

**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(2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** STELLA LORENS

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Appeal No. 97-4151  
Application 08/379,181<sup>1</sup>

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ON BRIEF

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Before CALVERT, FRANKFORT and McQUADE, ***Administrative Patent Judges.***

CALVERT, ***Administrative Patent Judge.***

***DECISION ON APPEAL***

This is an appeal from the final rejection of claims 1 to 3, 5 to 13 and 15 to 20, all of the claims remaining in the

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<sup>1</sup>Application for patent filed January 27, 1995.

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application.<sup>2</sup>

Claim 1, as amended after final rejection, is illustrative of the subject matter involved, and reads:

1. A compartmentalized tabletop organizer comprising:

a substantially rectangular container having four peripheral sides and a bottom, the four peripheral sides and the bottom configured to define a compartment;

means contained within said peripheral sides for displaying a graphic item allowing said means to include a display pocket configured for insertion of the graphic item into the display pocket;

a compartment divider disposed within the compartment defined by the peripheral sides and the bottom; and

a removable compartment adapted to fit within the tabletop organizer.

The references applied by the examiner in the final rejection are:

Albert	3,258,017	Jun. 28, 1966
Phibbs	3,433,383	Mar. 18, 1969
Trombly	4,047,633	Sep. 13, 1977
Lackie	5,439,108	Aug. 08, 1995

(Filed May 10, 1994)

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<sup>2</sup>Claims 4 and 14 were canceled after final rejection by the amendment filed on February 7, 1997 (Paper No. 12).

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The claims on appeal stand finally rejected under 35 USC § 103 as unpatentable over the following combinations of references:

(1) Claims 1, 2, 8 to 12 and 18 to 20, Phibbs in view of Trombly;

(2) Claims 3, 5, 6, 13, 15 and 16, Phibbs in view of Trombly and Albert;

(3) Claims 7 and 17, Phibbs in view of Trombly and Lackie.

Rejections Under 37 CFR 1.196(b)

(I) Pursuant to 37 CFR 1.196(b), claims 1 to 3, 5 to 10, 12, 13 and 15 to 20 are rejected for failure to comply with the second paragraph of 35 USC § 112, on the following grounds:

(A) The recitation of a means for displaying in lines 4 to 6 of claim 1 is indefinite. The claim recites a "means . . . for displaying a graphic item allowing said means to include a display pocket". This language is unclear

in that, according to what is recited, the means allows itself to include a display pocket, which makes no sense. Apparently what was intended, but is not clearly expressed, is that the means includes a display pocket.

(B) Claims 2, 3, 5 to 7, 12, 13 and 15 to 17 are indefinite when one attempts to read them in light of the disclosure. Cf. In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971). The problem with these claims can be described by referring to claim 3 as an example. Claim 3 recites (emphasis added) "The invention of claim 1 wherein said compartment divider is a four compartment divider." The use of the singular verb "is" and noun "divider" in this claim implies that the claim is drawn to a single element of structure which divides the container compartment into four compartments. Similar language is found in the disclosure on page 8, lines 12 to 15, but the drawing (Fig. 4) does not clearly show a single divider having three vertical members, but rather appears to show three separate vertical dividers (plural) 144 dividing the organizer 100 into four compartments. The scope of these claims is therefore unclear.

(C) Claims 9, 10, 19 and 20 are indefinite in their

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use of the term "comprising". The use of this term, rather than "consisting of", renders the Markush groups recited in these claims indefinite, in that their scope is unrestricted. See Ex parte Morrell, 100 USPQ 317, 319 (Bd. Apps. 1953) and MPEP

§ 2173.05(h). Likewise, the expression "may be selected from" in claims 9, 10 and 19 is indefinite in that it indicates the materials recited are merely exemplary, and therefore does not define the metes and bounds of the claimed subject matter. Ex parte Hasche, 86 USPQ 481, 482 (Bd. Apps 1949).

