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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte W. MICHAEL DUNN

Appeal 2019-001837
Application 13/844,649
Technology Center 3600

Before: JOHN C. KERINS, JILL D. HILL, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

HILL, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

W. Michael Dunn (Appellant) filed a request for rehearing on August 21, 2019 (hereinafter “Request”), in response to our Decision on Appeal mailed June 21, 2019 (hereinafter “Decision”), affirming the Examiner’s rejection of the claims under 35 U.S.C. § 103.

ISSUES RAISED ON REQUEST FOR REHEARING

I. Did the Patent Trial and Appeal Board (“Board”) misapprehend the proper test for analogous art?

II. Did the Board overlook the Examiner’s burden to show that one skilled in the art would have been motivated to combine the prior art references?

ANALYSIS

37 C.F.R. § 41.52 states in relevant parts:

(a)

(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. . . . The request for rehearing must state with particularity the point believed to have been *misapprehended or overlooked* by the Board. *Arguments not raised [in the brief before the Board], and [e]vidence not previously relied upon [in the brief and the reply brief(s)] are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section. . . .*

(2) Appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(3) New arguments responding to a new ground of rejection made pursuant to § 41.50(b) are permitted.

. . . .

(Emphasis added).

Appellant is required to state with particularity the point(s) believed to have been misapprehended or overlooked by the Board. 37 C.F.R.

§ 41.52(a)(1). Although the Request for Rehearing does not explicitly identify any such points, the Board has identified two points for further consideration, based on arguments presented in the Request.

ISSUE I

Appellant argues that our finding that Krane is analogous art is inconsistent with relevant precedent. Request 2. According to Appellant, our “cite to *In re Schreiber* (Decision, page 5) is not relevant to the question of nonanalogous art.” *Id.* Rather, Appellant argues, “the court cases cited by the Appellant at footnotes 5 and 6 on page 19 of Appellant’s Appeal Brief . . . are better authorities for purposes of determining whether [Krane] is analogous art.” *Id.* The cases cited by Appellant include *In re Clay*, 966 F.2d 656, 658–59 (Fed. Cir. 1992); *In re Klein*, 647 F.3d 1343 (Fed. Cir. 2011); *Schott Gemtron Corp. v. SSW Holding Co., Inc.*, IPR2014-00367; and *Ex parte Haymond*, 41 U.S.P.Q.2d 1217 (BPAI 1996).

The Decision stated that “[c]onsidering Appellant’s Specification, including the pending claims, we define the field of use as containers capable of storing seeds and growing medium.” Decision 5–6. Because we discerned no error in the Examiner’s finding that Krane’s container is capable of storing seeds and growing medium, we agreed that Krane is analogous art. *Id.*

Schreiber does not explicitly support a principle that, where an intended use of a claimed apparatus is only recited in a claim preamble, the field of the invention should be defined as an apparatus capable of performing that intended use. *Schreiber* held that non-analogous art was not a defense to an anticipation rejection (128 F.3d at 1478), and then determined that *Schreiber* could not make non-analogous art arguments

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against an oil dispenser when his Specification acknowledged that “the prior art pertinent to his invention include[d] patents related to dispensing fluids.” *Id.* at 1479. Thus, we cannot rely on *Schreiber* to support our determination that the field of use of Appellant’s invention is properly defined as “containers capable of storing seeds and growing medium.” However, our Decision cited *Schreiber* only to indicate the effect a preamble may have on a claim. Thus, our reliance on *Schreiber* was not in error.

In re Bigio, which was cited in the Decision, discusses analogous art and determining the field of endeavor, and states that “the scope of any field of endeavor will vary with the factual description of each invention,” and “the PTO must show adequate support for its findings on the scope of the field of endeavor in the application’s written description and claims, including the structure and function of the invention.” 381 F.3d 1320, 1326 (Fed. Cir. 2004).

The art must be analogous to the invention as set forth in the claims, and it is the field of endeavor of the claimed invention that must be determined. Therefore, despite *Bigio*’s statement that support for a finding of the scope of a field of endeavor should come from “the application’s written description and claims, including the structure and function of the invention,” the field of endeavor of the claimed invention should look particularly, although not solely, to the scope of the claims. *See, e.g., id.* at 1324–27 (firstly performing claim construction, and secondly determining field of endeavor based upon the claim construction). As set forth in the Decision,

The claims recite a structurally complete container compartment comprising top and bottom portions, and a frangible strip therebetween. Appeal Br. 42 (Claims App’x). Score lines defining the frangible strip are also claimed. The

only reference to seeds and growing medium is in the preamble. . . . Appellant has defined a structurally complete invention in the body of the claims, and uses the preamble only to state a purpose or intended use of the invention. We therefore agree with the Examiner that “seedling” and “for receiving one or more seeds and growing medium” define intended use, rather than structural limitations.

