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Decisions of the United States Courts and of the United States Patent and Trademark Office in Patent, Trademark, and Copyright Cases

Court of Appeals, Federal Circuit

In re Sernaker

No. 82-579

Decided Feb. 28, 1983

PATENTS

1. Claims — Dependent (§20.35)

Dependent claims, patentability of which were not argued separately, stand or fall with independent claims.

2. Patentability — Anticipation — Combining references (§51.905)

Assuming that all prior art references are sufficiently related to one another and to related and common art that hypothetical person skilled in art must be presumed to be familiar with all of them, next questions as to whether Board of Appeals correctly deduced obviousness from prior art are whether combination of teachings of all or any of references would have suggested, expressly or by implication, possibility of achieving further improvement by combining such teachings along line of invention in suit, and whether claimed invention achieved more than combination that any or all of prior art references suggested, expressly or by reasonable implication.

3. Court of Appeals for the Federal Circuit — Pleading and practice (§26.57)

CCPA cases reviewing decisions of Board of Appeals under Section 103 are binding precedents in CAFC, as much as CAFC's cases will be; none can be treated as discredited merely because expressions in them can be taken out of their context and construed as in conflict with expressions in other cases.

4. Patentability — Anticipation — Modifying references (§51.217)

Patentability — Evidence of — Suggestions of prior art (§51.469)

It is not necessary that prior art suggest expressly or in so many words changes or possible improvements inventor made; it is only necessary that he apply knowledge clearly present in prior art.

5. Patentability — Anticipation — Combining references (§51.905)

Lesson of In re Imperator, 179 USPQ 730, is that prior art references in combination do not make invention obvious unless something in prior art references would suggest advan-

which the teddy bear mold raises as to ndant's overall credibility in this case, likelihood of plaintiff's success on the its as to the charms registered in 1975 is iderable.[1] Irreparable harm to plaintiff inevitably flow from the infringement of opyrights, whose validity have not been ificantly challenged in this action. Thus, o these nine charms, the standard for nting a preliminary injunction has been . See Jackson Dairy, Inc. v. H.P. Hood ons, Inc., 596 F.2d 70, 72 (2d Cir. 1979).

Upon reargument, the cat charm presents iewhat different problems. Summary gment was first granted in defendant's or based on unchallenged documentary of. While plaintiff's employee, Angel ier, stated by affidavit that he created charm in 1975, defendant submitted an oice dated March 1974, indicating the : of a charm number 114 which the endant claims refers to its cat charm. At hearing, however, plaintiff took issue h the authenticity of the invoice. Plaintiff v urges that defendant's credibility is at ie. Thus, a reasonable person could con- de that the invoice was fabricated, or that defendant's cat mold was given a style nber corresponding to the number on the oice in order that it would appear to have en sold on the date listed on the invoice. :, e.g., Mode Art Jewelers Co. v. Expan- n Jewelry, Ltd., 190 USPQ 329, 337 D.N.Y. 1977). These new considerations tify the withdrawal of this court's earlier mmary judgment ruling as well as the uance of a preliminary injunction against : sale of the cat charm by defendant.

Accordingly, plaintiff's motion for a eliminary injunction is granted with spect to all ten mini-charms. This Court's der granting summary judgment to defen- nt on the cat charm is withdrawn.

So ordered.

No motivation for substitution

[1] No issue of defendant's access to plaintiff's arms has been raised here. The parties are rect competitors in the retail charm market, and fendant had ready access to the plaintiff's talog, as well as to plaintiff's charms sold on the en market. Arrow Novelty Co., Inc. v. ENCO ational Corp., 393 F.Supp. 157, 187 USPQ 413 .D.N.Y. 1974), aff'd 515 F.2d 504 (2d Cir. 75).

Patent and Trademark Office Board of Appeals

Ex parte Acosta

Opinion dated Dec. 27, 1979

Patent No. 4,237,011 issued Dec. 2, 1980

PATENTS

1. Patentability — Anticipation — Combining references (§51.205)

Patentability — Anticipation — Modifying references (§51.217)

Examiner's combination of primary and secondary references is improper in case in which there is no basis in record from which it can be reasonably inferred that one skilled in art would have been led or motivated to modify primary reference in manner proposed by examiner and modification of primary reference's structure in proposed manner would lead to inoperative construction.

Particular patents — Cartridge Filter

Acosta, Quick Change Cartridge Filter, rejection of claims 15-20, 22, and 24 reversed.

Appeal from Art Unit 176.

