

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BRETT McBRYDE

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Appeal No. 98-2086  
Application 08/539,353<sup>1</sup>

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ON BRIEF

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

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Brett McBryde appeals from the final rejection of claims 1 through 3, 5 and 6, all of the claims pending in the application. We reverse and enter new rejections pursuant to 37 CFR § 1.196(b).

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<sup>1</sup> Application for patent filed October 5, 1995.

The invention relates to "the field of devices used by musicians and others for the safekeeping of stringed instruments having 'necks' such as guitars, violins, violas, bass fiddles, ukuleles, mandolins, bass guitars, banjos and the like" (specification, page 1). Claim 1 is illustrative and reads as follows:

1. An apparatus for locking musical instruments having necks to a fixed structure comprising:

first and second relatively rigid arms;

each of said relatively rigid arms having length and thickness and having a first straight portion and a second curved portion forming a right angle at the point of connection of said portions;

each of said relatively rigid arms having a thickness small compared to the length of each said arm;

said rigid arms forming a single closed essentially semicircular loop when mutually engaged;

said first and second arms formed into mirror images of each other for engaging the neck of the musical instrument;

each of said arms has first and second engaging means formed thereon for engaging the other arm; said first arm first engaging means is formed into an eye means;

said second arm first engaging means is formed into an eye means;

said first and second arms second engaging means are formed into first and second mating cylinder members which when engaged form a hinge means for permitting the relative

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rotation of the first arm with respect to the second arm.

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

Grisel	4,059,209	Nov. 22, 1977
McIntosh et al. (McIntosh)	5,544,505	Aug. 13, 1996
	(§ 102(e) date of Nov. 28,	
1994)		

Claims 1, 2 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Grisel, and claims 3 and 6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McIntosh.

Reference is made to the appellant's main and reply briefs (Paper Nos. 21 and 23) and to the examiner's final rejection and answer (Paper Nos. 12 and 22) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

Turning first to the § 102(b) rejection of claims 1, 2 and 5, Grisel discloses a carrier "used by skiers in the carrying of their skis and poles and . . . to secure such equipment against theft when it is not in use" (column 1, lines 6 through 9). The carrier 10 consists of a pair of side

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frames 11, 12 which are hinged together at 13 to allow them to be pivoted together in clamshell-type fashion. The side frames include resilient strips 16 on their inner surfaces for gripping the ski equipment, latches/catches 23, 24, 26 and 27 for securely clamping them together, and tubular locking members 30, 31. The locking members 30, 31 are designed to telescope over posts 32, 33 on a backing member 36 mounted to a building wall or similar structure. Tubular member 30 contains a lock 38 adapted to engage a hole 37 in post 32 to secure the carrier 10 to the backing member 36.

Anticipation is established only when a single prior art reference discloses, expressly or under 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).

The appellant's contention (see pages 4 and 5 in the main brief) that the carrier disclosed by Grisel does not include first and second arms of the type required by independent claim 1 is well taken. By way of example, one of the claim limitations in question calls for the arms to form "a single closed essentially semicircular loop when mutually engaged."

Notwithstanding the examiner's rather strained arguments to the contrary (see page 3 in the answer), no parts of the Grisel carrier arguably meeting the other arm recitations in claim 1 also meet this particular limitation. Grisel also fails to respond to the recitation in claim 1 that each of the arms has a first engaging means formed thereon for engaging the other arm wherein each such means is formed into an eye means. The examiner's reliance on Grisel's tubular locking members 30, 31 to meet this limitation (see page 3 in the final rejection) is unsound because neither of these elements is involved in engaging the other "arm" of the Grisel carrier.

Thus, Grisel does not disclose each and every element of the invention set forth in claim 1 or in claims 2 and 5 which depend therefrom. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of these claims as being anticipated by Grisel.

