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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHUN W. HUNG, PATRICK GUILLORY, and
PATRICIA WALESH

Appeal 2018-008944
Application 14/596,521
Technology Center 3600

Before HUBERT C. LORIN, NINA L. MEDLOCK, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Chun W. Hung, et al. (“Appellant”)¹ seeks our review under 35 U.S.C. § 134 of the Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). The Appellant identifies The Ames Companies, Inc. as the real party in interest. Appeal Br. 1.

THE INVENTION

Claim 1 is illustrative, and is reproduced below:

1. A watering assembly for a generic planter, said planter including a body with a base member and an upwardly depending sidewall, said planter body defining an enclosed space, said watering assembly comprising:

a reservoir body defining an enclosed space;

a support assembly;

a first wicking assembly;

an inlet assembly;

said support assembly structured to support a particulate material;

said support assembly coupled to said reservoir body;

said first wicking assembly including at least one first wicking element, said at least one first wicking element having a first portion at least partially disposed in said reservoir enclosed space and having a second portion that extends through a sidewall of the reservoir body to a location outside said reservoir enclosed space;

said inlet assembly coupled to said reservoir body and structured to provide fluid communication from a location outside said reservoir enclosed space to said reservoir enclosed space; and

wherein, when said reservoir body, said support assembly, said first wicking assembly and said inlet assembly are assembled, said reservoir body, said support assembly, said first wicking assembly and said inlet assembly form a contained watering assembly.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Letz	US 3,471,968	Aug. 18, 1967
de Oliveira	US 4,356,665	Nov. 2, 1982
Ho	US 5,934,017	Aug. 10, 1999
Lin	US 2012/0066971 A1	Mar. 22, 2012
Prescott	US 2016/0192604 A1	July 7, 2016

THE REJECTIONS

The following rejections are before us for review:

Claims 1, 7, 8, and 10 are rejected under 35 U.S.C. § 103 as unpatentable over Lin and Prescott .

Claims 2–6 are rejected under 35 U.S.C. § 103 as unpatentable over Lin, Prescott, Letz and Ho .

Claim 9 is rejected under 35 U.S.C. § 103 as unpatentable over Lin, Prescott, and de Oliveira .

Claims 11 and 17–20 are rejected under 35 U.S.C. § 103 as unpatentable over Lin and de Oliveira.

Claim 12 is rejected under 35 U.S.C. § 103 as unpatentable over Lin, de Oliveira, and Letz.

Claims 13–16 are rejected under 35 U.S.C. § 103 as unpatentable over Lin, de Oliveira, Letz, and Ho.

ISSUE

Did the Examiner err in rejecting claims 1, 7, 8, and 10 under 35 U.S.C. § 103 as unpatentable over Lin and Prescott; claims 2–6 under 35 U.S.C. § 103 as unpatentable over Lin, Prescott, Letz, and Ho; claim 9 under 35 U.S.C. § 103 as unpatentable over Lin, Prescott, and de Oliveira; claims 11 and 17–20 under 35 U.S.C. § 103 as unpatentable over Lin and

de Oliveira; claim 12 under 35 U.S.C. § 103 as unpatentable over Lin, de Oliveira, and Letz; claims 13–16 under 35 U.S.C. § 103 as unpatentable over Lin, de Oliveira, Letz, and Ho?

ANALYSIS

The rejection of claims 1, 7, 8, and 10 under 35 U.S.C. § 103 as unpatentable over Lin and Prescott.

The Examiner’s position is that Lin discloses the majority of the limitations of independent claim 1, including “a first wicking assembly 21” and “said first wicking assembly including at least one first wicking elements.” Final Act. 2. The Examiner acknowledges that “Lin does not specifically teach at least one first wicking element having a first portion at least partially disposed in said reservoir enclosed space and a second portion that extends through a sidewall of the reservoir body.” *Id.* at 3. The Examiner finds that

Prescott teaches at least one first wicking element 4 having a first portion at least partially disposed in said reservoir enclosed space 9, 13 and a second portion that extends through a sidewall of the reservoir body [FIG. 8] for the purpose of efficiently delivering water and air directly into a planting substrate from a reservoir to create a moisture rich area around the plant grown while keeping irrigation water isolated.

Id. And the Examiner determines that:

It would have been obvious to one having ordinary skill in the art before the effective filing date of the claimed invention to modify the watering assembly taught by Lin to include at least one first wicking elements having a first portion at least partially disposed in said reservoir enclosed space and a second portion that extends through a sidewall of the reservoir body as taught by Prescott because doing so would have provided for efficiently delivering water and air directly into a planting

substrate from a reservoir to create a moisture rich area around the plant grown while keeping irrigation water isolated.

Id.

The Appellant argues, *inter alia*, that a person of ordinary skill in the art would not have had a reason to combine the features of Lin and Prescott. Appeal Br. 6. The Appellant contends that “positioning the water absorbing material in the water within the water supply space 18, as opposed to the water storage space 12 is critical to the invention in Lin, as the water supply hole 15 can be closed off to create a vacuum effect in the absence of air.”

Id. at 4–5 (citing paragraph 23 of Lin). According to the Appellant, “removal of this feature, i.e., not positioning the water absorbing material 21 within the water supply space 18, would frustrate the purpose of the system discussed therein.” *Id.* at 5.

Responding to the Appellant’s arguments in the Answer, the Examiner states that the proposed modification

does not necessarily entail the removal of the water supply space feature of Lin as it is possible to modify Lin to have the wicking element having a first portion at least partially disposed in the reservoir enclosed space and a second portion that extends through a sidewall of the reservoir body as taught by Prescott while retaining the feature of the water absorbing material being inserted into the water supply space.

