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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOE WYWROT and NEAL BILLETDEAUX

Appeal 2019-003677
Application 14/029,501
Technology Center 3600

Before DANIEL S. SONG, MICHAEL J. FITZPATRICK, and ANNETTE R. REIMERS, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant, SmithGroupJJR, Inc.,[1] appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1, 2, and 9. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

[1] Appellant is the "applicant" under 37 C.F.R. § 1.42(b) and identifies itself as the sole real party in interest. Appeal Br. 2.

STATEMENT OF THE CASE

The Specification

The Specification's "disclosure relates to techniques for managing the impact development has on site rain water drainage." Spec. ¶1.

The Claims

Claims 1, 2, and 9 are rejected. Final Act. 1. The remaining pending claims, namely claims 3–8, are withdrawn from consideration. *Id.* Claim 1 is representative and reproduced below.

> 1. A site having a surface area, the site comprising:
>
> post-development buildings, parking lots or sidewalks arranged to occupy a portion of the surface area greater than existing buildings, parking lots and sidewalks of the site; and
>
> post-development rainwater containers or rainwater infiltration systems configured to slow a rate at which rain water drains from the site and arranged on the site such that a water score of the site falls within a predetermined range of values, wherein the water score is an amount of rain water runoff associated with post-development conditions that is derived from expected rainfall and curve numbers for the site under the post-development conditions and is normalized such that
>
> one of (i) an amount of rain water runoff associated with pre-settlement conditions that is derived from expected rainfall and curve numbers for the site under the pre-settlement conditions and (ii) an amount of rain water runoff associated with existing conditions that is derived from expected rainfall and curve numbers for the site under existing conditions defines a maximum achievable water score,
>
> the other of the amount of rain water runoff associated with the pre-settlement conditions and the amount of rain water runoff associated with the existing conditions defines a minimum achievable water score, and

> the water score falls between the minimum and maximum achievable water scores.

Appeal Br. Claims App. 1.

The Examiner's Rejections

The following rejections are before us:

1. claims 1 and 9, under 35 U.S.C. § 102(a)(1), as anticipated by Day[2] (Final Act.); and

2. claim 2, under 35 U.S.C. § 103, as unpatentable over Day (*id.* at 5).

DISCUSSION

Rejection 1 – Claims 1 and 9 as Anticipated

Appellant argues the patentability of claims 1 and 9 together. Appeal Br. 2–4. We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Day begins by explaining:

> Urbanization disrupts natural soil profiles, increases impervious surfaces and decreases vegetative cover. These disruptions increase stormwater runoff at the expense of groundwater recharge, degrading water quality and impairing aquatic habitats. . . . Creative Best Management Practices (BMPs) that harness the ability of vegetation and soils to mitigate urban runoff are needed.

Day 1. Day proceeds to disclose, as cited by the Examiner, "using structural soils to simultaneously allow healthy tree growth, water infiltration, and pavement–all on the same land area." Day 5 (cited at Final Act. 3). "Tree root systems and the structural soil that supports them combine to form a

[2] Susan Downing Day et al., "Managing Stormwater for Urban Sustainability Using Trees and Structural Soils," VIRGINIA POLYTECHNIC INSTITUTE AND STATE UNIVERSITY (2008) ("Day").

shallow but extensive reservoir for capturing and storing stormwater." *Id.* "Structural soils are engineered soil mixes with a high porosity that allow tree root to penetrate freely, and stormwater to infiltrate rapidly and then be stored until it percolates into the soil beneath." *Id.*

The Examiner found that Day's use of structural soils satisfies claim 1's recitation that the site comprise "post-development rain water containers or rain water infiltration systems . . . configured to slow a rate at which rainwater drains from the site . . . and arranged on the site." Final Act. 3. The Examiner found that Day's use of structural soils in conjunction with "urban infill development" satisfies claim 1's recitation that the site comprise "post-development buildings, parking lots or sidewalks arranged to occupy a portion of the surface area greater than existing buildings, parking lots and sidewalks of the site." Final Act. 3 (citing Day 3). The Examiner found that adding structural soils as taught by Day would "bring the [water] score to somewhere between" the water scores under the pre-settlement and existing conditions, thereby satisfying claim 1's language directed to the water score. *Id.* at 3–4.

