

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD W. HALL

Appeal No. 2000-1622
Application No. 08/752,445

ON BRIEF

Before CALVERT, COHEN, and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 66 to 68, 70, 72 and 75 to 86, all the claims remaining in the application.

The claims on appeal are drawn to a waste discharge system, and are reproduced in the appendix of appellant's brief.¹

¹ All references herein to appellant's brief are to the Supplemental Appeal Brief filed on Sept. 3, 1999.

carrier extends to (claim 81), and that the water closet provides support for (claim 82) the off-the-floor water closet carrier, renders the claims indefinite because the off-the-floor water closet is not a positively recited element of the claims.

Defining the width or other dimension of an element of a subcombination with a direct relationship to an element of a combination where the claim is clearly intended to be drawn to the subcombination renders the intended scope of the claim indefinite. The claim then fails to distinctly define the metes and bounds of the subject matter that will be protected by the patent grant as required in the second paragraph of 35 U.S.C. 112.

Considering claim 66 as exemplary, it recites, inter alia:

66. A waste discharge system for at least one off-the floor water closet having waste discharge conduit means connected to waste conduit junction means, the at least one off-the-floor closet being in at least one of adjacent rooms, each having a wall comprised of consecutive, vertical studs, the walls providing a partition between the adjacent rooms, the waste discharge system comprised of,

a water closet carrier comprised of front and back structural means;

wherein said water closet carrier is adapted to be disposed within the walls of the adjacent rooms;

* * * * *

wherein the width of said water closet carrier is approximately the distance between the consecutive, vertical studs.

Appeal No. 2000-1622
Application No. 08/752,445

As the examiner notes, the stubs are not recited as part of the claimed combination, and yet the width of the claimed structure, the water closet carrier, is defined in relation to the distance between the stubs.

We are not unsympathetic to the examiner's position, supra. Nevertheless, we consider that the present situation is governed by the Court's decision in Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1572, 1 USPQ2d 1081, 1085-86 (Fed. Cir. 1986). In that case, claim 1 of the '867 patent read:

1. In a wheel chair having a seat portion, a front leg portion, and a rear wheel assembly, the improvement wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof . . .

(806 F.2d at 1568, 1 USPQ2d at 1082; emphasis added). The Court hold that the emphasized language was not indefinite under

35 U.S.C. § 112, second paragraph, noting that witnesses testified that measuring the space between a selected automobile's doorframe and its seat and then dimensioning the front legs of the travel chair to fit that particular space in

Appeal No. 2000-1622
Application No. 08/752,445

that particular automobile was evident from the specification, and that one of ordinary skill in the art would easily have been able to determine the appropriate dimensions. The Court then stated (806 F.2d at 1076, 1 USPQ2d at 1088):

The claims were intended to cover the use of the invention with various types of automobiles. That a particular chair on which the claims read may fit within some automobiles and not others is of no moment. The phrase "so dimensioned" is as accurate as the subject matter permits, automobiles being of various sizes. See *Rosemont, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 1547, 221 USPQ 1, 7 (Fed. Cir. 1984). As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, § 112, 2d ¶ requires nothing more. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

By analogy, in the present case one of ordinary skill would have been able to determine the distance between consecutive studs, and to easily determine the dimensions of the water closet carrier so that its width would be approximately that distance, as claimed. Pursuant to the Orthokinetics decision, that is sufficient to comply with the second paragraph of § 112.

Appeal No. 2000-1622
Application No. 08/752,445

The same conclusion applies with regard to the claims which recite the width of the water closet carrier in relation to the width of the water closet (e.g., claim 68), or the height of the water closet carrier in relation to the height of the water closet (e.g., claim 72).

Accordingly, rejection (1) will not be sustained.

Rejection (2): 35 U.S.C. § 102(b)

Reading claim 66 on the unit 50 shown at the lower left of Groeniger's Fig. 1, as the examiner has done,² there is a water closet carrier width front and back structural means (walls) connected by independent structural means (side walls), the carrier adapted to receive a waste conduit junction, being of rigid construction, and having means 58 at the front for attaching and supporting as off-the-floor water closet 55. Groeniger does not disclose that the carrier 50 is adapted to be disposed within the walls of adjacent rooms or of a width approximately the distance between consecutive studs, but the examiner asserts that Groeniger meets the claim

² Attachment A of the examiner's answer apparently inadvertently show the lower right unit 10.

