

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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CARLA SCHNEIDER

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Appeal No. 2002-0421  
Application No. 09/264,294

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ON BRIEF<sup>1</sup>

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Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 6. These claims constitute all of the claims in the application.

Appellant's invention pertains to an infant's toy and pacifier. A basic understanding of the invention can be derived

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<sup>1</sup> Attendance at the oral hearing set for Tuesday, July 2, 2002 was waived by appellant (Paper No. 15).

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from a reading of exemplary claim 1, a copy of which appears in the APPENDIX to the brief (Paper No. 9).

As evidence of obviousness, the examiner has applied the documents listed below:

Grubb et al. (Grubb)	Des. 291,122	Jul. 28, 1987
Silverstein	5,344,355	Sep. 6, 1994

The following rejections are before us for review.<sup>2</sup>

Claim 5 stands rejected under 35 U.S.C. § 112, first paragraph, as being based upon a disclosure which lacks descriptive support therefor.

Claims 1 through 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grubb in view of Silverstein.

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<sup>2</sup> We have listed herein a lack of description rejection of claim 5. It is most regrettable that the examiner has given the impression that claim 5 is under rejection but has not explicitly set forth the same. Because of the latter circumstance, appellant has presented argument on the new matter issue pertaining to an objection and to a rejection. In particular, we note that appellant asserts that the rejection under 35 U.S.C. § 112(1) should be withdrawn (main brief, page 9). This panel of the Board can, appropriately, only address the matter of the rejection of claim 5 under 35 U.S.C. § 112, first paragraph.

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The examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 10), while the complete statement of appellant's argument can be found in the main and reply briefs (Paper Nos. 9 and 12).

In the brief (page 3), appellant groups claim 1 through 6 together. Thus, like the examiner (answer, page 3), it is clear to us that these claims are intended to stand or fall together. Accordingly, we select claim 1 for review, with the remaining claims standing or falling therewith; 37 CFR § 1.192(c)(7).

#### OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims, the applied teachings,<sup>3</sup> and

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<sup>3</sup> In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the Board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The 35 U.S.C. § 112, first paragraph issue

We do not sustain the examiner's rejection of claim 5.

As our reviewing court stated in In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983):

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claimed language. The content of the drawings may also be considered in determining compliance with the written description requirement. (citations omitted)

The fact one skilled in the art might realize from reading a disclosure that something is possible is not a sufficient indication to that person that the something is a part of an appellant's disclosure. See In re Barker, 559 F.2d 588, 593,

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194 USPQ 470, 474 (CCPA 1977), **cert. denied**, 434 U.S. 1064, 197 USPQ 271 (1978). Precisely how close the original description must come to comply with the description requirement must be determined on a case-by-case basis. The primary consideration is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure. See Cas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1561-63, 19 USPQ2d 1111, 1115-17 (Fed. Cir. 1991).

In the answer (pages 3 and 4), the examiner gives reasons to support the conclusion that the recitation of "one-piece" in claim 5 is new matter.

From our review of the entirety of appellant's original disclosure (specification, drawing, and claims), we derive a clear and fair understanding that the "one-piece" feature now claimed was descriptively supported in the original disclosure. The most telling statement in appellant's disclosure to one skilled in the art as to the "one-piece" characteristic of the pacifier appears in the summary of the invention section of the specification (page 1), as follows.

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The pacifier is preferably fabricated from a molded polymeric material, preferably containing silicone, and defines at least one tab on the side of the annular flange opposite the nipple. (Underlining added for emphasis)

Thus, the molded pacifier defines the tab, i.e., the tab is a molded part of the pacifier. The pacifier is of the type which is molded to have not only a nipple portion but also an annular ring (specification, page 3). On the basis of the above, it is apparent to us that one skilled in the art would appreciate from appellant's original disclosure that the pacifier is molded in "one-piece" defining the nipple, the annular flange, and at least one tab, as set forth in claim 5. For the above reasons, the rejection of claim 5 under 35 U.S.C. § 112, first paragraph, cannot be sustained.

The 35 U.S.C. § 103(a) issue

We cannot sustain the obviousness rejection of appellant's claims.

Claim 1 addresses an infant's toy and pacifier comprising, inter alia, a stuffed toy, a pacifier molded from a polymeric

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material and defining at least one tab on a side of an annular flange opposite a nipple, and means for fixedly securing the tab

At the outset, it is well worthy of commenting on the circumstance that a design patent to Grubb is the basic reference. Due to the extremely limited information that can be derived from a design reference, it becomes quite clear in the present case that important findings cannot be made relative to this reference, e.g., the precise nature of the connection between the teething ring and the toy and whether stitching is employed to fixedly secure the teething ring to the depicted toy. Thus, it is speculative as to the structural attributes of the teething toy portrayed in the design patent. In any event, it readily appears from the examiner's rationale that the teething toy of Grubb would have to be significantly altered to achieve the claimed stuffed toy and pacifier invention. From our perspective, the motivation to do so would come from appellant's teaching and not the applied prior art. We certainly are cognizant of the highly relevant teaching of Silverstein as it pertains to the infant's toy and pacifier set forth in appellant's claim 1. However, in the context of the examiner's rejection on appeal, it is our opinion that the two references,

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as applied according to the examiner's rationale, would not have been suggestive of the claimed invention. Thus, we cannot sustain the obviousness rejection of appellant's claims.

REMAND TO THE EXAMINER

We REMAND this application to the examiner to consider the patentability of the claimed infant's toy and pacifier under 35 U.S.C. § 103(a) taking into account the combined disclosures of Silverstein and the acknowledged prior art combination of a pacifier with a tab secured to a plastic ring or the like (specification, page 3). It would appear that the latter prior art securement would reasonably be expected to be a fixed securement that would prevent removal; verification of this would be appropriate. The examiner should determine whether it would have been obvious to replace the detachable securement arrangement of Silverstein with the alternative of a fixed securement arrangement that prevents removal, for the advantage thereof.

In summary, this panel of the board has reversed the rejections on appeal and REMANDED the application to the examiner to address the matter discussed above.

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The decision of the examiner is reversed.

REVERSED AND REMANDED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	

ICC/lbg

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