

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. 25

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte TAM KIEN LE

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Appeal No. 2002-1685  
Application No. 08/995,431

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ON BRIEF

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Before McQUADE, NASE, and CRAWFORD, Administrative Patent Judges.  
CRAWFORD, Administrative Patent Judge.

Decision on Appeal

This is a decision on appeal from the examiner's final rejection of claims 14 to 17, 20 and 23. Claims 18, 19, 21, 22, 24 and 25 are allowed. Claims 1 to 13 have been canceled.

The appellant's invention relates to a spring door crustacean trap. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Lile	2,196,928	Apr. 9, 1940
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The rejections

Claims 14 to 17 and 23 stand rejected under 35 U.S.C. § 102 as being anticipated by Lile.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lile.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 19) and the answer (Paper No. 22) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 21) and reply brief (Paper No. 23) for the appellant's arguments thereagainst.

Opinion

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 14 to 17 and 23 under 35 U.S.C. § 102(b). The examiner is of the opinion that Lile discloses the invention as claimed.

The appellant argues that Lile does not disclose at least one tensioning member extending around the door and connected to and producing a spring tension in the rods.

The examiner states:

The concentric circles of Lile extend around the door and produce a spring tension in the rods since the rods are shown to be bent in an arc such as in Fig. 2. If the rods were not under a spring tension, they would be straight. [final rejection at page 4]

As such the examiner states that Lile inherently discloses each and every element of the claims. We note that the prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. See Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed. Cir. 1985). Rather, if a claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding anticipation.

See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631-33, 2 USPQ2d 1051, 1052-54 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

It is well settled that the burden of establishing a prima facie case of anticipation resides with the Patent and Trademark Office (PTO). See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed Cir. 1991); Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990). Inherency, however, can not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Continental Can Co., 948 F.2d at 1269, 20 USPQ2d at 1749 (quoting In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

After the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not

possess the characteristics of the claimed invention. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986).

The specification discloses that the crab pot is comprised of spring steel rods 36 connected by spring steel wire 33 and plastic fishing line material 34. As the spring steel rods 36 are bound by the wire 33 and plastic fishing line material 34, a tension is developed in the spring steel rods 36 (specification at pages 6 to 7).

Lile discloses that the dome-like shaped compartments are built up of substantially rigid wire framework having a foraminous screen covering. Lile discloses nothing about spring tension or the use of spring steel in the substantially rigid wire framework. As such, in our view, the examiner's reasoning that Lile discloses a tensioning member producing a spring tension in the rods is speculative in nature and can not support a rejection under 35 U.S.C. § 102(b). Therefore, the examiner has failed to establish a prima facie case of anticipation by inherency. As such, we will not sustain this rejection.

We turn next to the examiner's rejection of claim 20 under 35 U.S.C. § 103 as being unpatentable over Lile. In support of this rejection, the examiner states:

The patent to Lile shows a crab trap as discussed above. Lile shows a top portion and a bottom portion with a gap between the members. Lile does not disclose if the gap is located at a midpoint between the top and bottom portion, but it appears to be close to the midpoint. At any rate, it would have been obvious to locate the gap at the midpoint between the top and bottom member since the exact location of the gap is a matter of design choice to be determined through routine experimentation since the function is the same and no showing of unexpected results was made. [final rejection at pages 3 to 4]

We will not sustain this rejection because we are of the opinion that Lile does not suggest at least one tensioning member as is recited in claim 14 from which claim 20 depends. In fact Lile suggests the opposite by disclosing that the compartment is substantially rigid (page 1, col. 1, lines 32 to 35).

The decision of the examiner is reversed.

Reversed

JOHN P. McQUADE	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

MEC/jrg

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