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for publication and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LUEDER MOSLER
and MARTIN PUSCH

Appeal No. 2003-1359
Application No. 09/285,260

HEARD: OCTOBER 8, 2003

Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 3 and 21-29. Claims 4-20, the only other claims currently pending in the application, have been withdrawn from consideration under 37 CFR § 1.142(b) as not reading on the elected species.

THE INVENTION

Appellants' invention pertains to a resilient insert for an artificial foot, wherein the insert comprises at least one spring element for determining the spring rigidity of the artificial foot, and an adapting device for changing the spring rigidity of the spring element in response to a load placed on the artificial foot. A further understanding to the invention can be derived from a reading of exemplary claims 1 and 24 which appear in the appendix to appellants' main brief.

THE APPLIED PRIOR ART

The references applied by the examiner against the claims in the final rejection are:

Robinson	4,892,554	Jan. 9, 1990
Phillips	5,728,177	Mar. 17, 1998

THE REJECTIONS

Claims 1, 3 and 24-26 stand rejected under 35 U.S.C. § 112, second paragraph.[1]

Claims 1 and 23-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Robinson.

Claims 1 and 23-29 stand further rejected under 35 U.S.C. § 102(b) as being anticipated by Phillips.

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[1]In that claims 1, 3 and 24 constitute all the independent claims on appeal, it is not clear why the examiner did not include all the appealed claims in this rejection.

Reference is made to appellants' main and reply briefs (Paper Nos. 22 and 26) and to the examiner's answer (Paper No. 24) for the respective positions of appellants and the examiner regarding the merits of these rejections.[2]

DISCUSSION

The 35 U.S.C. § 112, second paragraph, rejection

Considering first the standing rejection of claims 1, 3 and 24-26 under 35 U.S.C. § 112, second paragraph, the examiner explains this rejection as follows:

> This rejection was prompted by appellant's [sic, appellants'] introduction of the language "attachment member" in Amendment D. It is the Examiner [sic] position that "attachment member" is indefinite due to no support [for this term] in the specification . . . making the intended scope unclear. [Answer, page 4.]

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In this regard, the definiteness of the language in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

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[2]In claim 24, last line, the term "the adapting device" lacks a proper antecedent. For purposes of this appeal, we shall consider "the adapting device" as corresponding to the previously recited "means . . . for changing." Although this informality does not obscure the metes and bounds of claim 24, it is deserving of correction upon return of this application to the Technology Center.

In each of the independent claims on appeal, the term “attachment member” appears in the claim in the following context: “an attachment member connected to at least one of said spring elements, for mounting the artificial foot to a prosthesis. . . .” Based on the way the term “attachment member” is used in the independent claims, and the fact that the specification states that “adapter 4 allows the artificial foot to be connected to an artificial leg” (specification, page 5), we agree with appellants’ argument (main brief, page 6) that one of ordinary skill in the art would understand the “attachment member” terminology of appellants’ claims as referring to adapter 4 shown in the drawings figures. Accordingly, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of these claims.[3]

Claim interpretation

Prior to addressing the standing rejections based on prior art, it is particularly important in this appeal to understand the meaning of certain terminology appearing in independent claims 1 and 24.

The PTO applies to the verbiage of claims before it 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 appellants’

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[3]The examiner may wish to have appellants amend the specification to provide antecedent basis therein for the claim term “attachment member” in order to bring the specification into full compliance with 37 CFR § 1.75(d)(1).

specification. *In re Morris,* 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). *See also, In re Sneed,* 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

Independent claim 1 is directed to an artificial foot comprising, *inter alia,* a first spring element comprising at least one forefoot leaf spring element extending into the forefoot region of the artificial foot, a second spring element located at least in part in the heel region of the artificial foot, and

> an adapting device actuated in response to flexing of said second spring element and operatively connected to the second spring element for changing the spring rigidity of the artificial foot *by changing the spring rigidity of the forefoot leaf spring element* responsive to a load placed on the artificial foot which causes flexing of the second spring element, wherein the adapting device is operatively connected to the forefoot leaf spring element *for directly changing its bending resistance* and wherein deflection of the second spring element in the heel due of flexing thereof comprises an input variable for actuating the adapting device. [Emphasis added.]

Independent claim 24 is similar to claim 1 in that it also is directed to an artificial foot comprising a first spring element comprising at least one forefoot leaf spring element, and a second spring element located at least in part in the heel region of the artificial foot. However, claim 24 claims the adapting device in means-plus-function format. More particularly, claim 24 calls for

> means, operatively connected to the second spring element, for changing the spring rigidity of the artificial foot *by directly changing the bending resistance of the forefoot spring element* responsive to flexing of said second spring element due to a load placed on the artificial foot, wherein deflection of the second spring element in the heel due to flexing thereof comprises an input variable for actuating the adapting device [sic, means for changing]. [Emphasis added.]

