

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT E. PETERSON and GEORGE W. PETERSON

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Appeal No. 97-1974  
Application 08/286,696<sup>1</sup>

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ON BRIEF

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Before CALVERT, MEISTER, and PATE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 9. Claim 10, the other claim in the application, stands withdrawn from consideration under 37 CFR 1.142(b) as being directed to a nonelected invention.

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<sup>1</sup>Application for patent filed August 5, 1994.

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The appealed claims are drawn to a flowerpot hanger, a saucer holder, and a method of hanging a flowerpot. Claims 1 to 9 are reproduced in Appendix A of appellants' brief.

The references applied in the final rejection are:

Minnick	5,074,504	Dec. 24,
1991		
Shepherd et al. (Shepherd)	5,405,116	Apr. 11,
1995		
		(Filed Apr. 19, 1994)

The claims on appeal stand finally rejected as follows:

- (1) Claims 5 to 8, unpatentable for failure to comply with 35 USC § 112, second paragraph;
- (2) Claims 1 to 5, anticipated by Shepherd, under 35 USC § 102(e);
- (3) Claim 4, anticipated by Minnick, under 35 USC § 102(b);
- (4) Claims 6 to 9, unpatentable over Shepherd, under 35 USC § 103.

Rejection Pursuant to 37 CFR § 1.196(b)

Before considering the merits of the rejections appealed from, we enter the following rejection pursuant to 37 CFR

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1.196(b).

Claim 3 is rejected for failure to comply with 35 USC § 112, second paragraph. This claim recites a slot in the base, "aperture means" extending through the saucer holder, and "fastener means for mounting said aperture means to said slot". These recitations are indefinite, in that it is not apparent how an aperture, i.e., an opening, can be fastened to another opening (the slot). Also, when attempting to read this claim on appellants' disclosed apparatus, it is not evident what structure it is intended to define (cf. In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971)). Presumably the "aperture means" would be the tapped holes in the saucer holder (page 13, line 9), and "fastener means" is intended to read on fasteners 104A and 104B, but the fasteners do not mount the tapped holes to the slot 102 in base 30, but rather serve to mount the saucer holder 32, as disclosed at page 13, lines 3 to 16. Since one of ordinary skill would not be reasonably apprised of the scope of claim 3, it is indefinite. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

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Rejection (1)

The rejection of claims 5 to 8 under 35 USC § 112, second paragraph, is based on the examiner's finding that "it is not clear if applicant [sic] is claiming the 'clay flowerpot holder' in combination with the saucer holder" (answer, pp. 3 to 4). We

consider this rejection to be well taken. A claim is indefinite if it does not reasonably apprise those of skill in the art of its scope. In re Warmerdam, *supra*. Regardless of whether claim 5 is in Jepson form (i.e., as provided in 37 CFR § 1.75(e)), as argued by appellants at page 18 of their brief, its scope is indefinite in that one of ordinary skill could not readily determine whether the recited "a clay flowerpot holder" constitutes a part of the apparatus which the claim is intended to cover, or is merely a point of reference for the positions of the saucer holder. Appellants' argument that "Everything recited in claim 5 is claimed but the claim specifies the improvement" begs the question of whether or not the "clay flowerpot holder" is an element of the claimed

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combination.

Rejection (1) will therefore be sustained.

Rejection (2)

The rejection of claim 1 as anticipated by Shepherd will be sustained.

Appellants' only argument with regard to claim 1 is that Shepherd's base 12 and upper flowerpot holder 26, which is

disclosed as being attached to the base by bolt 42 and nut 44, are not "integrally formed", as recited. The construction of the expression "integrally formed" was considered in In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). In that case, the examiner held that an elastomeric pad 100 disclosed in the reference (Brown) as being engaged between the base plate and lower housing was "integrally formed" as a portion of the support member. The court sustained this interpretation, as follows (127 F.3d at 1055-1056, 44 USPQ at 1029):

We conclude that the PTO's interpretation is

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reasonable in light of all the evidence before the Board. As the cases cited above demonstrate, our predecessor court had on several prior occasions interpreted the term "integral" to cover more than a unitary construction. See, e.g., *In re Kohno*, 391 F.2d 959, 157 USPQ 275 (CCPA 1968), *In re Dike*, 394 F.2d 584, 157 USPQ 581 (CCPA 1968), *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965), and *In re Clark*, 214 F.2d 148, 102 USPQ 241 (CCPA 1954). This court has also endorsed that interpretation. See, e.g., *Advanced Cardiovascular Sys. v. Scimed Life Sys.*, 887 F.2d 1070, 1074, 12 USPQ2d 1530, 1542 (Fed. Cir. 1989) (nothing of record limited "integral" to mean "of one-piece" construction). Appellants' attempt to distinguish these cases misses the point. Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation.

Here, looking at appellants' specification, we find no express definition therein of "integral" or "integrally formed".

Therefore, in accordance with *In re Morris*, we interpret "integrally formed" as covering the bolted-together construction of base 12 and upper flowerpot holder 26 of Shepherd, and consequently conclude that Shepherd anticipates the apparatus recited in claim 1. As for claim 2,

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appellants argue that the lower saucer holder disclosed by Shepherd does not include, as recited, "a slanting surface" for gripping the edges of the saucer. The examiner identifies Shepherd's "slanting surface" as Shepherd's surface 34, but, as shown in Figs. 4 and 5, this surface does not engage the saucer 7, but rather the saucer is held between lip 38 and the slanting surfaces at the lower ends of the sides 21 of the base. The rejection of claim 2 as anticipated by Shepherd will therefore not be sustained.

