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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WAYNE CASTLEBERRY

Appeal 2020-005001
Application 14/843,572
Reissue of US Patent 8,522,475 B2
Technology Center 3900

Before MICHELLE R. OSINSKI, JILL D. HILL and
CYNTHIAL. MURPHY, *Administrative Patent Judges*.

HILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from the Examiner’s decision to reject claims 1–20.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

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

BACKGROUND

Appellant seeks reissue of US Patent 8,522,475 B2 (“the ’475 Patent”) issued from U.S. Application 11/239,344, filed September 30, 2005, which was a continuation-in-part of U.S. Patent Application No. 10/670,531, filed September 26, 2003. Appellant’s claimed invention is directed to a triangular flower stem wrap with an outer plastic covering. ’475 Patent, Title. The ’475 Patent issued with claims 1–18. Claims 2–5 and 8–17 remain the same in this reissue application examination. Claims 1, 6, 7, and 18 are amended. Claims 19 and 20 are added.

Claims 1 and 14 are independent. Claim 1, reproduced below, illustrates the claimed invention.

1. A horticultural cut flower container assembly comprising:
a wrap member of flexible diphenylmethane diisocyanate foam material adapted to be folded over the stem ends of a bunch of piece of cut flowers and a band encircling said folded foam material to hold said foam material in a wrapped configuration and an outer plastic bag placed over said folded foam material, wherein the flexible diphenylmethane diisocyanate foam material contains no fillers.

Appeal Br. 25 (Claims App’x). Claim 1 was amended to replace “triangular shaped” with the term “wrap” as a modifier for the foam “member,” and to add that the foam member “contains no fillers.” *See id.*; ’475 Patent 4:51–59.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Ballard	US 2,309,742	February 2, 1943
Benoist	US 3,657,840	April 25, 1972
Glück	US 3,899,850	August 19, 1975
Hann	US 6,479,433 B1	November 12, 2002
Weder	US 6,499,251 B2	December 31, 2002
Gilbert	US 6,944,988 B2	September 20, 2005

REJECTIONS

I. Claims 1–20 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Final Act. 2.

II. Claims 1–20 stand rejected under 35 U.S.C. § 251 for not claiming subject matter directed to the invention disclosed in the original patent. Final Act. 5.

III. Claims 1–3 and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Benoist and Hann. Final Act. 5.

IV. Claims 4, 5, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Benoist, Hann, and Glück. Final Act. 7.

V. Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Benoist, Hann, and Ballard. Final Act. 8.

VI. Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Benoist, Hann, Ballard and Weder. Final Act. 8.

VII. Claims 10–13 and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Benoist, Hann, and Gilbert. Final Act. 9.

VIII. Claims 14, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Benoist, Gilbert, and Hann. Final Act. 10.

IX. Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Benoist, Gilbert, Hann, and Ballard. Final Act. 11.

ANALYSIS

Rejection 1: Written Description, Claims 1–20

The Examiner rejects claims 1–20 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Final Act. 2. According to the Examiner, “it appears that the foam member being a triangular shape is considered an essential or critical feature of the container assembly,” and Appellant’s originally-filed disclosure only contemplated triangular-shaped members, such that Appellant “did not have possession of the claimed invention.” *Id.* at 3.

Appellant argues, initially, that “claims 10–19 each include the limitation that the wrap member be *triangularly shaped*,” such that the written description rejection thereof should be reversed. Appeal Br. 4. We agree with Appellant. Remaining claims 1–9 and 20 are argued as a group. *Id.* at 3–6. We select independent claim 1 as representative for our analysis below.

Regarding independent claim 1, which was amended to, *inter alia*, change a “triangular shaped” member to a “wrap” member, the Examiner contends that, with Appellant’s Specification “contemplating only triangular-shaped members, [Appellant] did not have possession of the claimed invention.” Final Act. 3. The Examiner finds that the portions of the originally-filed disclosure that Appellant

relies on for written description support fail to establish that Appellant “envisioned the foam wrap member being shaped other than triangular.” *Id.*

Here, Appellant contends that disclosure of a triangular-shaped member provides sufficient written descriptive support for a member having any shape, where the written description does not expressly disclose any other member shapes. This is, in a sense, a genus-species argument, with a triangular shape being the species of a genus including, perhaps, all shapes that can be folded over as recited in the claim.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

In re Kaslow, 707 F.2d 1366, 1375 (Fed. Cir. 1983).

