

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. MARTIN

Appeal No. 2000-1630
Application No. 09/085,540

ON BRIEF

Before STAAB, McQUADE, and BAHR, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 4-6 and 9-12, all the claims currently pending in the application.

The claims on appeal are drawn to a storm shelter for placement in the ground. A correct copy of appealed claims 9-12 appears in the appendix to appellant's brief. A correct copy of appealed claims 4-6 appears in the appendix to the examiner's answer.

Appeal No. 2000-1630
Application No. 09/085,540

The references applied in the final rejection are:

Monie	1,712,510	May 14, 1929
Kennon	183,575	Oct. 24, 1876
Moran	5,487,604	Jan. 30, 1996
Meyers	5,617,679	Apr. 8, 1997

The claims stand finally rejected as follows:

- (1) Claims 4 and 9-12, under 35 U.S.C. § 102(b), as being anticipated by Meyers;
- (2) Claims 4, 10 and 12, under 35 U.S.C. § 102(b), as being anticipated by Moran;
- (3) Claim 12, under 35 U.S.C. § 102(b), as being anticipated by Monie;
- (4) Claim 5, under 35 U.S.C. § 103, as being unpatentable over Meyers;
- (5) Claim 6, under 35 U.S.C. § 103, as being unpatentable over Kennon.

Preliminary Matters

In claim 12, line 3, "said chamber" lacks a clear antecedent. For purposes of this appeal, we consider "said chamber" to be a reference to the space defined within the "upright hollow member." With further regard to claim 12, line

Appeal No. 2000-1630
Application No. 09/085,540

5 calls for a base section including "a cylindrical wall" and line 9 calls for "said cylindrical wall being tapered." A side wall that is "tapered," as the side wall of appellant's base section, is not "cylindrical." Thus, the term "cylindrical" as applied to the side wall of appellant's base section is inaccurate and misdescriptive. For purposes of this appeal, we interpret the aforementioned instances of the words "cylindrical wall" of the base section to be a reference to the "side wall" thereof, such that claim 12 sets forth a base section including a bottom wall and a *side* wall extending upwardly therefrom, with said *side* wall being tapered. Although these informalities do not obscure the metes and bounds of claim 12, they nonetheless are deserving of correction upon return of this application to the Technology Center.

Rejection (1)

Independent claim 12 calls for a base section having a tapered side wall and a top section that is tapered to enable the base and top sections to be nested for shipment. The examiner has not convincingly explained, and it is not apparent to us, where Meyers discloses both a base section *and* a top

Appeal No. 2000-1630
Application No. 09/085,540

section that are tapered, much less a base section and a top section that are tapered "to enable said base section and said top section to be nested for shipment," as called for in claim 12. In this regard, the examiner's argument on page 6, lines 16-19, of the answer does not suffice. For this reason, the examiner's anticipation rejection of claim 12, as well as claims 4 and 9-11 that depend therefrom, based on Meyers cannot be sustained.

Rejection (2)

The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). As stated by Judge Plager in his concurring opinion in *Oetiker*, 977 F.2d at 1449, 24 USPQ2d at 1447:

The process of patent examination is an interactive one The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner. The 'prima facie case' notion, the exact origin of which appears obscure . . . , seemingly was intended to leave no doubt

Appeal No. 2000-1630
Application No. 09/085,540

among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness.

In the present instance, in both the final rejection (Paper No. 7, page 3) and the answer (Paper No. 10, page 4), the examiner, in rejecting claims 4, 10 and 12 under 35 U.S.C. § 102(b), has merely stated that the claims are rejected "as being clearly anticipated by . . . Moran" without any further elaboration in either office action of precisely how Moran meets the specific limitations of the rejected claims. In particular, the examiner has not addressed appellant's argument on page 8 of the brief that the structure of Moran (1) is not a storm shelter for placement in the ground, and (2) is missing the elements of a hollow chamber because Moran includes a breaker bar extending diametrically through the bin. In addition, the examiner has not explained, and it is not clear to us, how Moran satisfies the requirement of claim 12 that the upright hollow member "ha[s] a height and diameter sufficient to permit at least one person to seek shelter therein," notwithstanding that Moran's

Appeal No. 2000-1630
Application No. 09/085,540

specification is silent as to the dimensions of the bin disclosed therein.

Under these circumstances, we hold that the examiner has failed to meet the examiner's initial burden of establishing a prima facie case of anticipation, such that the standing rejection of claims 4, 10 and 12 as being anticipated by Moran cannot be sustained.

Rejection (3)

As noted above, claim 12 calls for a base section having a tapered side wall and a top section that is tapered to enable the base and top sections to be nested for shipment. The examiner has taken the position (answer, page 4) that the base section of Monie has a tapered wall extending upwardly from the bottom wall to an upper edge thereof; however, we are in accord with appellant's argument (brief, page 8) that the base section of Monie does not have a side wall that is tapered. In

Appeal No. 2000-1630
Application No. 09/085,540

addition, given appellant's argument (brief, page 8) that each of the sections of Monie includes a rung 28, we cannot accept the examiner's determination that there is a reasonable basis for concluding that Monie's top and bottom sections are inherently capable of being nested for shipment, as now claimed.

For these reasons, the examiner's rejection of claim 12 as being anticipated by Monie cannot be sustained.

Rejection (4)

This rejection cannot be sustained because even if the riser of Myers were made of fiberglass, as proposed by the examiner, the claimed subject matter would not result. This is so because the modified Meyers riser still would lack top and bottom sections that are tapered to allow nesting for shipment.

Rejection (5)

Kennon pertains to a cistern "consist[ing] of a walling of burned clay, made in sections or solid, and with [an] enlarged upper edge or seat part" (column 1, lines 14-17). Kennon further states that "the walling may be made in sections, or in

Appeal No. 2000-1630
Application No. 09/085,540

one solid piece, as in Fig. 2, with a top to close the same"
(column 2, lines 7-9).

Concerning the requirement of claim 12, from which claim 6 depends, that the claimed shelter comprises a base section having a tapered side wall and a top section that is tapered to enable the base and top sections to be nested for shipment, the examiner has taken the position that "Kennon (column 2, lines 7-8) discloses the cistern[] being made in sections or in one solid piece. And as the sections are tapered, they are certainly capable of being nested for shipment" (answer, page 7).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id.*

Appeal No. 2000-1630
Application No. 09/085,540

In the present case, the examiner has failed to advance any factual basis to support the conclusion that it would have been obvious to one of ordinary skill in the art to modify the Figure 2 cistern of Kennon by dividing it along a horizontal plane through the widest part of the cistern to produce a base section and a top section in accordance with the base and top sections called for in claim 12. The mere fact that the prior art *could* be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification (see *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Kennon contains no such suggestion. Rather, Kennon teaches that when the cistern is to be made of plural sections, the sections should be generally cylindrical in shape as shown in Figure 1.

Accordingly, we cannot sustain the standing 35 U.S.C. § 103 rejection of claim 6 as being unpatentable over Kennon.

Appeal No. 2000-1630
Application No. 09/085,540

Summary

Each of the examiner's rejections is reversed.

The decision of the examiner is reversed.

REVERSED

LAWRENCE STAAB)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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Appeal No. 2000-1630
Application No. 09/085,540

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Letty

JUDGE STAAB

APPEAL NO. 2000-1630

APPLICATION NO. 09/085,540

APJ STAAB

APJ McQUEADE

APJ BAHR

DECISION: **REVERSED**

PREPARED: Jul 18, 2002

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK