

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(2) is not binding precedent of the Board.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. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN W. VROLYKS

Appeal No. 97-1079
Application 08/562,471¹

ON BRIEF

Before, COHEN, MEISTER and McQUADE, ***Administrative Patent Judges.***

MEISTER, ***Administrative Patent Judge.***

DECISION ON APPEAL

Jan W. Vrolyks (the appellant) appeals from the final rejection of claims 1, 2, 4, 5, 7 and 8, the only claims remaining in the application.

¹Application for patent filed November 24, 1995. According to appellant, this application is a continuation of Application no. 08/380,492, filed January 30, 1995.

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We REVERSE and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), enter a new rejection of the appealed claims under 35 U.S.C. § 112, second paragraph.

The appellant's invention pertains to a ladder safety attachment. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the appellant's brief.

The references relied on by the examiner are:

Lamp	467,468	Jan. 19, 1892
Schwarting	619,235	Feb. 07, 1899
Kummerlin	4,359,138	Nov. 16, 1982

Claims 1, 2, 4, 5, 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kummerlin in view of either Lamp or Schwarting. Normally claims which fail to comply with the second paragraph of § 112 will not be analyzed as to whether they are 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. **See In re Steele**, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and **In re Wilson**, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Nevertheless, in this instance, we are able to reach the question of patentability

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over the prior art based on those portions of the claims which are understandable.

It is the examiner's position that:

Kummerlin (7) shows the claimed ladder and attachment with the exception of the claimed foot pad section. Both Lamp and Schwarting show foot pad sections as claimed to prevent slipping. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tips of Kummerlin's legs to comprise pad sections as claimed in lieu of his plates (114') to prevent slipping of his ladder. [Answer, page 3.]

In support of this position the answer states:

The examiner's [sic, examiner] notes that while Kummerlin does not show or state that his u-shape[d] frame (112) pivots between a forwardly and rearwardly position, the structural pivot connection (see fig. 8) between support frame (103) and u-shaped frame (112) [sic, (112) allows for such pivoting. Kummerlin's support frame (103) lies in a first plane defined by and from the outer edge of hook (104) to the outer edge of arms (103'), and the pivot axis of the u-shape[d] frame is located in arms (103'), and the pivot axis of the u-shape[d] frame is located in the arms (103'), therefore, the pivot axis lies both within the plane of the u-shaped frame and the plane of the support frame. [Page 4.]

We will not support the examiner's position. Initially, we cannot agree with the examiner that Kummerlin in Fig. 8 teaches that the U-shaped frame 112 is "pivotally mounted" on the supporting frame 103' so as to be "pivotable about a pivot axis relative to said supporting frame" as expressly required by

independent claim 1. Terms in a claim should be interpreted in a manner consistent with the specification and construed as those skilled in the art would construe them (*see In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990), *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)). Here, the appellant's specification teaches that the supporting frame is provided with a hollow tube 82 and that the U-shaped frame is provided with a main central support tube 108 that is coaxially received within the hollow tube 82, which arrangement allows "pivoting of the main support 108 [and hence the U-shaped frame] from the dotted line position to the solid line position shown in Figure 6" (page 15, lines 20 and 21).² In *Kummerlin*, however, the U-shaped frame 112 is mounted between spaced parallel arms 103'. Both the central portion of the U-shaped frame and the spaced parallel arms are provided with spaced apertures and a pin 121 is provided which

² We observe that in Fig. 5 the portion of the member 108 which is illustrated as crossing the side rails 74, 76 of the ladder with hidden or dashed lines should, instead, be illustrated with solid lines. We also observe that in Fig. 6 that portion of the U-shaped member which is illustrated as crossing the side rail 76 of the ladder with solid lines should, instead, be illustrated with hidden or dashed lines.

