

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TERRY R. JACKSON

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Appeal No. 2000-0305  
Application No. 08/887,453

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HEARD: November 28, 2000

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Before COHEN, STAAB, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 9, 11 and 12. Claim 10, the only other claim pending in this application, stands allowed.

We AFFIRM-IN-PART and enter a new rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to protective casings for articles (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Alwitt 1992	5,101,974	April 7,
Andersen 1994	5,320,261	June 14,
De Putter et al. (De Putter)	EP 0 577 582 A1	Jan. 05, 1994

The claims on appeal stand finally rejected as follows:

- (1) Claims 1, 2, 8, 9, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Andersen.
- (2) Claims 1, 6 to 9, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Alwitt.
- (3) Claims 3, 6 and 7 under 35 U.S.C. § 103 as being unpatentable over Andersen in view of Alwitt.

(4) Claims 4 and 5 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Andersen.

(5) Claims 4 and 5 under 35 U.S.C. § 103 as being unpatentable over Andersen in view of De Putter.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 20, mailed May 7, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 19, filed February 24, 1999) and reply brief (Paper No. 21, filed July 2, 1999) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

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**Rejection (1)**

We sustain the rejection of claims 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Andersen, but not the rejection of claims 1, 2, 8 and 9.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Andersen discloses a restraining and protection device 100 for the protection and the restraint of neckstrap-suspended equipment used in the field (e.g., binoculars 80). As shown in Figures 1-3, the restraining and protective device 100 includes (1) a cover 10 which consists of a single expanse of flexible material, preferably also being stretchable and waterproof;

(2) an elastomeric material 20 sewn directly to the outer extremities of the cover 10, fed through a casing, or otherwise attached to the outer extremities of the cover 10 to form an expandable opening; (3) attach tabs 40A and 40B sewn or otherwise attached directly to the cover 10; and (4) slits 70A and 70B provided for the attachment of a stretchable strap 90 or a clip 30A and 30B. Andersen teaches (column 4, lines 30-33) that the restraining and protective device could be made in one piece by forming or molding elastomeric, stretchable, waterproof materials into a one piece stretchable cover with attaching means built in. Andersen further teaches (column 2, lines 31-41) that

[t]he relaxed length of the elastomeric material 20 is less than the relaxed length of the cover 10 edge. A gathering or puckering of the cover 10 edge occurs when

the elastomeric material 20 is attached. The cover 10 size, and the length of the elastomeric material 20 attached to the cover 10 is of sufficient size and length to allow for the covering of approximately 98% of all neckstrap-suspended equipment surfaces not facing the user, in this case a pair of binoculars as shown in FIGS. 1 and 2.

To use Andersen's device the user merely stretches the elastomeric material 20 and the cover 10 to a size sufficient to allow the positioning of the device 100 over the piece of equipment to be restrained and protected. For example (see column 3, lines 11-19), a pair of neckstrap-suspended binoculars 80 is protected and restrained from movement by first stretching the lower portion of the cover 10 and elastomeric material 20 around and over the lower portion of the suspended binoculars 80 which covers the lenses facing down. Next the upper portion of the cover 10 and elastomeric material 20 is stretched up, over, and around the upper portion of the suspended binoculars covering the lenses facing up.

*Claim 11*

The appellant argues (brief, p. 12) that Andersen does not disclose stretching and inverting only that portion of the casing that covers an end of the article to cover and uncover the end of an article as recited in claim 11. We find this argument unpersuasive since we find ourselves in agreement with the examiner that Andersen's device is inherently capable of stretching and inverting only that portion of the casing that covers an end of the article to cover and uncover the end of an article. In that regard, the prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. See Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed. Cir. 1985). Rather, if a claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding anticipation. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d at 631-33, 2 USPQ2d at 1052-54.

It is well settled that the burden of establishing a prima facie case of anticipation resides with the Patent and Trademark Office (PTO). See In re Piasecki, 745 F.2d 1468,

1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When relying upon the theory of inherency, the PTO must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990).

After the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986).

In this case, the basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of Andersen is his teaching that cover 10 is made of a stretchable flexible material which can be stretched up,

over, and around the upper portion of the suspended binoculars covering the lenses facing up. In view of the nature of Andersen's cover 10, it is our determination that it is reasonable to conclude that the cover 10 is inherently capable of stretching and inverting only that portion of the cover that covers an end of the article to cover and uncover the end of an article. Hence, the appellant's burden before the PTO is to prove that Andersen does not perform the functions defined in claim 11. The appellant has not come forward with any evidence to satisfy that burden. Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971). Appellant's mere argument on page 12 of the brief that Andersen does not disclose the functions defined in claim 11 is not evidence. See In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974)(attorney's arguments in a brief cannot take the place of evidence).

