

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte MARY ANN HRISINKO

Appeal No. 2003-0231
Application No. 09/749,372

ON BRIEF

Before ABRAMS, FRANKFORT, 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, 3, 4, 6, 7 and 12 to 14. Claims 2, 5 and 8 to 11 have been withdrawn from consideration. No claim has been canceled.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a microscope slide carrier assembly having a record pocket integral with a microscope slide carrier (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art relied upon by the examiner in rejecting the appealed claims is:

Young et al. (Young)	4,919,268	Apr. 24, 1990
Yuen	4,936,462	June 26, 1990

Official Notice that it was known in the art to provide a container having a stacking means such as protrusions and recesses to facilitate stacking.

Claims 4 and 7 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.¹

Claims 1, 3, 4, 6, 7, 13 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yuen.

¹ Since claim 6 depends from claim 4 it appears that this ground of rejection should have also been applied to claim 6.

Claims 1, 3, 4, 6, 7 and 12 to 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yuen in view of Official Notice and Young.

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. 12, mailed July 11, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 11, filed June 4, 2002) 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 claims 4 and 7 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).

Claim 4 includes the limitation "the compartment for the at least one sheet of paper being adapted to control information on the at least one sheet of paper as related to the microscope slides."

In this rejection, the examiner (answer, p. 3) stated that the phrase "being adapted to control information on the at least one sheet of paper as related to the microscope slides" is vague, confusing and indefinite since it has no clear meaning as to how the compartment is adapted to control information on the sheet.

The appellant argues (brief, p. 7) that this rejection is improper since functional language is permitted in claims and the claims have sufficient structure so that the functional language serves to clarify the claims.

In our view, the metes and bounds of the limitation "the compartment for the at least one sheet of paper being adapted to control information on the at least one sheet

of paper as related to the microscope slides" is not understandable with a reasonable degree of precision and particularity as required by the second paragraph of 35 U.S.C. § 112. This limitation is indefinite since it is not clear how the compartment is adapted to control information on the at least one sheet of paper² This rejection is based not on the presence of functional language but on the inability of the claimed structure to be able to perform that function (i.e., that the compartment is adapted to control information on the at least one sheet of paper).

For the reasons set forth above, the decision of the examiner to reject claims 4 and 6 under 35 U.S.C. § 112. second paragraph, is affirmed.

The anticipation rejection

We sustain the rejection of claims 1, 3, 4, 6, 7, 13 and 14 under 35 U.S.C. § 102(b) as being anticipated by Yuen.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.

² Perhaps the appellant meant to claim that the compartment for the at least one sheet of paper being adapted to control **access to** information on the at least one sheet of paper related to the microscope slides.

Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claims 1 and 13, the independent claims on appeal read as follows:

1. A microscope slide carrier assembly adapted to carry slides and hold related records at the same time comprising:
 - (a) a slide carrier being adapted to hold a plurality of microscope slides;
 - (b) a compartment being adapted to contain at least one sheet of paper;and
 - (c) the slide carrier and the compartment being joined together.

13. A microscope slide carrier assembly for retaining printed reports, forms, requisitions and worksheets associated with patient slides requiring a microscopic review comprising a three-sided compartment with a lengthwise opening for easy insertion of printed material secured to a slide carrier in order to form the microscope slide carrier assembly.

Yuen's invention relates to a story book that has two pages, with the first page having the beginning part of a story displayed therein; and with the second page having the ending of the story located beneath a food tray, which when filled with food hides the story but when emptied of food reveals the story ending. Figure 1 shows a

perspective view of the combination story book and food tray 10 folded together as a closed book. Figure 2 shows a perspective view of the combination story book food tray 10 laid open so as to display the story page 12 on the left-hand side and the food tray compartment page 16 on the right-hand side. Figure 3 shows an expanded perspective view of the story book food tray of Figure 2, and additionally shows how information means 14 and 20 can be inserted into the story page and under the food tray compartment, and how a food tray is removable.

Yuen's story book page 12 contains a first means 14 for providing information. Means 14 could be made of cardboard or a sheet of plastic material that is flat on both sides and has information thereon, such as printed words and/or pictures, that would be instructive, amusing, attention getting, and educational for small children.

Yuen's second page 16 has means 18 for holding food, and has a second means 20, which is shown in Figure 3 for providing information located beneath the food holding means 18. Information providing means 20 could be of the same construction as the first means 14 for providing information, as discussed above.

Yuen's story book food tray also has means 22 for connecting the first page 12 to the second page 16. The story book food tray also has means 24 for releasably

sealing together the first page 12 and the second page 16 to form the closed book, as shown in Figure 1.

Yuen's Figure 3 shows how a first information providing means 14 can be inserted into the story page 12 and how a second information providing means 20 can be inserted under the food tray 18. Figure 3 also shows how a food tray 18 can be removed from page 16. The first page 12 comprises at least one window 26 for viewing the first means 14 for providing information. There is a first housing 28 beneath the window for holding the first means 14 for providing information, and there is a means 30 for providing entry into the first housing 28 or exit out from the first housing for the first means 14 for providing information.

