

The opinion in support of the decision being entered today 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* DANIEL J. DAIGGER, RODNEY K. MOORE,  
and MARLOW G. CLARK

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Appeal 2007-3148  
Application 10/638,885  
Technology Center 3600

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Decided: September 26, 2007

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Before BRADLEY R. GARRIS, PETER F. KRATZ, and  
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 the final rejection of claims 1-9. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and REMAND.

INTRODUCTION

Appellants claim a form assembly for use with a rough-in floor drain line (claim 1). The form assembly includes a molded plasticized form

which, prior to pouring the concrete, is secured over a rough-in area in which a plumbing drain line is located (Specification 1:5-9). The form assembly isolates the upwardly angled drain line from the encircling cement and prevents the concrete from encroaching within the rough-in area (Specification 1:9-11).

Claims 1, 2, 6, and 7 are illustrative:

1. A form assembly for use with a rough-in floor drain line, the drain line extending in exposed fashion from a ground location prior to the pouring of a concrete aggregate, said form assembly comprising:

a body exhibiting a three-dimensional outline with a height, width and depth and which defines an open interior, said body adapted to being positioned so that said open interior surrounds the exposed floor drain line and said body defines a perimeter about said open interior; and

a plurality of ground securing fasteners, engaged through lower-most extremities associated with said body, and in order to secure said body upon the ground location;

said body isolating the floor drain line from the encircling and poured concrete adhering against exteriorly facing services associated with said body.

2. The form assembly as described in claim 1, said lower-most extremity of said body further comprising an extending and encircling lip.

6. The form assembly as described in claim 1, said body having a specified shape and size and further comprising a volume of sand aggregate adapted to being filled into said open interior prior to the poured concrete.

7. The form assembly as described in claim 1, said body exhibiting a specified shape and size and including an upwardly directed and inwardly angled taper.

The Examiner relies on the following prior art reference as evidence of unpatentability:

Meyers                            US 5,529,436                            Jun. 25, 1996

The rejection as presented by the Examiner is as follows:

1. Claims 1-9 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Meyers.

Appellants separately argue independent claims 1, 8, and 9 and dependent claims 2, 6, and 7. Accordingly, non-argued dependent claims 3-5<sup>1</sup>, stand or fall with these claims.

## OPINION

### INDEPENDENT CLAIMS 1, 2, AND 8

Appellants argue Meyers does not disclose and teaches away from using a perimeter defining enclosure (Br. 4). Instead, Appellants argue that Meyers discloses a series of U-shaped trenches 24 to which pipe sections 42 are connected (Br. 4). Regarding claim 2, Appellants argue that Meyers'

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<sup>1</sup> Claim 3 depends upon itself which is improper under 37 C.F.R. § 1.75(c). A review of the prosecution history reveals Appellants attempted to correct the improper dependency in an after Final Amendment filed March 28, 2005 by making claim 3 dependent on claim 1. According to the Examiner's Answer, the after Final Amendment of March 28, 2005 was not entered (Answer 2). Accordingly, the improper dependency of claim 3 has not been corrected. In any event, dependent claim 3 can only properly depend from either claim 1 or claim 2 according to 37 C.F.R. § 1.75(c). For reasons given in our Opinion below, we affirm the Examiner's § 102(b) rejection of claims 1 and 2, such that the rejection of non-argued dependent claim 3 must stand with our affirmance of the rejection of these claims. This claim dependency issue needs to be corrected in any further prosecution of this application.

extensions 56a and 56b do not extend around the perimeter of the body and so do not define an encircling lip (Br. 5).

We have considered Appellants' arguments and are unpersuaded for the reasons below.

Meyers discloses a trench drain system 20 (i.e., body) that includes a U-shaped drain member 24 that has a three-dimensional outline with height, width and depth and defines a drainage channel 50 (i.e., open interior) (Meyers, Figures 1 and 2, col. 3, ll. 43-67). Meyers further discloses that the drainage channel 50 (i.e., open interior) is adapted to be positioned (i.e., drain opening 27 with pipe connector flange 58 permits the U-shaped drain member to surround the pipe 42) so that the drainage channel 50 (i.e., open interior), via the pipe connector flange 58, surrounds the pipe 42 (i.e., exposed floor drain) (Meyers, Figure 2; col. 4, ll. 64-67; col. 5, ll. 1-2).

