

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD E. WEDER

Appeal No. 96-1997
Application 08/176,614¹

ON BRIEF

Before COHEN, LYDDANE, and CRAWFORD, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claim 8, which is the only claim remaining in the application.

¹ Application for patent filed January 3, 1994. According to appellant, this application is a continuation of Application 07/984,815, filed December 3, 1992, now Patent No. 5,274,900, issued January 4, 1994.

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Claim 8 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Clement.

Rather than reiterate the examiner's statement of the above rejection and the conflicting viewpoints advanced by the examiner and the appellant, we refer to pages 3 and 4 of the examiner's answer, to pages 2 through 7 of the appellant's brief and to the appellant's reply brief for the full exposition thereof.

OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellant's specification and claim, to the applied prior art, and to the respective positions advanced by the appellant and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish an anticipation of claim 8 under 35 U.S.C. § 102(b). Our reasoning for this determination follows.

We initially observe that an anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1064 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988); RCA Corp. v.

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Applied Digital Data Sys. Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), 468 U.S. 1228 (1984). Additionally, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found 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) (and overruled in part on another issue) SRI Int'l v. Matsushita Elec. Corp. Of Am., 775 F.2d 1107, 1118, 227 USPQ 577, 583 (Fed. Cir. 1985). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of properties that are inherently possessed by the reference. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). Also, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. See In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), cert. denied, 116 S.Ct. 1362 (1996), quoting from In re LeGrice, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

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With this as background, we have carefully analyzed appealed claim 8, comparing it with the receptacle and method disclosed in the patent to Clement and taking into account the positions advanced by both the examiner and the appellant. It is apparent that the method of assembly of the receptacle of Clement, using the collar or ring member 20 and blank 10 depicted in Figures 1 through 3, and their use with a flower pot as disclosed in column 2, lines 67 through 69, is quite similar to the method recited in appealed claim 8.

However, we agree with the appellant's position expressed in the paragraph spanning pages 2 and 3 of the reply brief that appealed claim 8 requires

that the collar and pot are first provided,
then the collar is secured to the pot, and
finally the sheet is shaped about both the
pot and collar,

and we so interpret appealed claim to require the above sequence of steps. Consequently, even assuming arguendo that the step of "securing said collar on the outer peripheral surface of said flower pot" reads on the use of the assembled receptacle with a flower pot to retain it securely against shifting as asserted by the examiner, we must further agree with the appellant's position

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that the method of Clement fails to disclose appellant's claimed step of

shaping the sheet of material generally about at least a portion of the outer peripheral surface of the flower pot and generally about the collar.

Therefore, the receptacle and method of Clement fail to include every element of the invention recited in appealed claim 8. Thus, claim 8 is not anticipated thereby, and we cannot sustain the examiner's rejection thereof.

However, we make the following new rejection pursuant to the provisions of 37 CFR § 1.196(b).

Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of appellant's prior U. S. Patent No. 5,274,900. The method of claim 1 of the patent is virtually the same as that recited in appealed claim 8 except that claim 1 additionally requires the collar to be positioned and secured "between the upper and lower ends of the flower pot" and "placing the bottom of the flower pot on the sheet of material." Nevertheless, it is our opinion that one having ordinary skill in the art would have

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readily appreciated the broader method recited in appealed claim 8 as obvious from the more specific method of the patent claim. We note that the law presumes skill on the part of the artisan rather than the converse. See In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985).

This new rejection of appealed claim 8 may be overcome by an appropriately filed terminal disclaimer.

Accordingly, the decision of the examiner rejecting claim 8 under 35 U.S.C. § 102(b) is reversed, and a new rejection has been made of claim 8 under the judicially created doctrine of obviousness-type double patenting pursuant to the provisions of 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision. 37 CFR § 1.197. Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action

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in connection with this appeal may be extended under
37 CFR § 1.136(a).

REVERSED, 37 CFR § 1.196(b)

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William E. Lyddane)	BOARD OF PATENT
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