It is a general rule that the “disclosure of a species may be sufficient written descriptive support for a later claimed genus including that species.” *Bilstad v. Wakalopulos*, 386 F.3d 1116, 1124 (Fed. Cir. 2004). There are several exceptions to that general rule. One exception is when the art is unpredictable. *Id.* at 1125; *Hynix Semiconductor Inc. v. Rambus Inc.*, 645 F.3d 1336, 1352 (Fed. Cir. 2011) (“Whether the genus is supported *vel non* depends upon the state of the art and the nature and breadth of the genus.”). Additionally, there is no support if the specification specifically distinguishes the prior art as inferior and touts the advantages of the species. *See Hynix*, 645 F.3d at 1352 (“There was substantial evidence that the invention would not be undermined by the use of [other species of the genus].”). Such statements make clear that the written description discloses only the species and nothing broader. *Bilstad*, 386 F.3d at 1124.

We find no such exceptions in this case. We cannot say that the art here is unpredictable. Further, Appellant's Specification neither distinguishes other shapes as inferior nor touts the advantages of the triangular shape.

For this reason, we do not sustain the Examiner's rejection of claims 1–20 under 35 U.S.C. § 112, first paragraph, for failing to provide written descriptive support.

Rejection II: 35 U.S.C. § 251, Claims 1–20

The Examiner rejects claims 1–20 under 35 U.S.C. § 251 for not claiming subject matter directed to the invention disclosed in the original patent. Final Act. 4. The Examiner contends that Appellant's Specification "discloses a member which is triangular shaped" and, although the terms "wrap" and "container" are sometimes used in the Specification without the "triangular" modifier, the terms are generally preceded by a reference to "triangular shaped foam material" and Appellant's Figures do not show any other shape. *Id.*

The Examiner also contends that, although Appellant's Specification refers to the disclosed triangular shaped member as a preferred embodiment, and includes boilerplate language that the disclosure should "not be construed as limited to the particular embodiments," a mere suggestion of other embodiments is not sufficient to satisfy the original patent requirement of 35 U.S.C. § 251. *Id.* (citing *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354, 1358–59 (Fed. Cir. 2014) (citations omitted)).

Appellant again argues, initially, that "claims 10–19 each include the limitation that the wrap member be *triangularly shaped*," such that the original-patent rejection thereof should be reversed. Appeal Br. 12; Reply Br. 3–4. We agree with Appellant. Remaining claims 1–9 and 20 are argued as a group.

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Appeal Br. 12. We select claim 1 as representative. Claims 2–9 and 20 stand or fall with claim 1.

Appellant argues that claim 1 satisfies the original patent test. Appeal Br. 8 (citing MPEP § 1412.01). According to Appellant, the original disclosure supports a member that is not triangular, because: (1) the objects of the invention include features that are not limited to the particular shape of the member; (2) the facts of *Antares* are distinguishable from the current scenario, because the reissue claims in *Antares* were directed to an entirely different invention, which is not the case here; (3) the triangular shape of the member is discussed far less than the foam material from which it is made; (4) the last paragraph of the written description “makes it clear that the invention is not limited to the specific embodiments described in detail;” (5) the absence of a triangular shape of the member would not prevent the system from working and is separable from the material thereof; (6) the facts of Appellant’s case are more analogous to *Scriptpro* than *Antares*, and Appellant’s Specification contains “no sufficiently clear language” limiting the invention to a particular shape; (7) the claims should not be limited by the expression of a preferred embodiment; (8) the prosecution history indicates that the Board previously concluded that it would have been obvious to make Benoist’s shape triangular (as taught by Weder) “to save material and for aesthetic reasons,” which refutes the Examiner’s determination that the triangular shape is critical. Appeal Br. 9–12 (citing *Scriptpro, LLC v. Innovation Associates, Inc.*, 762 F.3d 1355 (2014) (reversing summary judgment of invalidity under 35 U.S.C. § 112); *Antares*, 771 F.3d at 1358–59; *Bendix Commercial Vehicle Sys. v. Haldex Brake Prod. Corp.*, No. 1:09-CV-0176, 2010 WL 3607476 (N.D. Ohio Sept. 10, 2010)).