Appeal No. 2000-1622
Application No. 08/752,445

because it is "capable of being placed within the spacing of studs of a generic wall" (answer, page 8).

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). However, the law of anticipation does not require that the reference "teach" what the applicant teaches, but only that the claim "read on" something disclosed in the reference. Celeritas technologies, Ltd. v. Rockwell Int'l Corp., 150 F.3d 1354, 1361, 47 USPQ 1516, 1522 (Fed. Cir. 1998), cert denied, 119 S.Ct. 874 (1999).

Appellant in arguing that Groeniger does not suggest putting his invention in a wall, asserts that Groeniger teaches "providing the wall by four cabinets integrated together "(brief, page 30). We do not agree. In Fig. 3 of Groeniger, the kitchen (upper half of drawing) and bathroom (lower half of drawing) are shown as being separated by a wall (broken lines), and the patentee discloses on page 3, col. 2, lines 45 to 50, that Fig. 3 shows as arrangement of "a kitchen and a bath room in adjacency, wherein a partition of the

Appeal No. 2000-1622
Application No. 08/752,445

building is common to both bath room and kitchen." It is evident that units 10 and 50 do not provide the wall between the bath room and kitchen, for if they did, there would be no wall between the bathtub (lower right of Fig. 3) and the kitchen. Rather, Groeniger's units 10, 520 are positioned against the wall, as shown.

In any event, this issue is somewhat irrelevant to the question of anticipate, as are appellant's arguments that Groeniger does not teach or suggest putting his invention in a stud wall (brief, pages 30 and 41), since these arguments relate to obviousness under § 103, rather than anticipate under § 102. Claim 66 does not recite any particular distance between consecutive studs, nor, as appellant emphasizes on page 20 of the brief, are the studs included in claimed combination. Also, the distance between consecutive studs may vary widely from the conventional 16-inch or 24 inch spacing, depending on the circumstances; as appellant states in the amendment (filed Sept. 3, 1998) to page 27, line 8 of the specification

Studs are usually spaced 16 inches, center to center. However, the spacing between consecutive, or successive, studs may be greater

Appeal No. 2000-1622
Application No. 08/752,445

or less than 16 inches, center to center,
depending on desired spacing adjustments in
construction, as explained previously herein.

Therefore, since no distance between consecutive studs is specified in the claim, and the distance between consecutive studs is not an invariable quantity, an object such as the cabinet 50 disclosed by Groeniger has a width which is "approximately the distance between the consecutive, vertical studs," as recited in claim 66. Whether Groeniger's structure is designed or intended to be placed between studs in a wall is not germane to the question of anticipation, such being simply an intended new use for an old product, which does not make a claim to that old product patentable. In re Schreiber, supra. Claim 66 is anticipated by Groeniger since the claimed structure "reads on" Groeniger's disclosed apparatus. Celeritas Technologies, supra.

We reach the same conclusion with regard to the other independent claims in which the width of the carrier is claimed in relation to the stud spacing, i.e., claims 76, 83 and 86.

Appellant further argues that claim 66 distinguishes over Groeniger in that it recites that the water closet carrier "is

of rigid construction substantially independently of the wall and the waste conduit junction" (brief, pages 36 to 40). This argument is not well taken. The Groeniger carrier 50 is of rigid construction, having, like cabinet 10, a framework of angle irons 12, 14 (page 2, col. 2, lines 10 to 16, and see Figs. 2 and 3) which is independent of the wall and waste conduit junction, and rests on the floor (page 1, col. 2, lines 48 to 51; Fig. 2).³ Whether or not carrier 50 of Groeniger is intended to be connected to the wall or other structure (which Groeniger does not disclose) is not relevant to whether the structure recited in the claim reads on Groeniger.

The discussion in the foregoing paragraph is also applicable to the other claims on appeal, including claim 82.