Meyers further discloses that a plurality of nails 148 (i.e., ground securing fasteners) are engaged with the ground through base members 56a and 56b (i.e., lower-most extremities associated with said body) (Meyers Figure 12, col. 10, ll. 10-15). Meyers' trench drain system 20 (i.e., body) composed of U-shaped drain members 24 with the connector flange 58 isolates the end of the pipe 42 (i.e., the floor drain) from the encircling and poured concrete C, which adheres against exteriorly facing surfaces (i.e., 56a, 56b, 52a, 52b) of said body (Figures 1 and 2).

Regarding claim 2, Meyers discloses that when the desired trench drain length is achieved, end caps 110 and 94 are placed on both ends of the trench drain system 20 (Meyers, col. 10, ll. 30-35). Once the end caps 110 and 94 are placed on the trench drain system 20, the base extensions 56a and 56b form a closed and encircling lip as claimed.

From the above disclosures, the Examiner properly found that Meyers discloses all of Appellants' structural features of claims 1, 2, and 8 (Answer 3-5). While Appellants use functional language in the claims (e.g., "said body isolating the floor drain line from the encircling and poured concrete adhering against exteriorly facing services associated with said body" (independent claims 1 and 8)), Meyers' system inherently possesses the capability of performing this function and therefore the appealed apparatus claims do not structurally or functionally define over the prior art. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (explaining that, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure where the recited function is inherently possessed by the prior art).

Accordingly, we affirm the Examiner's § 102(b) rejection of argued claims 1, 2, and 8 and dependent claims 3-5.

#### DEPENDENT CLAIM 6 AND INDEPENDENT CLAIM 9

Appellants argue that claims 6 and 9 recite a volume of sand aggregate that can be adapted to be filled into said open interior which is contrary to the teachings of Meyers because Meyers' disclosed invention is constructed to operate as a continuous drainage trench (Br. 5).

We have considered Appellants' argument and find it unpersuasive for the reasons below.

The absence of a disclosure in the prior art relating to an inherently possessed function does not alone defeat a finding of anticipation.

*Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431.

The argued feature of claims 6 and 9, “a volume of sand aggregate adapted to being filled into said open interior,” merely states the function of the open interior, namely, holding the sand aggregate. However, we find, like the Examiner (Answer 4-5), that the drainage channel 50 (i.e., open interior) is inherently functionally capable of holding sand. *Schreiber*, 128 F.3d at 1477, 42 USPQ2d at 1433. Our finding is not contrary to Meyers’ disclosure to form a trench drain as argued by Appellants (Br. 5). Rather, the drainage channel 50 (i.e., open interior) possesses the capability of holding sand, if only temporarily, to provide added compressive strength to the drain unit 22 while the concrete is being poured.

We also note that Meyers discloses an inner cavity 140 (i.e., open interior) that surrounds the end of the pipe 42 and flange 58 (Meyers col. 9, ll. 50-67, col. 10, ll. 1-7; Figure 11; Figure 2). The inner cavity 140 may be filled with concrete 142 (i.e., sand aggregate) to provide added compressive strength (Meyers col. 9, ll. 50-67, col. 10, ll. 1-7). The drain openings 27 where the pipe section 42 connects are not shown in Figure 11, but would be present in the Figure 11 embodiment because Meyers’ Figure 11 shows a cross-sectional view of a trench drain unit of Figure 1 that has the drain openings 27 (Meyers, col. 3, ll. 28-30). Accordingly, the Figure 11 embodiment satisfies the argued feature of Appellants’ claims 6 and 9.

For the above reasons, we affirm the Examiner’s § 102(b) rejection of claims 6 and 9.

#### DEPENDENT CLAIM 7

The Examiner stated in the rejection of claim 7 that:

[Meyers discloses] the body exhibiting a specified shape and size but tapers in the opposite direction than what is claim[ed]; one of ordinary

skill in the art would have appreciated configuring the body in any shape which would aid in providing the intended use, function and purpose of the form assembly (Answer 4).

