

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

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARVIN B. STARK

Appeal No. 2000-0511
Application No. 08/758,343

ON BRIEF

Before ABRAMS, FRANKFORT and JENNIFER D. BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-7, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to a device for holding articles. An understanding of the invention can be derived from a reading of exemplary claim 1, which reads as follows:

1. A device for holding articles comprising:

a handle;

a clamping member on said handle designed to at least partly surround and grip an article, said clamping member being adjustable to the size of the article; and

an anchoring member on said handle designed to abut and stabilize the article, said anchoring member being movable from a retracted position to an extended position independently of said clamping member.

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

Blue	2,917,338	Dec. 15, 1959
Bramming	2,942,910	Jun. 28, 1960

An additional reference of record relied on by this panel of the Board is:¹

Polotti	4,667,359	May 26, 1987
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A reference made of record by this panel of the Board is:

McLeod et al. (McLeod)	1,394,033	Oct. 18, 1921
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The following rejections are before us for review.

¹ This reference was cited by the examiner in Paper No. 3 and a copy is of record in the application file.

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Claims 1, 3, 4, 6 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Blue.

Claims 2 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Blue in view of Bramming.

Reference is made to the brief and reply brief (Paper Nos. 7 and 9) and the answer (Paper No. 8) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

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.

The anticipation rejection

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d

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1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Blue discloses a can holder or implement 10. As explained in column 4, lines 1-60, the gripping assembly 16 of Blue's implement 10 is movable between a retracted position providing maximum clearance between the assembly 16 and the other gripping assembly 15 and an extended position closer to the assembly 15, by means of an actuating member 14, to thereby engage and grip an appropriately-sized can received between the gripping assemblies 15, 16. However, as pointed out in column 4, lines 61-64, the degree of movement of the gripping assembly 16 toward the gripping assembly 15 will be limited by the length of the slots 31, which of course limits the range of can diameters that can be gripped between the assemblies 15, 16. In order to extend the range of can diameters that can be accommodated, a second gripping element 34 is pivotably connected to the gripping assembly 16 by means of a hinged connection 37. In order to grip a can, the second gripping element 34 having an arcuate body 35 is moved to its operative position shown in Figure 1 and the implement 10 is moved downward over the can. A can of relatively small diameter is gripped between the second gripping element 34 and the gripping assembly 15 by depressing the actuating member 14 to

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extend the gripping assembly 16 and gripping element 34 toward the gripping assembly 15. When the implement is moved downward over a can of greater diameter than the clearance between the gripping element 34 and gripping assembly 15, the upper rim of the can will engage the underside of the body 35 to swing the element 34 upward to its inoperative position shown in Figure 2. The can is then gripped directly between the gripping assemblies 15, 16 by depressing the actuating member 14.

Independent claim 1 requires (1) a clamping member which is both "designed to at least partly surround and grip **an** article" and "adjustable to the size of **the** article" and (2) an anchoring member "designed to abut and stabilize **the** article" and movable from a retracted position to an extended position "independently of said clamping member" (emphasis ours). We construe this language as requiring that the anchoring member be capable of abutting and stabilizing the same article which the clamping member is capable of at least partly surrounding and gripping. In other words, a device having a clamping member which is capable of gripping an article of a first type, but incapable of gripping an article of a second type, and an anchoring member which is capable of abutting and stabilizing an article of the second type only, would not meet the limitations of claim 1. For the reasons which follow, we conclude that Blue cannot be construed so as to meet both limitation (1) and limitation (2).

At the outset, we agree with the appellant, for the reasons stated on page 8 of the brief, that, notwithstanding that the support portion 11 of Blue is made of spring steel, it is not

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"adjustable to the size of the article" as required by the claim. Nevertheless, the gripping assemblies 15, 16 and support portion 11 form a clamping member which is designed to partly surround and grip an article having a relatively large diameter (i.e., greater than the maximum clearance between the gripping assembly 15 and the second gripping element 34 in its operative position) and which is adjustable, by depression of the actuating member 14, to the size of the article, thereby meeting limitation (1) for articles of relatively large diameter. The second gripping element 34 is movable between an extended (operative) position and a retracted (inoperative) position independently of the gripping assemblies 15, 16 and support portion 11 and, further, is designed to abut and stabilize (by gripping) an article having a relatively small diameter (i.e. sufficiently small to be received between the second gripping element 34 in its operative position and the gripping assembly 15). However, the second gripping element 34 is not capable of abutting and stabilizing an article of relatively large diameter. Conversely, the "clamping member" formed by the gripping assemblies and support portion alone is not itself capable of gripping an article of relatively small diameter which can be abutted and stabilized by the second gripping element. While we appreciate that the second gripping element 34 could be considered to be part of the "clamping member," in that it is connected to the gripping assembly 16 and helps grip the article, it cannot then also reasonably be considered to be an anchoring member movable "independently of said clamping member" as additionally required by claim 1.

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For the foregoing reasons, we cannot sustain the examiner's rejection of claim 1, or claims 3, 4, 6 and 7 which depend from claim 1, as being anticipated by Blue.

