

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL GILLESPIE

Appeal No. 2000-0504
Application 08/799,898

ON BRIEF

Before PATE, STAAB, and JENNIFER D. BAHR, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 17 and 21 through 23. These are all the claims in the application.

The claimed invention is directed to an apparatus for holding and stabilizing a Christmas tree. The apparatus is

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screwed into a nearby surface such as a wall and comprises an arm with a mounting means for holding the Christmas tree mounted on the end.

Claims 1 and 11, reproduced below, are further illustrative of the claimed subject matter.

1. Apparatus for stabilizing an object that extends upwardly from a surface comprising:

means attachable to a fixed position above said surface for mounting said object; and

means on the mounting means for fixedly attaching said object at a single position thereof.

11. A method of stabilizing a surface mountable object comprising the steps of:

(a) displacing positioning means away from said surface for mounting said object with respect to said surface; and

(b) fixedly attaching said object on the mounting means away from said surface with said object having the same orientation that it would otherwise have.

The references of record relied upon by the examiner as evidence of anticipation and obviousness are:

Jones	1,340,273	May 18, 1920
Mahannah	2,019,789	Nov. 5, 1935
Riccio	2,731,223	Jan. 17, 1956

THE REJECTIONS

Claims 1 through 3 stand rejected under 35 U.S.C. § 112,

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second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.¹ The examiner has stated that there is an inconsistency between the preamble and the body of the claim. According to the examiner, this inconsistency renders it impossible to determine whether the claim is directed to a subcombination or a combination.

Claims 1 through 3 stand rejected under 35 U.S.C. § 102 as anticipated by Jones.

Claims 1 through 5 and 11 through 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Riccio.

Claim 4 stands rejected under 35 U.S.C. § 103 as unpatentable over Jones.

Claims 6 through 9, 16, 17 and 21 through 23 stand rejected under 35 U.S.C. § 103(b) as unpatentable over Riccio in view of Mahannah.

¹In paragraph 10 of the Examiner's Answer, we note that claims 1 through 3 are rejected under "35 U.S.C. § 102(b)." We have treated this reference to § 102(b) as a typographical error, for we note that the arguments section of the Examiner's Answer is responsive to the brief, wherein the § 112 second paragraph rejection is argued.

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Finally, claim 10 stands rejected under 35 U.S.C. § 103 as unpatentable over Riccio in view of Jones.

For details of these rejections, reference is made to the Appeal Brief and the Examiner's Answer.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the conclusion that Jones anticipates claims 1 through 3, Jones renders claim 4 *prima facie* obvious, and that Riccio renders obvious claims 1 through 5. We have further concluded that claims 6 through 9 would have been obvious over Riccio in view of Mahannah. Likewise, claim 10 would have been prima facie obvious to one of ordinary skill in view of the teachings of Riccio and Jones. However, with respect to claims 11 through 17, it is our conclusion that these claims are so indefinite that the art cannot be applied, and hence, we enter a rejection under 35 U.S.C. § 112, second paragraph. Finally, we reverse the rejection of claims 21 through 23 under section 103 and the rejection of claims 1-3 under section 112, second paragraph.

A detailed explanation of these actions follows.

Turning first to the rejection of claims 1 through 3 under 35 U.S.C. § 112, second paragraph, we are not in agreement with the examiner that the metes and bounds of the invention cannot be determined with specificity. It is clear to us that claim 1 is directed to an apparatus for stabilizing, and the object to be stabilized is merely recited in the body of the claim. We agree with the appellant that the claim can clearly be understood as directed to a subcombination.

With respect to the § 102 rejection of claims 1 through 3 as anticipated by Jones, we agree with the examiner's finding that Jones discloses a mounting means plate 7, bracket 4, and arm 1 and a means for attaching, arms and clamp 2,3,10. We further agree that the mounting means has a single axis extending outwardly from a fixed position and that the object, the lamp socket, is vertically mountable with respect to the axis and the surface.²

²Neither the appellant, nor the examiner has raised the issue of the interpretation of the "means for" limitations in the rejected claims. The means for mounting in claim 1 has been construed as an arm such as arm 22/23 as disclosed in the

We will also sustain the rejection of claim 4 as unpatentable over Jones considered alone. The appellant never discusses this rejection in appellant's brief. This unargued rejection is affirmed.

