THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 2003-0992
Application 09/934,026[1]

ON BRIEF

Before SCHAFER, LEE and MEDLEY, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of appellants' claims 2-14. Claim 1 has been cancelled and no claim has been allowed.

References relied on by the Examiner

Wayne	4,341,412	July 27, 1982
Dresen et al. ("Dresen")	4,693,507	Sep. 15, 1987
Kuhns	5,365,858	Nov. 22, 1994

[1] Application for patent filed August 21, 2001. According to the appellant, it is a continuation of 09/576,565, filed May 22, 2000, which is a continuation of 09/322,616, filed May 28, 1999, which is a continuation of 08/895,915, filed July 17, 1997. The real party in interest is Penda Corporation.

The Rejection on Appeal

Claims 2-8 and 10-14 stand rejected under 35 U.S.C. § 103 as being unpatentable for obviousness over the combined teachings of Dresen and Kuhns.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Dresen, Kuhns, and Wayne.

For purposes of this appeal, the appellant has grouped claims 4 and 5 with claim 2, claims 9 and 10 with claim 6, and claim 14 with claim 11. (Supp. Brief at 7)

The Invention

The claimed invention is directed to a bed liner for a pickup truck. Each independent claim 2, 6 and 11 includes a particular recitation about the material from which the bed liner is made. Specifically,

Claim 2 recites, in pertinent part:

> said bed liner fabricated of a material comprising a mixture of a non-conductive plastic and a conductive material selected from the group consisting of carbon particles and carbon fibers.

Claim 6 recites, in pertinent part:

> said bed liner fabricated of a plastic material and including conductive material in at least a portion of said plastic material for dissipating electrical charges.

Claim 11 recites, in pertinent part:

> said bed liner fabricated of a mixture of a non-conductive material and conductive material for dissipating electrical charges.

In the background section of the specification, it is described that very recently it has been reported that in a handful of cases explosions have occurred while gas cans resting on the plastic surface of a bed liner in a pickup truck were being filled with gasoline and that it has been theorized that such explosions have been caused or may be caused in the future by the buildup of static electricity during refueling of gas containers resting on plastic bed liners. The background section concludes with this sentence: "Therefore, a need is perceived to provide a one-piece plastic protective cargo bed liner which will prevent and dissipate static electricity buildup on the liner surface."

Discussion

The appellant argues that Kuhns belongs to the category of non-analogous art and therefore cannot be relied on to support a rejection of the appellant's claims. The argument is rejected. A prior art reference is not "non-analogous" if either (1) it is within the field of the inventor's endeavor, or (2) it is reasonably pertinent to the particular problem with which the inventor was involved. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). Kuhns' invention is a plastic pallet which incorporates an electrostatic discharge element. As is stated in column 2, lines 56-60 of Kuhns:

> As used herein, the term "pallet" includes any form of tray, platform, or carrier for supporting, storing, and transporting by rail or truck various types of goods and articles, and it also includes platforms and other structures sometimes referred to as "skids."

The problem with which Kuhns' invention was concerned is that of the buildup of static electricity on the pallet, which can cause sparks in areas where combustible vapors or gases exist. In that connection, in column 1, lines 34-45, Kuhns states:

> Because plastics in general have a very low electrical conductivity, they are often used when insulating properties are desired. However, in a number of applications in which plastics are used their low conductivity results in a buildup of static electrical charge. Such static charges can attain significant voltages, of the order of up to about ½ million volts or so. Clearly, such charges on plastic shipping pallets are undesirable, because they can discharge and cause sparks in areas where combustible vapors or gases exist, and they cause uncomfortable shocks to personnel unloading or otherwise handling the items carried on pallets made from plastics.

