

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICHOLAS J. CHAPMAN

Appeal No. 96-4149
Application 08/276,436¹

ON BRIEF

Before MEISTER, STAAB and GONZALES, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final

¹ Application for patent filed July 18, 1994.

Appeal No. 96-4149
Application 08/276,436

rejection of claims 1 to 7, all the claims currently pending in the application. An amendment filed subsequent to the final

rejection (Paper No. 6, filed April 1, 1996) has not been entered. See the examiner's advisory letter (Paper No. 9, mailed April 25, 1996).

Appellant's invention pertains to a method and apparatus for securing, and preventing violent movement of, heavy objects, such as water heaters or other appliances, in the event of an earthquake. Claim 1, a correct copy of which can be found in the appendix to the supplemental examiner's answer (Paper No. 12, mailed April 18, 1997) is representative of the appealed subject matter.

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

Horvath 1990	4,955,573	Sept. 11,
Mayr 4, 1991	5,020,760	Jun.
Daubenspeck 1993	5,190,260	Mar. 2,

Appeal No. 96-4149
Application 08/276,436

The following rejections under 35 U.S.C. § 102(b) are before us for review:²

(1) claims 1 to 5 and 7, as being anticipated by Horvath;

(2) claims 1 to 5 and 7, as being anticipated by Daubenspeck; and,

(3) claims 1, 4 and 6, as being anticipated by Mayr.

The rejections are explained in the examiner's answer (Paper No. 10, mailed July 8, 1996).

The opposing viewpoints of appellant are set forth in the brief (Paper No. 7, filed April 1, 1996).

OPINION

We have encountered substantial difficulty determining the metes and bounds of appellant's claims. Independent method claim 1 is directed to the method of restraining an object from violent movement. The method includes the step of fastening a first bracket to a structure "in such a manner that the bracket can undergo slight, controlled, movement with relation to the structure under conditions of stress to the

²The final rejection (Paper No. 4, mailed October 30, 1995) also included a rejection of claim 3 under 35 U.S.C. § 112, second paragraph, however, this rejection has since been withdrawn by the examiner. See page 2 of the answer.

structure." Independent apparatus claim 4 is directed to an apparatus to restrain movement of an object associated with a structure which is subjected to severe physical shock. The apparatus includes a first bracket fastened to the structure "in such manner that the structure may move a controlled amount with relation to the position of the bracket in a limited, and repeated manner." Independent claims 6 and 7 contain similar limitations. In appellant's specification (e.g., paragraph spanning pages 7 and 8), we are informed that movement of the bracket relative to its

supporting structure is accomplished by holes 23 in the bracket that are oversized relative to the shanks of the lag bolts 24 to allow for sufficient movement for dampening, or shock absorbing movement. It is clear to us, however, that clearance between the bracket holes and the lag bolts is but one of several factors that would have an effect on the sort of controlled movement called for in the claims. Of paramount importance, in our view, is the amount of friction between the bracket and the supporting structure at their interface, which

is influenced by, among other things, the degree to which the lag bolts are tightened and the coefficients of friction of the materials of the bracket and the supporting structure. In addition, appellant indicates in the brief (see page 2) that the capacity of the brackets to temporarily bend and distort also has an effect on the ability of appellant's device to control movement.³ Moreover, there is the question of the threshold amount of force required to initiate the controlled movement.

In the present instance, appellant's specification and claims are devoid of any guidelines whatsoever regarding how the

tightening of the lag bolts, the coefficients of friction of the bracket and supporting structure, and/or the bending strength of the brackets affect the ability of appellant's device to provide the desired result, i.e., the controlled

³It is noteworthy that appellant's specification is silent as to how temporary bending and distortion of the bracket might bring about the sort of controlled movement desired here.

