

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte ELLIOT W. LEE

---

Appeal No. 2001-2288  
Application 09/175,570

---

ON BRIEF

---

Before STAAB, MCQUADE, and BAHR, Administrative Patent Judges.  
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Elliot W. Lee appeals from the examiner's rejection (Paper No. 15) of claims 1, 2, 6, 9 and 11. Claims 10 and 19, the only other claims pending in the application, stand allowed.

THE INVENTION

The invention relates to "adhesive-type traps for catching . . . insects, particularly cockroaches" (specification, page 2). Representative claim 1 reads as follows:

1. An adhesive roach trap comprising:  
a first horizontal planar base member for supporting a plurality of adhesive roach traps;

a plurality of pairs of stanchions formed on the first horizontal planar member, each pair of the plurality of pairs of stanchions defining a plurality of horizontally adjacent spaces for accepting a corresponding plurality of adhesive roach traps placed between adjacent pairs of the plurality of stanchions, the plurality of adhesive roach traps being placed on the first horizontal planar member, horizontally adjacent to one another so as to form a continuous linear horizontal array of horizontally adjacent adhesive roach traps; and

a plurality of adhesive roach traps, each of the plurality of adhesive roach traps being slidably placed between adjacent pairs of the plurality of stanchions so as to form a continuous linear array of horizontally adjacent adhesive roach traps, each adhesive roach trap being located to one horizontal adjacent side of an adjacent adhesive roach trap.

#### THE PRIOR ART

The references relied on by the examiner to support the prior art rejections on appeal are:

Ollier	1,293,894	Feb. 11, 1919
Snider	1,792,774	Feb. 17, 1931
McQueen	4,815,231	Mar. 28, 1989

#### THE REJECTIONS

Claims 1, 2, 6, 9 and 11 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out

Appeal No. 2001-2288  
Application 09/175,570

and distinctly claim the subject matter the appellant regards as the invention.

Claims 1, 2, 6 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Snider in view of McQueen.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Snider in view of McQueen and Ollier.

Attention is directed to the appellant's briefs (Paper Nos. 19 and 21) and to the action appealed from and the examiner's answer (Paper Nos. 15 and 20) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.<sup>1</sup>

#### DISCUSSION

---

<sup>1</sup> Although the examiner's answer did not restate the 35 U.S.C. § 112, second paragraph, rejection, the comments on page 8 thereof indicate that the omission was inadvertent. Also, contrary to the assertions made throughout the appellant's reply brief, the above 35 U.S.C. § 103(a) rejections are not new grounds of rejection entered for the first time in the examiner's answer. These rejections have a clear basis in the action appealed from (Paper No. 15). Finally, the action appealed from also contains a 35 U.S.C. § 102(b) based on U.S. Patent No. 4,709,503 to McQueen and a 35 U.S.C. § 103(a) rejection utilizing the McQueen '503 patent as the primary reference. Upon reconsideration (see page 4 in the answer), the examiner has withdrawn these rejections.

I. The 35 U.S.C. § 112, second paragraph, rejection

The examiner considers claim 1, and claims 2, 6, 9 and 11 which depend therefrom, to be indefinite because

[i]n reference to claim 1, the phrase "for accepting a corresponding plurality of adhesive roach traps ... the plurality of adhesive roach traps being placed ..." renders the claim vague and indefinite since later in the claim "a plurality of adhesive roach traps, each of the plurality of adhesive roach traps being slidably ..." is set forth later in the claim.

It is unclear whether applicant is attempting to functionally recite the location of the adhesive traps in the former phrase or positively recite the structure and location of the adhesive traps. In addition, both phrases attempt to claim the same subject matter and is somewhat redundant [Paper No. 15, page 2].

A fair reading of claim 1 indicates that the adhesive roach traps are mentioned first in the context of defining the stanchions and the associated spaces in terms of their intended function or use,<sup>2</sup> and then in the context of being set forth in a positive manner as part of the claimed combination. While this sequencing may be somewhat unusual, it does not render the claim, read as a whole and in light of

---

<sup>2</sup> There is nothing intrinsically wrong with the use of functional language in a claim to define something by what it does rather than by what it is. In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971).

the underlying specification, redundant or otherwise indefinite.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 1, 2, 6, 9 and 11.