The Examiner responds that the first sentence of the “Summary of the Invention” section of Appellant’s Specification starts with “[a] triangular shaped foam material,” and “[t]he terms ‘triangular shaped’ or ‘triangle shape’ . . . are used throughout the [S]pecification,” despite the use of boilerplate language such as “preferred embodiments’ and not being “construed as limited to the particular embodiments.” Ans. 14–15. Thus, the Examiner contends, “with the only shape of the member shown and discussed being a member with a triangular shape, any non-triangular-shaped member was not ‘clearly and unequivocally’ disclosed,” such that “it is not evident on its face that the patent intended to claim a non-triangular member.” *Id.* at 15.

Regarding *Scriptpro* (and *Bendix*), the Examiner responds that “[u]nlike *Scriptpro*, here in this reissue a non-triangular wrap was not described or shown in the specification,” and Appellant “is not picking a subset of described features but claiming a feature new to the invention.” Ans. 15–16.

Regarding the prosecution history of the ’475 Patent, the Examiner responds, *inter alia*, that “whether the triangular shape is critical or susceptible to obviousness rejections is not dispositive,” because the original patent requirement of 35 U.S.C. § 251 “concerns whether the patent as issued describes the new limitations” and, even if a non-triangular-shaped member is noncritical and obvious, it is not disclosed or discussed in Appellant’s Specification. Ans. 17.

Further, the Examiner cites *Forum US v. Flow Valve*, 926 F.3d 1346 (Fed. Cir. 2019) for its determination that

“for broadening reissue claims, the specification of the original patent must do more than merely suggest or indicate the invention recited in reissue claims; [I]t must appear *from the face of the instrument* that what is covered by the reissue was intended to have been covered and secured by the original.” . . . Stated differently, the original patent

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“must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Antares*, 771 F.3d at 1362.

Ans. 15 (citing *Forum*, 926 F.3d at 1351–52 (emphasis in original)).

The *Forum* panel further stated that

the “essential inquiry under the ‘original patent’ clause of § 251 ... is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees.”

Forum, 926 F.3d 1353.

Based on the guidance set forth in the *Forum* decision, we agree with the Examiner that reissue claims 1–9 and 20 do not claim an invention that was unequivocally disclosed in the original patent as required under 35 U.S.C. § 251. While the ’475 Patent discloses and discusses the composition of the member in greater detail than the shape of the member, the face of the ’475 Patent simply does not unequivocally inform a skilled artisan that a flower container assembly with a non-triangular member, as covered by claims 1–9 and 20 of the reissue application, was intended to have been covered and secured by the original patent. Indeed, on the face of the ’475 Patent, the title recites “TRIANGULAR SHAPED FLOWER STEM WRAP . . . ,” and the Abstract recites an “assembly having a triangular shaped piece of flexible foam material” The disclosure most favorable to Appellant is the first sentence of the Technical Field of the Invention Section, which states that “[t]he present invention relates generally to the use of a wrap for transporting cut flowers and plants,” and “[m]ore particularly, this invention relates to a triangular shaped stem wrap” ’475 Patent 1:12–14. The first (i.e., introductory) sentence of the Summary of the Invention refers explicitly to “[a] triangular shaped foam material,” and the first (i.e., introductory) sentence of the

Brief Description of the Drawings states that Figure 1 is a perspective view of a “triangular shaped foam member” of Appellant’s invention. *Id.* at 2:11–12, 2:45–46. Thereafter, the second sentence of the Detailed Description of the Invention explicitly states that “[t]he invention is directed toward a triangular shaped foam member.” *Id.* at 3:10–11. Reviewing Appellant’s disclosure in its entirety, we are left to conclude that a skilled artisan would not have clearly and unequivocally understood that Appellant considered a flower container assembly having a non-triangular member to be another invention (i.e., in addition to a flower container assembly having a triangular member). For this reason, we sustain the rejection of claim 1 under 35 U.S.C. §251, and claims 2–9 fall with claim 1.

Rejection III: Obviousness of Claims 1–3 and 9

Regarding independent claim 1, the Examiner finds that Benoist discloses the claimed invention, except for the flexible material being a diphenylmethane diisocyanate foam material. Final Act. 5. The Examiner finds, however, that Hann discloses using diphenylmethane diisocyanate foam for growing plants, the foam material being “foldable or flexible (from ‘elastic’ of col. 5, lines 1-9).” *Id.* The Examiner concludes that it would have been obvious to modify Benoist’s container assembly by substituting the foam material of Hann for the cardboard of Benoist “to use a growing material with ideal flexibility, strength, and wetting characteristics.” *Id.* at 6 (citing Hann 3:40–43 (“The horticultural growing medium of the present invention displays flexibility, strength, and wetting characteristics which make it an ideal medium for plant growth.”)). According to the Examiner, “[t]hese characteristics, particularly the wetting characteristic, would assist the plants (either seedlings or cut flowers) both grow (as disclosed in Hann) and conserve the plant in good conditions.” *Id.* (citing Benoist 2:25–28 (“This

arrangement presents numerous advantages, particularly as regards conserving the plant in good conditions . . .”).

