

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2005-0371
Application No. 10/210,313

ON BRIEF

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

DECISION ON APPEAL

Giuseppe Monti appeals from the final rejection of claims 1 through 10, all of the claims pending in the application.

THE INVENTION

The invention relates to "a method for transferring blister packs from the outlet line of a blistering machine to the feeding line of a packaging machine, and a device for carrying out the method" (specification, page 1). Claims 1 through 8 are directed to the method and claims 9 and 10 are drawn to the device.

THE REFERENCE

The reference relied on by the examiner to support the final rejection is:

Monti, Published European 1 164 099 Dec. 19, 2001
Patent Application

THE REJECTION

Claims 1 through 10 stand rejected under 35 U.S.C. § 102(a)¹ as being anticipated by the published European application.

Attention is directed to the main and reply briefs (filed August 3, 2004 and September 29, 2004) and the answer (mailed September 10, 2004) for the respective positions of the appellant and the examiner regarding the merits of this rejection.

DISCUSSION

On the record before us, the following facts are not in dispute:

a) the published European application discloses each and every element of the subject matter recited in appealed claims 1 through 10;

¹ 35 U.S.C. § 102(a) provides that a person shall be entitled to a patent unless “(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.”

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b) the published European application matured from European Application No. 01113607.4, and lists Italian Application No. B0000357 as a priority document;

c) the published European application has a publication date, Dec. 19, 2001, which is less than one year prior to the filing date of the instant application, August 1, 2002; and

d) the published European application reflects the appellant's own work.

In rejecting claims 1 through 10 as being anticipated by the published European application, the examiner reasons that

[s]ince there is no priority claim to either of applicant's earlier applications Italy B[O]000357 or European 01113607.4, the publication EP1164099 A1 [i.e., the published European application] is useable as a reference. Note that under 35 U.S.C. 102(a) the issue is not "invention "by others"". The issue is "know[n] by others...or described in a printed publication in...a foreign country, before the invention" (U.S. filing date) "by applicant". Due to the lack of diligence in filing the U.S. application, applicant has lost the right to a U.S. patent [answer, page 3].

The examiner's position here has no basis in law. As stated by the predecessor of our reviewing court in In re Katz, 687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982):

It may not be readily apparent from the statutory language that a printed publication cannot stand as a reference under §102(a) unless it is describing the

work of another. A literal reading might appear to make a prior patent or printed publication "prior art" even through the disclosure is that of the applicant's own work. However, such an interpretation of this section of the statute would negate the one year period afforded under §102(b)[footnote omitted] during which an inventor is allowed to perfect, develop and apply for a patent on his invention and publish descriptions of it if he wishes. *Illinois Tool v. Solo Cup Co.*, 461 F.2d 265, 172 USPQ 385 (CA 7), cert. denied, 407 U.S. 916 (1972).

Thus, one's own work is not prior art under §102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under §102(a). Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter so disclosed (or subject matter obvious therefrom) only when the disclosure occurred more than one year prior to the date of the application, that is, when the disclosure creates a one-year time bar, frequently termed a "statutory bar," to the application under §102(b). As stated by this court in *In re Facius*, 56 CCPA 1348, 1358, 408 F.2d 1396, 1406, 161 USPQ 294, 302 (1969), "But certainly *one's own invention*, whatever the form of disclosure to the public, may not be prior art against oneself, *absent a statutory bar.*"

Hence, the published European application is not prior art under § 102(a) with respect to the subject matter recited in claims 1 through 10. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(a) rejection of these claims.

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SUMMARY

The decision of the examiner to reject claims 1 through 10
is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. MCQUADE)	APPEALS
Administrative Patent Judge)	AND INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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