Turning to the rejection of claims 1 through 5 rejected under Riccio alone, we are in agreement with the examiner that Riccio discloses a means 2,4 for mounting an object and means 6 for attaching the object. Appellant argues that there is nothing in Riccio to suggest that a single stabilizing arm could be used to hold the tree. Claims 1 through 5 are of the open-ended type and use the word "comprising". It is our view that these claims do not preclude the presence of additional arms over and above any single arm disclosed in Riccio. Therefore, the rejection of claims 1 through 5 is affirmed.

specification (and equivalents thereof). The "means for fixedly attaching" has been construed as a clamp, such as clamp 25/26 as disclosed in the specification (and equivalents thereof).

Likewise, with respect to the rejection of claims 6 through 9 as unpatentable over Riccio in view of Mahannah and claim 10 rejected as unpatentable over Riccio in view of Jones, here again the open-ended language of claim 1, does not preclude the presence of additional arms.

Turning now to the rejection of claims 11 through 17, we have determined that these claims are so indefinite as to prevent us from being able to apply the prior art thereto. In the second line of claim 11, as it appears in the appendix to the examiner's answer, we note the presence of the expression "said surface for mounting." No such surface for mounting an object has been previously recited in the claim. In line 4 of claim 11, we note the presence of the expression "the mounting means." This expression also lacks antecedent basis in independent claim 11. In claim 12, in the second line we note the expression "the fixed position." Similarly, this expression has no antecedent basis in claims 11 or 12. In lines 3 and 4 of claim 14 as it appears in the appendix to appellant's brief, we find no antecedent basis

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for the expression "fixedly positioned mounting means."

In view of the situation, wherein numerous claim terms lack antecedent basis, it is our opinion that no definite meaning can be ascribed to the claimed subject matter. When this is true of the terms in a claim, the subject matter of the claim cannot be considered obvious, but rather the claim should be rejected as indefinite. See In re Wilson 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since it is clear to us that considerable speculation and assumption are necessary to determine the metes and bounds of what is being claimed, and since a rejection under 35 U.S.C. § 103 cannot be based upon speculation and assumption, we are constrained to reverse the examiner's rejection of claims 11 through 17. See In re Steele 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our reversal of the rejection under § 103 is not a reversal on the merits of the rejection but rather is a procedural reversal predicated upon the indefiniteness of the claimed subject matter.

Accordingly, under the provision of 35 CFR 1.196(b) we enter this rejection of claims 11 through 17 under 35 U.S.C. § 112

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second paragraph as indefinite.

Finally, with respect to claims 21 through 23, rejected as unpatentable over Riccio in view of Mahannah, we will not sustain the rejection of these claims. While we agree that Mahannah discloses a pivotally mounted extension at E and 22, which is attached to the inner slideable member, we are of the view that it would not have been obvious to provide such a pivotal connection in the Christmas tree holder of Riccio. In Riccio, the two clamping structures are designed to clamp a colinearly extending trunk. The use of a pivot to somehow change the orientation of the clamp means is antithetical to this teaching in Riccio. Therefore, we must conclude that this combination of references is based on hindsight reconstruction. Such hindsight reconstruction is impermissible in a rejection under 35 U.S.C. § 103.

SUMMARY

The rejection of claims 1 through 3 under 35 U.S.C. § 112 is reversed. The rejection of claims 1 through 3 under 35 U.S.C. § 102 as unpatentable over Jones is affirmed, and the rejection of claim 4 as unpatentable over Jones is

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affirmed. The rejections of claims 1 through 5 and 6 through 10 under Riccio taken alone, Riccio taken with Mahannah, or Riccio taken with Jones are affirmed. The rejections of claims 11 through 17 have been reversed, and a new rejection entered pursuant to our authority under 37 CFR 1.196(b). Finally, the rejection of claims 21 through 23 has been reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

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 (§ 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

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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. . . .

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

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Administrative Patent Judge)
)
) BOARD OF PATENT
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