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may be inserted through the apertures in the spaced parallel arms and the central portion of the U-shaped frame in order to retain the frame in a desired position. The U-shaped frame may be angularly adjusted by (1) removing the pin from the apparatus, (2) manually grasping the frame, (3) manually **supporting** (at least against lateral movement as depicted in Fig. 8) and simultaneously angularly adjusting the position of the frame and (4) reinserting the pin through either the same or different apertures in the arms and through different apertures in the central portion of the U-shaped frame. It is thus readily apparent that in the appellant's device a clearly defined pivot axis (that is always constrained to be positioned at a fixed location) is provided by the coaxial members 82 and 108 whereas in Kummerlin any axis of rotation is at least in part defined by the hand of the hand of a user (and thus is not necessarily always constrained to be positioned at a fixed location). In our view the artisan, consistent with the appellant's specification, would not construe the arrangement of Kummerlin to fairly teach a U-shaped frame that is "pivotally mounted" on a supporting frame so as to be "pivotable about a pivot axis relative to said supporting frame" as set forth in independent claim 1.

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Even assuming that Kummerlin teaches a pivotal mounting and pivot axis as claimed, the axis would not be located "within both said first plane and second plane" as claimed. That is, the supporting frame is defined by independent claim 1 as being located in the first plane that in turn is defined as being parallel to the longitudinal plane of the ladder. Consistent with the appellant's specification, one of ordinary skill in this art would interpret the first plane to pass through the members 106, 107 of Kummerlin, which plane is clearly offset from the location where the U-shaped frame 112 is angularly adjusted (see Fig. 8).

Although Kummerlin states that the embodiment of Figs. 7 and 8 "can be used as desired as wall spacer, ladder stiffener or ground leveling base," we find nothing in the combined teachings of Kummerlin and either Lamp or Schwarting which would fairly suggest the placement on the U-shaped supporting frame 112 of Kummerlin an "impaling device" which is "available to penetrate a **vertical** wall surface" as set forth in independent claim 1. While both Lamp and Schwarting teach impaling devices, such devices are on the end of crutches which engage the **ground**.

In view of the foregoing, we will not sustain the rejection

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of claims 1, 2, 4, 5, 7 and 8 under 35 U.S.C. § 103 as being unpatentable over Kummerlin in view of either Lamp or Schwarting.

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

Claims 1, 2, 4, 5, 7 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention. The purpose of the second paragraph of § 112 is to provide those who would endeavor, in future enterprises, to approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). Moreover, in order to satisfy the requirements of the second paragraph of § 112, a claim must accurately define the invention in the technical sense. *See In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). In addition, in determining the definiteness of a claim, the terminology employed therein may not be read apart from and independent of the supporting disclosure

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on which it is based. *See In re Cohn*, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971).

Applying these principles to the present case, we are of the opinion that the recitations in independent claim 1 of (1) the impaling device "being locatable in either an extended position or a retracted position" and (2) "each foot pad section being retractable locating of its respective said impaling device" introduce uncertainty into the claim which would preclude one skilled in the art from determining the metes and bounds of the claimed subject matter. As to limitation (1), the appellant's impaling device 154 is not "locatable" in either an extended or retracted position as set forth. Instead, it is the sleeve 152 and the attached foot pad 166 which are extended (and either locked in the extended position or yieldingly maintained in the extended position by the bias of spring 162) and retracted so as to either cover or uncover the **stationary** impaling device 154. Thus, not only does this limitation fail to accurately define the invention in the technical sense, but the language thereof, when read in light of the appellant's own disclosure, results in an inexplicable inconsistency that renders independent claim 1 indefinite. As to limitation (2), while it is clear that each

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foot pad section 166 extends and retracts (by virtue of the fact that it is mounted on a sleeve 152) so as to cover and uncover empaling device 154, the meaning of "retractable locating" in the context of independent claim 1 is totally unclear.

In summary:

The rejection of claims 1, 2, 4, 5, 7 and 8 under 35 U.S.C. § 103 is reversed.

A new rejection of claims 1, 2, 4, 5, 7 and 8 under 35 U.S.C. § 112, second paragraph, has 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, 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

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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).

REVERSED

37 CFR § 1.196(b)

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Administrative Patent Judge)	
)	
)	
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