The appellant here is concerned with the problem of the buildup of static electricity on the plastic bed liner of a pickup truck used to carry cargo. That buildup of static electricity is described in the specification as a possible cause of explosions when gas cans are refueled when resting on the bed liner. Based on the above-quoted portions of Kuhns, we find that the Kuhns invention is reasonably pertinent to the problem with which the appellant is concerned. Indeed, the Kuhns invention is very pertinent, since it also seeks to avoid or eliminate static electricity buildup on a plastic object used to carry or otherwise support a load being transferred. While it is stated in the appellant's brief that "[o]ne skilled in the art of bed liners concerned with gas can explosions would not look to the pallet art for a solution to this problem," we do not accept mere attorney argument as evidence. The appellant has not submitted the testimony of anyone with ordinary skill in the art in connection with that assertion and has not provided any meaningful

explanation. The fact that Kuhns is classified in a different class for searching purposes from Dresen is not alone convincing or persuasive that one with ordinary skill in the art would not find the invention of Kuhns to be reasonably pertinent to the problem with which the appellant is concerned. At most, that would be some indication of different fields of invention but not that Kuhns would not be reasonably pertinent to the problem with which the appellant is concerned.

For these reasons, the Kuhns reference is not non-analogous art.

As is found by the examiner (Answer at 2), Dresen discloses the basic structure of a bed liner for a pickup truck including side walls 42, front wall 34, and "longitudinally corrugated bottom panel 18 joining the side and front walls." The appellant does not dispute that Dresen discloses each and every recited feature of independent claims 2, 6, and 11, except for the last feature of each claim regarding the material from which the bed liner is made or fabricated, as already reproduced above earlier in this opinion. According to claim 11, the bed liner is fabricated of a mixture of a non-conductive material and conductive material for dissipating electric charges. According to claim 6, the bed liner is fabricated of a plastic material and including conductive material in at least a portion of said plastic material for dissipating electric charges. According to claim 2, the bed liner is fabricated of a material comprising a mixture of a non-conductive plastic and a conductive material selected from the group consisting of carbon particles and carbon fibers.

We are in full agreement with the examiner's discussion beginning from the last four lines on page 2 of the final rejection (Paper No. 7) to line 7 on page 4 of the same paper. That discussion is reproduced below and herein adopted as our own:

> Dresen et al disclose the truck bed receptacle with side walls 42, front wall 34, and longitudinally corrugated bottom panel 18 joining the side and front walls. Dresen et al. shows wheel wells 28. The receptacle is made of a high density polyethylene, a thermoplastic material. Dresen et al lacks the claimed mixture of a non-conductive plastic and a conductive material selected from the group consisting of carbon particles and carbon fibers. "Mixture" is interpreted per the dictionary definition of "a portion of matter consisting of two or more components" (Merriam-Webster's Collegiate Dictionary", tenth edition), or "any combination of contrasting elements" (Random House College Dictionary, 1980).

The appellant acknowledges that in Kuhns it is disclosed that a metallic spike is formed which extends through the pallet which is otherwise made of non-conductive material, to dissipate or avoid the buildup of static electricity on the pallet. The appellant also acknowledges that as an alternative to a metal spike, Kuhns uses a conductive element in the form of a plurality of conductive particles contained within a suitable binder. The appellant indicates that in either form, the spike extends through the pallet, and it is also argued that Kuhns' conductive particles are not "in the material" of the pallet but are "in" a binder, i.e., the spike. (Supp. Brief at 10)

Specifically, with regard to claim 2, the appellant argues that at best Kuhns teaches use of a spike formed of conductive particles contained in non-conductive material, and thus does not teach a pallet fabricated of a material comprising a mixture of non-conductive plastic and a conductive material selected from the group consisting of carbon particles and carbon fibers. With regard to claim 6, the appellant argues that Kuhns teaches a conductive spike extending

"through" the plastic material of the molded pallet, which is not disclosure of conductive material "in" a plastic material as is required by claim 6. With regard to claim 11, the appellant argues that Kuhns teaches a spike formed of conductive particles contained in a non-conductive material, which is not a disclosure of "a mixture of non-conductive material and conductive material" as claimed in claim 11.

We reject all of the appellant's above-noted arguments.