(II) Claims 7 and 17 are rejected for failing to comply with the first paragraph of 35 USC § 112. These claims, ultimately dependent on claims 1 and 11, respectively, each recite (emphasis added) "The invention of [the parent claim] further including at least two removable compartments . . . .". Since parent claims 1 and 11 have been amended to recite a removable compartment, the recitation in claims 7 and 17 of an organizer "further including"

at least two removable compartments would result in an organizer having at least three removable compartments.

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However, we find no written description of such an organizer in the application as filed. Cf. In re Barker, 559 F.2d 588, 194 USPQ 470 (CCPA 1977), cert. denied, 434 U.S. 1064 (1978).

#### Rejections Under 35 USC § 103

In general, if a claim is indefinite such that it is necessary to indulge in considerable speculation as to the meaning of terms therein, it should be rejected under § 112, and not under 35 USC § 103. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). However, in some instances, even though a claim is rejected under § 112, second paragraph, the merits of a rejection of that claim under § 103 may still be considered. See Ex parte Saceman, 27 USPQ2d 1472 (BPAI 1993).

In the present case, we would have to engage in such considerable speculation as to the meaning of claims 2, 3, 5 to 7, 12, 13 and 15 to 17, that consideration of the § 103 rejections of those claims would not be appropriate, and accordingly, said rejections will not be sustained, *pro forma*. This is not to say, however, that claims 2, 3, 5 to 7, 12, 13 and 15 to 17 would necessarily be patentable over the applied

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prior

art if the rejection under § 112, second paragraph, were overcome. On the other hand, we do not consider that claims 1, 8 to 10 and 18 to 20 are so indefinite that their rejection under § 103 should not be treated on the merits, and will therefore proceed to consider rejection (1), supra.

Phibbs discloses in Fig. 1 a rectangular container 10 which is divided into several compartments by partitions (dividers) 16 "for receiving various packaged or bottled items" (col. 2, lines 4 and 5). Such items 37 are shown in Fig. 2 as being boxes of washing powder and starch, and bottles of bleach and fabric softener. Trombly discloses a rectangular container having double walls of clear material between which a decorative insert 13 may be placed. The basis of the rejection is stated on pages 3 and 4 of the examiner's answer as:

In the embodiment of figure 1 [of Phibbs] an organizer is disclosed comprising a carrier made of plastic with three compartments defined by divider 16. Trays 17 are provided in one of the compartments which is considered [the] equivalent

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[of] a removable compartment.

PHIBBS '383 discloses the claimed device except for a means for displaying a graphic [sic] item. TROMBLY '633 teaches that it is known to provide a means 24 for displaying a graphic item. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the plastic carrier of PHIBBS '383 with inner an [sic: and] outer transparent walls as taught by TROMBLY '633, since TROMBLY '633 states at column 2, lines 38-44 that such a modification would provide a decorative appearance for eye appeal which makes the container aesthetically appealing.

Appellant argues that it would not have been obvious to add a graphic insert to the Phibbs container because the container is collapsible, i.e., telescopic. However, this argument is not relevant to the rejection, which, as the examiner states, is based on the non-collapsible container disclosed in Phibbs'

Fig. 1.

Appellant further argues that in her disclosed invention the graphic material is not on clear material and is not seated between the walls of the container, unlike that of Trombly. However, the claims do not call for a graphic item which is opaque or for the "display pocket" to be unsealed, and it is axiomatic that claims will be given their broadest

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reasonable interpretation consistent with the specification, and that limitations appearing in the specification will not be read into the claims. In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969).

Appellant also contends that Phibbs does not disclose a removable compartment, as recited in claims 1 and 11. It is not clear to us what the examiner means by his statement, quoted above, that trays 17 of Phibbs (which are not disclosed as removable) are considered the equivalent of a removable compartment. Nevertheless, we consider that Phibbs discloses a removable compartment as claimed.

In construing claims of a pending application

the PTO applies to the verbiage of the proposed claims, the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d, 1023, 1027 (Fed. Cir. 1997).