Ans. 4–5. *See also id.* at 5–6 (“[W]ater absorbing material 21 can be modified to extend out of the sidewall of the water storage space 12 and into the planting container as Prescott teaches water absorbing material extending out of a sidewall.”); Advisory Action mailed March 5, 2018.

In the Reply Brief, the Appellant argues that the proposed modification is based on inappropriate hindsight. Reply Br. 2.

container 10 is not supported with reasoning that is logically underpinned. A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references to make the proposed combination or other modification. *See In re Lintner*, 458 F.2d 1013, 1016 (CCPA 1972). There is insufficient evidence in support of the Examiner's position that a person of ordinary skill in the art would have been motivated to modify the water absorbing material 21 of Lin to extend out of the sidewall of the water storage space 12 and into the planting container 10. The Examiner's statement that the proposed modification would provide for "efficiently delivering water and air directly into a planting substrate from a reservoir to create a moisture rich area around the plant grown while keeping irrigation water isolated" (Final Act. 3) does not account for the fact that Lin already provides the plant with water from water storage space 12 via water absorbing material 21. And the Examiner does not explain how the proposed modification would more efficiently provide water or air to the planting substrate. The Examiner has not provided any findings that either Lin or Prescott recognized a problem with the water supply technique disclosed in Lin. In our view, only through hindsight knowledge of the Appellant's disclosure would one of ordinary skill in the art having the cited prior art in hand have been led to modify water absorbing material 21 of Lin to extend out of the sidewall of the water storage space 12 and into the planting container 10. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) ("A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . [The Board] may not . . . resort to

speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”). Only through using such knowledge as a blueprint to reconstruct the claimed subject matter from the isolated teachings of the prior art would one reach the claimed subject matter.

Because “[o]bviousness [cannot] be established by hindsight combination to produce the claimed invention,” *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998), a prima facie case of obviousness has not been made out in the first instance by a preponderance of the evidence. Accordingly, we reverse the rejection of independent claim 1. For the same reasons, we also do not sustain the rejection of dependent claims 7, 8, and 10. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

The rejection of claims 2–6 under 35 U.S.C. § 103 as unpatentable over Lin, Prescott, Letz, and Ho.

The rejection of claim 9 under 35 U.S.C. § 103 as unpatentable over Lin, Prescott, and de Oliveira.

The Examiner does not rely on the additional references (Letz, Ho, and de Oliveira) in any way that cures the deficiency discussed above. The rejections of claims 2–6 and 9 are not sustained for the reasons given above for not sustaining the rejection of independent claim 1 from which they depend.

The rejection of claims 11 and 17–20 under 35 U.S.C. § 103 as unpatentable over Lin and de Oliveira.

The Examiner’s position is that Lin teaches every limitation of independent claim 11, except that

Lin does not specifically teach said support assembly coupled to said reservoir body having a number of vertical passages and wherein said first wicking elements include tubular members each defining a generally enclosed space and depending from said support assembly, as well as being in fluid communication with one of said vertical passages.

Final Act. 9. According to the Examiner, it would have been obvious to modify the planter assembly taught by Lin to include wherein said first wicking elements include tubular members each defining a generally enclosed space and depending from said support assembly, as well as being in fluid communication with one of said vertical passages as taught by de Oliveira because doing so would have provided for watering plants in the same way that occurs naturally, i.e., water flows from beneath the roots up to the roots through capillary action.

Id.

The Examiner’s position is problematic at least because it is not clear why the modification of Lin is needed so that “water flows from beneath the roots up to the roots through capillary action” when Lin already discloses a system that performs exactly that function. *See* Lin, para. 26:

When plants consume water content within the culturing soil, the culturing soil can be resupplied with water content through the water absorbing material 21, and the water absorbing material 21 utilizes the siphon principle to pump the water in the water supply space 18 again to lower the water level to achieve the goal of automatically supplying water. Accordingly, the invention can automatically regulate the water supply based upon the condition in which plants absorb water content to allow the plants to obtain proper water supply.

Given that Lin discloses watering plants by providing water via water absorbing material 21 which utilizes the siphon principle to pump water upward to the plant roots, we do not see how any modification of Lin is needed to achieve a system that provides for “watering plants in the same way that occurs naturally,” i.e., wherein “water flows from beneath the roots up to the roots through capillary action.” The Examiner has not provided any findings that either Lin or de Oliveira recognized a problem with the water supply technique disclosed in Lin. As with the rejection of claim 1 discussed above, only through using knowledge of the Appellant’s disclosure as a blueprint to reconstruct the claimed subject matter from the isolated teachings of the prior art would one reach the claimed subject matter of independent claim 11.

Accordingly, we reverse the rejection of independent claim 11. For the same reasons, we also do not sustain the rejection of dependent claims 17–20.

The rejection of claim 12 under 35 U.S.C. § 103 as unpatentable over Lin, de Oliveira, and Letz.

The rejection of claims 13–16 under 35 U.S.C. § 103 as unpatentable over Lin, de Oliveira, Letz, and Ho.

The Examiner does not rely on the additional references (Letz and Ho) in any way that cures the deficiency discussed above. The rejections of claims 12 and 13–16 are not sustained for the reasons given above for not sustaining the rejection of independent claim 11 from which they depend.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 7, 8, 10	103	Lin, Prescott		1, 7, 8, 10
2-6	103	Lin, Prescott, Letz, Ho		2-6
9	103	Lin, Prescott, de Oliveira		9
11, 17-20	103	Lin, de Oliveira		11, 17-20
12	103	Lin, de Oliveira, Letz.		12
13-16	103	Lin, de Oliveira, Letz, Ho		13-16
Overall Outcome				1-20

REVERSED