

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLEN E. CHAPMAN

Appeal No. 1998-3301
Application No. 08/784,361¹

ON BRIEF

Before FRANKFORT, McQUADE, 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 2, 4 through 19 and 25 through 30, which are all of the claims pending in this application.²

¹ Application for patent filed January 17, 1997.

² Claim 8 was amended subsequent to the final rejection.

Appeal No. 1998-3301
Application No. 08/784,361

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a drive-up mail distribution, storage and pick-up assembly. An understanding of the invention can be derived from a reading of exemplary claim 25, which appears 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:

| | | |
|-----------------------------------|----------------------|----------|
| Crowder 1899 | 618,846 | Feb. 7, |
| Wright et al. 1902 (Wright) | 693,770 | Feb. 18, |
| Harmony 1931 | 1,817,191 | Aug. 4, |
| Steinbronn 1935 | 2,025,251 | Dec. 24, |
| Christensen 1968 | 3,367,613 | Feb. 6, |
| Phipps et al. 1988 (Phipps) | 4,753,385 | June 28, |
| Sohr 1929 | 655,984 ³ | Apr. 25, |
| | (France) | |

³ In determining the teachings of Sohr, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

Claims 2, 4 through 19 and 25 through 30 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 8, 9, 11, 15, 17, 18, 21, 22 and 23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 2, 4 through 7, 12, 14, 15 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Crowder.

Claims 2, 4 through 7, 12, 14, 15 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wright.

Claims 2, 4 through 7, 12, 13, 14 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Harmony.

Claims 19, 26 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wright.

Claims 19, 26 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crowder.

Claims 19, 26 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Harmony.

Claims 27, 28 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over either Crowder, Wright or Harmony each in view of Sohr.

Claims 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over either Crowder, Wright or Harmony each in view of Phipps.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over either Crowder, Wright or Harmony each in view of Steinbronn.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over either Crowder, Wright or Harmony each in view of Phipps as applied above, and further in view of Christensen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 7, mailed December 15, 1997) and the examiner's answer (Paper No. 12, mailed July 1, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 11, filed May 11, 1998) and reply brief (Paper No. 13, filed August 27, 1998) 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 rejection

We sustain the rejection of claim 15 under 35 U.S.C. § 112, second paragraph, but not the rejection of claims 8, 9, 11, 17, 18, 21, 22 and 23.

In the final rejection (pp. 3-4), the examiner rejected claims 8, 9, 11, 15, 17, 18, 21, 22 and 23 as being indefinite for the following two reasons. One, claim 8 was dependent on canceled claim 1. Two, no antecedent basis for "said rented mailboxes" in claim 15. In the answer (p. 4) the examiner stated that (1) the amendment to claim 8 had been entered and "the rejection is overcome," and (2) the rejection of claim 15 had not been addressed by the appellant in the brief.

We agree with the examiner that the appellant has not specifically contested the specific objection to claim 15 raised by the examiner in this rejection. Accordingly, we summarily sustain the rejection of claim 15. However, since the examiner has not set forth any specific basis for the rejection of claims 8, 9, 11, 17, 18, 21, 22 and 23, we summarily reverse the decision of the examiner to reject

claims 8, 9, 11, 17, 18, 21, 22 and 23 under 35 U.S.C. § 112, second paragraph.

The enablement rejection

We will not sustain the rejection of claims 2, 4 through 19 and 25 through 30 under 35 U.S.C. § 112, first paragraph.⁴

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art **without undue experimentation.** See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223

⁴ This rejection concerns the locking system for the doors and the motorized system of Figure 15 (see page 2 of the final rejection). This rejection no longer concerns the manner in which the mail flag is maintained in place, since such objection has been rescinded by the examiner (answer, p. 4).

(Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that

basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention **without undue experimentation**. The threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. Clearly, the examiner has not met this burden.

The appellant's disclosure does not explicitly show or describe the locking system for the doors or the motorized

system of Figure 15. However, the examiner has not provided any reasoning⁵ as to why one skilled in the art would not have been able to make the claimed "lockable front door" or the "motorized means" of claim 16 **without undue experimentation**.

For the reasons stated above, the decision of the examiner to reject claims 2, 4 through 19 and 25 through 30 based upon the enablement requirement of the first paragraph of 35 U.S.C. § 112 is reversed.

