

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN E. LINVILLE,
DONALD R. MAIER and PATRICK M. SAAF

Appeal No. 2004-2238
Application No. 09/878,743

ON BRIEF

Before TIMM, DELMENDO and JEFFREY T. SMITH, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal the decision of the Primary Examiner finally rejecting claims 21 to 23 and 35.¹ We have jurisdiction under 35 U.S.C. § 134.²

¹ According to the Appellants, claims 1 to 20, 33 and 34 have been withdrawn from consideration as drawn to a non-elected invention. (Brief, p. 2). The Examiner has indicated that the subject matter of claims 24 to 32 is allowable. (Final Rejection, p.1)

² In rendering this decision, we have considered Appellants' arguments presented in the Brief filed December 8, 2003, and the Reply Brief filed June 21, 2004.

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CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Edwards	1,507,957	Sep. 09, 1924
Elder	4,730,370	Mar. 15, 1988
Nishibori	4,610,900	Sep. 09, 1986

The Examiner rejected claims 21-23 and 35 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Edwards, Elder and Nishibori. (Answer, pp. 3-4).

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellants in support of their respective positions. This review leads us to conclude that the Examiner's § 103 rejection is well founded. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPO2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984).

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants concerning the above-noted rejection, we refer to the Answer and the Briefs.

We initially note that Appellants assert "that there are at least three separately patentable groups of claims. Group 1 consists of claim 21. Group 2 consists of claims 22 and 23. Group 3 consists of claim 35. Appellants submit that "each of these groups of claims are separately patentable from each of the other of the groups of claims for reasons which will be developed below in the argument." (Brief, p. 3). However, Appellants have failed to provide arguments directed to the separate groups. Consequently, the rejected claims will stand or fall together.

The Examiner rejected claims 21-23 and 35 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Edwards, Elder and Nishibori. We select claim 21 as representative of the rejected claims.³

Appellants' invention relates to one-piece, unitary lid for a casket. The unitary casket lid comprises a crown, a pie, a header and side rim members. Claim 21, which is representative of the claimed invention, appears below:

³ The Examiner relied upon the Nishibori reference for teaching elements that do not appear in claim 21. Thus, in our discussion of the rejection we will not discuss the teachings of this reference.

21. A casket lid comprising:
 a crown;
 a pie at one end of said crown, said crown and pie together comprising a cover having a pair of sides and a pair of ends;
 a header at one of said ends of said cover opposite from said pie; and
 a side rim member at each of said pair of cover sides and an end rim member at the other of said cover ends;
 said crown, pie, rim members and header being molded as a one-piece, unitary structure.

The subject matter of claim 21 is directed to a casket lid that has been molded as a one-piece unitary structure that includes a crown, a pie, rim members and a header. According to the Examiner, Edwards teaches a casket molded from wood pulp wherein the lower body and cover (lid) are separately molded in molds that impart the desired shape (Answer, p. 3). The Examiner acknowledges that Edwards is silent towards the shape of the casket lid and whether it contains a crown, a pie, rim members and a header (Answer, p. 3).

The Examiner cites Elder for its teaching that a conventional shape for casket lids includes a crown, a pie, rim members and a header (Answer, p. 3). Appellants description appearing in the background section of the

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specification is in agreement with the teachings of Elder that it was conventional for a casket lid to include a crown, a pie, rim members and a header (Specification, p. 2, line 5 to p. 3, line 5).

Appellants argue that there is no motivation to combine the teachings of Edwards and Elder and that the statement of obviousness is merely conclusory (Answer, pp. 10-11, Reply Brief, pp. 1-2). We do not agree. In an obviousness determination it is important that the prior art establishes that there was a reason, suggestion or motivation to make what is claimed and that one of ordinary skill in the art would have had a reasonable expectation of success in so carrying it out. *See In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). In the present case, Edwards teaches a casket comprising a lid (cover) and lower body which are each separately molded in a mold of the desired shape (Edwards, ll. 22-24 and 42-47). A person of ordinary skill in the art would have recognized that a casket lid could conventionally include a crown, a pie, rim members, and a header. (See Elder's figures). In light of the teaching in Edwards that the mold is formed to impart the desired shape to the casket lid, a person of ordinary skill in the art would have reasonably

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expected that a mold for a casket lid could have included a crown, a pie, rim members, and a header and produce a unitary casket lid with this structure. "For obviousness under § 103, all that is required is a reasonable expectation of success." *In re O'Farrell*, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

Appellants argue that the Examiner has not made findings concerning the "identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved or any other factual findings that might serve to support a proper obviousness analysis." (Brief, p. 5).

We find that the references in this record are representative of the level of ordinary skill in the art. *See In re Oelrich*, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978) ("the PTO usually must evaluate both the scope and content of the prior art and the level of ordinary skill solely on the cold words of the literature"); *In re GPAC Inc.*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995) (the Board did not err in adopting the approach that the level of skill in the art was best determined by the references of record); *Okajima v. Bourdeau*, 261 F.3d 1350, 1355,

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59 USPQ2d 1795, 1797 (Fed. Cir. 2001) (“ [T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown.’ ”). Appellants have not said what they consider to be the level of skill in the art, how such would be determined to their satisfaction, or how a different level of skill would affect the outcome. Appellants also have not refuted the teachings of Elder that a conventional casket lid comprise a crown, a pie, rim members, and a header. As stated above, a person of ordinary skill in the art would have reasonably expected that a conventionally shaped unitary casket lid could have included a crown, a pie, rim members, and a header.

Appellants also argue that the passage of nearly 80 years from the time of the Edwards invention and Appellants’ invention suggests non-obviousness. (Reply Brief, p. 2). This argument is not found to be persuasive. Obviousness is determined at the time the invention was made. One skilled in the art looking at the art as a whole at the time Appellants’ invention was made would have considered all available prior art.

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Appellants further argue that “the claimed invention eliminates a number of manufacturing steps, and in doing so reduces the cost associated with fabricating casket lids.” (Reply Brief, p. 2). This argument is not persuasive because the claims on appeal are directed to a casket lid and not the process of manufacturing the lid.

For the foregoing reasons and those set forth in the Answer, based on the totality of the record, we determine that the preponderance of evidence weighs in favor of obviousness, giving due weight to Appellants arguments. Accordingly, we determine that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 21-23 and 35 which has not been sufficiently rebutted by the Appellants.

CONCLUSION

The rejection of claims 21 to 23 and 35 under 35 U.S.C. § 103(a) as obvious over the combined teachings of Edwards, Elder and Nishibori is affirmed.

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TIME FOR TAKING ACTION

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

AFFIRMED

CATHERINE TIMM
Administrative Patent Judge

ROMULO H. DELMENDO
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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