

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for publication and is not binding precedent of the Board.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 RODNEY W. TYLER

Appeal No. 2005-2694
Application No. 10/208,631

ON BRIEF

Before McQUADE, CRAWFORD and BAHR, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Rodney W. Tyler appeals from the final rejection (mailed May 18, 2004) of claims 1-21, 56, 69-71, 76-84, 113 and 114. Claims 22-55, 57-68, 72-75 and 85-112, the only other claims pending in the application, stand withdrawn from consideration.

THE INVENTION

The subject matter on appeal relates to "devices, systems, and methods . . . for controlling erosion, retaining sediment, preventing siltation, treating runoff, removing pollutants, remediating environmental damage, protecting plants, bordering play areas, absorbing spills, establishing vegetation, protecting ecosystems, and/or restoring waterways and/or other riparian areas" (specification, page 1). Representative claims 1, 113 and 114 read as follows:

1. A system comprising a first tubular mesh enclosure formed from a mesh material having a nominal opening size of less than 0.5 inches, said first tubular mesh enclosure having a first opposing pair of ends, at least one of said first opposing pair of ends sealed, said first tubular mesh enclosure defining a first length and a first generally oval cross-section defining a first major diameter, a first ratio of said first length to said first major diameter greater than approximately 40, said first tubular mesh enclosure surrounding a filling.

113. A method for forming a storm water control device comprising:

placing a compost-based filling into a mesh tube formed from a mesh material having a nominal opening size of less than 0.5 inches, a ratio of a length of the mesh tube to a diameter of the mesh tube greater than 40; and

providing the mesh tube to a location prone to storm-water flow.

114. A method for forming a sediment control device comprising:

placing a compost-based filling into a mesh tube formed from a mesh material having a nominal opening size of less than 0.5 inches, a ratio of a length of the mesh tube to a diameter of the mesh tube greater than 40; and

providing the mesh tub to a location prone to sediment-containing water flow.

THE EVIDENCE

The items relied on by the examiner as evidence of obviousness are:

Grabhorn	5,595,458	Jan. 21, 1997
Burke	5,679,247	Oct. 21, 1997
Ito et al. (Ito)	5,747,633	May 05, 1998
Garcia et al. (Garcia)	5,854,304	Dec. 29, 1998

Albright Seed Company, "Construction Site Erosion Costly, Illegal"
©1997, 1998 (Albright).

The item relied on by the appellant as evidence of non-obviousness is:

The 37 CFR § 1.132 Declaration of Dr. Jerald S. Fifield filed July 28, 2004.

THE REJECTIONS

Claims 1-3, 9-13, 15-21, 56, 69-71, 76-84, 113 and 114 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Albright in view of Grabhorn.

Claims 4-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Albright in view of Grabhorn and Burke.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Albright in view of Grabhorn and either Ito or Garcia.

Attention is directed to the main and reply briefs (filed October 28, 2004 and March 30, 2005) and answer (mailed February 4, 2005) for the respective positions of the appellant and examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 103(a) rejection of claims 1-3, 9-13, 15-21, 56, 69-71, 76-84, 113 and 114 as being unpatentable over Albright in view of Grabhorn

Albright discloses a so-called "Agromin Bio-Filter Bag" designed for use on construction sites to prevent erosion from storm water runoff. The "Bag" is a "12 by 9 by 40-inch long object" (page 1) in the form of a mesh bag filled with 100 percent recycled wood chips. This construction allows water to flow

therethrough while holding back entrained soil, silt and debris.

According to Albright,

[t]he Agromin Bio-Filter Bags are suitable for open slopes and embankments, gullies, catch basins, culvert retention areas, roadside ditches, swales and around drain openings.

The filter bags are easily installed. At about forty-five pounds each, workers can readily handle them.

Depending on application, the bags can be staked in place using two 1 x 2 inch wood stakes or their equivalent for each filter bag [page 2].

As implicitly conceded by the examiner (see pages 3 and 4 in the answer), Albright does not meet the limitations in independent claims 1, 113 and 114 requiring (1) the mesh material to have a nominal opening size of less than 0.5 inches and (2) the enclosure or tube to have a length to diameter ratio of greater than 40 (or approximately 40).

Grabhorn discloses a water permeable erosion control bag similar in many respects to the one disclosed by Albright. The Grabhorn bag consists of hammer-milled wood fragments packed within

cylindrical polyethylene tubes having a $\frac{1}{2}$ (0.5) inch mesh size, a diameter of about 12 inches and a length of either 30 or 60 inches (see column 2, lines 24-34).

