

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not binding precedent of the Board.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 MICHAEL SHALIT

Appeal No. 2006-1386
Application No. 10/206,567

ON BRIEF

Before OWENS, CRAWFORD, and BAHR, *Administrative Patent Judges*

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1-10 and 15-19. Claims 11-14 have been canceled and claims 20-24 stand withdrawn from consideration by the examiner as claiming a nonelected invention.

THE INVENTION

The appellant claims a trash bag removal system. Claim 1 is illustrative:

1. A trash bag removal system comprising:

at least one flexible trash can liner having first and second ends, said at least one trash can liner adapted to be arranged within a trash can having a top rim and at least one internal sidewall, said at least one trash can liner being positioned within the trash can adjacent the at least one sidewall so as to form opposing first and second sides terminating at said first and second ends where both of said ends extend toward the top rim of the trash can and are not

Appeal No. 2006-1386
Application No. 10/206,567

connected to each other at any time, whereby an at least partially filled trash bag within the trash can will urge said opposing sides of said at least one trash can liner against the at least one internal side wall of the trash can such that said first and second ends of said trash can liner will slide upwardly along the at least one internal sidewall of the trash can upon removal of a trash bag therefrom, said flexible liner being constructed and arranged to remain at least partially within the trash can when the trash bag is removed.

THE REFERENCES

Peterson	4,140,257	Feb. 20, 1979
Poliquin	6,015,063	Jan. 18, 2000

THE REJECTIONS

The claims stand rejected as follows: claims 1-10 and 16 under 35 U.S.C. § 112, first paragraph, written description requirement; claims 1-10, 15 and 17-19 under 35 U.S.C. § 102(b) as anticipated by Peterson; and claim 16 under 35 U.S.C. § 103 as obvious over Peterson in view of Poliquin.

OPINION

We affirm the rejection under 35 U.S.C. § 102(b) and reverse the rejections under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 103.

Rejection under 35 U.S.C. § 112, first paragraph

The examiner argues that the requirements that the ends of the trash can liner are not connected to each other at any time (claims 1 and 7) or are unconnected at all times (claim 10), and the requirement that the plurality of flexible liners are not connected to each other at any time (claim 16), are not in the originally filed application (answer, page 3). The examiner acknowledges that the appellant's drawings show ends and flexible liners that are not connected,

Appeal No. 2006-1386
Application No. 10/206,567

and argues that the drawings show that the ends and flexible liners are not connected at a particular time but do not show ends and flexible liners that are never connected (answer, page 5).

The appellant argues that what the claims require is no connection when a specific condition or conditions exist, i.e., when a trash can liner is “positioned within the trash can … so as to form opposing first and second sides” (claims 1 and 7), when trash can liners are “arranged within a trash can … such that said plurality of flexible trash can liners are adjacent said at least one sidewall with said bottom ends being adjacent to said bottom wall” (claim 10), and when flexible liners are “arranged within said trash can on opposite sides of said internal side wall” (claim 16) (reply brief, pages 3-6).

A specification complies with the 35 U.S.C. § 112, first paragraph, written description requirement if it conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)

The appellant’s drawings show possession, at the time the original application was filed, of ends and flexible liners that are not connected when the claim conditions set forth by the appellant exist. Accordingly, we reverse the rejection under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 102(b)

Peterson discloses a sling for lifting a filled trash bag out of a trash container without the bag being ruptured by the weight of the trash therein (abstract). The sling comprises a pair of straps (12) that extend under the bottom of the trash bag, past a disc or plate at which they are joined together, and up the trash container's sides to the top of the trash container where they are hooked (col. 2, lines 1-12; figure 2). When the filled trash bag is to be lifted from the trash container the ends of the straps are hooked to each other at the top of the trash bag (col. 2, lines 15-19; figure 1).

The appellant argues that Peterson's pairs of straps must be connected at the top of the trash bag for the trash bag to be removed from the trash container and that, therefore, Peterson's sling has a different structure and operation than the appellant's system (brief, pages 11-13; reply brief, pages 9-10). The appellant is claiming a trash bag removal system, not a method for operating it. Thus, the relevant issue is whether Peterson's system is capable of meeting the functional language in the appellant's claims. As indicated by the claim language set forth by the appellant with respect to the rejection under 35 U.S.C. § 112, first paragraph, discussed above, the appellant's claims require that the ends of Peterson's straps must be capable of being not connected when a trash can liner is positioned within a trash container. Peterson's straps meet that requirement as shown in Peterson's figure 2.

Appeal No. 2006-1386
Application No. 10/206,567

The appellant argues that the term “removal” in the preambles of the appellant’s claims must be given weight and that, therefore, the claims require that the ends of the liner are not connected when the trash bag is removed (reply brief, pages 6-9). The preambles of the appellant’s claims require a system that is capable of trash bag removal. Peterson discloses such a system (col. 2, lines 15-19). The appellant’s preamble term “removal” pertains to the claimed system, not to the appellant’s disclosed method of operating it.

For the above reasons we are not convinced of reversible error in the examiner’s rejection under 35 U.S.C. § 102(b).¹

Rejection under 35 U.S.C. § 103

Poliquin discloses a trash can vent system that is securable to a trash can and includes a vent channel (24) along the interior sidewall of the trash can to prevent the trash can liner from forming a vacuum seal with the interior trash can sidewalls (col. 1, lines 43-47).

The examiner argues that Peterson discloses the invention in claim 16 except that Peterson’s liners are connected to each other (col. 2, line 7) (answer, page 5). Regarding the combination of Peterson and Poliquin, the examiner argues: “Poliquin teaches trash can vents or liners that are not connected to each other at any time. It would have been obvious to separate at least two of the liners in order to use the vacuum preventing liners as needed as motivated by the

¹ The appellant does not separately address independent claim 15. That claim, therefore, falls with the other rejected claims.

Appeal No. 2006-1386
Application No. 10/206,567

need for a liner in another trash can or the reduced cost of providing a single liner rather than multiple liners” (answer, page 5).

Poliquin does not disclose that the vent functions as a liner, and Poliquin’s figure 1, which shows each vent extending down a corner of the trash can and ending above the trash can’s bottom, indicates that the vent cannot function as a liner. Hence, there is no basis in Poliquin for equating vents and liners. The examiner argues that “Peterson provides a liner or sling which relieves the presence of vacuum lock between the trash bag and trash can at prescribed, equally spaced locations” (answer, page 8). Thus, the examiner is arguing that Peterson provides support for equating vents and liners. Peterson, however, does not disclose that the sling relieves vacuum lock, and the examiner has provided no evidence or reasoning to that effect.

The examiner, therefore, has not provided a proper basis for combining the disclosures of Peterson and Poliquin. Consequently, we reverse the rejection under 35 U.S.C. § 103.

DECISION

The rejection of claims 1-10, 15 and 17-19 under 35 U.S.C. § 102(b) over Peterson is affirmed. The rejections of claims 1-10 and 16 under 35 U.S.C. § 112, first paragraph, written description requirement, and claim 16 under 35 U.S.C. § 103 over Peterson in view of Poliquin, are reversed.

Appeal No. 2006-1386
Application No. 10/206,567

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

AFFIRMED-IN-PART

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TERRY J. OWENS)
Administrative Patent Judge)
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MURRIEL E. CRAWFORD) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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JENNIFER D. BAHR)
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Appeal No. 2006-1386
Application No. 10/206,567

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