

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTEN BURGDORF
and DIETMAR PRZYTULLA

Appeal No. 97-2535
Application 08/129,108¹

HEARD: APRIL 7, 1999

Before McCANDLISH, Senior Administrative Patent Judge, COHEN and MEISTER, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 9, 10 and 14 through 24. The only other claims still pending in the application have been withdrawn from consideration as being directed to a non-elected invention.

¹ Application for patent filed November 18, 1993. According to appellants, this application is a 371 of PCT/EP93/00284, filed February 6, 1993.

Appellants' invention relates to a pallet container assembly (10) having a plastic container (12), a steel mesh support cage (14) and a floor pallet (16). The plastic container (12) is seated on what is described as a top plate (22)² of the floor pallet. The steel mesh support cage (14) peripherally surrounds the plastic container (12) and is described as having horizontal rods (34) and vertical rods (18) welded to the horizontal rods. The lowermost horizontal rod (34) of the cage (14) is seated on the upper face of the top plate (22) of the floor pallet. The floor pallet also includes a bottom plate (24) and a structure between the top and bottom plates

In the embodiment shown in Figure 3 of appellants' drawings, some of the vertical rods (18) are longer than others. These longer vertical rods extend through bores (20) in the pallet plates and are threaded at their lower ends (26) to removably receive nuts (28). The nuts (28) engage the underside of the bottom pallet plate (24) to effectively connect the threaded vertical rods (18) to the bottom pallet plate (24), thereby securing the plastic container (12) in place on the top pallet plate (22). In other embodiments, such as Figure 5, discs (30) engage the underside of the bottom pallet plate and are welded to the lower ends of the longer vertical rods (18) to effectively provide a permanent attachment of the longer vertical rods to the bottom pallet plate.

² The top plate of the floor pallet is shown in Figure 3 to constitute two plate members, one seated on the other.

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An amendment directed to claim 18 and filed with appellants' reply brief has been entered by the examiner (see the supplemental answer mailed January 29, 1997). A copy of claim 18 in its amended form, along with the other appealed claims, is appended to appellants' reply brief (Paper No. 24). Because of the multiple dependency of claims 14, 15, 17 and 18, the copy of the claims appended to appellants' reply brief, as well as appellants' main brief, include claims that were withdrawn by the examiner as being direct to a non-elected invention. To set the record straight, the claims on appeal are claims 9, 10, 14/9, 14/10, 15/14/9, 15/14/10, 16, 17/9, 17/10, 18/9, 18/10 and 19 through 24.

A copy of claim 9, which is illustrative of the subject matter at issue, is appended to this decision.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Marques	4,054,223	Oct. 18, 1977
Schutz	4,909,387	Mar. 20, 1990
Rudko	4,921,196	May 1, 1990
Salaun et al. (Salaun) (France Application) ³	2,643,043	Aug. 17, 1990

³ Translation attached.

The grounds of rejection are as follows:

1. Claims 9, 10, 17/9, 17/10, 18/9 and 18/10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schutz in view of Rudko and Marques.

2. Claims 14/9, 14/10, 15/14/9 and 15/14/10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the references applied in the rejection of claims 9 and 10 above, and further in view of Salaun.

3. Claims 9, 10 and 14 through 24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regards as their invention.⁴

With regard to the rejection of the appealed claims under the second paragraph of § 112, the examiner states that the independent claims, namely claims 9, 16 and 19, "are indefinite because they are submitted in improper Jepson type format" (answer, page 4). His position is

⁴ We will decide this rejection on basis of the claims that are actually on appeal as we have set forth above.

that the recitation of the word "wherein" instead of the word "comprises" in the preambular phrase "the improvement wherein . . ." renders the claim language indefinite.

Admittedly, the word "comprises" is used in the customary Jepson format. Although this language is suggested in 37 CFR § 1.75(e), it does not necessarily follow that the use of the word "wherein" in place of the word "comprises" renders the claims indefinite. Despite the use of the word "wherein" in the preambular phrase "the improvement wherein . . .", one skilled in the art would nevertheless understand what is claimed. As a result, the claims are considered to be definite as required by the second paragraph of § 112. See Seattle Box Co. v. Industrial Crating & Packing Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). Accordingly, we must reverse the examiner's rejection of claims 9, 10 and 14 through 24 under the second paragraph of § 112.

With regard to the § 103 rejection of independent claim 9, the examiner concludes that "[i]t would have made it obvious to replace the welded vertical rod connection [of Schutz] with a threaded connection by adding threads to the vertical rod of Schutz and extending this vertical rod through the plate of Schutz and fastening the vertical rod to the plate with a nut as taught by both Marques and Rudko in order to make the connection between the vertical rod and pallet

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detachable to provide for [the] replacement of damaged parts without having to replace the entire pallet container" (answer, page 7). This rejection is not sustainable.

