

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD S. FAIN

Appeal No. 1999-2556
Application 08/774,848

ON BRIEF

Before ABRAMS, MCQUADE, and JENNIFER D. BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Gerald S. Fain appeals from the final rejection of claims 1, 3, 5 through 10, 17 through 19, 25 and 41 through 45, all of the claims pending in the application.

THE INVENTION

The invention relates to "a pest control device capable of repelling or attracting animals and insects to a garden"

(specification, page 2). Claims 1, 25 and 44 are illustrative and read as follows:

1. An animal control device comprising:
a base portion having a plurality of containing regions;
a cap portion which covers said containing regions to prevent the gravitational accumulation of material in said containing regions;
at least two odor-producing odorous substances located within said containing regions of said base portion and exposed to an ambient environment surrounding the device; and
a stake which passes through said base portion and said cap portion to removably secure said cap portion in position over said base portion, and to secure said base portion to the ground;
wherein one of said substances produces respective odors which repel certain creatures and another of said substances produces other respective odors which attract desirable creatures, said odors from said substances being released to the ambient environment.

25. A pest control system, comprising:
a plurality of pest control devices interconnected together to form a pest control barrier surrounding a certain geographic area, wherein each of said pest control devices includes
A. a base portion having a containing region;
B. a cap portion which covers said containing region to prevent the gravitational accumulation of material in said containing region; and
C. at least one odor-producing odorous substance located within said containing region of said base portion and exposed to an ambient environment surrounding the device to allow odors from said odorous substance to be released to the surrounding ambient environment.

44. An animal control device comprising:
a base portion for containing a plurality of different odorous substances; and
a cap portion for covering said substances;

Appeal No. 1999-2556
Application 08/774,848

wherein said different odorous substances are exposed to an ambient environment surrounding the device so as to produce odors which attract desirable creatures and repel undesirable creatures.

THE PRIOR ART

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

Watson 1934	1,964,611	Jun. 26,
Manning 1980	4,208,829	Jun. 24,
Clark, Sr. (Clark) 1982	4,364,194	Dec. 21,
Rhodes 1992	5,152,097	Oct. 6,
Weldon 1993	5,184,417	Feb. 9,

THE REJECTIONS

Claim 44 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Watson.

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Manning.

Claims 1, 5 through 9, 41 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Manning in view of Watson.

Appeal No. 1999-2556
Application 08/774,848

Claims 3, 10 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Manning in view of Watson and Rhodes.

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Manning in view of Watson and Clark.

Claims 19 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Manning in view of Watson and Weldon.

Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Watson in view of Weldon.

Attention is directed to the appellant's brief (Paper No. 16) and to the examiner's final rejection and answer (Paper Nos. 14 and 17) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

DISCUSSION

Watson, applied to support the anticipation rejection of claim 44, discloses an exterminator for rodents and insects. This exterminator consists of a base 1, a lure compartment 6a formed by a cylindrical wall 6 disposed on the base, poison

Appeal No. 1999-2556
Application 08/774,848

bait compartments 8 formed by an apertured cylindrical wall 9 and partitions 7 disposed on the base in surrounding relation to the wall 6, an insect poison compartment 11 formed by a rim 4 disposed about the periphery of the base, and a canopy 12 disposed above the foregoing elements.

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 44 reads on the exterminator disclosed by Watson. More particularly, Watson's exterminator certainly constitutes an "animal control device" as recited in the preamble of claim 44, with Watson's base 1, lure compartment 6a, cylindrical

wall 6, poison bait compartments 8, cylindrical wall 9, partitions 7 and rim 4 collectively meeting the recitation of the "base portion for containing a plurality of different odorous substances" and Watson's canopy 12 meeting the recitation of the "cap portion for covering said substances." The appellant's position (see pages 14 through 17 in the brief) that Watson is not an anticipatory reference because it does not disclose different odorous substances which attract desirable creatures and repel undesirable creatures is not persuasive because it is not commensurate with the actual scope of claim 44. The "wherein" clause in the claim relating to the odorous substances merely sets forth an intended use of the claimed device; it does not recite such odorous substances as part of the claimed device.¹ Since the Watson exterminator is inherently capable of being so used, it fully responds to the claim language at issue. This is in accord with the well settled principle that the recitation of an intended use of an old product does not make a claim to that old product

¹ In contrast, independent claims 1 and 25 do recite at least one odorous substance as part of the claimed device or system.

Appeal No. 1999-2556
Application 08/774,848

patentable (see In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)).

Thus, Watson discloses, expressly or under principles of inherency, each and every element of the animal control device recited in claim 44. Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of this claim as being anticipated by Watson.

Claim 45 depends from claim 44 and requires the claimed device to further comprise a solar-powered fan for distributing odors. In rejecting this claim under 35 U.S.C. § 103(a), the examiner concludes (see page 5 in the final rejection) that Weldon would have suggested the provision of such a fan to the Watson device. The appellant does not challenge this conclusion. Instead, the appellant contends (see page 28 in the brief) that the rejection is unsound because Weldon fails to overcome the alleged deficiencies of Watson with respect to parent claim 44.² For the reasons

² In traversing the rejection of claim 45, the appellant has chosen not to rely on the 37 CFR § 1.132 declaration submitted August 20, 1998 (Paper No. 13) as evidence of non-obviousness. Therefore, we find no need to assess the evidentiary weight to which the declaration may be entitled.

Appeal No. 1999-2556
Application 08/774,848

expressed above, Watson has no such deficiencies. Thus, the appellant's position is not well taken.

Therefore, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 45 as being unpatentable over Watson in view of Weldon.