Appeal No. 96-4149
Application 08/276,436

movement of the bracket relative to its supporting structure to provide a dampening effect "much like the effect of a spring, shock absorber, or the like" (specification, page 5) for a given force. Accordingly, we are left to speculate as to just which combinations of brackets secured to supporting structures by fasteners with clearance between a bracket aperture and a fastener would fall within the metes and bounds of the claims and which would not. Stated differently, while any bracket and strap restraint arrangement wherein the bracket is secured to a supporting structure by a fastener extending through an aperture in the bracket with clearance would meet the broad structural and step requirements of the appealed claims, it is not clear which of these restraint arrangements appellant intends to exclude through the use of language such as "in such a manner that the bracket can undergo slight, controlled, movement with relation to the structure under conditions of stress to the structure" (claim 1) and "in such manner that the structure may move a controlled amount with relation to the position of the bracket in a limited, and repeated manner" (claim 4).

Appeal No. 96-4149
Application 08/276,436

While we might speculate as to the scope of the appealed claims, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art as we are obliged to do. Rejections based on prior art should not be based upon considerable speculation as to the meaning of terms employed and assumptions as to the scope of the claims. See *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become unpatentable over the prior art, but rather the claim becomes indefinite. See *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Accordingly, we are constrained to reverse the examiner's rejections of claims 1 to 5 and 7 as being anticipated by Daubenspeck, and claims 1 and 4 as being anticipated by Mayr. We hasten to add that reversal of these rejections is not based on the merits of the above-noted rejections, but rather is a procedural reversal predicated on the indefiniteness of the claimed subject matter.

Considering the examiner's rejection of claims 1 to 5 and

7 as being anticipated by Horvath, and claim 6 as being anticipated by Mayr, as is apparent from the previous paragraph, normally a

claim whose scope is indeterminate will not be analyzed as to whether it is patentable over the prior art, since to do so would of necessity require speculation with regard to the metes and bounds of the claimed subject matter. Nevertheless, with respect to the anticipation rejection of claims 1 to 5 and 7 based on Horvath and claim 6 based on Mayr, we are of the opinion that these rejections cannot be sustained on the basis of those portions of the claims that are understandable.

Considering the anticipation rejection based on Horvath, each of appealed claims 1 to 5 and 7, in one form or another, requires that the strap-like member be fastened to the bracket.⁴ Since the strap-like member 1 and brackets 2 of Horvath are not fastened to each other, but are instead merely

⁴Consistent with appellant's specification and claims, we interpret the terminology of the claims calling for the strap-like member to be fastened to the bracket as meaning that strap-like member is *directly* fastened to the bracket.

Appeal No. 96-4149
Application 08/276,436

individually fastened to the support channel 10, it cannot be said that Horvath anticipated claims 1 to 5 and 7. As to the anticipation rejection of claim 6 based on Mayr, claim 6 requires that the first bracket has an elongated slot wider than the width of the strap-like member to allow movement of the strap relative to the first

bracket. Notwithstanding the examiner finding that Mayr's buckle 75 is configured "to accommodate the width of the belt or strap [79]" (answer, page 4), we see nothing in Mayr that meets the elongated slot limitation of claim 6. In light of the foregoing, it is clear that the § 102 rejection of claims 1 to 5 and 7 as being anticipated by Horvath, and the § 102 rejection of claim 6 as being anticipated by Mayr, cannot be sustained. We therefore reverse these rejections on the merits.

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

Claims 1 to 7 are rejected under 35 U.S.C. § 112, second paragraph.

Appeal No. 96-4149
Application 08/276,436

While we are mindful that appellant is free to claim his invention in broad terms and in language of his own choosing, we must also remember that because a patentee has a right to exclude others from making, using and selling the invention covered by a patent (35 U.S.C. § 154), the public must be appraised of exactly what the patent covers, so that those who would approach the area circumscribed by the claims of the patent may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. It is to

this end that the second paragraph of 35 U.S.C. § 112 is directed. See *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). The inquiry, as stated in *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971) is:

. . . whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. . . . [T]he definiteness of the language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular

Appeal No. 96-4149
Application 08/276,436

application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

Moreover, no claim may be read apart from and independent of its supporting disclosure, and claim language which otherwise appears to be definite, may take on an unreasonable degree of uncertainty when read in light of the supporting specification. *In re Cohn*, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971); *In re Moore*, 439 F.2d at 1235 n.2, 169 USPQ at 238 n.2.

