

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**

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

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*Ex parte* DONALD SOUTHERN

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Appeal No. 2006-2096  
Application No. 10/353,882  
Technology Center 3600

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**ON BRIEF**

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Before OWENS, HORNER and FETTING, *Administrative Patent Judges*.  
HORNER, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's rejection of claims 1, 2, 4-10, 12, 13, and 15-21, all of the claims pending in the application. Claims 3, 11, and 14 have been canceled.

We reverse.

## BACKGROUND

The appellant's invention relates to a plant pot system and method of selling potted plants. In particular, the system includes an inner plant pot (12) having an outwardly protruding lip lock ridge (24) and containing a growing medium and a plant or flower and an outer container (14) with an outwardly protruding portion forming a lip lock groove (22) on the inside of its continuous sidewall.

(Specification, page 3, line 33 – page 4, line 6) In one embodiment the outer container (14) is coded according to customer specifications with a particular color or pattern. (Specification, page 2, lines 10-11) The inner pot (12) and outer container (14) securely engage with one another by complimentary mating of the lip lock ridge (24) and lip lock groove (22) when the inner pot (12) is placed within the outer container (14). (Specification, page 4, lines 25-27) In one embodiment, the inner plant pot (12) further includes a lip lock belt (26) below the lip lock ridge (24) that frictionally engages the inner face of the sidewall of the outer container (14). (Specification, page 4, lines 27-29) Claims 1 and 19-21 are representative of the subject matter on appeal, and a copy of these claims can be found in the appendix to the appellant's brief.

The examiner relies upon the following as evidence of unpatentability:

|                                 |             |               |
|---------------------------------|-------------|---------------|
| Myers                           | 1,679,621   | Aug. 07, 1928 |
| Shapiro <i>et al.</i> (Shapiro) | 3,288,340   | Nov. 29, 1966 |
| Maher                           | 3,973,316   | Aug. 10, 1976 |
| George                          | WO 87/02327 | Apr. 23, 1987 |
| Avôt                            | 6,161,332   | Dec. 19, 2000 |

The following rejections are before us for review.

1. Claims 1, 2, 4, 6, 7, 10, 15-18, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maher in view of Myers.
2. Claims 1, 2, 4, 6, 7, 10, 15-18, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Myers in view of Maher.<sup>1</sup>
3. Claims 5 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maher in view of Myers and further in view of Shapiro.
4. Claims 5 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Myers in view of Maher and further in view of Shapiro.
5. Claims 8, 9, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maher in view of Myers and further in view of Avôt.
6. Claims 8, 9, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Myers in view of Maher and further in view of Avôt.
7. Claims 13 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maher in view of Myers and further in view of George.
8. Claims 13 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Myers in view of Maher and further in view of George.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the office action (mailed March 22, 2005), the examiner's answer (mailed February 9, 2006) for the examiner's complete reasoning in support of the rejection and to the

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<sup>1</sup> The examiner raised the rejections based on Myers in view of Maher as new grounds of rejection in the Answer.

appellant's brief (filed November 25, 2005) and reply brief (filed March 6, 2006) for the appellant's arguments.

## OPINION

In reaching our decision in this appeal, we have carefully considered the appellant's specification and claims, the applied prior art, and the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow.

In the rejection of independent claim 21, the examiner determined that Maher teaches a plant pot container formed from a cup and that contains a growing medium and a plant. The examiner contends that "it is old and notoriously well-known to grow plants in cup shaped containers." (Office Action, p. 2) The examiner relies on Myers for the teaching of inner and outer containers, as claimed, that securely engage with one another by engagement of the lip lock ridge and lip lock groove and by engagement of the lip lock belt with the inside face of the outer container. (Office Action, p. 3) The examiner determined

It would have been obvious to one of ordinary skill in the art to modify the teachings of Maher with the teachings of Myers at the time of the invention since the modification is merely the selection of a known alternate pot/container selected for the advantage of providing the thermal insulation properties . . . as taught by Myers to protect against frost or over heating/evaporation in hot outside temperatures; or for the advantage for aesthetic advantages; or for protecting the inner pot from damage such as scratching during shipping. (Office Action, p. 3)

In the new grounds of rejection, the examiner further determined,

It would have been obvious to one of ordinary skill in the art to modify the teachings of Myers with the teachings of Maher at the time of the invention since a container functions as a storage device thus one would be motivated to store the plant and growing medium in the storage container of Myers; or to give plant roots some protection from frost or over heating/evaporation in hot outside temperatures since Myers has insulating properties . . .; or for the advantage for aesthetic design advantages for enhanced consumer appeal; or to be environmental [*sic*] conscious by recycling the container after the liquid contents are gone. (Examiner's Answer, p. 5)

