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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NICHOLAS STALEY

Appeal 2019-004752
Application 13/820,990
Technology Center 3700

Before BIBHU R. MOHANTY, NINA L. MEDLOCK, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

SCHOPFER, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–5, 7, and 12–21. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Nicholas Staley. Appeal Br. 3.

BACKGROUND

The Specification discloses that “[t]he present invention relates to a storage housing for a waste receptacle and particularly, but not exclusively to a storage housing for a so-called ‘wheelie bin.’” Spec. 1, ll. 3–4.

ILLUSTRATIVE CLAIM

Independent claim 1 is the only independent claim on appeal and recites:

1. An assembly comprising a storage housing and a wheeled waste receptacle contained within the housing, the housing comprising front, rear and opposite side walls which extend from a base, and which terminate at an upper periphery of the housing thereof, at least the front side wall comprising a door which can be opened and closed relative to the side wall to enable the waste receptacle to be removably positioned within and removed from the housing through the front side wall;

the housing further comprising locking means for releasably locking the door when closed and a lid slidably mounted with respect to said opposite side walls which is slidably moveable in a horizontal direction with respect to the front side wall between a first position in which the lid substantially closes the housing and a second position in which the lid substantially opens the housing;

the waste receptacle comprising a hinged cover and the housing comprising a linkage which is secured at an end opposite the hinge of the hinged cover and the lid of the housing closest to the hinge of the hinged cover, wherein the linkage hinges the cover of the waste receptacle upwardly and forwardly as the lid is slid horizontally forwardly from said first to said second position to open the cover of the waste receptacle and to enable waste to be deposited within the open receptacle, the housing being arranged to close the cover of the waste receptacle as the lid is slid horizontally rearwardly from said second to said first position.

Appeal Br. 18.

REJECTIONS²

1. The Examiner rejects claims 1–5, 7, and 12–21 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.
2. The Examiner rejects claims 1–5, 7, and 12–21 under 35 U.S.C. § 112(b) as indefinite.

DISCUSSION

Written Description

With respect to claim 1, the Examiner finds that there is insufficient written description support for “a linkage which is secured at an end opposite the hinge of the hinged cover and the lid of the housing closest to the hinge.” Final Act. 3. The Examiner further states that “[i]f the claim requires that the linkage is attached to the lid closest to the hinge the limitation is new matter since the original disclosure did not teach this specific connection location.” *Id.*

Appellant argues that the Specification

at Figure 2 clearly illustrates a waste bin (element 11) with a cover (element 23) that is hinged open. A linkage (element 22) is also clearly illustrated as being connected to the cover by a clip. This linkage then runs down the top of the waste bin cover and connects to the sliding lid (element 16) of the housing (element 10).

Appeal Br. 8. Appellant asserts that text of the Specification provides further support. *Id.* citing Spec. 5, ll. 1–7. Appellant asserts that this evidence provides “explicit disclosure that 1) there is a linkage, 2) it is coupled to the waste bin cover opposite the hinge, and 3) it couples to the

² The Examiner has withdrawn the rejections under 35 U.S.C. § 103. *See* Ans. 4.

housing lid at the other end. This includes every element of the newly added claim language.” *Id.* at 9. Finally, Appellant asserts that a person of ordinary skill in the art would understand that the basic functionality of the device is dependent on the structure as claimed, and thus it is considered inherently disclosed. *Id.*

“[T]he test for the sufficiency of the written description ‘is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.’” *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 682 (Fed. Cir. 2015). “[T]he written description requirement is not met if the specification merely describes a ‘desired result.’” *Id.* The “telling question is whether the specification shows possession by the inventor” of how this desired result “is achieved.” *Id.* at 683.

Here, we agree with the Examiner that the Specification does not adequately support the limitation at issue. As discussed below, we agree with the Examiner that the claim language is unclear regarding to what location of the lid the linkage is attached. Similarly, we find that the disclosure cited by Appellant also lacks a clear teaching regarding where the linkage is attached to the lid. Regarding Figure 2, we are not persuaded that it shows a particular attachment point, as the figure merely depicts the linkage extending under the lid of the housing. Regarding the cited paragraph of the Specification, no specific location for attachment of the linkage to the lid is disclosed. Rather, the Specification states that the tether “is securable at one end of the lid.” Spec. 5, ll. 1–7; *see also id.* at 6, ll. 18–22. Notably, the Specification requires a specific point of attachment of the linkage to the hinged cover, i.e. opposite the hinge, without further

specifying the location of the point of attachment to the lid. *Id.* The Specification goes on to describe the function of the linkage, but we do not agree with Appellant that this function necessarily limits the point of attachment between the lid and linkage to any particular location. Thus, we determine that the Specification does not reasonably convey that the inventor was in possession of a linkage with any particular attachment point to the lid.

Based on the foregoing, we sustain this rejection.

Indefiniteness

The Examiner rejects claim 1 as indefinite based on the recitation “and the lid of the housing closest to the hinge.” Final Act. 2. The Examiner finds that “[i]t is unclear if the linkage is attached to this point.” *Id.* Appellant does not appear to specifically address the substance of this rejection in the Appeal Brief. *See* Appeal Br. 8–9.

We agree with the Examiner that it is unclear from the claim language to which end of the claimed lid the linkage must be attached. Specifically, the claim appears to require different locations for the linkage depending on whether the lid is in the first or second position as claimed. When the lid is in the first position, i.e., everything is closed, the “end opposite . . . the lid of the housing closest to the hinge of the hinged cover” would be the end of the lid closest to the unhinged end of the hinged cover. In contrast, when the lid is in the second position, i.e. the receptacle is open, the “end opposite . . . the lid of the housing closest to the hinge of the hinged cover” would be the other end of the lid. Further, because there is not adequate written description support for any specific location of the attachment of the tether to the lid, one of ordinary skill would not be able to understand the scope of the claim by reference to the Specification.

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Because this limitation is amenable to multiple plausible claim constructions, the USPTO is justified in requiring the Appellant to more precisely define the metes and bounds of the claimed invention. *See Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (Precedential). Accordingly, we sustain this rejection.

CONCLUSION

We AFFIRM the rejections of claims 1–5, 7, and 12–21.

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)(l)(iv).

In summary:

| Claims Rejected | 35 U.S.C. § | Basis | Affirmed | Reversed |
|------------------------|--------------------|---------------------|-----------------|-----------------|
| 1–5, 7, 12–21 | 112(a) | Written Description | 1–5, 7, 12–21 | |
| 1–5, 7, 12–21 | 112(b) | Indefiniteness | 1–5, 7, 12–21 | |
| Overall Outcome | | | 1–5, 7, 12–21 | |

AFFIRMED