For the reasons set forth above, the decision of the examiner to reject claim 11 under 35 U.S.C. § 102(b) as being anticipated by Andersen is affirmed.

*Claim 12*

The appellant argues (brief, p. 12) that Andersen does not disclose a hollow interior space similar to the shape of an article whereby closure and release is provided through an opening as a portion of the protective case is inverted and re-inverted over an end of the article as recited in claim 12. We find this argument unpersuasive for the same reasons as set forth above with respect to claim 11. Furthermore, as shown in Figures 1-3 of Anderson, his cover 10 does provide a hollow interior space similar to the shape of the binoculars 80.

For the reasons set forth above, the decision of the examiner to reject claim 12 under 35 U.S.C. § 102(b) as being anticipated by Andersen is affirmed.

*Claims 1, 2, 8 and 9*

The appellant argues (brief, pp. 9-11) that Andersen's cover does not provide a shape retaining hollow interior space as recited in claim 1. We agree. In that regard, the hollow interior space defined by Andersen's cover is not shape

retaining (i.e., unchangeable shape) due to the material thereof being flexible and thus fully capable of changing shape.

For the reasons set forth above, the decision of the examiner to reject claims 1, 2, 8 and 9 under 35 U.S.C. § 102(b) as being anticipated by Andersen is reversed.

**Rejection (2)**

We sustain the rejection of claims 1, 6 to 9, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Alwitt.

Alwitt discloses a reversible, deformable camera carrying case. Alwitt states (column 1, lines 53-61) that his invention overcomes the drawbacks of the prior art, by protecting the camera with a case of flexible, deformable material with a latch included in the material in the form of an aperture that slides over the case-covered lens portion of the camera. The resiliency and deformability of the material is such that one case

size will fit most cameras. The case is also of unitary construction,<sup>1</sup> in that the cover and body of the case are continuous, minimizing assembly time and costs.

As shown in Figures 1-3, the camera protective case 10 is of unitary composition, and comprises main body housing 14, which provides a housing for the complete camera 12, and cover 16. Main housing 14 has contours which correspond generally to the contours of a camera to be carried therein. Although the housing is of unitary construction, it may be considered to have a floor 18, front 20 and rear panels 22, sides 24, lenspiece 26, and top 28. The housing has an open pocket 32 through which a camera may be inserted in and removed from housing 14. Cover 16 extends from the main housing 14 at the top of rear panel 22. Cover 16 contains aperture 34 disposed

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<sup>1</sup> As used by Alwitt, the term "unitary construction" or "unitary composition" refers to an object that, although it may be manufactured from one or more pieces of material, has no well-defined boundaries, so that it is impossible to determine where one portion or component of the object ends and the next begins. In the camera case of his invention, for example, the cover and body of the case are made of continuous material, and there is no distinct boundary between the two portions. (Column 2, lines 50-58).

near the center. Aperture 34 may be of any shape or size as long as it is deformable to a position permitting entry of the lenspiece 26 and the part of floor 18 underlying lenspiece 26 when the camera is disposed in pocket 32. When aperture 34 is engaged by entry of lenspiece 26 and floor 18, the aperture fits snugly over the lens and the case is closed by the "latch" so formed, as seen in Figure 3.

Alwitt teaches (column 3, lines 14-27) that

[i]n the preferred embodiment of this invention, body 14 and cover 16 are made of resilient, deformable, waterproof material, most preferably both are made of the same material. Examples of such materials are elastic polymers including neoprene rubber, Hypolon®, or neoprene rubber with laminated nylon on one or both sides.

The resilient, deformable nature of the material and the unitary construction of the case permits the case to be easily reversible or invertible, so that pocket 32 becomes the outer surface of body housing 14 and vice versa. Reversibility permits the user to change at will the color, texture, or other qualities of the outer surface of the case.

*Claim 11*

The appellant argues (brief, p. 14) that Alwitt does not disclose a casing having an opening that is maintained in an open state and where the portion of the casing that covers an end of the article is stretchable to permit the opening to be enlarged as the casing is stretched and inverted to thereby cover and uncover the end of an article as recited in claim 11. We find this argument unpersuasive since we find ourselves in agreement with the examiner that Andersen's device inherently meets these limitations. In that regard, Alwitt's camera case in the position shown in Figures 1 and 2 does have an opening (i.e., open pocket 32 through which a camera may be inserted in and removed from housing 14) that is capable of being maintained in an open state. Additionally, Alwitt's cover 16 is capable of being stretched and inverted to permit the opening to be enlarged to thereby cover and uncover an end of an article.

