

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS F. MARINO

Appeal No. 97-2625
Application No. 08/118,925¹

ON BRIEF

Before FRANKFORT, McQUADE and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 14, which are all of the claims pending in this application.

¹ Application for patent filed September 9, 1993.

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The appellant's invention relates to a collapsible spill containment receptacle for use with storage and transport tanks (claims 1 through 12) and to a method for containing a spill from a tank (claims 13 and 14). An understanding of the invention can be derived from a reading of exemplary claims 1 and 13 which appear in the appendix to appellant's brief.

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

Bartels	2,754,869	Jul. 17, 1956
Malloy	4,201,307	May 6, 1980
Van Romer et al. (Van Romer)	5,090,588	Feb. 25, 1992

The following rejection is before us for review:

Claims 1 through 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bartels in view of Van Romer and Malloy.

Reference is made to the appellant's brief (Paper No. 19) and to the examiner's answer (Paper No. 20) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

OPINION

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In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Independent claim 1 is directed to a foldable spill containment receptacle for use with a tank comprising (a) a flexible and foldable receptacle member defining an enclosure having (i) a bottom wall, (ii) a side wall extending upwardly and inwardly from the periphery of the bottom wall to a height that is less than the width of the bottom wall, (iii) a collar at about the upper end portion of the side wall and (iv) an opening adjacent the upper end of the receptacle member which is of lesser area than the bottom wall and (b) a foldable means attached to the collar for securing the receptacle member to a tank.

Independent claim 13 recites a method for containing a spill from a tank comprising the steps of (a) providing a flexible and foldable spill containment receptacle having the features identified in claim 1, above, (b) placing the

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receptacle below and adjacent the point of the leak of the tank and (c) engaging the securing means with the tank.

Bartels, the examiner's primary reference, discloses a foldable or collapsible pail or container for holding water or other liquids. The container may take the shape of a truncated cone (Figs. 1-3) or pyramid (Fig. 4) having a bottom panel 3 and upwardly tapering flexible wall 2 or 2' formed from a plastic material such as polyvinyl chloride or polyethylene. The container includes a pair of handle straps 10 for carrying the container and for fastening across the bottom of the container when the container is in a collapsed condition. See, Fig. 3 and col. 2, lines 12-15 and 19-24.

Bartels further discloses that

[w]hen it is desired to use the device it is extended and while it may not have sufficient stability to maintain its extended position when empty the introduction of a liquid 15 imparts an outward pressure on the inwardly and upwardly tapering wall 2 to impart a force component acting to prevent container collapse. [Col. 2, lines 29-34].

Bartels does not meet the limitation in independent claim 1 requiring a side wall extending upwardly and inwardly from the periphery of the bottom wall to a height that is less than the width of the bottom wall. Also, Bartels does not teach or

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suggest a method for containing a spill from a tank as recited in independent claim 13.

Van Romer discloses a portable containment device (10) for containing spilled hazardous chemicals such as agricultural chemicals and preventing ground water contamination (col. 1, lines 3-6). The containment device includes a floor (12) and integral side walls (16, 18, 20, 22) extending vertically from the floor. Resilient side braces (A), bracing straps (B), and compressible top braces (C), maintain the side walls in an upright position while allowing the walls to collapse when a wheeled vehicle or aircraft (13) is rolled onto and off of the containment in the field. A perimetric flap (56) is carried by the floor and extends outwardly away from the side walls for allowing the device to be fastened to a ground surface such as by using stakes (60). See, Abstract and col. 2, lines 22-50 and col. 4, lines 15-18.

Malloy discloses a receptacle (20) for collecting oil drippings from the underside of an inboard engine of a boat comprising a rectangular sheet (24) of semirigid plastic material having a plurality of hinge lines (32, 34) formed by

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scoring to provide an integral receptacle defined by a base (36), sidewalls (38, 40), and corner members (42) (col. 4, lines 15-22 and 37-40 and col. 4, line 65 to col. 5, line 16). The sidewalls and corner members are folded flat against the base for insertion beneath the engine (col. 8, line 62 to col. 9, line 5). When fully inserted the sidewalls are erected to a substantially vertical position (Fig. 1). Retention members (54) are employed adjacent the corners of the receptacle for maintaining the sidewalls in their erected positions and for holding the corner members in place against the outer surface of a respective sidewall (col. 6, lines 1-26). With the receptacle in position, straps (70) integral with the sidewalls are attached to the engine supporting structure for suspension of the receptacle beneath the engine (col. 7, lines 8-15).

In rejecting independent claims 1 and 13 under 35 U.S.C. § 103, the examiner contends that

[i]t would have been obvious to one having ordinary skill in the area to design a draining foldable container having a bottom wall and sidewalls extending upwardly and inwardly from the periphery of the bottom wall to a collar defining an opening which has an area lesser [sic] than the bottom area in order to provide more stability

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to a container as taught by Bartels. Moreover, to design such draining container with a height less than width of a bottom wall as shown by Malloy and Van Romer et al would also have been obvious because it may receive more capacity. [Answer, pages 3 and 4].

The appellant's argument that the proposed combination of Bartels, Van Romer and Malloy is predicated on impermissible hindsight (see pages 10 through 12 in the brief) is persuasive. We find no support in either Van Romer or Malloy for the examiner's assertion that the capacity of a container of the type disclosed by Bartels may be increased by reducing the height of Bartels' side wall. Conversely, we find no motivation in Bartels for modifying Van Romer or Malloy to provide side walls extending upwardly and inwardly from the periphery of their respective bottom wall. Considering the fundamental differences between the device disclosed by Bartels and the device disclosed by Van Romer and Malloy, it is apparent that the examiner has improperly employed appellant's disclosure as an instruction manual to selectively piece together isolated disclosures in the prior art in order to support a conclusion of obviousness. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or

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suggestion supporting the combination" (footnote omitted).
See ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Here, the prior art contains none. As our reviewing court has said, "[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."
W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Thus, the examiner's conclusion that the differences between the subject matter recited in claims 1 and 13 and the applied prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art is not well founded.

Accordingly, we will not sustain the standing 35 U.S.C. § 103 rejection of these claims.

Claims 2 through 12, dependent on claim 1, and claim 14, dependent on claim 13, contain all of the limitations of their

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respective independent claim. Accordingly, the examiner's rejection of claims 2 through 12 and 14 under 35 U.S.C. § 103 will not be sustained.

The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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