

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID R. MOORMAN

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Appeal No. 95-3406  
Application 07/940,016<sup>1</sup>

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ON BRIEF

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Before COHEN, LYDDANE and ABRAMS, Administrative Patent Judges.  
LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 6 through 9, which are all of the claims pending in the application.

The subject matter on appeal is directed to a casing for a test apparatus. Claim 6 is exemplary of the invention and a copy

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<sup>1</sup> Application for patent filed September 3, 1992.

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thereof, as it appears in the appendix to the appellant's brief, has been appended to this decision.

The reference of record relied upon by the examiner in rejections of the claims under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103 is:

Stiso (EPA)                      0 183 442                      June 4, 1986

Claims 6 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Stiso.

Claims 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stiso. The examiner has taken the position that it would have been obvious to one having ordinary skill in the art to modify the casing of Stiso to include a means for holding the casing for optimum handling thereof by the user, as well as to include an indication as to where to read test results thereof.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant, we refer to pages 4 through 6 of the examiner's answer and to pages 3 through 5 of the appellant's brief for the full exposition thereof.

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OPINION

Our evaluation of the patentability issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art, and the respective positions advanced by the appellant and the examiner. With respect to the applied reference, we have considered all of the disclosure of that reference for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, we have taken into account not only the specific teachings of the reference, but also the inferences which one skilled in the art would have reasonably been expected to draw from the disclosure of that reference. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). On the basis of the knowledge and level of skill in the art at the time of appellant's invention, as reflected by the applied reference, it is our conclusion that the examiner's rejections of claim 6 under 35 U.S.C. § 102(b) and of claim 9 under 35 U.S.C. § 103 are well founded, but that the rejections of claim 7 under 35 U.S.C. § 102(b) and of claim 8 under 35 U.S.C. § 103 are not. Additionally, we have added a new rejection of claim 8 under 35 U.S.C. § 112, first and second

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paragraphs, and under 35 U.S.C. § 102(b), pursuant to the provisions of 37 CFR § 1.196(b). Our reasoning for this determination follows.

At the outset, we observe that appealed claim 6 recites, inter alia, an opening "defined by two pairs of opposing sides, one pair of which slopes from top to bottom to define a flow means, said pair terminating in a ridge means" (emphasis added). The only appearance of the term "ridge means" found in appellant's disclosure as originally filed is in original claim 3. Although there is no other specific description to define the term "ridge means" in the disclosure as originally filed, it is clear to us from the description of the "second port 44" which "slopes downward" as discussed on page 37 of the specification as originally filed, when read with reference to Figure 3a of the drawings as originally filed, that the opposing sides with the indicia 46, 47 slope downwardly and terminate in opposing edges that define longitudinal edges of the port 44. These edges inherently have some finite thickness, although not depicted in any view of the drawings, which we interpret to be the claimed "ridge means" consistent with the common definition for the term "ridge" which is "1. The long, narrow upper section or crest of something: *ridge of a wave*," The American Heritage Dictionary,

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Second College Edition, Houghton Mifflin Co., 1982. Thus, we have applied this interpretation of the term "ridge means" in analyzing the claims before us in this appeal.

Turning to the disclosure of the Stiso reference, it is clear that Stiso discloses a casing 20 for a test strip 24, the casing comprising a top member 26 and a bottom member 28. The top member includes a first opening 58 and a second opening 54, with the second opening defined by two pairs of opposing sides (note Figures 1 and 2), with the two longitudinal opposing sides bearing indicia (note Figure 4) and sloping downwardly from top to bottom and terminating in opposing edges that define the opening 54. As apparent from Figure 3 of Stiso, these opposing edges terminate in a ridge means in the same manner that we understand the edges of appellant's second opening to terminate in "ridge means" as discussed above. Furthermore, contrary to appellant's argument on page 4 of the brief that neither of the edge lines 30,32 of Stiso is "on the bottom of the top member," clearly the pair of longitudinal edge lines 30 are on the lower side of the top member (Figure 5) and engage with the pair of longitudinal, upwardly extending edge lines 32 on the bottom member (Figure 8). These edge lines 30,32 are sealed together as

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described in the paragraph spanning pages 7 and 8 of Stiso and, as the examiner has asserted, provide response to appellant's claimed "means for engaging" defined on the respective top and bottom members as recited in appealed claim 6. Accordingly, it is our conclusion that the casing of Stiso includes every element recited in appealed claim 6, and we shall thus sustain the examiner's rejection of appealed claim 6 under 35 U.S.C. § 102(b).