With regard to claim 1, the examiner relied on the same combination of prior art references with the same analysis of the motivation to combine the references. (Office Action, p. 4 and Examiner's Answer, p. 6) The appellant contends that there is no motivation, teaching, or suggestion to combine Maher and Myers. (Appellant's Brief, pp. 8-12)

We agree with the appellant and hold that there is no teaching, suggestion, or motivation, either expressly or by implication, to combine the teachings of the prior art references that would have led one of ordinary skill in the art to have arrived at the claimed invention. Myers is directed to a sanitary container for milk and the like. (Myers, page 1, lines 3-4) Myers teaches a container that is a lighter and less expensive bottle than previously used, better preserves its contents under extreme variations in temperature, and reduces the production of bacteria by obviating certain unsanitary conditions. (Myers, page 1, lines 5-15)

Maher is directed to a container for a plant that is formed by severing the lower portion (16) of a tapered cup (10) and then inserting that portion into the

large end of the upper portion (20) of the cup (10) until the lower portion (16) wedges against the interior of the narrowest part of the upper portion (20). (Maher, col. 2, lines 1-4) The purpose of this construction is to allow the user to easily remove the plant from the container for transplanting without inverting the container. (Maher, col. 2, lines 16-19) As such, to remove the plant from the container, one needs to only hold the container in an upright position and push up on the bottom (14) of the container until the lower portion (16) loosens from the upper portion (20). (Maher, col. 2, lines 13-16)

The requirement of a “teaching, suggestion, or motivation” to modify or combine the prior art teachings was recently described in *In re Kahn*,

[T]he “motivation-suggestion-teaching” test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art – i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention-support the legal conclusion of obviousness. (internal citations omitted).

441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

To establish a prima facie case of obviousness, the references being combined do not need to explicitly suggest combining their teachings. See e.g., *Kahn*, 441 F.3d at 987-88, 78 USPQ2d at 1337-38 (“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly

stated in the references”). “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.”” *Id.* at 987-88, 78 USPQ2d at 1336 (quoting *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

With respect to claim 21, we hold that a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in Myers and Maher, would not have been led to make the combination recited in the claim. Specifically, we find no motivation to modify the plant container of Maher with the two-container arrangement as taught by Myers. There is nothing in the prior art that would have suggested to one of ordinary skill in the art to have modified the container of Maher to use a locking engagement as disclosed in Myers to attach the lower portion to the upper portion. Rather, one skilled in the art would not have been motivated to modify the lower portion of the Maher container to engage the upper portion in a locking fashion, because such a configuration would have made it more difficult, if not impossible, to push up on the lower portion of the container in order to remove and transplant the plant. Such a modification would destroy the function of the Maher container. As such, we hold that there is no motivation from the combined teachings of Myers and Maher and the knowledge of one of ordinary skill in the art to have modified the container of Maher with the locking configuration of Myers that would have led to the claimed invention.

We similarly find no motivation to modify the container of Myers to add a growing medium and a plant. The purpose of the container of Myers is to provide insulation and sanitary conditions to the contents of the container. We agree with

the appellant that putting soil in the inner container would destroy the sanitary condition and thus destroy the intent and purpose of the Mayer container.

(Appellant's Brief, p. 11) There is nothing in the teaching of the prior art that would have suggested either expressly or implicitly to one skilled in the art to use the container of Myers for growing a plant, absent the teachings of the present invention.

For the same reasons discussed for claim 21, we also hold with respect to claim 1, that a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in Myers and Maher, would not have been led to make the combination recited in the claim. As such, we do not sustain the examiner's rejection of independent claims 1 and 21.

With regard to rejected dependent claims 2, 4, 6, 7, 10, and 15-18, because these claim rejections rely upon the underlying rejection of independent claim 1, we also do not sustain the examiner's rejection of these claims. See *In re Fine*, 837 F.2d 1071, 5 USQP2d 1596 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim dependent therefrom is nonobvious).

With regard to the remaining rejections of claims 5, 8, 9, 12, 13, 19, and 20, all of these rejections are based on the same underlying combination of Myers in view of Maher or Maher in view of Myers. Because we find no motivation, teaching, or suggestion to combine Myers and Maher, we do not sustain the examiner's rejection of these claims for the same reasons set forth above.

## CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 4-10, 12, 13, and 15-21 is reversed.

*REVERSED*

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TERRY J. OWENS )  
Administrative Patent Judge )  
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) BOARD OF PATENT  
LINDA E. HORNER ) APPEALS  
Administrative Patent Judge ) AND  
) INTERFERENCES  
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ANTON W. FETTING )  
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