The anticipation rejections

We will not sustain any of the examiner's rejections of claims 2, 4 through 7, 12 through 15 and 25 under 35 U.S.C. § 102(b).

⁵ Factors to be considered by an examiner in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) citing Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The claims (i.e., claims 2, 4 through 7, 12 through 15 and 25) recite a drive-up mail distribution, storage and pick-up assembly comprising, inter alia, a plurality of mail boxes and a driveway. The claims further recite that (1) the mail boxes are arranged in horizontal rows and retained in a frame including a front panel, (2) each mail box includes a lockable front door opening from the front panel, and (3) the driveway is arranged in such close proximity to the front panel that a driver of a vehicle can reach out from the vehicle and open and close the mail box front door without having to leave the vehicle.

The appellant argues (brief, pp. 10-12, and reply brief, pp. 2-3) that the claimed driveway in close proximity to the

mail boxes is not shown or taught by Crowder, Wright or Harmony.

The examiner responded to this argument of the appellant (answer, p. 5) by determining that the surface adjacent the mail boxes of Crowder, Wright and Harmony is a "driveway" since a "driveway" is a surface "over which a vehicle may pass."

We agree with the appellant's argument (brief, pp. 10-12, and reply brief, pp. 2-3) that Crowder, Wright and Harmony do not disclose a driveway⁶, much less a driveway positioned in close proximity to the front panel of a plurality of mail boxes so that a driver of a vehicle can reach out from the vehicle and open and close the mail box front door without having to leave the vehicle.

⁶ It is our opinion that the appellant's definition of "driveway" set forth in the brief (p. 17) and reply brief (pp. 2-3) is the proper definition. Claim language must be given its broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

Since all the limitations of claims 2, 4 through 7, 12 through 15 and 25 are not found in a single reference (i.e., Crowder, Wright or Harmony), the decision of the examiner to reject claims 2, 4 through 7, 12 through 15 and 25 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejections

We will not sustain the rejection of claims 8 through 10, 17 through 19 and 26 through 30 under 35 U.S.C. § 103.

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). A prima facie case of obviousness is established by presenting evidence 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 to arrive at the claimed invention. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 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).

Like the claims subjected to the anticipation rejections reversed above, the claims (i.e., claims 8 through 10, 17 through 19 and 26 through 30) subjected to the obviousness rejections recite a drive-up mail distribution, storage and pick-up assembly comprising, inter alia, a plurality of mail boxes and a driveway. The claims further recite that (1) the mail boxes are arranged in horizontal rows and retained in a frame including a front panel, (2) each mail box includes a lockable front door opening from the front panel, and (3) the driveway is arranged in such close proximity to the front panel that a driver of vehicle can reach out from the vehicle and open and close the mail box front door without having to leave the vehicle.

As set forth above, Crowder, Wright and Harmony do not disclose a driveway, much less a driveway positioned in close proximity to the front panel of a plurality of mail boxes so that a driver of vehicle can reach out from the vehicle and open and close the mail box front door without having to leave the vehicle. The examiner has not provided any **evidence** in the rejections under 35 U.S.C. § 103 that would have suggested to one of ordinary skill in the art at the time the invention was made to have modified Crowder, Wright or Harmony to have provided a driveway positioned in close proximity to the front panel of their plurality of mail boxes so that a driver of a vehicle can reach out from the vehicle and open and close the mail box front door without having to leave the vehicle.

Since all the claimed limitations of claims 8 through 10, 17 through 19 and 26 through 30 are not suggested by the applied prior art, the decision of the examiner to reject claims 8 through 10, 17 through 19 and 26 through 30 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2, 4 through 19 and 25 through 30 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claim 15 under 35 U.S.C. § 112, second paragraph, is affirmed; the decision of the examiner to reject claims 8, 9, 11, 17, 18, 21, 22 and 23 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 2, 4 through 7, 12 through 15 and 25 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner

to reject claims 8 through 10, 17 through 19 and 26 through 30
under 35 U.S.C. § 103 is reversed.

AFFIRMED-IN-PART

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| CHARLES E. FRANKFORT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOHN P. McQUADE |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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Appeal No. 1998-3301
Application No. 08/784,361

Page 20

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APPEAL NO. 1998-3301 - JUDGE NASE
APPLICATION NO. 08/784,361

APJ NASE

APJ McQUADE

APJ FRANKFORT

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 02 Jun 99

FINAL TYPED: