

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY A. NIEMIER

Appeal No. 98-0964
Application 08/557,436¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge,
FRANKFORT and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 23 through 34, which are all of the claims

¹Application for patent filed November 14, 1995. According to appellant, this application is a continuation-in-part of application no. 29/020,506, filed March 25, 1994, which was a continuation-in-part of application no. 29/011,308, filed August 2, 1993.

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statements made by appellant in the paper filed December 5, 1996 (Paper No. 5, page 8) wherein it is indicated that "a sit-on-top kayak substantially as depicted in FIGS. 14-20 of the present application was placed on sale by the Applicant in approximately April 1994." In

maintaining this rejection, the examiner has determined that appellant is not entitled to benefit under 35 U.S.C. § 120 of the filing date of March 25, 1994 associated with appellant's earlier filed application SN 29/020,506 which matured into Design Patent No. 377,473 (issued January 21, 1997), and has thus accorded the subject matter of the present utility application only the filing date of the present application (i.e., November 14, 1995), thereby making the sales of the embodiment seen in Figures 14-20 of the present application made by appellant "in approximately April 1994" a bar under 35 U.S.C. § 102(b).

Claims 23 through 34 stand additionally rejected under the judicially created doctrine of double patenting over the

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claim of appellant's prior U.S. Design Patent No. 377,473
"since the claims, if allowed, would improperly extend the
'right to exclude' already granted in the patent" (answer,
page 4). According to the examiner,

"[t]he subject matter claimed in the instant
applica-tion is fully disclosed in the patent and is
covered by the patent since the patent and the
application are claiming common subject matter, as
follows: a distinctive configuration for a kayak.

Furthermore, there is no apparent reason why
applicant was prevented from presenting claims
corresponding to

those of the instant application during prosecution
of the application which matured into a patent. *In
re Schneller*, 397 F.2d 350, 158 USPQ 210(CCPA 1968).
See also MPEP § 804. (answer page 4)

Claims 23 through 34 also stand rejected under the
judicially created doctrine of obviousness-type double
patenting as being unpatentable over the claim of appellant's
prior U.S. Design Patent No. 377,473. In this regard, it is
the examiner's position that

[a]lthough the conflicting claims are not identical,
they are not patentably distinct from each other
because one of ordinary skill in the art at the time
of the invention would have sit and placed his/her
feet as claimed in the kayak of Des. 377,473.

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Re "hatch surface", such fails to positively recite a hatch per se, merely a surface, and therefore fails to define over the claim of Des. 377,473. The surface between the seats of Des. 377,473 can be seen as having straight line cross hatching running in different directions in different views, thereby illustrating a planar surface. (answer page 4)

Reference is made to the examiner's answer (Paper No. 12, mailed October 27, 1997) for the examiner's reasoning in support of the above-noted rejections. Appellant's arguments there-against are found in the brief (Paper No. 11, filed July 28, 1997).

OPINION

In reaching our conclusions on the issues raised in this appeal, we have carefully considered appellant's specification and claims, the applied reference, and the respective viewpoints advanced by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

As to the examiner's rejection of the claims on appeal under 35 U.S.C. § 102(b), the examiner has determined that the present utility application contains all of the utilitarian

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features not covered by the design patent, and more specifically that there is nothing in the '506 application which matured into the design patent to clearly indicate the presence of aft, middle and forward seating surfaces, a footwell associated with each of the seating surfaces, or first and second hatch surfaces, as now set forth in independent claim 23 of the present utility application. In the examiner's opinion, viewing the '506 application in a vacuum, it is unclear exactly what utilitarian features have been shown therein.

Appellant urges that the examiner's rejection of the appealed claims under 35 U.S.C. § 102(b) is in error because the

present application claims priority from and is entitled to the filing date of design application SN 29/020,506 (now the '473 design patent) which antedates the April 1994 sale of the invention and clearly describes the now claimed invention "in writing" as required by 35 U.S.C. § 112, first paragraph. The present utility application is denominated a "continuation-in-

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part" of the '506 design application.

After considering all of the evidence before us, it is our conclusion that the examiner correctly denied appellant the benefit of the earlier filing date of the '506 design patent application and properly rejected claims 23 through 34 before us on appeal on the basis of the prior sale of the invention as acknowledged by appellant to have occurred in April 1994, more than one year prior to the November 14, 1995 filing date of the present utility application. With regard to appellant's argument concerning the asserted benefit of an earlier effective filing date for the present application under 35 U.S.C. § 120, we note that an express prerequisite in the statute for such benefit is that the invention as now claimed must be disclosed in the earlier application "in the manner provided by the first

paragraph of section 112 of this title." As appellant has noted on pages 5 and 6 of the brief (Paper No. 11), the test for sufficiency of disclosure of support in a parent

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application with regard to the written description requirement of the first paragraph of 35 U.S.C. § 112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. See, e.g., In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) and Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). In this regard, and in accordance with the Court's determination in Vas-Cath, we agree with appellant that the drawings of a design application may provide an adequate written description for the claims of a subsequently filed utility application.