Accordingly, rejection (2) will be sustained as to claims 66, 76, 82, 83 and 86, and as to dependent claims 67 and 77, which appellant has not argued separately from their parent claims.

³ The statement on page 38 of the brief that the angle irons are part of the wall structure is not understood, since they are located in Groeniger's carrier 50, not in the wall behind it.

Appeal No. 2000-1622
Application No. 08/752,445

The remaining claims on appeal contain limitation relating the width and/or height of the water closet carrier to the width and/or height of the off-the-floor water closet.

Claim 68, which is representative of the "width" claims, recites, inter alia:

wherein said water closet carrier is approximately the same width as the width of one of the one or more off-the-floor water closets.[⁴]

Looking at Fig. 3 of Groeniger, it is evident that carrier 50 is not "approximately the same width" as water closet 55. The rejection under § 102(b) of claim 68, of dependent claims 70 and 80, and of claims 75, 84 and 85, which contain similar limitations, therefore will not be sustained.

Claims 72, representative of the "height" claims, recites, inter alia:

wherein said water closet carrier is approximately of equal height with the one or more off-the-floor water closets.

The carrier 50 of Groeniger is shown as extending a considerable distance above the bowl of the water closet 55,

⁴ We do not find antecedent basis in the specification for this language, as required by 37 CFR § 1.75(d)(1).

Appeal No. 2000-1622
Application No. 08/752,445

in order to accommodate the flush tank 52. While the flush tank might well be considered part of the water closet, we believe that one of ordinary skill in the art, reading claim 72 in light of appellant's disclosure (i.e., page 26 and Fig. 4) would interpret the term "height," as it relates to the off-the-floor water closet, to mean the height of the top of the bowl which is supported by the attachment means on the front and/or back of the carrier. As so construed, claim 72 is not anticipated by Groeniger, since Groeniger's carrier is not of "approximately equal height" with the top of the water bowl 55. Likewise, claims 78, 79, 81 and 85 are not anticipated, and rejected (2) will not be sustained as to them.

Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 68, 70, 75 and 84 are rejected under 35 U.S.C. § 103(a) as unpatentable over Groeniger. As discussed above, Groeniger meets all the limitations of these claims, except that it does not disclose that the carrier 50 is approximately the same width as water closet 55. However, as far as Groeniger is concerned, carrier 50 will perform its function of supporting the water closet 55

Appeal No. 2000-1622
Application No. 08/752,445

as long as it is not least as wide as the water closet; whether it is made any wider depends only on the space available in the bathroom in which it is to be installed and the distance which the designer wishes to have between the lavatory (supported at 16) and the water closet. Thus, it would have been obvious to make the carrier 50 of Groeniger approximately the width of the water closet 55, this being a matter of design choice dependent on the space available and personal preference, not achieving a different purpose. Cf. In re Gal, 980 F.2d 717, 719, 25 USPQ2d 1076, 1078 (Fed. Cir. 1992).

Conclusion

The examiner's decision to reject claims 66 to 68, 70, 72, 75 and 78 to 85 under the second paragraph of § 112 is reversed, and the reject claims 66, 68, 70, 72 and 75 to 86 under § 102(b) is affirmed as to claims 66 to 67, 76, 77, 82, 83 and 86, and reversed as to claims 68, 70, 72, 75, 78 to 81, 84 and 85. Claims 68, 70, 75 and 74 are rejected pursuant to 37 CFR § 1.196(b).

Appeal No. 2000-1622
Application No. 08/752,445

In addition to affirming the examiner's rejection of one or more claims, 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, "[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

Appeal No. 2000-1622
Application No. 08/752,445

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

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. 2000-1622
Application No. 08/752,445

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)

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. GONZALES)	
Administrative Patent Judge)	

Appeal No. 2000-1622
Application No. 08/752,445

L. LEE HUMPHRIES, ESQ.
7821 TIBANA STREET
LONG BEACH, CA 90808

Shereece

Appeal No. 2000-1622
Application No. 08/752,445

APJ CALVERT

APJ

APJ

AFFIRMED-IN-PART; 37 CFR 1.196(b)

Prepared: December 20, 2001