Appellant argues that Day does not anticipate claim 1 because Day "does not contemplate post-development buildings, parking lots or sidewalks arranged to occupy a portion of the surface area *greater than* existing buildings, parking lots and sidewalks of the site." Appeal Br. 3. In making this argument, Appellant attacks additional findings by the Examiner, which were set forth on pages 6 and 7 of the Final Action. *Id.* at 3–4. Neither the Appeal Brief nor the Reply Brief ever addresses Day's teaching that the use of structural soils "may prove particularly useful in areas of urban infill development." Day 3. The Examiner cited this teaching both in the Final

Action and in the Answer. *See* Final Act. 3; Ans. 3. We find Day's teaching that adding structural soils may be particularly useful for urban infill development sites satisfies the claim language reciting "post-development buildings, parking lots or sidewalks arranged to occupy a portion of the surface area greater than existing buildings, parking lots and sidewalks of the site."

Appellant additionally argues that Day "does not make clear that any resulting post-development water score *necessarily* falls between limits bounded by existing conditions and pre-settlement conditions." Appeal Br. 3 (footnote quoting MPEP § 2163.09(a) omitted). Appellant explains its argument as follows:

> [T]he addition of a rain water container or water infiltration system will not inherently normalize the water score as asserted by the [E]xaminer because the surface area occupied by the post-development buildings, parking lots or sidewalks could be so much greater than that of existing conditions that the simple addition of a rain water container may not be sufficient to drive the water score between that defined by pre-settlement and existing conditions.

Id. at 4. This argument does not apprise us of error for at least two reasons.

First, Appellant's argument is premised falsely; the hypothetical Day embodiment contemplated by Appellant is not within the scope of Day's teachings. Day teaches:

> The goals of stormwater [best management practices] are to *reduce peak flow, reduce runoff volume* and remove pollutants. The system described in this manual addresses all three of these goals by utilizing trees and structural soils to aid in water interception, storage, and infiltration while increasing evapotranspiration potential.

Day 1 (emphasis added). Appellant has not identified any teaching by Day to post-develop a site in a manner that would result in a net increase of peak flow or runoff volume. Indeed, such post-development would be inconsistent with the explicit goals of Day.

Second, Appellant's argument is based on a misunderstanding of the inherency doctrine. Under that doctrine, "[a] single prior art reference may anticipate without disclosing a feature of the claimed invention if such feature is necessarily present, or inherent, in that reference." *Allergan, Inc. v. Apotex Inc.*, 754 F.3d 952, 958 (Fed. Cir. 2014). It is sufficient if the missing feature is necessarily present in a single embodiment. *See Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1321 (Fed. Cir. 2004) ("For inherent anticipation, the [prior art reference] must have sufficiently described and enabled *at least one embodiment* that necessarily featured or resulted in the subject matter embraced by limitation (c)." (emphasis added)). However, the missing feature need not be necessarily present in all embodiments taught by Day. As discussed above, we do not agree that Day teaches any embodiments that would increase a site's peak flow and/or runoff volume. Regardless, it cannot be disputed reasonably that Day teaches embodiments with the opposite result. Day 3. Such embodiments would necessarily have a "water score [that] falls between the minimum and maximum achievable water scores," as recited in claim 1. In this regard, "a reference can anticipate a claim even if it 'd[oes] not expressly spell out' all the limitations arranged or combined as in the claim, if a person of skill in the art, reading the reference, would 'at once envisage' the claimed arrangement or combination." *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d

1376, 1381 (Fed. Cir. 2015) (citing *In re Petering*, 301 F.2d 676, 681 (CCPA 1962)).

Appellant has not apprised us of Examiner error. Thus, we affirm the rejection of claim 1, as well as that of claim 9, which falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Rejection 2 – Claim 2 as Obvious

Appellant does not present arguments against this rejection beyond those already considered and found unavailing above. *See* Appeal Br. 2–4 (arguing all claims and all rejections together). Accordingly, for similar reasons, we affirm Rejection 2.

DECISION SUMMARY

Claims Rejected	**35 U.S.C. §**	**Reference/ Basis**	**Affirmed**	**Reversed**
1, 9	102(a)(1)	Day	1, 9	
2	103	Day	2	
Overall Outcome			1, 2, 9	

TIME PERIOD FOR RESPONSE

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

AFFIRMED