

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSE L. PEREZ

Appeal No. 97-1476
Application No. 08/458,689¹

ON BRIEF

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

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 20, which are all of the claims pending in this application.

¹ Application for patent filed June 2, 1995.

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We REVERSE.

BACKGROUND

The appellant's invention relates to a hanging plant apparatus. An understanding of the invention can be derived from a reading of exemplary claims 1, 8 and 14 (the independent claims on appeal), which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Maasbach 1978	4,109,442		Aug. 29,
O'Sullivan 1985	4,556,184		Dec. 3,
Lyon 30, 1990	4,965,963		Oct.
Takahisa Green 15, 1985	56-9525 ² 2,147,484	(Japan) (Gr. Britain)	Jan. 31, 1981 May
Hawkins	94/09614	(WIPO)	May 11, 1994

Claims 1 through 13 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

² In determining the teachings of Takahisa, we will rely on the translation provided to the PTO. A copy of the translation is attached for the appellant's convenience.

particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hawkins in view of Maasbach.

Claims 2 through 6, 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hawkins in view of Maasbach and Takahisa.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hawkins in view of Maasbach and O'Sullivan.

Claims 11 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hawkins in view of Maasbach, Takahisa and Lyon.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hawkins in view of Maasbach and Green.

Claims 15 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hawkins in view of Maasbach, Green and Takahisa.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hawkins in view of Maasbach, Green and O'Sullivan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 11, mailed November 18, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 10, filed July 15, 1996) 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 references, and to the respective positions articulated by the appellant and the

examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness issue

We do not sustain the rejection of claims 1 through 13 under 35 U.S.C. § 112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner determined (answer, p. 3) that

[i]n claims 11-13, the references to "said receptacle" and the positive recitation of a structural limitation associated therewith (in this case, a wick) is confusing in that the preamble of each claim is directed to a "hanging plant container apparatus" and not a combination of an apparatus and a receptacle per se. . . . It is not clear whether Applicant is attempting to claim the combination or merely the subcombination.

We do not agree. As correctly pointed out by the appellant (brief, pp. 4-5), claims 1-10 are clearly directly

to the subcombination of the apparatus as shown in Figure 1 for use with an unclaimed plant receptacle. The mere fact that claims 11-13 recite further details of the unclaimed plant receptacle with which the claimed apparatus is intended to be used does not render the claims indefinite. Thus, it is our determination that claims 1 through 13 do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity. Accordingly, the decision of the examiner to reject claims 1 through 13 under 35 U.S.C. § 112, second paragraph, is reversed.

The obviousness issue

We do not sustain the rejection of claims 1 through 20 under 35 U.S.C. § 103.

The examiner determined (answer, pp. 4-5 and 7) that Hawkins failed to teach the drawstring means as recited in independent claims 1 and 14 and the drawing means as recited in independent claim 8. The examiner then concluded that it would have been obvious to one having ordinary skill in the art to modify Hawkins to have a drawstring based upon

Maasbach's teachings of utilizing cord 2 to easily tighten the bag 6 to the shrub 15 as shown in Figure 6.

We agree with the appellant's argument (brief, pp. 6-8) that there is no teaching, suggestion or motivation for combining Maasbach's teaching with Hawkins's plant receptacle absent impressive hindsight.

Furthermore, it is our view that cord 2 of Maasbach or the string-like member 2 of Takahisa are not equivalent to the cable ties disclosed by the appellant. In order to meet a "means-plus-function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989). In this case, the

structure disclosed in the specification (pp. 2-3) for performing the function of the "drawstring means" (claims 1 and 14) and the "drawing means" (claim 8) consists of two plastic cable ties 10 of the type well known in the electronics art, shown in detail in Figure 4. As shown in Figure 1, the bottom hem 3 provides access to the cable ties 10 at two locations. In addition, the appellant discloses that when the cable ties 10 are pulled tight around a pot 11, they cannot be released without cutting the cable ties. Thus, the tightened cable ties become relatively permanently secured to the pot 11. The cord 2 of Maasbach and the string-like member 2 of Takahisa both consist of a single member accessible at a single location. In addition, the cord 2 of Maasbach and the string-like member 2 of Takahisa both are easily tightened and untightened. Accordingly, it is our view that the cord 2 of Maasbach and the string-like member 2 of Takahisa are not an equivalent structure to the two cable ties 10 disclosed by the appellant. Thus, even if it were obvious to replace Hawkins' lower wire 156 engaged behind flange 154 of the ring 152 (which is permanently connected to dish 122) with a drawstring as taught by either Maasbach or Takahisa,

the resulting apparatus would not render the hanging plant container apparatus of the appealed claims unpatentable under 35 U.S.C. § 103.

We have also reviewed the Lyon, Green and O'Sullivan references additionally applied in the rejection of some of the appealed claims but find nothing therein which makes up for the deficiencies of the applied prior art discussed above.

For the reasons set forth above, the decision of the examiner to reject claims 1 through 20 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 13 under 35 U.S.C. § 112, second paragraph, and the decision of the examiner to reject claims 1 through 20 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/458,689

APJ NASE

APJ MEISTER

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 08 May 98

FINAL TYPED:

3 MAN CONF.

Mail copy of translation with decision