Application for patent of William A. Acosta, Serial No. 767,251, filed Feb. 10, 1977. From decision rejecting claims 15-20, 22, and 24, applicant appeals (Appeal No. 372-50). Reversed.

Stanley H. Cohen, and Caesar, Rivise, Bernstein & Cohen, Ltd., both of Philadelphia, Pa., for appellant.

Before Sturtevant and Merker, Examiners-in-Chief, and Lovell, Acting Examiner-in-Chief.

Lovell, Acting Examiner-in-Chief.

This is an appeal from the final rejection of claims 15 through 20, 22 and 24. Claims 3 through 5, 7, 11 through 14, 25 through 28, 33 through 35, 37 through 43, 45, 46 and 48 through 50 have been indicated to be allowable.

Claim 15 is representative of the appealed claims:

15. A filter cage assembly comprising a tube sheet, a plate positioned below said tube sheet, wall means connecting said tube sheet and said plate, and forming a chamber between said tube sheet and said plate, a plurality of filter tubes passing through said tube sheet and being releasably secured in said plate, said filter tubes having a plurality of openings formed therein, with said openings being above and below said tube sheet, and replaceable filter cartridges on each of said filter tubes.

The references of record relied on by the examiner are:

Brundage	2,889,933	June 9, 1959
Soriente et al (Soriente)	3,279,608	Oct. 18, 1966
Mott	3,598,242	Aug. 10, 1971
Soriente et al (Soriente)	3,615,016	Oct. 26, 1971

All the appealed claims have been rejected as obvious under 35 U.S.C. 103 in view of the combination of Soriente '016 and Mott. Soriente '608 has been added to this combination as evidence of the obviousness of claim 16, and Brundage has been added to this combination as evidence of the obviousness of claims 19 and 20.

We shall not sustain the examiner's rejection.

The examiner states that element *28* of Soriente '016 (Figure 1) reads on the claimed tube sheet and element *18* reads on the claimed plate. The examiner reasons that the tank wall *12* reads on the defined wall means connecting the tube sheet and plate and that the cartridge *32* and seat means *34* read on the claimed filter cartridges and tubes, respectively. The examiner concludes that Soriente '016 discloses the appellant's filter assembly except for the requirement that the filter tubes are releasably secured in the plate member. The examiner has cited Mott as evidence of the obviousness of such a feature. Apparently, the examiner reasons that it would have been obvious to screw the filter tubes into the tank bottom of the Soriente '016 structure.

[1] We cannot subscribe to the examiner's reasoning. There is simply no basis in the record from which it can be reasonably inferred that one of ordinary skill in this art would have been led or motivated to modify the Soriente '016 filter tank in the manner proposed by the examiner. Moreover, we agree with appellant that modification of the Soriente '016 structure in the manner proposed by the examiner would lead to an inoperative construction. Thus, we agree with appellant that the combination of Soriente '016 and Mott is improper.

There appears to be no dispute that Brundage teaches the claimed filter cartridges; however, we agree with appellant that rod *52* of the Soriente '608 patent is not equivalent to appellant's reinforcing bar as required in claim 16. In any event, these references considered singly or collectively fail to cure the basic deficiencies of the above combination.

Accordingly, based on the record before us, we do not find that the examiner's reference combination establishes a prima facie case of obviousness within the purview of 35 U.S.C. 103, and we therefore reverse.

The decision of the examiner is reversed.

Reversed.

Patent and Trademark Office Board of Patent Interferences

Weber, v. Cornely, and Keith Kunz

Opinion dated Oct. 9, 1980

PATENTS

1. Court of Customs and Patent Appeals — In general (§28.01)

Interference — Practice (§41.60)

Pleading and practice in Patent Office — Rules effect (§54.9)

Revised Statutes 4915 Suits (35 U.S.C. 145) — In general (§59.01)

Provisions of Patent Rule 256(b) apply to final decision; time for filing appeal or civil action expires thirty days after date of present action on request for reconsideration of final decision; accordingly, request for extension of time for appeal or civil action under Patent Rule 304 is dismissed as moot.

2. Interference — Evidence — In general (§41.351)

Interference — Evidence — Corroboration (§41.355)

Exhibits do not speak for themselves; implication from silence as to exhibits, of inventors' original showing in supplemental affidavit, of affiant whose signature appears on those exhibits is more likely that affiant did not witness experiments described in them than that he is implicitly corroborating them.

3. Interference — Practice (§41.60)

Acceptance of excuse is within discretion of Board of Patent Interferences.