Appellant argues that a skilled artisan would not have considered it “advisable to place cut flowers, as opposed to live plants that are intended to be grown, into Hann’s plant growth material,” because Hann does not disclose that its growing medium would conserve cut flowers. Appeal Br. 16–17. Appellant further argues that seedlings (as addressed by Hann) and cut flowers (as addressed by Benoit) are non-analogous arts, such that a skilled artisan would *not* understand that Hann’s material could be used to replace Benoit’s cardboard. *See* Appeal Br. 15–16. According to Appellant, the needs of seedlings/plants and cut flowers differ, and “[w]hile placing cut flowers in water is appropriate, soaking of potted plant roots in supersaturated soil or medium may cause the roots of many plants to rot or the plants to falter,” and placing cut flowers in soil “would make the stems of the cut flowers dirty and also have a negative effect on the flowers’ shelf life.” *Id.* at 16. Appellant argues that a skilled artisan would not look to Hann’s teachings regarding growing seedlings “when dealing with cut flowers” because “[t]he technology, methods of retaining, and methods of nourishing are entirely different.” *Id.*

The Examiner responds that “both cut flowers and potted plants need water,” and “Hann’s hydrophilic polymer could provide water” to either a plant of Hann or the cut flowers of Benoit. Ans. 17. According to the Examiner, Benoit’s cardboard provides surrounding humidity required by cut flowers, and Hann’s foam “would do the same as the cardboard since it absorbs and contains a high level of water available for plants.” *Id.* The Examiner finds that Hann’s hydrophilic polymer would “contain enough water (moisture at a tension that is

available to the cut flower) that a cut flower would have the required humidity to not wilt,” and that a skilled artisan “would know to try and use the hydrophilic polymer of Hann to retard wilting in cut flowers since it has shown efficacy in growing plants.” *Id.* at 18.

We agree that Hann does not explicitly disclose that its growing medium would function to conserve cut flowers. The question, therefore, is whether a skilled artisan would consider using Hann’s material in place of Benoist’s cardboard. Appellant’s contention is that providing water to plants is, itself, non-analogous to providing water to cut flowers, because roots and stems need different water provisions. Appeal Br. 10. Neither the Examiner nor Appellant provides us with evidence supporting their position on whether provision of water to seedlings/plants is analogous to (or would be understood by a skilled artisan as relevant to) provision of water to cut flowers. Indeed, no evidence is provided regarding how either a seedling/plant or a cut flower obtains water. Because it is the Examiner’s burden to establish *prima facie* obviousness with substantial evidence supporting the underlying findings, and we have not been provided with sufficient evidence to establish that providing water to seedlings/plants is analogous to, or would be understood by a skilled artisan to be relevant to, providing water to cut flowers, the Examiner has not provided substantial evidence to support a finding that a skilled artisan would understand that Hann’s material could be used to replace Benoist’s cardboard so as to purportedly provide the ideal wetting characteristics for conserving the cut flowers in good conditions. For this reason, we do not sustain the obviousness rejection.

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Rejections IV–IX: Obviousness of Claims 4–8 and 10–20

For the reasons discussed above regarding Rejection III, we do not sustain the rejection of claims 4–8 and 10–20 in Rejections IV–IX.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–20	112, ¶ 1	Written Description		1–20
1–20	251	Original Patent	1–9, 20	10–19
1–3, 9	103(a)	Benoist, Hann		1–3, 9
4, 5, 20	103(a)	Benoist, Hann, Glück		4, 5, 20
6	103(a)	Benoist, Hann, Ballard		6
7, 8	103(a)	Benoist, Hann, Ballard, Weder		7, 8
10–13, 19	103(a)	Benoist, Hann, Gilbert		10–13, 19
14, 17, 18	103(a)	Benoist, Gilbert, Hann		14, 17, 18
15, 16	103(a)	Benoist, Gilbert, Hann, Ballard		15, 16
Overall Outcome:			1–9, 20	10–19

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)(1)(iv).

AFFIRMED-IN-PART