The problem with the appellant's positions is with the appellant's unduly narrow reading of the claim terms "mixture" and "in" which are just ordinary English words without any specially made definition in the context of the appellant's specification. The appellant does not argue that it has taken the role of its own lexicographer and set forth special definitions for the words "mixture" and "in" which are contrary to their ordinary usage in the English language. As is pointed out by the examiner, the dictionary definition of "mixture" is simply any "combination of contrasting elements" or "a portion of matter consisting of two or more components." (Paper No. 7, at 3). Also as is pointed out by the examiner, the dictionary definition of "in" is simply "inclusion within space." It is also well established that during patent examination, claim terms are construed as broadly as they reasonably allow. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1990); In re Pearson, 494 F.2d 1399, 1404, 181 USPQ 641, 645 (CCPA 1974); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). As is stated by the Federal Circuit in In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983), in

proceedings before the U.S. Patent and Trademark Office, claims in an application are to be given their broadest reasonable interpretation consistent with the specification. See also In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984).

Therefore, Kuhn's pallet material which is all non-conductive plastic except for one or more spikes driven therethrough, either made of metal or conductive carbon particles within a binder,[2] is very much indeed (1) a "mixture of a non-conductive plastic and a conductive material selected from the group consisting of carbon particles and carbon fibers" as is recited in claim 2; and (2) "a mixture of a non-conductive material and conductive material" as is recited in claim 11. Nothing in claims 2 or 11 requires the overall material to have a homogenous composition or a substantially uniform distribution of the conductive particles or material within the non-conductive material. In that regard, note that even the appellant's own preferred embodiments as shown in the specification do not illustrate a homogenous material or a uniform distribution of conductive particles or material within the rest of the non-conductive material, since the appellant's specification discloses a conductive film 84 superimposed or overlaid on a non-conductive base structure 54 (Figure 4 and Specification at 5, lines 8-9). In that connection, note that it would be unreasonable to regard the conductive film 84 itself, which constitutes only a minor portion of the bed liner, as the material from which the bed liner is fabricated or made.

[2] Kuhns discloses that its conductive particles can be carbon particles. (Column 4, lines 24-25)

Similarly, as for claim 6, Kuhn's pallet material which is all non-conductive plastic except for one or more spikes driven therethrough, either made of metal or conductive carbon particles within a binder,[3] is very much indeed "a plastic material including conductive material in at least a portion of said plastic material." The metal spikes are in all directions surrounded in space by the non-conductive plastic and thus are reasonably deemed to be within the plastic material or at least within a portion of the plastic material. Even with regard to the alternative embodiment in Kuhns using spikes made of conductive particles embedded in a binder, the conductive particles are nonetheless still within the space defined by the surrounding plastic material. In either case, Kuhns' pallet material designed to dissipate or avoid static electrical charge is a plastic material including conductive material in at least a portion of said plastic material for dissipating electrical charges as is recited in claim 6.

The level of ordinary skill in the art is not high and is reflected by the prior art references Dresen and Kuhns themselves. It is manifestly evident that one with ordinary skill in the art would have recognized that if the material disclosed by Kuhns would work to dissipate static electrical charge when used to construct a pallet, which is any form of a tray, platform, or carrier for supporting, storing, and transporting by rail or by truck various types of goods and articles, it would do the same as the material for a bed liner in a pickup truck. The bed of a pickup truck is

[3] Kuhns discloses that its conductive particles can be carbon particles. (Column 4, lines 24-25)

a tray, platform, or carrier for supporting, storing, and transporting various types of goods and articles.

For the foregoing reasons, we are persuaded of no error in the rejection of claims 2, 6 and 11 under 35 U.S.C.§ 103 as being unpatentable over the combined teachings of Dresen and Kuhns .

Claim 7 recites that the conductive material includes particles and the particles are dispersed throughout the plastic material. Claim 12 recites that the conductive material includes particles and the particles are dispersed throughout the non-conductive material. The examiner's position is that it would have been obvious to have more than one of Kuhns' conductive spike. The problem, however, is that having more than one conductive spike does not meet the requirement of conductive particles dispersed throughout the non-conductive material. The particles in the spikes of Kuhns are confined to discrete locations where the spikes are placed. In the case of claim 7, the particles are not dispersed throughout the plastic material from which the bed liner is fabricated. In the case of claim 12, the particles are not dispersed throughout the non-conductive portion of the mixture from which the bed liner is fabricated.