Manning, applied to support the obviousness rejection of independent claim 25, discloses a bait station for dispensing poisoned feed to rodents. In Manning's words, the bait station

includes a bottom wall **11**, preferably circular in outline and of substantial diameter, having an integral upstanding perimeter wall **12** or shell. Axially arranged within the confines of the perimeter wall **12** is an upstanding bait container or feeder **13**, welded or otherwise secured firmly to the bottom wall **11**. An externally flanged top wall or cover **14** is seated on the perimeter wall or shell **12**.

The assembly hereinabove described is secured to a selected surface, such as a cement block or floor **15**, by embedding in the floor a headed stud **16** which may be screw threaded at its upper end to receive the lower threaded end of an axial rod **17**, which extends outwardly through the bottom wall **11**, the bait container **13** and out through an aperture in the cover **14**. Removal of the cover **14** may be prevented by a lock **18** engaged with the rod **17**.

A plurality of equally spaced apart circular openings **19** of a size having a diameter sufficient

Appeal No. 1999-2556
Application 08/774,848

to permit passage of a rodent are provided in the perimeter wall 12 [column 2, lines 12 through 31].

As conceded by the examiner (see page 3 in the final rejection), Manning does not meet the limitations in claim 25 requiring the claimed system to comprise a plurality of pest control devices interconnected together to form a pest control barrier surrounding a certain geographic area. Nonetheless, the examiner concludes that "it would have been obvious to employ a plurality of [Manning's] devices or bait stations to form a barrier around an area to keep certain pests away from the area" (final rejection, page 3).

Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

Because the examiner has not supplied any factual support for the conclusion that it would have been obvious to employ a

Appeal No. 1999-2556
Application 08/774,848

plurality of Manning's bait stations in the arrangement specified by claim 25, the rejection of this claim must fall.

Thus, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 25 as being unpatentable over Manning.

Manning is also the primary reference applied in support of the obviousness rejection of independent claim 1. Implicitly acknowledging that Manning does not meet the limitations in this claim requiring the recited device to include a plurality of containing regions and at least two odorous substances within the regions with one substance producing odors which repel certain creatures and another substance producing other odors which attract desirable creatures, the examiner concludes (see page 3 in the final rejection) that Watson would have suggested furnishing same to the Manning device. Arguably, Watson would have suggested adding a plurality of containing regions to the Manning device. There is nothing in the combined teachings of Watson and Manning, however, which would have suggested the further addition of at least two odorous substances having the characteristics called for in claim 1. The examiner's

Appeal No. 1999-2556
Application 08/774,848

position (see page 3 in the final rejection) that Watson inherently discloses such odorous substances has no reasonable support in Watson's disclosure.

Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, or of claims 5 through 9 which depend from claim 1, as being unpatentable over Manning in view of Watson.

The deficiencies of Manning with respect to the subject matter recited in independent claim 25 and of the Manning-Watson combination with respect to the subject matter recited in independent claim 1 find no cure in the various references applied to support the obviousness rejections of the claims which respectively depend from these independent claims.

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 41 and 42, which depend from claim 25, as being unpatentable over Manning in view of Watson, the standing

35 U.S.C. § 103(a) rejection of claims 3, 10 and 17, which depend from claim 1, as being unpatentable over Manning in view of Watson and Rhodes, the standing 35 U.S.C. § 103(a)

Appeal No. 1999-2556
Application 08/774,848

rejection of claim 18, which depends from claim 1, as being unpatentable over Manning in view of Watson and Clark, or the standing 35 U.S.C. § 103(a) rejection of claim 19, which depends from claim 1, and of claim 43, which depends ultimately from claim 25, as being unpatentable over Watson in view of Manning and Weldon.

NEW REJECTION

The following rejection is entered pursuant to 37 CFR § 1.196(b).

Claims 3, 7 and 8 are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with the written description requirement of this section of the statute.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or

Appeal No. 1999-2556
Application 08/774,848

absence of literal support in the specification for the claim language.

In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id.

Notwithstanding the statement on page 17 of the original specification that

mixing and matching of the foregoing embodiments provides devices having a desired combination of

features. Therefore, any such combination is likewise considered to be within the scope of the present invention,

there is no basis in the original disclosure for the subject matter now recited in claims 3, 7 and 8. As indicated above, these claims depend from independent claim 1. Claim 1 is limited to the animal control device shown in Figure 5 and described on specification page 13 wherein the base 80 and cap 84 are held together by a stake 92 extending therethrough and

Appeal No. 1999-2556
Application 08/774,848

into a surface below the base such as the earth. The disclosure of the application as originally filed would not reasonably convey to the artisan that the appellant had possession at that time of such embodiment in combination with the mating screw threads recited in claim 3 for connecting the cap and base portions or the means/eyelet recited in claims 7 and 8 for suspending the device. A fair reading of the original disclosure indicates that the embodiment set forth in claim 1 and the features recited in claims 3, 7 and 8 are mutually exclusive.

SUMMARY

a) The decision of the examiner to reject claims 1, 3, 5 through 10, 17 through 19, 25 and 41 through 45 is affirmed with respect to claims 44 and 45 and reversed with respect to claims 1, 3, 5 through 10, 17 through 19, 25 and 41 through 43.

A new rejection of claims 3, 7 and 8 is entered pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of

Appeal No. 1999-2556
Application 08/774,848

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, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

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 (37 CFR § 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. . . .

Appeal No. 1999-2556
Application 08/774,848

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

Appeal No. 1999-2556
Application 08/774,848

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

AFFIRMED-IN-PART; 37 CFR § 1.196(b).

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
)	
)	APPEALS AND
JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

Appeal No. 1999-2556
Application 08/774,848

JPM/kis
Patrick J. O'Shea
CESARI & MCKENNA
30 Rowes Wharf
Boston, MA 02110