In the present instance, the emphasized terminology in the above quoted portions of claims 1 and 24 requires interpretation. Consistent with appellants' specification[4], we consider that the broadest reasonable interpretation one of ordinary skill in the art would give to the "changing the spring rigidity" and "changing its bending resistance" terminology of claim 1 and the "changing the bending resistance" terminology of claim 24 is that this terminology requires a physical change in the forefoot leaf spring that effects a change in the characteristic resistance to bending of the leaf spring.[5] This interpretation comports with appellants' argument on page 7 of the main brief and page 3 of the reply brief concerning these claim limitations.

The anticipation rejection based on Robinson

In attempting to read claims 1 and 24 on the prosthetic foot of Robinson, the examiner has taken the position (answer, page 3) that elements 78 and 14 of Robinson correspond to the claimed first spring element, that element 58 of Robinson corresponds to the claimed second spring element, and that element 12 of Robinson corresponds to the "adapting device" of claim 1 and the "means . . . for changing" of claim 24. It is not entirely clear from the examiner's explanation of the rejection in the answer how the

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[4]See, for example, page 5, lines 3-9; page 6, lines 20-24; page 7, lines 5-12; and, page 9, lines 18-19.

[5]We note that the examiner has not provided an alternative interpretation of the terminology in question.

examiner reads the above quoted limitations of the last paragraphs of claims 1 and 24 calling for a change in the bending resistance *of the forefoot leaf spring* in response to a load being placed on the artificial foot on Robinson's prosthetic foot. In this regard, the examiner's comments on page 8 of the answer regarding an alleged change in bending resistance of Robinson's pad 78 does not suffice, as this element is not a leaf spring.

In any event, assuming that the examiner is correct in finding that the combination of elements 14 and 78 of Robinson corresponds to the claimed first spring element comprising at least one forefoot leaf spring, a position with which we do not necessarily agree, Robinson does not disclose anything that directly results in a physical change in element 14, the only element of Robinson that can reasonably be considered a forefoot leaf spring, to effect a change in its characteristic resistance to bending in response to a load being placed on the artificial foot which causes flexing of the second spring element. Rather, Robinson indicates that element 14 is fabricated to achieve a desired flexing action based on the individual needs of each user (column 5, lines 46-50; column 5, line 62, through column 6, line 8), such that the characteristic resistance to bending of element 14 does not change during use. On this basis alone, the examiner's anticipation rejection of claims 1 and 23-29 based on Robinson cannot be sustained.

In addition, the examiner has not established that the arrangement of Robinson is a 35 U.S.C. § 112, sixth paragraph, equivalent of any of the embodiments disclosed by appellants for accomplishing the functions recited in the last paragraph of claim 24.

Hence, appellants' argument (main brief, page 9) in this regard with respect to claim 24 also is well taken, thereby providing an additional basis for not sustaining the anticipation rejection of claims 24 and 28 based on Robinson.

The anticipation rejection based on Phillips

In this rejection, the examiner finds correspondence between lower foot plate 22 of Phillips and the claimed first spring element comprising at least one forefoot leaf spring, correspondence between upper ankle plate 24 of Phillips and the claimed second spring element located at least in part in the heel region, and correspondence between foam block 26 of Phillips and the adapting device of claim 1 and means for changing of claim 24. Be that as it may, we perceive nothing in Phillips that can reasonably be considered as satisfying the requirements of the last paragraphs of claims 1 and 24 regarding changing the "spring rigidity" and "bending resistance" of the forefoot leaf spring in response to a load being placed on the artificial foot which causes flexing of the second spring element. More particularly, nothing in Phillips indicates that flexing of foam block 24 directly results in a physical change in element 14 to effect a change in its characteristic resistance to bending in response to a load being placed on the artificial foot which causes flexing of the second spring element. For this reason, the examiner's anticipation rejection based on Phillips cannot be sustained.

Likewise, the examiner has not established that the arrangement of Phillips is a 35 U.S.C. § 112, sixth paragraph, equivalent of any of the embodiments disclosed by appellants for accomplishing the functions recited in the last paragraph of claim 24. Hence, appellants' argument (main brief, page 11) in this regard with respect to claim 24 also is well taken, thereby providing a further basis for not sustaining the anticipation rejection of claims 24 and 28 based on Phillips.

CONCLUSION

Each of the standing rejections is reversed.

The decision of the examiner finally rejecting the appealed claims is reversed.

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)

LJS/dal

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