

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. COLEMAN et al.

Appeal No. 1999-1972
Application No. 08/807,780¹

HEARD: November 15, 1999

Before STAAB, 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 1 to 12.² At the oral hearing, the appellants withdrew the appeal with respect to claims 1 to 4, 6 to 9 and 12. Accordingly, the appeal with respect to claims

¹ Application for patent filed February 28, 1997.

² Claim 11 was amended subsequent to the final rejection (see Paper Nos. 5 and 6).

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1 to 4, 6 to 9 and 12 is dismissed. Claims 5, 10 and 11
remain on appeal.

We REVERSE.

BACKGROUND

The appellants' invention relates to a novelty candy holding device. A copy of claims 5, 10 and 11 appears in the appendix to the appellants' brief.

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

Tanaka 1978	4,114,501	Sep. 19,
Dickhut 1995	5,395,278	March 7,

Claim 11 stands 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 appellants regard as the invention.

Claim 11 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Dickhut.

Claims 5 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dickhut in view of Tanaka.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 4, mailed November 25, 1997) and the answer (Paper No. 9, mailed June 23, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 8, filed May 14, 1998) and supplemental response (Paper No. 13, filed August 19, 1999) for the appellants' arguments thereagainst.

OPINION

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

The indefiniteness issue

We will not sustain the rejection of claim 11 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). Thus, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Int. 1992).

With this as background, we turn to the specific rejection of claim 11 under 35 U.S.C. § 112, second paragraph, made by the examiner. As set forth in the answer (pp. 7-8), the examiner determined claim 11 to be indefinite since it was "unclear what structure is being referred to as the 'noise maker' which is inside the housing." The examiner questioned whether the noise maker was a separate structure from the material of the main housing. If so, the examiner stated that "this would contradict claim 1."

In our view, the metes and bounds of claim 11 would be understood with a reasonable degree of precision and particularity by those skilled in the art. In that regard, we agree with the appellants (supplemental response, p. 4) that claim 11 recites two noise makers. One noise maker being the bendable and stretchable material of the main housing which makes a noise itself during bending and stretching of the material as set forth in parent claim 1. The second noise maker being a separate noise maker secured in the main housing which makes a noise due to flexing or stretching of the housing as recited in claim 11. We see no basis for the examiner's determination that this second, separate noise maker, contradicts claim 1.³

For the reasons set forth above, the decision of the examiner to reject claim 11 under 35 U.S.C. § 112, second paragraph, is reversed.

³ The issue of whether the claimed two noise maker embodiment complies with the written description requirement of the first paragraph of 35 U.S.C. § 112 is not before us in this appeal. In any event, the appellants have argued that original claims 1 and 11 provide the required written description support for claim 11 under appeal.

The anticipation issue

We will not sustain the rejection of claim 11 under 35 U.S.C. § 102(b).

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).

We agree with the appellants' argument (brief, pp. 6-7) that Dickhut does not disclose a separate noise maker as recited in claim 11. In that regard, Dickhut only discloses that the elongated tube 12 is formed so that an audible effect is created when the tube is extended. Dickhut does not disclose a separate noise maker secured in the tube 12 which makes a noise due to flexing or stretching of the tube 12. Thus, all the limitations of claim 11 are not found in Dickhut. Accordingly, the decision of the examiner to reject claim 11 under 35 U.S.C. § 102(b) is reversed.

The obviousness issue

We will not sustain the rejection of claims 5 and 10 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

We agree with the appellants' argument (brief, pp. 9-10) that the combined teachings of Dickhut and Tanaka would not have rendered it obvious to have arrived at the invention as recited in claims 5 and 10. In that regard, the applied prior art does not teach or suggest that an aperture for receipt of a candy sucker stick include an "expandable sleeve" as recited in claims 5 and 10. Contrary to the examiner's position (answer, p. 12), the claimed "expandable sleeve" is not readable on part of the flexible tube 12 of Dickhut since to meet the limitations of claim 1, the flexible tube 12 of Dickhut itself defines the aperture and thus there is no

aperture which includes an "expandable sleeve" for receipt of an end of a sucker stick. Accordingly, the decision of the examiner to reject claims 5 and 10 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 11 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claim 11 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 5 and 10 under 35 U.S.C. § 103 is reversed.

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

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APJ NASE

APJ STAAB

APJ McQUADE

DECISION: **REVERSED**

Prepared By: Gloria

Henderson

DRAFT TYPED: 23 Nov 99

FINAL TYPED:

HEARD: November 15, 1999