It is well established patent law that there must be some teaching, suggestion or inference in the prior art as a whole or some knowledge generally available to one of ordinary skill in the art that would have led one of ordinary skill in the art to make the modification needed to arrive at the claimed invention. See, inter alia, In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed Cir. 1988) and Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988). See also In re Lahu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) (the prior art must provide one of ordinary skill in the art with the motivation to make the modification needed to arrive at the claimed invention).

In the present case, appealed claim 9 expressly requires that the mesh cage be permanently attached to the floor plate. In contrast, both Marques and Rudko suggest the concept of detachably connecting vertical rods to a floor plate. Thus, even if the teachings of Marques and Rudko would have made it obvious to detachably connect the vertical rods of Schutz's cage to the floor plate for purpose stated by the examiner, the result would not arrive at

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the invention defined in claim 9 as required in Fine, 837 F.2d at 1074, 5 USPQ2d at 1598.

Accordingly, we must reverse the § 103 rejections of appealed claims 9, 10, 14/9, 14/10, 15/14/9, 15/14/10, 17/9, 17/10, 18/9 and 18/10.

Under the provisions of 37 CFR § 1.196(b), the following new grounds of rejection are entered against claims 9, 10 and 14 through 24:

1. Claims 9, 10, 14/9, 14/10, 15/14/9, 15/14/10, 16, 17/9, 17/10, 18/9, 18/10 and 19 through 24 are rejected under the first paragraph of 35 U.S.C. § 112 as being based on a specification which, as filed, does not satisfy the description requirement in that paragraph.

2. Claims 10, 14/10, 15/14/10, 17/10, 18/10, and 19 through 24 are rejected under 35 U.S.C. § 112 ¶ 2 as being indefinite and hence failing to particularly point out and distinctly claim the subject matter which appellants regards as their invention.

Considering first the new rejection under the first paragraph of § 112, all of the independent claims 9, 16 and 19 recite that the mesh cage is permanently attached to the same plate on which the

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plastic container is seated. However, according to appellants' application disclosure as filed (namely the original specification, the original claims and the original drawings), the plastic container is seated on the top plate of the pallet floor while the mesh cage is attached to the bottom plate of the pallet floor through the engagement of the fastening elements (e.g., discs 30) with the underside of the bottom plate. The specific language that the container and the cage are respectively seated on and permanently attached to the same floor plate cannot be ignored.

As a result, the disclosure in appellants' application as originally filed does not reasonably convey to the artisan that appellants had possession at that time of the subject matter now claimed. The disclosure as originally filed, therefore, does not satisfy the description requirement in the first paragraph of § 112. See In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

With regard to the new rejection under the second paragraph of § 112, the combination defined by dependent claim 10 contains limitations of two mutually exclusive embodiments, namely the embodiment of Figure 5 (and its variation in Figure 6) and the embodiment of Figure 3. In the embodiment of Figure 5, the cage is permanently attached to the pallet floor plate. In the embodiment of Figure 3, the cage is detachably connected to the floor plate by the removable nuts 28.

Parent claim 9 recites that the cage is permanently attached to the pallet floor plate and thus is readable on the embodiment of Figure 5 to the exclusion of the embodiment of Figure 3. Claim 10, on the other hand, recites the threaded nut (28) and therefore is readable on the embodiment of Figure 3 to the exclusion of the embodiment of Figure 5. In substance, the combination of claim 10 contains two mutually exclusive limitations, namely the permanent attachment of the cage, on the one hand, and the detachable nut attachment, on the other hand. Thus, the metes and bounds of claim 10 are obscured because it requires reading on two mutually exclusive embodiments.

Similar to the combination of claim 10, claim 19 recites the permanent attachment of the cage to the floor plate and detachable threaded nut connection in the same combination. Recitation of these mutually exclusive limitations in the same combination obscures the metes and bound of claim 19 and also of claims 20 through 24 which depend directly or indirectly from claim 19.

In summary, the examiner's decision rejecting claims 9, 10 and 14 through 24 is reversed, and new grounds of rejections have been entered against claims 9, 10, 14/9, 14/10, 15/14/9, 15/14/10, 16, 17/19, 17/10, 18/9, 18/10 and 19 through 24 under the provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended

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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 that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

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 (§ 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. . . .

REVERSED/196(b)

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HARRISON E. McCANDLISH)
Senior Administrative Patent Judge)

IRWIN CHARLES COHEN)
Administrative Patent Judge)

JAMES M. MEISTER)
Administrative Patent Judge)

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APPENDIX

9. In a pallet container (10) comprised of a thin-walled plastic container (12) for liquid or flowable substances, a steel-mesh support cage (14) of horizontal and vertical rods welded together and tightly enclosing the plastic container (12), and a floor pallet (16) including at least one plate having a bottom side and an opposite top side on which the plastic container (12) is seated and to which the steel-mesh support cage is permanently attached, the improvement wherein:

a) the pallet includes at least one bore (20) extending into said at least one plate from the top side thereof; and

b) one vertical rod (18) of said vertical rods of the steel-mesh support cage (14) extends into each bore (20) from the top side of said at least one plate and is connected to said plate against relative movement with respect thereto.