Moreover, with respect to the rejection of appealed claim 9 under 35 U.S.C. § 103 based on Stiso, as noted above, the two longitudinal sides defining the second opening 54 bear indicia as depicted in Figures 1, 2 and 4, and it is clear that these indicia are related to the results revealed by the test strip 24. Whether the indicia are formed as numbers, as depicted by Stiso, or whether any of the indicia is formed as an arrow would have been an obvious matter of choice in design dictated by the information desired to be conveyed to the user. We note that the obviousness question cannot be approached on the basis that skilled artisans would only know what they read in the references; such artisans must be presumed to know something

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about the art apart from what the references disclose. See In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). Moreover, the conclusion of obviousness may be made "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference," (In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), and skill is presumed on the part of those versed in the art rather than the converse (In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985)). We also note that the use of an arrow on a scale to mark a point of importance is conventional, as for example on oral thermometers where the "normal" temperature of the average human is often marked by an arrow at 98.6°F on the temperature scale. Thus, we shall also sustain the examiner's rejection of appealed claim 9 under 35 U.S.C. § 103.

In arriving at our decision to affirm the above noted rejections of claims 6 and 9, we have given careful consideration to each of the arguments advanced by the appellant for patentability, but we are not persuaded as to any error in those rejections for the reasons expressed above. In particular, appellant's arguments on page 4 of the brief as to a lack of

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discussion in the Stiso reference with respect to the sloping sides of opening 58 are not well taken since it is clear that the sloping sides of opening 54 provide the same structure and ridge means disclosed by appellant. Moreover, as we noted above, appellant's disclosure as originally filed also fails to provide any particular description of the "ridge means," but we have applied the interpretation discussed above for an understanding of appellant's "ridge means" that is equally appropriate for the sloping side walls of Stiso's opening 54.

We do, however, reach a different conclusion with respect to the rejection of claim 7 under 35 U.S.C. § 102(b) and of claim 8 under 35 U.S.C. § 103. First, with respect to the rejection of claim 7 under § 102(b), we observe that the bottom member 28 of Stiso is provided with three openings 53 which allow the casing to drain (page 10, lines 27-29 of Stiso). Given the presence of the drain openings 53, we find no structure, nor has the examiner pointed to any in the Stiso reference, which is provided by the means for engaging on the top and bottom members (edge lines 30 and 32 of Stiso) of the casing that would "form a reservoir for reception of fluid" as required by appealed claim 7. Thus,

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appealed claim 7 cannot be anticipated by the casing of Stiso, and we cannot sustain the examiner's rejection of claim 7 under 35 U.S.C. § 102(b).

Turning next to the rejection of appealed claim 8 under 35 U.S.C. § 103, we observe that prior to an analysis of whether this claim on appeal is patentable under § 103, similar to the situation in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), "the claims must be analyzed first in order to determine exactly what subject matter they encompass," and the first inquiry is thus to "determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity." Moore, supra. This analysis of the claims must be made, not in a vacuum, but in light of the specification disclosure and the teachings of the prior art.

With this in mind, we analyze dependent claim 8, which reads

[t]he casing of claim 6, wherein said first member comprises a depression at an end thereof of [sic] opposite to the end at which one of said openings is positioned.

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<sup>2</sup> We note that this claim is identical to claim 5 as originally filed (except that it is dependent from claim 6 rather than claim 1 which has now been canceled, and it includes the word "of" after the word "thereof" in line 2 that seems to have been added inadvertently since it renders the claim confusing).

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Thus, claim 8 is directed to a depression at an end of the top member of the casing that is opposite to the end at which one of the openings is positioned. We first note that neither claim 8, nor claim 6 from which it depends, defines either of the claimed "two openings" as being at an end of the casing top member. Furthermore, in order to understand the nature of the claimed "depression" it is necessary to look to the descriptive portion of the specification and the drawings, neither of which refer to or depict a depression at all. Thus, it is unclear on which end of the casing appellant intended the "depression" to be located. Accordingly, it is our opinion that the metes and bounds of appealed claim 8 cannot be accurately determined and that claim 8 fails to comply with the provisions of 35 U.S.C. § 112, second paragraph.

Moreover, other than the recitation in original claim 5 that

said first member comprises a depression at  
an end thereof opposite to the end at which  
one of said openings is positioned,

there is no mention whatsoever, in the descriptive portion of the specification as originally filed or depiction in the figures of the drawings as originally filed, of such a depression. It is our opinion that Figure 3A and Figure 3A' of the new drawings

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filed with Paper No. 16, dated October 19, 1994, contain new matter not supported by the appellant's disclosure as originally filed. Appellant's depiction of the depression as it appears now in the newly filed drawings in the top surface of the top member adjacent the end opposite opening 43, as well as the particular shape of the depression, is not based on any information provided by the disclosure as originally filed. In view of the broad language of original claim 5 which is the sole basis for the claimed "depression", the depression could have any shape, could be located on any of the top, bottom or side surfaces of the top member, and could be on the end opposite opening 43 or on the end opposite opening 44. It is readily apparent that the newly submitted depiction of the casing and the depression with its particular shape and location constitutes new matter that is not supported by anything in the specification as originally filed. Since the claims must be interpreted in light of the disclosure, it is also clear that appealed claim 8 is drawn to this new matter and hence is based on a disclosure that fails to comply with the written description requirement of 35 U.S.C. § 112. Moreover, the metes and bounds of appealed claim 8 cannot be adequately determined since an understanding of the term

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"depression" recited therein relies upon a specification that fails to comply with the description requirement of 35 U.S.C. § 112, first paragraph.

Nevertheless, with respect to the rejection of appealed claim 8 under 35 U.S.C. § 103, the examiner has held that it would have been obvious to have provided the casing of Stiso

with a means for holding the casing . . . .  
In this case, one of ordinary skill in the art would have recognized the addition of a holding means to the casing so that the user or technician may achieve optimum handling of the casing, preventing slippage. [page 4 of Paper No. 12, dated November 2, 1993, remailed May 19, 1994 per Paper No. 14]

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A prima facie case of obviousness is established by presenting evidence indicating that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA

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1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988), Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986), In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984), and ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Additionally, rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017,

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154 USPQ 173, 178 (CCPA 1967). Our reviewing court has repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

As stated in W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is our conclusion that the only reason to modify the casing of the Stiso reference in the manner proposed by the examiner to include a depression results from a review of appellant's disclosure and the application of impermissible hindsight. Thus, we cannot sustain the examiner's rejection of appealed claim 8 under 35 U.S.C. § 103.

We make the following new rejections pursuant to the provisions of 37 CFR § 1.196(b).

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Claim 8 is rejected under 35 U.S.C. § 112, first and second paragraphs, as being based on a specification that fails to comply with the written description requirement of the first paragraph of 35 U.S.C. § 112 and as failing to particularly point out and distinctly claim the invention under the second paragraph of § 112 for the reasons set forth above.

Claim 8 is rejected under 35 U.S.C. § 102(b) as being anticipated by Stiso. Focussing only on the breadth of the language of appealed claim 8 and applying the common definition of "An area that is sunk below its surroundings" (The American Heritage Dictionary, second College Edition, Houghton Mifflin Co. 1982) for the term "depression", it is clear from Figures 5, 6 and 14 of Stiso that the end of the top member 26 opposite the opening 58 (which end is clearly depicted in Figure 14) includes a "depression" as broadly claimed.

Accordingly, the decision of the examiner rejecting claim 6 under 35 U.S.C. § 102(b) and rejecting claim 9 under 35 U.S.C. § 103 is affirmed, the decision of the examiner rejecting claim 7 under 35 U.S.C. § 102(b) and rejecting claim 8 under 35 U.S.C. § 103 is reversed, and new rejections of claim 8 under

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35 U.S.C. § 112, first and second paragraphs, and under 35 U.S.C. § 102(b) have been made pursuant to the provisions of 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 CFR § 1.197).

With respect to the new rejections under 37 CFR § 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

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If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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

AFFIRMED-IN-PART, 37 CFR § 1.196(b)

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
WILLIAM E. LYDDANE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
NEAL E. ABRAMS	)	
Administrative Patent Judge	)	

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Felfe & Lynch  
850 Third Avenue  
New York, NY 10022

WEL/cam