

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CARL A. ACCARDO

Appeal No. 2002-0957
Application No. 09/635,634

ON BRIEF

Before COHEN, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 20-23. Claims 8, 15 and 20-25 were subsequently allowed in response to the amendment after final filed October 23, 2001 (Paper No. 10). Consequently, this appeal involves only claim 1. Claims 2-7, 9-14 and 16-19 are withdrawn from consideration as being directed to a non-elected species. No other claims are pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to containers useful for holding joint compound and similar material that can be mixed within the container and scooped therefrom for application with an applicator such as a taping knife or trowel and, more particularly, to double bay containers suitable for retaining in a second bay material spilled over the edge of a first bay as it is scooped therefrom (specification, page 1). Claim 1, the sole claim before us on appeal, reads as follows:

1. An open topped container comprising a first receptacle and a second receptacle joined at a common upper edge each receptacle having a rectangular open top and each receptacle enclosing a volume on all sides except the open top wherein panels extending from the common edge provide a sufficient length of space therebetween to rest on at least a portion of a forearm extended by a user therebetween and to accommodate at least a portion of a thumb of a hand of the user extended beneath and around one of the receptacles and wherein the first receptacle, the receptacle that is on the inside of the forearm as the container rests on the forearm, provides a curved path for raking material onto an applicator.

The examiner relied upon the following prior art references of record in rejecting claim 1:

Pratt	1,757,475	May 6, 1930
De Murguiondo	2,162,162	Jun. 13, 1939
Budd	4,800,845	Jan. 31, 1989

The following rejections are before us for review.

- (1) Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Budd.
- (2) Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by De Murguiondo.
- (3) Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Pratt.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 17) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 16 and 18) 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 claim, 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.

At the outset, we note that the limitation in claim 1 "panels extending from the common edge provide a sufficient length of space therebetween to rest on at least a portion of a forearm extended by a user therebetween and to accommodate at least a portion of a thumb of a hand of the user," the only claim limitation argued by appellant not to be met by the applied prior art, does not require a space wide or long enough to accommodate any portion of a forearm within the space. Rather, the claim language

simply requires the capability of the space to rest on a portion of the user's forearm and to accommodate a portion of a thumb (for example, a thumbnail or pinch of skin) of the user's hand. We also note that the claimed container has not been limited so as to require any particular type or size of user. Accordingly, claim 1 does not preclude the referenced user being a child with a small forearm and thumb, for example.

Budd discloses a disposable pet food dish comprising two receptacles (cavities 22, 32) separated by panels or sidewalls extending upwardly toward a common edge¹ so as to define a space therebetween (see Figure 2). The only arguments made by appellant as to why claim 1 is not anticipated by Budd are that (1) considering the obvious dimensions of the pet food dish there is not enough room to clasp the bottom of one of the compartments with a portion of a thumb in the space between the compartments let alone support the dish by inserting a portion of that hand's forearm in the remaining space and (2) the surrounding skirt of Budd's dish provides an unsurmountable impediment to actually supporting the pet dish with a forearm between the compartments (brief, page 5). Appellant has not asserted that any other limitation of claim 1 is not met by Budd.

As for the first argument, as discussed above, claim 1 simply calls for the space between the receptacles defined by the panels to be of sufficient length to accommodate "at least a *portion* of a thumb of a hand of the user" (emphasis ours), not

¹ Note that the top wall 12 and one sidewall portion depending therefrom may be considered to be one of the panels called for in claim 1, with the other sidewall portion depending from the top wall 12 being considered to be the other panel called for in claim 1.

the entirety of a thumb. We find no error in the examiner's determination that the space defined between the recesses 22, 32 of Budd's dish is of sufficient length to meet this broad limitation. We also note that appellant's first argument is not commensurate in scope with the language of claim 1, which merely requires sufficient length of space between the panels to rest on at least a portion of a forearm; the claim does not require sufficient length of space to permit insertion of a forearm therebetween. In any event, we agree with the examiner that the space between the recesses 22, 32 of Budd's dish is of sufficient length to rest on at least a portion, which could be as small as a single point, of a forearm of a user. As for appellant's second argument, while the surrounding skirt might provide an impediment to the entire length of space defined between the recesses 22, 32 resting on the forearm of a user, claim 1 is not so limiting. From our perspective, the skirt would not prevent the space between the recesses 22, 32 from resting on a portion, which could be as small as a single point, of a user's forearm. For example, the dish is capable of being supported by a user such that the skirt rests on one portion of the user's forearm while a portion of the space between the recesses rests on another portion of the user's forearm.

In that we have found neither of appellant's arguments persuasive of any error on the part of the examiner in determining the subject matter of claim 1 to be anticipated by Budd, we shall sustain this rejection.

We reach a similar conclusion with regard to the examiner's rejection of claim 1 as being anticipated by Pratt. While Figure 3 of Pratt illustrates the lateral spacing at

the bottom of the walls 3 forming the partition of Pratt's tray to be on the order of the diameter of the finger and thumb illustrated therein, this in no way indicates that the spacing is incapable of accommodating *a portion* of a thumb of that user. Further, while this spacing may not be sufficient to accommodate the entirety of a user's forearm, it certainly appears capable of resting on a portion of a user's forearm, for the same reasons discussed above with regard to the Budd reference, notwithstanding the presence of the skirt of the tray. Accordingly, appellant's arguments on pages 6 and 7 of the brief do not persuade us of any error on the part of the examiner in rejecting claim 1 as being anticipated by Pratt. It follows that we shall sustain this rejection as well.

Turning now to the rejection based on De Murguiondo, we note that De Murguiondo's ice cube tray comprises a plurality of cells 3 separated by inclined walls 6 so as to define spaces between the cells. Appellant's sole argument as to why the subject matter of claim 1 is not anticipated by De Murguiondo is that "[o]ne skilled in the art would not find enough space between a pair of rows of compartments on a ice tray to accommodate a portion of a thumb and a portion of that thumb's forearm even using hindsight from Appellant's invention" (brief, page 6).

In the first place, we observe that appellant's claim 1 is directed to a container and not to a method of supporting a container on a user's forearm. It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431

(Fed. Cir. 1997). In this case, appellant's claim 1 calls for a container comprising first and second receptacles joined at a common upper edge "wherein panels extending from the common edge provide a sufficient length of space therebetween to rest on at least a portion of a forearm extended by a user therebetween and to accommodate at least a portion of a thumb of a hand of the user." We find no requirement in claim 1 that the panels define a length of space sufficient to accommodate a portion of the user's forearm as appellant's argument implies. Rather, the claim simply requires that the length of space be sufficient to rest on a portion of the user's forearm. In any event, as explained above, a portion of a thumb can be as small as a thumb nail or a pinch of skin and a portion of a forearm can simply be a point on that forearm. With this in mind, we share the examiner's view that the spacing between the cells in De Murguiondo's ice tray is sufficient to rest on at least a portion of the forearm and to accommodate at least a portion of a thumb, as called for in claim 1. Therefore, as this is the only limitation argued by appellant not to be met by De Murguiondo, we shall sustain the examiner's rejection of claim 1 as being anticipated by De Murguiondo.

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed.

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

AFFIRMED

IRWIN CHARLES COHEN
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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