In this case, the basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of Alwitt is his teaching that case 10 (including

cover 16) is made of a resilient, deformable, waterproof material which permits the case to be easily reversible or invertible. In view of the nature of Alwitt's cover 16, it is our determination that it is reasonable to conclude that the cover 16 is inherently capable of stretching and inverting to cover and uncover an end of an article. Hence, the appellant's burden before the PTO is to prove that Alwitt does not perform the functions defined in claim 11. The appellant has not come forward with any evidence to satisfy that burden. Appellant's mere argument on page 14 of the brief that Alwitt does not disclose the functions defined in claim 11 is not evidence.

For the reasons set forth above, the decision of the examiner to reject claim 11 under 35 U.S.C. § 102(b) as being anticipated by Alwitt is affirmed.

*Claim 12*

The appellant argues (brief, p. 14) that Alwitt does not disclose a case whereby an enlarged opening is maintained when a portion of the case is inverted and re-inverted over an end

of the article as recited in claim 12. We find this argument unpersuasive for the same reasons as set forth above with respect to claim 11.

For the reasons set forth above, the decision of the examiner to reject claim 12 under 35 U.S.C. § 102(b) as being anticipated by Alwitt is affirmed.

*Claims 1, 8 and 9*

The appellant argues (brief, pp. 12-13) that Alwitt's case does not disclose inverting and reinverting part of the case to access or insert/remove an article as recited in claim 1. We do not agree. As set forth above with respect to claim 11, Alwitt's cover 16 is inherently capable of inverting and reinverting to access or insert/remove an article from the case 10.

For the reasons set forth above, the decision of the examiner to reject claims 1, 8 and 9 under 35 U.S.C. § 102(b) as being anticipated by Alwitt is affirmed.

*Claims 6 and 7*

The appellant argues (brief, p. 14) that Alwitt's case is of "unitary construction," wherein there is no distinct boundary (i.e., an independent wall as recited in claim 6). We do not agree. In our view, the claimed independent wall is readable on Alwitt's teaching (column 2, lines 50-58) that the cover may be manufactured from more than one piece of material.

For the reasons set forth above, the decision of the examiner to reject claims 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Alwitt is affirmed.

**Rejection (3)**

We will not sustain the rejection of claims 3, 6 and 7 under 35 U.S.C. § 103 as being unpatentable over Andersen in view of Alwitt. In that regard, the deficiency of Andersen discussed above with respect to claim 1 is not cured by the examiner's determination (answer, p. 8) that it would have been obvious in view of Alwitt to make Andersen's casing from neoprene rubber.

**Rejection (4)**

We will not sustain the rejection of claims 4 and 5 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Andersen. Once again the deficiency of Andersen discussed above with respect to claim 1 is not cured by this rejection.

**Rejection (5)**

We will not sustain the rejection of claims 4 and 5 under 35 U.S.C. § 103 as being unpatentable over Andersen in view of De Putter. In that regard, the deficiency of Andersen discussed above with respect to claim 1 is not cured by the examiner's determination (answer, p. 9) that it would have been obvious in view of De Putter to modify Andersen's casing to include a belt-engaging portion.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 2 and 3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Alwitt. As set forth above, Alwitt anticipates claim 1. The additional claim limitations of dependent claims 2 and 3 are clearly met by Alwitt's teaching (column 3, lines 14-20) that the body 14 and cover 16 are made of resilient, deformable, waterproof material, most preferably both are made of the same material such as neoprene rubber.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 8, 9, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Andersen is reversed as to claims 1, 2, 8 and 9 and affirmed as to claims 11 and 12; the decision of the examiner to reject claims 1, 6 to 9, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Alwitt is affirmed; the decision of the examiner to reject claims 3, 6 and 7 under 35 U.S.C. § 103 as being unpatentable over Andersen in view of Alwitt is reversed; the decision of the examiner to reject claims 4 and 5 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Andersen is reversed; the decision of the examiner to reject claims 4 and 5 under 35 U.S.C. § 103 as being unpatentable over Andersen in view of De Putter is reversed; and a new rejection of claims 2 and 3 under 35 U.S.C. § 102(b) has been added pursuant to provisions of 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of

rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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Administrative Patent Judge	)	

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