II. The 35 U.S.C. § 103(a) rejections

Snider discloses a mouse trap assembly comprising a frame 1 formed of a horizontal base plate 2 and a vertical wall 3 extending upwardly therefrom, a plurality of horizontally spaced apertures 4 in the wall, pairs of guides 16 on the base plate respectively aligned with the apertures, a trap 6 received between each pair of guides, and a resilient clip 24 mounted adjacent one end of the vertical wall for latching engagement with an adjacent frame. The traps 6 have spring-biased jaws adapted to be triggered by rodents passing through the apertures in the vertical wall of the frame.

According to the examiner (see page 5 in the answer), Snider responds to all of the limitations in claim 1 except for the one requiring the traps to be "adhesive" traps. The examiner turns to McQueen for this feature. McQueen discloses

Appeal No. 2001-2288  
Application 09/175,570

a trap assembly comprising a housing and a plurality of panels removably disposed therein, with the panels having sticky glue on their surfaces. In proposing to combine Snider and McQueen, the examiner concludes that it would have been obvious to one of ordinary skill in the art

to substitute the adhesive traps, as taught by McQueen, for the spring operated traps of Snider to utilize traps that operate on the simple principle of adhesive entrapment and which do not require manual setting of the traps so as to be able to catch pests at all times versus spring operated traps which may become accidentally tripped without capturing a pest or may injure a user's hand when attempting to set the trap [answer, page 5].

The examiner's position here is reasonable on its face and has not been specifically challenged by the appellant.

The

appellant does contend, however, that the rejection is unsound because the combined disclosures of Snider and McQueen do not teach and would not have suggested a trap meeting the limitation in claim 1 requiring "a continuous linear array of horizontally adjacent adhesive roach traps."

As shown in Figures 1 and 2, Snider's traps are spaced apart by horizontal distances appreciably greater than the widths of the traps. While these traps might be horizontally

Appeal No. 2001-2288  
Application 09/175,570

"adjacent" in a broad sense, they do not form a "continuous linear array" due to the relatively large spacing therebetween. Hence, even if modified in view of McQueen in the manner proposed by the examiner, Snider would still lack response to the claim limitation argued by the appellant.

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, and dependent claims 2, 6 and 9, as being unpatentable over Snider in view of McQueen.

As Ollier does not cure the foregoing deficiencies of the Snider-McQueen combination relative to parent claim 1, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 11 as being unpatentable over Snider in view of McQueen and Ollier.

### III. New ground of rejection

The following rejection is entered pursuant to 37 CFR § 1.196(b).

Appealed claims 1, 2, 6, 9 and 11 and allowed claim 10 are rejected under 35 U.S.C. § 112, second paragraph, as

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

The recitations in claim 1 that "each pair of the plurality of pairs of stanchions [defines] a plurality of horizontally adjacent spaces for accepting a corresponding plurality of adhesive roach traps" and that "each of the plurality of adhesive roach traps [is] slidably placed between adjacent pairs of the plurality of stanchions" do not make sense. As shown and described in the underlying disclosure, each pair of stanchions defines a single space for accepting a single adhesive roach trap and each adhesive roach trap is slidably placed between the stanchions of a single pair of stanchions. The recitations in independent claim 10 that "each pair of the plurality of stanchions [defines] a plurality of spaces for accepting a corresponding plurality of roach traps" and that "each of the plurality of roach traps [is] slidably placed between adjacent pairs of the plurality of stanchions" pose similar problems. Claims 2, 6, 9 and 11 are indefinite by virtue of their dependency from claim 1.<sup>3</sup>

---

<sup>3</sup> Interestingly, since claims 2 and 3 accurately recite the relationship between the stanchions and traps, they conflict with parent claim 1 which does not.

SUMMARY

The decision of the examiner to reject claims 1, 2, 6, 9 and 11 is reversed, and a new rejection of claims 1, 2, 6 and 9 through 11 is entered pursuant to 37 CFR § 1.196(b).

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

Appeal No. 2001-2288  
Application 09/175,570

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

REVERSED; 37 CFR § 1.196(b).

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
	)	
	)	BOARD OF PATENT
	)	
	)	APPEALS AND
JOHN P. MCQUADE	)	
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

JPM/kis  
ROBERT P. BELL

Appeal No. 2001-2288  
Application 09/175,570

ROBERT, PLATT, BELL & ASSOCIATES  
8033 WASHINGTON ROAD  
ALEXANDRIA, VA 22308