

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN A. MONACO

Appeal No. 98-1036
Application 08/540,193¹

ON BRIEF

Before MEISTER, McQUADE, and NASE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

John A. Monaco appeals from the final rejection of claims 1 through 14 and 21 through 26, all of the claims pending in the application. We affirm-in-part.

¹ Application for patent filed October 6, 1995.

The invention relates to a baseboard support form for attaching carpeting to a wall. Claims 1 and 8 are illustrative and read as follows:

1. A baseboard support form, for use with a carpet strip, a wall and a floor, the floor having a layer of carpet thereon, comprising:

a) a form body, said form body having a solid inner core, said form body also having a front, a back, a top and a bottom, said top having a means for bending said carpet strip over the top of said form body, said form body also having a means for receiving and securing said carpet strip in said form body, said form body also having a curved lower surface permitting said carpet strip to be curved thereunder, thereby securing said carpet strip between said form body and said floor; and

b) a means for securing said form body to said wall.

8. A baseboard support form system, for use with a carpet strip, a wall and a floor, the floor having a layer of carpet thereon, comprising:

a) a form body, made of bendable material, said form body including a face side, and a back side, and a curved upper surface for supporting said carpet strip, said curved upper surface having a generally semi-circular form, thereby permitting said carpet strip to be bent thereover;

b) a groove formed in said back side to receive said carpet strip, thereby removably securing said carpet strip therein;

c) a curved lower surface permitting said carpet strip to

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be curved thereunder, thereby securing said carpet strip between said form body and said floor; and

d) a means for securing said form body to said wall.

The references relied upon by the examiner as evidence of anticipation and obviousness are:

Mapes	2,506,030	May 2, 1950
Habrant	4,058,946	Nov. 22, 1977
Schafer et al. (Schafer) 1988	4,730,432	Mar. 15,

The appealed claims stand rejected as follows:

a) claims 4 through 7 and 11 through 14 under 35 U.S.C. § 112, first paragraph;

b) claims 1, 21, 22, 25 and 26 under 35 U.S.C. § 102(b) as being anticipated by Mapes;

c) claims 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Mapes;

d) claims 8 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Schafer;

e) claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over Mapes;

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f) claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Schafer;² and

g) claims 4 through 7 under 35 U.S.C. § 103(a) as being unpatentable over Mapes in view of Habrant; and

h) claims 11 through 14 under 35 U.S.C. § 103(a) as being unpatentable over Schafer in view of Habrant.

Reference is made to the appellant's brief (Paper No. 8) and to the examiner's answer (Paper No. 9) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

The 35 U.S.C. § 112, first paragraph, rejection of claims 4 through 7 and 11 through 14 rests on the examiner's determination that the appellant's specification is non-enabling with respect to the limitations in these claims

² In the final rejection (Paper No. 4), the examiner applied Mapes or Schafer as alternatives to support the 35 U.S.C. § 103(a) rejections of claims 2, 3 and 9. The examiner has since withdrawn Schafer from the rejection of claims 2 and 3 and Mapes from the rejection of claim 9 (see pages 6 and 7 in the answer, Paper No. 9).

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relating to the means for extending the baseboard support form or support form system around inside and outside corners of a wall (see pages 3, 4 and 8 in the answer).

The dispositive issue with regard to enablement is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

In the present case, the appellant's specification (see pages 6 and 7) indicates that the claim limitations in question read on elements 40, 50, 70 and 71. The examiner has not cogently explained, nor is it apparent, why the appellant's rather straightforward disclosure of these elements would not have enabled a person having ordinary skill in the art to make and use a baseboard support form or support form system including same. Thus, the examiner has failed to

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meet his burden of advancing acceptable reasoning inconsistent with enablement.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claims 4 through 7 and 11 through 14.

With regard to the standing 35 U.S.C. § 102(b) rejection, Mapes discloses a number of different molding strips or base shoes which can be easily attached to and removed from a wall. Generally speaking, these base shoes are elongated wooden strips having a quarter-round shape. In the embodiment illustrated in Figure 4, the base shoe 22 includes rear and bottom grooves forming a rib 23 which is adapted to be grasped by spring clips 24 and 25 extending from a metallic anchor strip member 26 mounted on a base board 10.

Anticipation is established when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the

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reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The examiner's finding (see page 4 in the answer) that Mapes' base shoe 22 and its anchor strip spring clips 25 meet, expressly or under principles of inherency, each and every element of the invention set forth in claim 1 is well taken. In this regard, base shoe 22 constitutes a body having a solid inner core and a front, back, top and bottom. The curvature at the top of the shoe and the groove at the rear provide full response under principles of inherency to the recitations of the means for bending a carpet strip over the top of the body and the means for receiving and securing the carpet strip in the body, respectively. The shoe 22 also has a curved lower surface which is inherently capable of permitting a carpet strip to be curved thereunder. Anchor strip 26 and its spring clips 25 constitute means for securing the body to a wall.

The appellant's position that the examiner has improperly

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combined the various base shoe embodiments disclosed by Mapes to

support the anticipation rejection of claim 1 (see pages 11 through 13 in the brief) is not persuasive. Although the examiner's explanation of the manner in which Mapes is applied to

support the rejection could have been clearer, it reasonably indicates that the examiner considers claim 1 to be anticipated by Mapes' Figure 4 embodiment.

Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Mapes.

In the brief, the appellant states that "[f]or purposes of this appeal, claims 1-7 and 21-25 stand together as one group and claims 8-14 stand together as a second group. These groupings apply to all issues related to the specific claims" (page 6). In this light, we also shall sustain the standing 35 U.S.C. § 102(b) and 35 U.S.C. § 103 rejections of claims 2 through 7 and 21 through 26 which depend from, and stand or fall with, claim 1.

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We shall not sustain, however, the standing 35 U.S.C. § 103 rejections of claim 8 or of claims 9 through 14 which depend therefrom.

Claim 8 recites a baseboard support form system comprising, inter alia, a form body which includes a curved lower surface permitting the carpet strip to be curved thereunder. Although Schafer discloses a molding track 10 which constitutes a

baseboard support form, this reference does not teach, and would not have suggested, a molding track having a curved lower surface as required by claim 8. The examiner's contention that the bottom 13 of the Schafer track is the "functional equivalent" of a curved lower surface (answer, page 5), even if true, is simply of no moment. Expedients which are functionally equivalent to each other are not necessarily obvious in view of one another. In re Scott, 323 F.2d 1016, 1019, 139 USPQ 297, 299 (CCPA 1963).

Habrant, applied in combination with Schafer in the 35 U.S.C. § 103 rejection of dependent claims 11 through 14, fails to

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cure this deficiency in Schafer.

In summary and for the above reasons, the decision of the examiner to reject claims 1 through 14 and 21 through 26 is affirmed with respect to claims 1 through 7 and 21 through 26 and reversed with respect to claims 8 through 14.

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

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AFFIRMED-IN-PART

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JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JEFFREY V. NASE)	
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JPM/pgg

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