Claim 3 depends from claim 2 and further recites that the bed liner comprises two layers and "said material comprises one of said two layers and another of said two layers comprises non-conductive plastic." It appears to us that the reference "said material" has multiple and different antecedent basis and thus this claim is indefinite. However, it is evident that both the examiner and the appellant has assumed that the reference refers to the conductive material.

Therefore, we will do the same here, but the problem should be taken care of upon return of the involved application to the examiner subsequent to this appeal. We reject the examiner's apparent position that if a conductive material like the spike of Kuhns passes through Dresen's upper layer of anti-slip material, then the spike can be deemed as the top layer. The spike is located only on discrete locations and would extend through the bottom layer of Dresen, a non-conductive plastic, as well. The conductive spike of Kuhns cannot be reasonably regarded as the top layer of a two layer structure when it is passed through Dresen's bed liner as is suggested by the examiner.

Claim 8 depends on claim 6 and recites that the plastic material comprises two layers and the conductive material is dispersed throughout one of said two layers. Claim 13 depends on claim 11 and recites that the non-conductive material comprises two layers and said conductive material is dispersed throughout one of said two layers. We do not see any discussion by the examiner of the feature articulated in these two claims, either in the final rejection (Paper No. 7) or in the examiner's answer (Paper No. 13). The closest discussion by the examiner is that pertaining to claim 3, wherein the examiner identifies the anti-slip material of Dresen as the first layer and the non-conductive plastic beneath the anti-slip material as the second layer. It is evident that if and when the conductive spikes of Kuhns are passed through the bed liner material of Dresen, neither the spikes nor the conductive particles within the spikes are dispersed throughout either the top anti-slip layer or the bottom non-conductive plastic layer of Dresen.

For the foregoing reasons, the appellant has shown error in the examiner's rejection of rejection of claims 3, 7, 8, 12 and 13 under 35 U.S.C. § 103.

The appellant also frames as an issue the question whether an interference should be declared between its involved application and U.S. Patent No. 6,176,537. On page 7 of its supplemental brief, the appellant states: While this may not clearly be an appealable issue, [appellant] seeks the appeal board's comments on this topic." The only comment we give in that regard is that the appellant should follow established procedures for commencing an interference proceeding, which does not include seeking comments from this panel in an ex parte appeal, and may consult with the examiner or the Interference Practice Specialist of the appropriate Technology Center when the involved application has been returned to the examiner.

The examiner is urged to focus on and consider whether there is written description support in the specification for each of the claims on appeal. At first glance, we see that the specification discloses and refers only to configurations having a conductive film or surface superimposed or overlaid on top of a plastic layer. The summary of invention section of the specification appears to be no broader than that. If that is the case, it is at least questionable whether there is written description in the specification for claims whose scope are broader. We refrain from making a new ground of rejection at this point because there may be matters which we have overlooked without having examined the application in the first instance and because we would like to see the issue first developed between the examiner and the appellant. Therefore, the examiner should conduct a thorough inquiry, keeping in mind that the requirements of 35

U.S.C. § 112, first paragraph, is no less stringent or demanding simply because the appellant is attempting to provoke an interference by copying claims from an issued patent.

Conclusion

The rejection of claims 2, 4, 5, 6, 10, 11 and 14 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Dresen and Kuhns is **affirmed**.

The rejection of claims 3, 7, 8, 12 and 13 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Dresen and Kuhns is **reversed**.

The rejection of claim 9 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Dresen, Kuhns, and Wayne is **affirmed**.

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

AFFIRMED-IN-PART

RICHARD E. SCHAFER Administrative Patent Judge	)
JAMESON LEE Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
SALLY C. MEDLEY Administrative Patent Judge	)

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