For the reasons stated in our procedural reversal of the standing rejections of claims 1 to 5 and 7 as being anticipated by Daubenspeck, and claims 1 and 4 as being anticipated by Mayr, we do not believe that the language of the appealed claims provides adequate notice to the public of what the claims cover to enable an accurate determination of the boundaries of

protection involved. Specifically, the claims do not allow one of ordinary skill in the art to determine with any

reasonable degree of certainty whether a device that meets the structural and step requirements of the appealed claims also meets the broadly worded functional statements of the claims⁵, so as to determine if, in fact, the device in question is or is not covered by the claims.

Claims 1 to 7 are also rejected under 35 U.S.C. § 112, first paragraph, as being based on a disclosure that fails to comply with the enablement requirement of the first paragraph of the statute.

The test regarding enablement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See *In re Moore*, 439 F.2d at 1236, 169

⁵These include: fastening a first bracket to a structure "in such a manner that the bracket can undergo slight, controlled, movement with relation to the structure under conditions of stress to the structure" as set forth in method claim 1, and the similar language in method claim 7; a first bracket "fastened to the structure in such manner that the structure may move a controlled amount with relation to the position of the bracket in a limited, and repeated manner" as set forth in apparatus claim 4; and holes in a first bracket that are "enlarged with respect to the size of the bolts so that limited movement of the first bracket with respect to the structure may be accomplished" as set forth in apparatus claim 6.

Appeal No. 96-4149
Application 08/276,436

USPQ at 239 and *In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 305 (CCPA 1974). The experimentation required, in addition to not being undue, must not require ingenuity beyond that expected of one of ordinary skill in the art. See *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

We find the invention as disclosed by appellant to be both confusing and incomplete with regard to some of the essential details of the invention, like the amount of tightening of the lag bolts, and the particulars of the coefficients of friction of the bracket and support structure at their interface, required to achieve the type of "slight, controlled, movement" (claims 1 and 7), "controlled amount" of movement (claim 4) and/or "limited movement" (claim 6) desired to restrain a given mass (i.e., object to be restrained) in response to a given shock force (i.e., earthquake magnitude). We also find appellant's disclosure to be particularly devoid of any guidance as to how to design a restraint that "resists, relaxes, resists, and relaxes in successive stages until the movement [of the structure?] has subsided" in response to a violent physical shock, as called for in method claim 3.

Appeal No. 96-4149
Application 08/276,436

Appellant has provided no guidance whatsoever as to the details of the apparatus with respect to these essential details and no insights into how one would go about

determining them for a given mass to be restrained in response to a given shock force. In addition, given the specification's silence as to any bending of the brackets acting to achieve appellant's desired result, the discussion on page 2 of the brief regarding bending and temporary distortion of the brackets only adds to the confusion. Given the ambiguity of the disclosure concerning exactly how to provide for "a dampening effect - much like the effect of a spring, shock absorber, or the like" or "regulated dampening effect" (specification, page 5), we find that one of ordinary skill in the art would be unable to make and use the claimed invention (method and apparatus) without undue experimentation.

SUMMARY

The rejection of claims 1 to 5 and 7 as being anticipated by Horvath (rejection (1)) is reversed *on the merits*.

Appeal No. 96-4149
Application 08/276,436

The rejection of claims 1 to 5 and 7 as being anticipated by Daubenspeck (rejection (2)) is reversed *on procedural grounds*.

The rejection of claims 1, 4 and 6 as being anticipated by Mayr (rejection (3)) is reversed, the reversal being *on procedural grounds* with respect to claims 1 and 4 and being *on the merits* with respect to claim 6.

In addition, pursuant to 37 CFR § 1.196(b), new rejections of claims 1 to 7 under 35 U.S.C. § 112, first and second paragraphs, have been made.

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,

Appeal No. 96-4149
Application 08/276,436

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 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).

The decision of the examiner is reversed.

REVERSED; 37 CFR § 1.196(b)

Appeal No. 96-4149
Application 08/276,436

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Administrative Patent Judge)	
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LAWRENCE J. STAAB)	
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