regard to claim 13 (brief, p. 12) is to the effect that Scott does not teach a plastic mesh container. While it is true that Scott does not teach or suggest a plastic mesh container, we find this argument unpersuasive since the examiner's rejection was based upon the teachings of Scott taken with knowledge known by one skilled in the art.⁹ Since the examiner's actual determination of obviousness was not contested by the appellant, we sustain the examiner's rejection of claim 13 under 35 U.S.C. § 103 as being unpatentable over Scott.

Claims 15 and 16

⁹ We observe that an artisan is presumed to know something about the art apart from what the references disclose (see In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)).

Claim 15 recites that the wood fragments are "sufficiently small to pass through a 1½ inch separation screen" so that the wood fragments within the container are "smaller than 1½ inch." As with claim 12 above, the examiner has not provided any **evidence** as to why it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the size of the wood fragments to be smaller than 1½ inch. Since the examiner has not established that the subject matter of claim 15 would have been obvious under 35 U.S.C. § 103, the decision of the examiner to reject claim 15 and claim 16 dependent thereon under 35 U.S.C. § 103 as being unpatentable over Scott is reversed.

Claim 17

It is our opinion that the subject matter of method claim 17 is inherently met by Scott for the reasons set forth above with respect to claim 6. In addition, it is our determination that the claimed step of placing the container on a surface in the region of run-off to slow the flow of water is met by Scott's disclosure that his mats are for use in the revetment of river banks and the like. Thus, the appellant's argument (brief, p. 13) that "Scott is unclear about how his woven mat is to be used" is inaccurate. Since anticipation is the epitome of obviousness, we sustain the examiner's rejection of appealed claim 17 under 35 U.S.C. § 103 as being unpatentable over Scott.

Claims 19 and 20

Claim 19 recites the step of providing "hammer milled wood fragments" within the container. As with claim 12 above, the examiner has not provided any **evidence** as to why it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have replaced the

clearly large wood fragments, branches, etc. of Scott with hammer milled wood fragments.¹⁰ Since the examiner has not established that the subject matter of claim 19 would have been obvious under 35 U.S.C. § 103, the decision of the examiner to reject claim 19 and claim 20 dependent thereon under 35 U.S.C. § 103 as being unpatentable over Scott is reversed.

Claim 21

It is our opinion that the subject matter of method claim 21 is inherently met by Scott. In addition to the reasons set forth above with respect to parent claim 17, it is our determination that the claimed step of placing a plurality of contiguous containers on the surface in the region of run-off is met by Scott's disclosure that his mats are for use in the revetment of river banks and the like. In this regard, it is our opinion that Scott's mats must be contiguous to each other if the mats are to function as Scott intends. Thus, the

¹⁰ The mere fact that hammer milled wood fragments existed in the prior art would not have by itself made it obvious to have substituted such hammer milled wood fragments for Scott's wood fragments.

appellant's argument (brief, p. 14) that the step of claim 21 is not shown in Scott is unpersuasive. Since anticipation is the epitome of obviousness, we sustain the examiner's rejection of appealed claim 21 under 35 U.S.C. § 103 as being unpatentable over Scott.

Claim 22

The appellant has grouped claims 21 and 22 as standing or falling together.¹¹ Thereby, in accordance with 37 CFR § 1.192(c)(7), claim 22 falls with claim 21. Thus, it follows that the decision of the examiner to reject claim 22 under 35 U.S.C. § 103 as being unpatentable over Scott is also affirmed.

Claims 23 and 24

Independent claim 23 recites the step of "screening the wood fragments through a plurality of screens to obtain size-selected wood fragments." Once again the examiner has not provided any **evidence** as to why it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have subjected the wood fragments of Scott to such a screening step. Since the examiner has not established that the subject matter of claim 23 would have been obvious under 35 U.S.C. § 103, the decision of the examiner to reject claim 23 and claim 24 dependent thereon

¹¹ See page 5 of the appellant's brief.

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under 35 U.S.C. § 103 as being unpatentable over Scott is
reversed.

Claim 25

Claim 25 recites the same features as discussed previously with respect to claims 10, 12 and 19 (i.e., the mesh openings having a dimension of about $\frac{1}{2}$ inch; the size of the wood fragments being smaller than $1\frac{1}{2}$ inch; and the wood fragments being hammer milled wood fragments). As with claims 10, 12 and 19 above, the examiner has not provided any **evidence** as to why it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the wood fragments of Scott and the wire mesh of Scott to have arrived at the claimed invention. Since the examiner has not established that the subject matter of claim 25 would have been obvious under 35 U.S.C. § 103, the decision of the examiner to reject claim 25 under 35 U.S.C. § 103 as being unpatentable over Scott is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 6, 7, 9 to 17 and 19 to 25 under the judicially created

doctrine of double patenting is affirmed; the decision of the examiner to reject claims 6, 7, 9 to 17 and 19 to 25 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 6, 7, 9 to 17 and 19 to 25 under 35 U.S.C. § 103 as being unpatentable over Stacy is reversed; and the decision of the examiner to reject claims 6, 7, 9 to 17 and 19 to 25 under 35 U.S.C. § 103 as being unpatentable over Scott is affirmed with respect to claims 6, 7, 9, 13, 14, 17, 21 and 22, and reversed with respect to claims 10 to 12, 15, 16, 19, 20 and 23 to 25.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPEAL NO. 1999-2446 - JUDGE NASE
APPLICATION NO. 08/705,592

APJ NASE

APJ FRANKFORT

APJ CALVERT

DECISION: **AFFIRMED**

Prepared By: Gloria Henderson

DRAFT TYPED: 10 Jan 00

FINAL TYPED: