

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROSALIE J. CALHOUN, ANTHONY S. CASABLANCA
LOLA J. FISHER, GARY M. MCBREEN,
DALE E. OLIVER and CHARLES F. WINBURN

Appeal No. 2003-1599
Application 09/494,028

ON BRIEF

Before WARREN, DELMENDO and MOORE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain the grounds of rejection advanced on appeal: appealed claims 1 through 3, 10 through 12 and 19 through 22 under 35 U.S.C. § 102(b) as being anticipated by Winburn et al. (Winburn); appealed claims 35 through 38 under 35 U.S.C. § 102(b) as being anticipated by Delaquila et al. (Delaquila); and appealed claims

5, 6, 8, 9, 14, 15, 17, 23, 24, 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Winburn in view of Cox.¹

The application of prior art to the claims requires as a first step, the determination of the broadest reasonable interpretation of the language of the claims in light of the written description in appellants' specification as it would be interpreted by one of ordinary skill in this art. *See, e.g., In re Thrift*, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). In doing so, *all* claim limitations must be given effect. *See In re Angstadt*, 537 F.2d 498, 501, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). Whether a statement of purpose or intended use in the preamble of a claim and/or in the body of the claim constitutes a limitation or limitations that is/are necessary in order to give meaning to the claim and properly define the invention, is determined in the context of the claimed invention as a whole, including consideration thereof in light of the written description in appellants' specification. *See generally In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1781 (Fed. Cir. 1992), citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir. 1984), *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989), *In re Stencel*, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987) ("Whether a [statement] . . . of intended purpose constitutes a limitation to the claims is, as has long been established, a matter to be determined on the facts of each case in view of the claimed invention as a whole.").

The language of appealed claim 1 illustrates, with the supplied italicized emphasis, the dispositive claim interpretation issue with respect to the first and third grounds of rejection:

1. A dish assembly adapted to be positioned in a lid of a *full top* casket, said assembly comprising:

¹ Claims 4, 7, 13, 16, 18, 25 and 28 through 34 are also of record and have been allowed by the examiner.

a cap panel sized and configured to fit within the *full top* casket lid and puffing members attached to said panel around a periphery thereof;

a first cap panel insert overlying said cap panel; and

second and third cap panel inserts positioned at opposite longitudinal ends of said first cap panel insert and overlying said cap panel;

said first cap panel insert sized and configured to fit within and substantially completely fill a dish assembly of a *cut top* casket;

said first, second and third cap panel inserts sized and configured to fit within and substantially completely fill said *full top* casket dish assembly.

The examiner states that “[r]egarding claims 1, 10, and 19, per the current claim language, a dish assembly of, and defined by, a *cut top* casket lid is not being positively claimed and represents the intended use of the invention” because the language “sized and configured” is not considered to be “a positive structural limitation” (answer, pages 4 and pages 5-6).

Appellants argue that the language must be given effect (brief, page 8, n.1; reply brief, page 3).

We agree with appellants. We determine that when the plain language of illustrative claim 1 is considered in light of the specification and in the context of the claimed invention as a whole, it is readily apparent that the claimed dish assembly encompasses a dish assembly wherein the cap panel must be of a size and configuration to fit within the lid of a *full top* casket, and the first cap panel insert of that cap panel must be of a size and a configuration to substantially completely fill the dish assembly for the lid of a *cut top* version of *that full top* casket.

Turning now to the application of *Winburn* and of the combined teachings of *Winburn* and *Cox* in the first and third grounds of rejection to appealed independent claims 1, 10 and 19, and appealed claims dependent thereon, it is well settled that in making out a *prima facie* case of anticipation under § 102, each and every element of the claimed invention, arranged as required by the claims, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). It is further well settled that in order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show

that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988). In these respects, it is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, see *In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

We find that the examiner admits that cap panel insert member **20**, which is bordered by cap panel inserts **40** and **42** of central panel **16** and by upper and lower puffing portions **30** and **32** of framing **18** of the dish assembly of cut top casket **10** as shown in **Figs. 1** through **8** and described in Winburn (cols. 2-3), does not substantially completely fill the dish assembly of that cut top casket as required by the appealed claims here considered (answer, pages 5-6). Thus, the examiner contends that panel member **20** "is 'capable of' being sized and configured to substantially completely fill a dish assembly of a cut top casket" (*id.*). Appellants point out that there is no basis in Winburn which factually supports the examiner's position and thus, the reference neither teaches nor provides motivation to arrive at a dish assembly encompassed by the rejected claims (brief, pages 7-8; reply brief, pages 1-3).

We again agree with appellants. It is not apparent on this record that one skilled in this art and/or one of ordinary skill in this art would have reasonably inferred from the figures and disclosure of Winburn with respect to the three panel arrangement for the cut top casket, that the size of panel **20** could be increased to substantially completely fill the dish assembly of cut top

casket **10**, even in view of the disclosure that “the present invention is applicable to one-piece casket lids” that we find in Winburn (col. 3, lines 49-51), because the three panel arrangement must necessarily be present. Indeed, while we find that Winburn discloses a single panel **50** in, e.g., **Fig. 9** as described at col. 3, lines 32-39, we fail to find therein a suggestion to combine this single cap panel inset with any other cap panel insert in applying such panel to a one-piece casket lid.

Thus, on this record, we find that as a matter of fact, Winburn does not describe the claimed dish assembly encompassed by the appealed claims within the meaning of § 102(b), and accordingly, we reverse the first ground of rejection. With respect to the ground of rejection under § 103(a), on this record, we further conclude as a matter of law that Winburn alone or combined with Cox does not provide any objective teaching, suggestion or motivation to arrive at the claimed invention encompassed by the appealed claims, and accordingly, we reverse the third ground of rejection.

With respect to the second ground of rejection, the language of appealed claim 35, on which appealed claims 36 through 38 depend, illustrates the involved dispositive claim interpretation issue:

35. A dish assembly adapted to be positioned in a lid of a casket, said dish assembly comprising:

a cap panel;

a first cap panel insert overlying said cap panel, said first cap panel having opposite end edge portions; and

a second cap panel insert overlying said cap panel, said second cap panel insert having an end edge portion overlying one of said end edge portions of said first cap panel insert.

The examiner states that “[r]egarding claim 35, per the current claim language, a casket and its lid are not being positively claimed and represents the intended use of the dish assembly” (answer, page 6; *see also* page 3). Appellants contend that “[a] dish assembly is a term of art well known in the funeral industry to describe an aesthetically pleasing unit structured, configured and arranged to fit within the underneath side of a casket cap” (brief, page 11). We note, in this respect, the disclosure at specification page 2, lines 6-8.

We find that the written description in appellants' specification makes clear to one of ordinary skill in this art what a dish assembly is and how it is used, such that in light of the specification and the claimed invention as a whole, the plain language of illustrative appealed claim 35 is clearly drawn to a dish assembly which can be positioned in the lid of a casket and comprises at least the stated separate panel and panel insert components in this respect. Thus, the preamble of appealed claim 35 is a structural limitation on the dish assembly as claimed even though such language does not otherwise limit the claimed dish assembly to that use. *See generally Stencel, supra.*

While the examiner correctly takes the position that the appealed claims are anticipated if they “‘read on’ something disclosed in the reference, i.e., all limitations of the claims are found in the reference, or ‘fully met’ by it,” *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), the question of whether a reference meets *all* of the claim limitation is one of fact. *See generally, Schreiber, supra; Preda, supra.* In this respect, we agree with appellants that the full view changeable display sign of Delaquila is simply “not a dish assembly as claimed” because, as a matter of fact, the display sign as described in the reference cannot be positioned in the lid of a casket in the same manner as a dish assembly, no matter how affixed to the lid. Indeed, we discern no disclosure in the reference or inference that one skilled in the art would have drawn from any disclosure therein, which would have described the claimed invention encompassed by appealed claims 35 through 38 within the meaning of § 102(b). Accordingly, we reverse the second ground of rejection.

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN
Administrative Patent Judge

ROMULO H. DELMENDO
Administrative Patent Judge

JAMES T. MOORE
Administrative Patent Judge

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