As seen in Figure 3 of Yuen, the means, located on the second page for holding food, is at least one food container 18 which is releasably fitted into the top portion of a well 32. The food container, when empty, is transparent for viewing through the bottom thereof the second means 20 for providing information. The bottom portion 34 of the well is in effect a second window which provides an unobstructed view of the second means 20 for providing information. There is a second housing 36 beneath the second window 34 for holding the second means 20 for providing information. There is a

means 38 for providing entry into the second housing 36 or for providing an exit out from this second housing for the second means 20 for providing information.

In this rejection, the examiner (answer, pp. 3-4) set forth how the claimed subject matter was readable on Yuen. Specifically, the examiner stated that the carrier of Yuen (i.e, Yuen's second page 16) was inherently capable of holding a plurality of microscope slides.

The appellant argues (brief, p. 6-8) that this rejection is improper since Yuen's container used to store food would be incapable of storing a plurality of microscope slides because of different depth requirements.

In our view, the limitation that the slide carrier is adapted to hold a plurality of microscope slides is readable on Yuen's second page 16 which includes well 32 and three food trays 18 which inherently are capable of holding a plurality of microscope slides. A prior art reference may anticipate when a claim limitation not expressly found in that reference is nonetheless inherent in it. See In re Oelrich, 666 F.2d at 581, 212 USPQ at 326; Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations (i.e., is

capable of performing the claimed limitations), it anticipates. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Where, as here, the result is a necessary consequence of what was deliberately intended, it is of no import that the article's authors did not appreciate the results. See W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983).

The appellant's argument is unpersuasive since attorney argument in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Moreover, the appellant has not cogently explained why each of Yuen's food containers 18 would be incapable of storing at least one microscope slide. While Yuen's food containers 18 may have a different depth than the slide carrier disclosed by the appellant, the appellant has not explained how this difference results in the inability of each of Yuen's food containers 18 to store at least one microscope slide.

For the reasons set forth above, it is our opinion that the subject matter of claims 1 and 13 is met by Yuen. Accordingly, the decision of the examiner to reject claims 1 and 13 under 35 U.S.C. § 102(b) is affirmed.

Claims 3, 4, 6, 7 and 14 which depend from either claim 1 or claim 13 have not been separately argued by appellant as required in 37 CFR § 1.192(c)(7) and (8)(iv). Accordingly, we have determined that these claims must be treated as falling with their respective independent claim. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). Thus, it follows that the decision of the examiner to reject claims 3, 4, 6, 7 and 14 is also affirmed.

The obviousness rejection

We sustain the rejection of claims 1, 3, 4, 6, 7, 13 and 14 under 35 U.S.C. § 103 since the rejection of these claims as being anticipated by Yuen has been sustained above. Affirmance of the 35 U.S.C. § 103 rejection is appropriate, since it is well settled that a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

We sustain the rejection of claim 12 under 35 U.S.C. § 103 as being unpatentable over Yuen in view of Official Notice and Young for the following reasons.

Claim 12 reads as follows:

- The microscope slide carrier assembly of Claim 1 further comprising:
- (a) the compartment having a height of up to about one centimeter;
 - (b) the microscope slide carrier assembly including a stacking means.
 - (c) the compartment having a depth of up to about 20 centimeters.

The examiner ascertained (answer, p. 4) that Yuen discloses all the claimed limitations of claim 12 except for the stacking means. The examiner then took Official Notice that it was known in the art to provide a container having a stacking means such as protrusions and recesses to facilitate stacking. Next, the examiner determined that Young, cited by way of example, taught a carrier with a stacking means in Figure 25. Lastly, the examiner concluded that it would have been obvious to one having ordinary skill in the art in view of the Official Notice and/or Young to modify Yuen to include a stacking means to facilitate stacking of a plurality of Yuen's story book food trays.

The appellant argues (brief, pp. 8-9) that claim 12 is patentable over Yuen. The appellant specifically challenges the examiner to provide a reference to support the examiner's position that it was known in the art to provide a container having a stacking means such as protrusions and recesses to facilitate stacking. Absent such a reference, the appellant traverses this rejection.

The appellant's argument is unpersuasive since the examiner has cited and applied the reference to Young in the rejection of claim 12. The appellant has not specifically contested the rejection of claim 12 based on the combined teachings³ of Yuen and Young as applied in this rejection. 37 CFR § 1.192(c)(8)(iv) requires the argument in a brief to specify the errors in the examiner's rejection under 35 U.S.C. § 103, and, if appropriate, the specific limitations in the rejected claims which are not described in the applied prior art, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. Since the appellant has not specified any error in the examiner's determination that the limitations not disclosed by Yuen would have been obvious to one skilled in the art from the teaching of Young, we are constrained to sustain the examiner's rejection of claim 12 as being unpatentable over Yuen in view of Official Notice and Young. Accordingly, the decision of the examiner to reject claim 12 under 35 U.S.C. § 103 is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 4 and 6 under 35 U.S.C. § 112, second paragraph, is affirmed; the decision of the examiner to reject claims 1, 3, 4, 6, 7, 13 and 14 under 35 U.S.C. § 102(b) is affirmed; and the decision of

³ 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).

the examiner to reject claims 1, 3, 4, 6, 7 and 12 to 14 under 35 U.S.C. § 103 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

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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