The obviousness rejection

Claim 2 depends from claim 1 and further recites that the clamping member includes a band which defines a loop of variable circumference and means for fixing the circumference of the loop at any of a plurality of values. Claim 5, which also depends from claim 1, further recites a screw adjustment for tightening the clamping member. In rejecting claims 2 and 5, the examiner's position is that it would have been obvious to replace the support portion 11 of Blue with an adjustable clamping band as taught by Bramming to provide a more efficient gripping of the clamping member on the article. Moreover, according to the examiner, "the modified Blue device would still include an anchoring member (34), as originally disclosed, and also include the claimed clamping member, as taught by Bramming" (answer, page 5).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). For the reasons which follow, we share the appellant's opinion, as expressed on page 4 of the reply brief, that the combined teachings of Blue and Bramming would not have suggested the subject matter of the claimed invention.

As explained by Blue (column 4, line 61, to column 5, line 35), the function of the second gripping element 34 is to extend the limited range of can diameters that can be gripped using the disclosed implement. It is the finite length of the slots 31 which limits the degree of adjustment of the gripping assembly 16. The adjustable clamping band 18 taught by Bramming, on the other hand, has an extremely wide range of adjustability, in that it is provided with apertures 19 around substantially the entire band (or at least around as much of the band as deemed necessary to achieve the desired adjustability).² Therefore, even assuming that the teachings of Bramming would have suggested to a person of ordinary skill in the art the use of the adjustable clamping band 18 of Bramming in the Blue can holder to grip the can, it is our opinion that such a person would not have seen any reason to combine such a band with either the retractable gripping assembly 16 or a second gripping element 34 taught by Blue. Moreover, even if the references were combined as proposed by the examiner, the combination would not cure the deficiencies of Blue noted above with regard to the subject matter of claim 1.

Accordingly, we shall not sustain the examiner's rejection of claims 2 and 5 as being unpatentable over Blue in view of Bramming.

NEW GROUNDS OF REJECTION

² Bramming also teaches that it would be feasible to provide the apertures along only a portion of the band (column 2, lines 16-19).

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Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new grounds of rejection.

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by Polotti.

With regard to claim 1, Polotti discloses a universal grip device for holding bottles and the like containers, comprising a handle (handgrip 2), a clamping member (band element 20) on the handle designed to surround and grip a bottle or like container and being adjustable to the size of the container (see column 1, lines 28-30; column 2, lines 58-61; column 3, lines 26-30) and an anchoring member (split ring 4) on the handle designed to be snap fitted onto the neck portion of the container (thereby abutting and stabilizing the container). As illustrated in Figure 5, the split ring 4 is movable from a first (retracted) position remote from the neck of the container to a second (extended) position abutting the neck of the container. While this movement of the split ring is with (and thus not independent of) the handle, it does occur independently of and relative to the band element 20 about an axial pin or pivot 30, as required by claim 1. Further, the band element 20 defines a loop of variable circumference and comprises, at one end thereof, a closure zone 21 provided with projecting teeth and, at the opposite end thereof, a dog 22 engageable with the projecting teeth for fixing the circumference of the loop at any of a plurality of values (column 2, lines 53-61), as recited in claim 2.

Claim 3 recites "means for moving said anchoring member between said retracted position and said extended position." In order to meet a "means-plus-function" limitation, the

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prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989). The axial pin or pivot 30 of Polotti is used to move the split ring between the first and second positions and, thus, performs the recited function. Additionally, in light of the disclosure in lines 24 and 25 on page 11 of the appellant's specification, the pin or pivot is equivalent to the structure disclosed in the specification. Accordingly, the pin or pivot 30 meets the "means for moving" limitation of claim 3.

With regard to the limitation in claim 4 that the anchoring means resembles a "bar," we note that, in proceedings before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In this instance, since the appellant's specification does not define the term "bar," it must be

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given its broadest reasonable interpretation. The split ring 4 is a solid oblong piece and thus resembles a "bar"³ as broadly claimed.

Claim 5 is rejected under 35 U.S.C. § 103 as being unpatentable over Polotti in view of Bramming.

Polotti discloses projecting teeth and a dog for engagement therewith, rather than a screw adjustment as claimed, for tightening the band element 20. However, as evidenced by Bramming (column 2, lines 37-53), screw adjustment arrangements for tensioning clamping bands of the type taught by Polotti were also well known in the art at the time of the appellant's invention. Merely to replace the teeth and dog arrangement of Polotti with another well known clamping band tensioning means, such as a screw adjustment, to obtain the self-evident advantages thereof (i.e., more precise control over the degree of tension applied) would have been obvious to one of ordinary skill in the art.

Claims 6 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over Polotti in view of McLeod.

Polotti does not disclose an opening through the handle for attaching the handle to an object as required by claims 6 and 7. It was well known in the art at the time of the appellant's invention to provide devices such as household implements and utensils with an opening or hole therethrough to facilitate hanging of the device on a nail or the like when not in use, as

³ An oblong piece or mass of something solid (Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)).

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illustrated, for example, by McLeod (see page 1, lines 45-48). Accordingly, to provide such an opening through the handgrip 2 of Polotti to facilitate hanging of the device on a nail, hook or the like when not in use would have been obvious to one of ordinary skill in the art.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-7 under 35 U.S.C. §§ 102 and 103 is reversed, but new rejections of these claims are added pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. 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 grounds 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 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. . . .

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

REVERSED; 37 CFR § 1.196(b)

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Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
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