The rejection of claims 3 and 5 will also not be sustained. We have rejected claim 3, *supra*, and have sustained the rejection of claim 5, on the ground that they fail to comply with the second paragraph of § 112, because their scope is not clearly defined. Under these circumstances, claims 3 and 5 should not be rejected as unpatentable over prior art. See *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). We note however, that our reversal of the rejection under § 102(e) is *pro forma* only, and should not be taken as a holding that if the indefiniteness rejections were overcome, claims 3 and 5 would

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necessarily be patentable over Shepherd.

Appellants argue as to claim 4 that it is not anticipated by Shepherd because, *inter alia*, Shepherd does not disclose "an outwardly slanting surface extending from the flat surface adapted to support a slanting portion of the saucer." We agree. The examiner states that Shepherd's flat surface is surface 32, and the slanting surface is 34. However, surface 34 is not "outwardly" slanting from surface 32, nor does it, as discussed above, support a slanting portion of saucer 7. Accordingly, we will not sustain the rejection of claim 4 over Shepherd under § 102(e).

#### Rejection (3)

On page 6 of the answer, the examiner reproduces Fig. 1 of the Minnick patent with labels showing where each element recited in claim 4 may be found. The appellants argue, however, that Minnick does not anticipate claim 4 because (1) Minnick does not include a separate base between the holder and the support structure, (2) Minnick discloses a flowerpot holder, not a saucer holder, and (3) Minnick does not disclose adjusting a holder

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with respect to a base (brief, pages 20 to 21).

In order to anticipate a claim, a 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). With regard to appellants' arguments (1) and (3), the examiner takes the position that the "base" recited in claim 4 is readable on the wall on which Minnick's holder is mounted. We consider this position to be well taken. During patent examination, the pending claims are to be interpreted as broadly as their terms reasonable allow, In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), and limitations from the specification are not to be read into the claims. Sjolund v. Musland, 847 F.2d 1573, 1581, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988). Contrary to appellants' arguments, claim 4 does not recite a base between the holder and support structure, but simply recites that the holder is "adapted to be mounted to a base" and has a "means fastened to said vertical member and movable with respect to said base for adjusting the saucer holder with respect to said base". Giving "base" its

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broadest reasonable interpretation, we consider that the wall on which Minnick's holder is adapted to be mounted, and with respect to which it is movable, constitutes a "base", as claimed.

Appellants' argument (2) is equally unpersuasive. The examiner found that Minnick's holder could inherently hold a saucer with a slant portion (final rejection, page 6), and appellants have not presented anything to prove that this finding is incorrect. In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-139 (Fed. Cir. 1986).

Rejection (3) will be sustained.

Rejection (4)

In view of our holding, *supra*, that rejection (1) will be sustained in view of the indefiniteness of claims 5 to 8, the rejection of claims 6 to 8 under § 103 will not be sustained, for the reasons discussed above in connection with our consideration of the rejection of claims 3 and 5 under § 102. Here again, however, we emphasize that if the § 112 rejection of claims 6 to 8 is overcome in any subsequent prosecution, they may still be unpatentable under § 103.

Turning to method claim 9,<sup>2</sup> appellants argue that this claim is patentable over Shepherd because in Shepherd the flowerpot and saucer are both supported by foot 32 and therefore the saucer would not be mounted underneath (i.e., after) the flowerpot and positioned with respect to the flowerpot (brief, pages 22 to 23). Although the examiner asserts that the claimed method would have been obvious and that Shepherd's flowerpot and saucer are not both supported by foot 32 (answer, page 10), this is not borne out by Shepherd's disclosure at col. 3, lines 5 to 31, which states that tray (saucer) 7 is mounted first (Fig. 4), and then the flowerpot 6 is "seated in the drainage tray 7, as shown in FIG. 5" (col. 3, lines 21 and 22). As for the question of support, Shepherd indicates that foot 32 supports both the tray (saucer) and the flowerpot, as follows (col. 3, lines 25 to 28):

The drainage tray 7 is thus supported on the foot 32 and held in place by the rim hook 38, while the

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<sup>2</sup>In reviewing the disclosure of the application, we note that since screws 104A and 104B are only accessible from the rear of the base 30, the steps described on page 17, line 16, to page 18, line 2, would have to be performed before the base is mounted on the support 14. The base would then have to be mounted on the support before the flowerpot is inserted (Fig. 12) so that the flowerpot would not block access to the mounting apertures 72, 74, 76. It is suggested that the application be clarified by amending the specification to point out these requirements.

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flowerpot 2 is supported by the drainage tray 7 and held in place by the rim hook 26, as shown in FIG. 6.

We therefore conclude that the method recited in claim 9 would not have been suggested by Shepherd, and will not sustain the rejection of claim 9.

#### Conclusion

The examiner's decision to reject claims 5 to 8 under 35 USC § 112, second paragraph, is affirmed; to reject claims 1 to 5 under 35 USC § 102(e) is affirmed as to claim 1 and reversed as to claims 2 to 5; to reject claim 4 under 35 USC § 102(b) is affirmed; and to reject claims 6 to 9 under 35 USC § 103 is reversed. Claim 3 is rejected 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 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

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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. . . .

Should the appellants 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. §§

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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 appellants elect 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 rehearing thereof.

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 )  
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WILLIAM F. PATE, III	)	
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