As for the § 102(e) rejection of claims 3 and 6, McIntosh discloses a lock bracket "for securing together two adjacent objects such as a gate and a fence post" (column 1, lines 4 and 5). The embodiment illustrated in Figures 1 and 2 has two

bracket members 1, 2 joined by a hinge 4. Each of the bracket members includes an apertured plate 5, 6 which is adapted to align with the other plate to receive a padlock when the bracket is closed. In the embodiment illustrated in Figure 3, the hinge 4 is replaced by a sliding connection formed by a housing 17 on one of the bracket members and an extended end 18 and stopper 19 on the other bracket member.

Claim 3 depends from claim 1 and requires the first and second arms to respectively have an aperture in and an "L" shaped member connected thereto, with the "L" shaped member adapted to fit inside of the aperture for relative rotation such that the first arm is able to rotate relative to the second arm. Here again, the appellant's contention (see pages 5 and 6 in the main brief) that the lock bracket disclosed by McIntosh does not include such structure is well taken. The examiner's insistence that McIntosh's housing 17, extended end 18 and stopper 19 constitute an aperture and "L" shaped member which allow relative rotation of the sort set forth in claim 3 (see page 3 in the final rejection and page 4 in the answer) is unsupported by, and indeed is inconsistent with, McIntosh's disclosure. Moreover, the examiner's reliance on the separate

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embodiments of the McIntosh lock bracket shown in Figures 1 and 2 and in Figure 3, respectively, to cover all of the limitations in dependent claim 3 and its parent claim 1 (see pages 3 and 4 in the final rejection) is also unsound. Anticipation is not established if in reading a claim on something disclosed in a reference it is necessary to pick, choose and combine various portions of the disclosure not directly related to each other by the teachings of the reference. In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

Thus, McIntosh does not disclose each and every element of the invention set forth in claim 3 or in claim 6 which depends therefrom. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(e) rejection of these claims as being anticipated by McIntosh.

The following rejections are entered pursuant to 37 CFR § 1.196(b).

Claim 3, and claim 6 which depends therefrom, are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of § 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 determining whether this standard is met, the definiteness of the language employed 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.

In the present case, the appellant's disclosure indicates that the aperture and "L" shaped member recited in claim 3 and the first and second mating cylinder members which form a hinge means recited in parent claim 1 are mutually exclusive characteristics of different locking apparatus embodiments. The recitation of both in claim 3 by virtue of its dependency from claim 1 renders the scope of claims 3 and 6 unclear.<sup>2</sup>

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<sup>2</sup>Although the following informalities are not serious enough in and of themselves to render the involved claims indefinite, they are nonetheless deserving of correction in the event of further prosecution before the examiner. The preambles of dependent claims 2, 5 and 6 ("The locking means . . .") is inconsistent with the preamble and ultimately recited

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Claims 3 and 6 are also rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with both the written description and enablement requirements of this section of the statute.<sup>3</sup>

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The disclosure of the appellant's application as originally filed lacks any basis for the subject matter now

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subject matter of parent claim 1 ("An apparatus for locking . . .). In claim 3, the references to "said first straight member" lack a proper antecedent basis ("member" should be -- portion-- for consistency with preceding claim terminology). Finally, claim 3 should end with a period rather than a comma.

<sup>3</sup>The written description and enablement requirements of 35 U.S.C. § 112, first paragraph, are, of course, separate and distinct. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

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recited in claim 3 which includes both an aperture and "L" shaped member (claim 3) and first and second mating cylinder members which form a hinge means (parent claim 1). Thus, the originally filed disclosure would not reasonably convey to the artisan that the appellant had possession at that time of the subject matter presently recited in claims 3 and 6.

Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982).

The brief discussion of the aperture and "L" shaped member on page 4 of the appellant's specification and the extremely ambiguous and inconsistent showing of same in Figures 6 through 9 would not have enabled one of ordinary skill in the art to make and use the invention set forth in claims 3 and 6 without undue experimentation.

In summary and for the above reasons:

a) the decision of the examiner to reject claims 1, 2 and

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5 under 35 U.S.C. § 102(b) and claims 3 and 6 under 35 U.S.C. § 102(e) is reversed; and  
b) new rejections of claims 3 and 6 are entered 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. 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 grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment

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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)

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

JPM/caw

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