

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WOLFGANG BEHRENS

Appeal No. 2003-0306
Application No. 08/967,043

ON BRIEF

Before STAAB, MCQUADE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 23, 25-27, 29-33 and 37-40, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a vegetation element for use in precultivation or direct on-site sodding. Further understanding of the invention can be obtained from a reading of claim 23, which is reproduced, infra, in the opinion section of this decision.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Nestor	2,648,165	Aug. 11, 1953
Allen	2,923,093	Feb. 2, 1960
Lippoldt et al. (Lippoldt)	3,516,196	Jun. 23, 1970
Angruner	3,890,910	Jun. 24, 1975
Schmidt	4,272,919	Jun. 16, 1981
Muldner	4,318,248	Mar. 9, 1982

Claims 23, 29, 30 and 37-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Muldner.

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Muldner and Schmidt.

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Muldner, Schmidt and Nestor.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Muldner, Schmidt and Lippoldt.

Claims 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Muldner and Angruner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection and answer (Paper Nos. 23 and 27) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 26) 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, for the reasons which follow, we cannot sustain any of the examiner's rejections.

Claim 23, the sole independent claim before us in this appeal, reads as follows:

An improved vegetation element having an upper surface and a lower surface for use when providing uniform sodding on a surface that is to receive plant growth, said vegetation element comprising a vegetation carrier layer (a) of flexible hygroscopic rock wool, and attached thereto a seed mat (b) of flexible biodegradable material which contains seeds therein that are secured and held in place at uniformly spaced locations within said seed mat, wherein said vegetation carrier layer (a) is positioned below said seed mat (b).

Each of the examiner's rejections relies, at least in part, on the basic determination that it would have been obvious, in view of the teachings of Muldner, to move the cover layer 9 of Allen's seed planting mat from above the seed layer (layer 6

of growing media in which seeds 8 are evenly distributed) to below the seed layer, as called for in claim 23. The examiner points out that Muldner teaches a vegetation element comprising a carrier layer 13 positioned below a seed mat 15 to provide structural integrity to the mat and determines from this disclosure that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to position the vegetation carrier layer of Allen below the seed mat of Muldner in order to provide structural integrity to the vegetation element of Allen” (final rejection, pages 2-3).

The “carrier layer” (base sheet 13) of Muldner comprises a biodegradable material which is preferably a light tissue paper which “deteriorates rapidly, losing a substantial portion of its strength upon initial wetting” (column 3, lines 7-9). The cover layer 9 of Allen, on the other hand, comprises loose fibres, such as natural fibres, synthetic plastic, glass wool or the like, “capable of felting and subsequently suffering gradual disintegration on exposure” (column 2, lines 15-17; emphasis ours) and serves to protect the seed from wind, rain and birds and other garden pests (column 2, lines 61-64).

We fail to perceive any teaching or suggestion in the applied references to modify Allen’s seed planting mat as proposed by the examiner by moving the cover layer 9 to a location below the seed layer. First, the cover layer 9 of Allen is located above the seed layer 6 to protect the seed in layer 6 from wind, rain and birds and other

pests. Movement of the cover layer to a location below the seed layer would render it incapable of serving its intended protection function and, thus, would not have been obvious to one of ordinary skill in the art.¹ Moreover, as to the motivation alluded to by the examiner, namely, to provide structural integrity to the vegetation element of Allen, a base or backing layer 5 of fibrous material is already provided below the seed layer 6 of Allen for this purpose. From our perspective, the only suggestion for putting the selected pieces from the references together in the manner proposed by the examiner is found in the luxury of hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). It follows that we shall not sustain the examiner's rejection of claim 23, or claims 29, 30 and 37-40 which depend from claim 23, as being unpatentable over Allen in view of Muldner.

The above-noted deficiency in the combination of Allen and Muldner finds no cure in the additional teachings of Schmidt, Nestor, Lippoldt and Angruner. Thus, we also shall not sustain the rejections of claim 25 as being unpatentable over Allen in view of Muldner and Schmidt, claim 26 as being unpatentable over Allen in view of Muldner, Schmidt and Nestor, claim 27 as being unpatentable over Allen in view of Muldner,

¹ Where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. See Tec Air Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Schmidt and Lippoldt and claims 31-33 as being unpatentable over Allen in view of Muldner and Angruner.

CONCLUSION

To summarize, none of the examiner's rejections is sustained. The decision of the examiner is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. MCQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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