Decision 4.

Based on this claim scope, it is our opinion that the field of endeavor of the claimed invention should similarly be defined as a container that is capable of performing the recited intended use of “receiving one or more seeds and growing medium.” We discern no points that we misapprehended or overlooked in determining that Krane is directed to analogous art.

Neither *Schott Gemtron* nor *Ex Parte Hammond*, cited by Appellant, are binding precedent. *Clay* is a very fact-specific case addressing method/process claims, and does not address limiting a field of invention based on an intended use recited in a claim’s preamble. *See Clay*, 966 F.2d at 659. Appellant has not explained how the reasoning of *Clay* applies to the facts at hand in a way that would change the outcome of our decision. In *Klein*, also a fact-specific case, the court determined that certain prior art was not reasonably pertinent to the problem with which the inventor was involved. *See Klein*, 647 F.3d at 1347–48, 1350. Notably, mixing of nectar was recited in both the preamble and the body of the claim. *Id.* at 1346. Appellant has not explained how the reasoning of *Klein* applies to the facts at hand in a way that would change the outcome of our decision.

ISSUE II

Appellant argues that the Board erred in “adopting the position of the Examiner that the Examiner is under no burden to show that one of skill in

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the art would have been motivated to remove the lid of [Krane's] ice cream container . . . to obtain the seedling container under application.” Request 2. According to Appellant, provision of such a motivation is required by *Graham v. John Deere Company*, 383 U.S. 1 (1966). *Id.* However, because we agreed with the Examiner that “Krane has no requirement that its container remain closed,” and ““in normal operation of the device of Krane, the lid would be removed,”” we discern nothing that we misapprehended or overlooked in not requiring motivation for removing Krane's lid.

Appellant argues that the claimed invention is a “seedling container” rather than a “seed container,” such that “the ice cream container of [Krane] cannot be made to function as the seedling container of the invention under application unless the lid which Appellant has shown is essential to the function and operation of the ice cream container of [Krane] be removed.” *Id.* This precise argument — based on the difference between containing a seed and a seedling — was not made in either the Appeal Brief or the Reply Brief, and therefore raises no issue that we misapprehended or overlooked. *See* Appeal Br. 25, 30 (“the ice cream container of KRANE . . . is incapable of receiving seed(s) and/or growing medium”). Further, Appellant's claim is directed to a seedling container's compartment “for receiving one or more seeds and growing medium,” and thus need only be capable of receiving a seed and growing medium. Lastly, the claim does not prohibit a lid. Thus, in addition to Krane having no requirement that its container remain closed, the claims do not explicitly recite an open top, providing further support for the Examiner not requiring a motivation to remove Krane's lid.

Appellant also argues that the Examiner's reliance “on the mere fact that the lid of [Krane] is briefly removed during consumption of ice cream . . . is no substitute for the requisite showing of why” a skilled artisan would

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have been motivated to remove Krane’s lid. Appellant contends that a skilled artisan would not have been motivated to remove Krane’s lid to make it usable as a seedling container— because such removal would have rendered Krane “unfit for its intended purpose” and changed Krane’s principle of operation. *Id.* at 2–3.

As set forth in the Decision and further explained above, “Krane need not be modified for its container to remain open, because it can be open during regular use.” Decision 8. With no modification, arguments regarding fitness for purpose and intended use are not applicable. Further, Appellant has not specifically defined the intended purpose or principle of operation, or explained why Krane’s naturally-occurring open container would render itself unfit for its own intended purpose or change its own principle of operation. Such conclusory arguments do not persuade us that we misapprehended or overlooked any points on appeal.

For the above reasons, we conclude that Appellant has not shown any points which we misapprehended or overlooked in our Decision.

DECISION

We have considered the arguments set forth in Appellant’s Request for Rehearing. Appellant’s Request is denied to the extent that we do not modify the outcome of the Decision.

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).

DENIED