Here, if we look to the appellant's specification for

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enlightenment as to the broadest reasonable meaning of the term "removable compartment", we find that on page 10, appellant discloses that the two removable compartments 408 and 410 "may be constructed to have planar peripheral sides or may be constructed to have more curvilinear design such as juice pitchers or maple syrup containers" (lines 8 to 11). In view of this disclosure, it is evident that the term "removable compartment" in appellant's claims encompasses containers of items to be dispensed therefrom (such as juice or maple syrup), and thus would include the containers of the "various packages or bottled items" 37 disclosed by Phibbs, from which washing powder, bleach, fabric softener or starch would be dispensed. Phibbs therefore meets the "removable compartment" limitation of the claims.

With regard to the examiner's combination of Phibbs and Trombly, we agree with the examiner that the proposed modification of Phibbs in view of Trombly would have been obvious to one of ordinary skill in the art. While Trombly's primary purpose for using a double-walled container may be for insulation, the reference also discloses that such

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construction allows the inclusion of a decorative insert in the space between the transparent walls, and we consider that this disclosure would have motivated one of ordinary skill to provide the container 10 of Phibbs with transparent double walls for the same reason. Such a modification of the Phibbs container would not be the result of impermissible hindsight, as argued by appellant, but would have been suggested by Trombly's disclosure of using double walls with an insert therebetween for the purpose of decoration.

In the reply brief, appellant contends that the Phibbs container is not a "tabletop organizer," as recited in the preamble of claims 1 and 11. It is not apparent how such a recitation would limit the structure recited in the claims, being only a statement of intended use<sup>3</sup>, but in any event, the container 10 of Phibbs is a "tabletop organizer" in that it is clearly capable of being placed on a table, and "organizes" items therein in that it contains compartments into which the items are placed, just as appellant's disclosed apparatus does.

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<sup>3</sup>The preamble generally does not limit the claims. De George v. Bernier, 768 F.2d 1318, 1322 n.3, 226 USPQ 758, 761 n.3 (Fed. Cir. 1985).

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With respect to claims 9, 10, 19 and 20, appellant argues that it would not have been obvious to use the claimed materials, which "have been selected for their strength, attractiveness, and suitability for the practice of this invention" (brief, page 12). The examiner's position is that (answer, page 4):

it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ any conventional material such as acrylic resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, [277 F.2d 197,] 125 USPQ 416 [(CCPA 1960)].

In spite of the statement on page 13 of appellant's brief that "use of the claimed material in the invention is but one type of material available from a wide range of other suitable materials", claims 9, 10, 19 and 20 are not limited to one particular material, but instead cover a very wide range of materials, including, *inter alia*, such well known plastics as polyethylene, polypropylene, polystyrene, etc., which are commonly used to make such items as containers. In view of the disclosure of both Phibbs (col. 2, line 1) and Trombly

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(col. 1, line 61) that their containers may be made of plastic, it would be remarkable if one of ordinary skill would not have found it obvious to make the container of Phibbs, as modified by Trombly, out of at least one of the plastics claimed by appellant; as

stated in In re Leshin, 227 F.2d at 199, 125 USPQ at 417-18:

Mere selection of known plastics to make a container-dispenser of a type made of plastics prior to the invention, the selection of the plastics being on the basis of suitability for the intended use, would be entirely obvious; and in view of 35 U.S.C. 103 it is a wonder that the point is even mentioned.

Accordingly, the rejection of claims 1, 8 to 11 and 18 to 20 under 35 USC § 103 will be sustained.

#### Conclusion

The examiner's decision to reject claims 1 to 3, 5 to 13 and 15 to 20 is affirmed as to claims 1, 8 to 11 and 18 to 20 and reversed as to claims 2, 3, 5 to 7, 12, 13, and 15 to 17.

Claims 1 to 3, 5 to 10, 12, 13 and 15 to 20 are rejected pursuant to 37 CFR 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final

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rule

notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

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***Affirmed-in-Part***

**37 CFR 1.196(b)**

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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