In the present case, however, even if we might agree with appellant that an artisan would have clearly understood that Figures 14 and 16 of the '506 design application depict the arrangement of seating and footwells in a sit-on-top kayak as set forth in claim 23 on appeal, we find nothing in Mr. Niemier's

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declaration (Exhibit I of the brief) or appellant's arguments which specifically addresses the "first and second hatch surfaces" set forth in claim 23. We note that the specification of the present utility application (page 8) describes the kayak (10) as comprising

"first, second, and third hatch surfaces 54, 56 and 58. Hatches formed in these surfaces 54, 56 and 58 allow access to the interior of the kayak 10, and hatch covers 60, 62 and 64 may be employed to cover the hatches to keep the interior of the kayak 10 dry."

While it is true that Figures 14 and 16 of the '506 design application show three spaced cylindrical projections extending slightly above the seating deck area, we see nothing in the '506 design application which would convey to the artisan that such projections are anything other than ornamental features of the water craft therein, that is, merely ornamental cylindrical projections.

Moreover, even if we assume that one of ordinary skill in the art may have possibly construed such projections to be hatch covers or surfaces thereof, we note that this possibility alone is not a sufficient indication to that

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person that such hatches

were in fact part of appellant's invention at the time of filing of the '506 design application. See, e.g., In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1064 (1978) and also Lockwood v. American Airlines Inc., 107, F.3d 1565, 1571-1572, 41 USPQ2d 1961, 1966 (Fed Cir. 1997), wherein the Court indicated that

"Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed" and that

"It is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose."

In light of the foregoing, we are convinced that the disclosure or "written description" of the '506 design application is insufficient to satisfy the written description requirement of § 112, first paragraph, with regard to the invention as now claimed in claims 23 through 34 of the present utility application, and accordingly that the present

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utility application is not entitled under 35 U.S.C. § 120 to benefit of the earlier filing date of the '506 design application. The fact that some of the elements of the presently claimed subject matter

have support in the earlier filed design application does not alter this determination, because as to given claimed subject matter, such as that set forth in independent claim 23 on appeal, only one effective filing date is applicable. See In re van Langenhoven, 458 F.2d 132, 137, 173 USPQ 426, 429 (CCPA 1972).

Since appellant has not otherwise contested the examiner's rejection of claims 23 through 34 under 35 U.S.C. § 102(b), we sustain the examiner's rejection of those claims on the basis of the prior sale of the invention which appellant concedes occurred in April 1994.

Turning next to the examiner's rejection of claims 23 through 34 under the judicially created doctrine of double patenting over the claim of appellant's prior U.S. Design Patent

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No. 377,473 "since the claims, if allowed, would improperly extend the 'right to exclude' already granted in the patent" (answer, page 4), we note that the examiner has taken the position that the subject matter in the instant application "is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter." As is apparent from our

determination above regarding benefit under 35 U.S.C. § 120 and our discussion of "written description" in the '506 design patent application under § 112, first paragraph, the examiner's stated position here is factually inconsistent with his own and our earlier determinations and is therefore in error. Since the design patent does not disclose or claim the first and second "hatch surfaces" required in independent claim 23 on appeal, it follows that the present application and the design patent are not "claiming common subject matter" and that the subject matter in the instant application is not "fully disclosed in the patent," as the examiner urges. In addition, we note that the examiner's reliance on In re Schneller (answer, page 4) is

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entirely inapposite in this design-utility double patenting rejection, since the claims of the utility application clearly could not have been presented in the design application. Thus, we will not sustain the examiner's rejection of claims 23 through 34 on this basis.

The last of the examiner's rejections for our review is that of claims 23 through 34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Design Patent No. 377,473. In this instance it

appears that the examiner has attempted to read the first and second "hatch surfaces" in claim 23 on appeal as merely surfaces, thereby giving no weight to the specific description of the surfaces in the claim as "hatch surfaces." While we agree that the design patent does show (in Figs. 14 and 16) a planar surface on each of the three raised cylindrical projections on the seating deck of the water craft therein, we do not agree with the examiner's failure to accord the "hatch surfaces"

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limitation in claim 23 on appeal appropriate weight when making his obviousness determination. The fact that appellant has expressly defined the structures in claim 23 as "hatch surfaces" can not be simply ignored by the examiner, or dismissed as of no moment. Accordingly, the examiner's rejection of claims 23 through 34 based on the judicially created doctrine of obviousness-type double patenting will not be sustained.

Given that one of the three rejections posited by the examiner, i.e., the examiner's § 102(b) rejection of claims 23 through 34, has been sustained, it follows that the decision of the examiner to reject claims 23 through 34 on appeal is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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| HARRISON E. McCANDLISH |) | |
| Senior Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHARLES E. FRANKFORT |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
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