Appellants argue that Meyers does not show an upwardly directed and inwardly angled taper (Br. 5).

We have considered Appellants' argument and we cannot sustain the Examiner's § 102(b) rejection of claim 7.

The Examiner's statement of the rejection quoted above indicates that the Examiner improperly applied an obviousness analysis to claim 7 when determining the patentability of the claim under § 102(b). In fact the Examiner states in the Answer that

Meyers shows the recited limitations except for the exact shape [of the] box configuration. See [the] obviousness rational[e] above. (Answer 5).

A § 102 rejection addresses whether the claimed invention is anticipated by the prior art. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In light of the Examiner's application of the incorrect legal standard in determining whether claim 7 is anticipated under § 102(b) by Meyers, we reverse the Examiner's § 102(b) rejection of claim 7.

## REMAND

We remand the application to the Examiner to determine whether claim 7 should be rejected under § 102(b) or § 103(a) over Meyers (US

5,529,436) in light of our discussion regarding the construction of claim 7 and Meyers' disclosure below.

Dependent claim 7 broadly recites: "said body exhibiting a specified shape and size and including an upwardly directed and inwardly angled taper." Claim 7 does not require that the sides or any other particular piece of the form assembly body have an "upwardly directed and inwardly angled taper." Accordingly, we construe claim 7 as only requiring that an "upwardly directed and inwardly angled taper" be present somewhere on the "body."

As noted above in our discussion of claim 1, Meyers discloses all that is claimed in independent claim 1. Meyers further discloses that end caps 94 and 110 have triangular-shaped gussets 109 that appear to have an "upwardly directed and inwardly angled taper" (Meyers, col. 7, ll. 24-26, Figures 2, 6, and 7). Accordingly, when the trench drain system 20 (i.e., body) is assembled and the end caps are placed on the drain units 22, the assembled trench drain system 20 (i.e., body) including the gussets 109 appears to have "an upwardly directed and inwardly angled taper" as recited in claim 7. Therefore, in view of our construction of claim 7, it appears that Meyers' disclosure anticipates claim 7.

Regardless of whether Meyers' trench drain system 20 (i.e., body) is interpreted as having or not having an upwardly directed and inwardly angled taper, it appears that a rejection under § 103(a) may be appropriate. The upwardly directed and inwardly angled taper is disclosed by Appellants as being part of the sides of the body (Specification 6: 11-13). The inwardly angled taper appears to provide a means for the concrete to cover the sides of the form and prevent the form from being removed from the concrete.

Meyers similarly discloses that the trench drain system 20 (i.e., body) is composed of trench drain members 24 having a wider base (i.e., extensions 56a and 56b) than the upper portion of the trench drain members 24 to better support and stabilize the drain unit once installed in the concrete (Meyers, col. 4, ll. 41-50). In other words, Meyers' disclosure that the trench drain members 24 are wider at their bases than at their upper portions suggests "tapered" side walls of the trench drain members 24 (i.e., an upwardly directed and inwardly angled surface) such that the concrete rests upon the wider base having extensions 56a and 56b to hold the trench drain member 24 in the concrete.

As such, it appears that it would have been obvious to one of ordinary skill in the art to configure Meyers' trench drain system 20 (i.e., the body) in any shape, including the upwardly directed and inwardly angled taper shape suggested by Meyers, which would aid in providing the intended use, function and purpose of the form assembly (i.e., preventing removal of the form from a poured slab of concrete as disclosed by Meyers (col. 4, ll. 41-50)).

In response to this remand the Examiner must determine and make of record the results of this determination: (1) the propriety of rejecting claim 7 under § 102(b) over Meyers, and (2) the propriety of rejecting claim 7 under § 103(a) over Meyers.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (2006) is **not** made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2)(2006) does not apply.

Appeal 2007-3148  
Application 10/638,885

DECISION

We AFFIRM the Examiner's § 102(b) rejection of claims 1-6 and 8-9 over Meyers.

We REVERSE the Examiner's § 102(b) rejection of claim 7 over Meyers.

The Examiner's decision is affirmed-in-part and remanded.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART & REMANDED

PL/LPL

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GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C.  
P.O. Box 7021  
Troy, MI 48007-7021