In proposing to combine Albright and Grabhorn to reject claims 1, 113 and 114, the examiner submits that

[t]o have formed the Albright tubular mesh with openings of about $\frac{1}{2}$ inch or less than $\frac{1}{2}$ inch, thus allowing appropriate flow of liquid through the tubular mesh while holding the filling material therewithin, would have constituted an obvious expedient to one having ordinary skill in the art at the time the invention was made as taught by Grabhorn '458. Forming the resulting tubular mesh in lengths of a magnitude to define a ratio of length to major diameter equal to 40, (as for example 40 feet or more), thus allowing expansive coverage with a single unit as well as forming the major diameter of more than 12 inches to allow for a height coverage of approximately 13-15 inches, would have constituted a further obvious expedient to one having ordinary skill in the art at the time the invention was made [answer, page 4].

The appellant does not dispute the examiner's conclusion that Grabhorn would have suggested forming the Albright mesh material with a nominal opening size of less than 0.5 inches. The appellant does contend, however, that the rejection is unsound because the combined teachings of Albright and Grabhorn would not have

suggested a system and method embodying the length to diameter ratios recited in claims 1, 113 and 114.

Responding to this line of argument, the examiner contends that

[t]he suggestion or motivation to enlarge the Albright tubular mesh is with the knowledge generally available to one of ordinary skill in the art as one of ordinary skill in the soils engineering art would wish to establish as much of a continuous barrier to water runoff as is possible while also striving to create a barrier which can hold back as much water level as feasible [answer, pages 5 and 6].

The examiner also takes a somewhat different approach by (1) characterizing the ratio difference between the claims and the applied references as an uncritical, and hence arbitrary, variation in size and (2) citing case law for the proposition that such size limitations

cannot be a basis for patentability, since where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. There had been no evidence submitted during the prosecution of the application, that any of the recited dimensions, sizes, and ratios are a critical factor to the invention, or that such values for the sizing of the mesh tube produces unexpectedly good results [answer, page 6].

Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In the present case, the combined teachings of Albright and Grabhorn do not supply the factual basis necessary to support a conclusion of obviousness with respect to the subject matter recited in claims 1, 113 and 114.

The anti-erosion device disclosed by Albright has a length to major diameter ratio of 40:12 (approximately 3.3) which is far smaller than the "greater than 40" or "greater than approximately 40" ratio required by these claims. Albright also teaches that the device disclosed therein weighs about forty-five pounds and is readily handled by workers and easily installed. This disclosure by Albright, and the disclosure of a similar device by Grabhorn, would not have furnished the artisan with any suggestion or motivation to selectively enlarge the dimensions, and change the proportion, of the Albright bag in the manner proposed by the examiner so as to arrive at the length to diameter ratio recited in the claims. The Albright device as so modified would be substantially longer and heavier than that contemplated by the reference for ready handling and easy installation.

The reliance by the examiner on a bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap posed by Albright and Grabhorn is not well taken. Such unfounded assertions are not permissible substitutes for evidence. See In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Moreover, the examiner's criticism of the claim limitations at issue as not being critical is of no moment. Claims are not legally required to include "critical" limitations. See W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Finally, the contention that uncritical limitations pertaining to differences in size or other variables in a claim cannot form the basis for patentability also is unsound. To begin with, the inference of such a general or per se rule of obviousness from cases turning on specific facts has no basis in law. Furthermore, the application of such a per se rule to reject a claim constitutes additional legal error because it bypasses the particularized fact-specific inquiry required by § 103(a). See In re Ochiai, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1995); In re Wright, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

For these reasons, the combined teachings of Albright and Grabhorn fail to establish a prima facie case of obviousness with respect to the subject matter recited in independent claims 1, 113 and 114.¹ Accordingly, we shall not sustain the standing 35 U.S.C.

¹ Consequently, it is unnecessary to delve into the merits of the appellant's declaration evidence of non-obviousness.

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§ 103(a) rejection of claims 1, 113 and 114, and dependent claims 2, 3, 9-13, 15-21, 56, 69-71 and 76-84, as being unpatentable over Albright in view of Grabhorn.

II. The 35 U.S.C. § 103(a) rejection of claims 4-8 as being unpatentable over Albright in view of Grabhorn and Burke

As the examiner's application of Burke does not overcome the deficiencies of Albright and Grabhorn relative to parent claim 1, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 4-8 as being unpatentable over Albright in view of Grabhorn and Burke.

III. The 35 U.S.C. § 103(a) rejection of claim 14 as being unpatentable over Albright in view of Grabhorn and either Ito or Garcia

Since the examiner's citation of either Ito or Garcia fails to cure the shortcomings of Albright and Grabhorn with respect to

parent claim 1, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 14 as being unpatentable over Albright in view of Grabhorn and either Ito or Garcia.

SUMMARY

The decision of the examiner to reject claims 1-21, 56, 69-71, 76-84, 113 and 114 is reversed.

REVERSED

JPM/ki

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