

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARRY S. MAY

Appeal No. 99-0622
Application No. 08/637,717¹

ON BRIEF

Before ABRAMS, NASE, and 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 25 through 39 and 41 through 55, which are all of the claims pending in this application.² The examiner

¹ National stage application under 35 U.S.C. § 371 of international Application PCT/GB94/02719, filed December 13, 1994, which claims priority under 35 U.S.C. §§ 119(a) and 365(b) based on United Kingdom Application 9325508.1, filed December 14, 1993.

² Claim 40 was canceled and claims 42 and 52 were amended in the amendment after final filed June 12, 1998 with the appeal brief.

withdrew the rejections of claims 31 through 35 and 42 through 55 under 35 U.S.C. § 112, second paragraph³, claims 48 and 51 under 35 U.S.C. § 102(b) and claims 32 through 35, 38, 49, 53 and 55 under 35 U.S.C. § 103 in the answer (see top of page 4). Accordingly, the claims involved in this appeal are claims 25 through 31, 36, 37, 39, 41 through 47, 50, 52 and 54. We note that the examiner's addition of a new ground of rejection of claim 44 under 35 U.S.C. § 102 as being anticipated by Leach in the answer (page 3) was not in compliance with 37 CFR § 1.193(a)(2) (added effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 121 (Oct. 21, 1997)). Our treatment of the rejection infra, however, ensures that the appellant suffers no prejudice from the inclusion of this new ground of rejection.

We REVERSE and enter a new ground of rejection pursuant to the provisions of 37 CFR § 1.196(b).

³ We interpret the examiner's reference to the 35 U.S.C. § 112, second paragraph, rejection on page 4 of the answer merely as notice that, in view of the latitude the examiner has afforded the appellant in defining "intermediate" in claim 31 by withdrawing the 35 U.S.C. § 112 rejection, the term "intermediate" is read by the examiner with similar breadth in assessing the claims in view of the prior art. It is not interpreted as a statement of intent to maintain the 35 U.S.C. § 112 rejection.

BACKGROUND

The appellant's invention relates to a fall arrest apparatus to be worn by workers at risk of falling from a structure such as a tree, pole or building. The apparatus utilizes support straps having connections to a harness or belt worn by the user which rupture upon application of a force exceeding a threshold level to sever any connections between the strap and locations on the harness or belt disposed at or below the waist of the worker. An understanding of the invention can be derived from a reading of exemplary claims 25, 42 and 52, which appear in the appendix to the appellant's brief.⁴

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

Dalmaso	4,253,544	Mar. 3, 1981
Leach	5,325,818	Jul. 5, 1994
		(filed Aug. 4, 1993)
Brda	3,604,973	Aug. 20, 1987

⁴ The copy of claim 52 in the appendix to appellant's brief contains two minor errors relative to claim 52 as amended in Paper No. 11. Specifically, the phrase "adapted to be" has inadvertently been inserted in line 9 instead of line 12.

(German Patent document)⁵

The following rejections are before us for review.

1. Claims 42, 44 through 47 and 50 stand rejected under 35 U.S.C. § 102(b)⁶ as being anticipated by Leach.
2. Claim 52 stands rejected under 35 U.S.C. § 103 as being unpatentable over Leach.
3. Claims 43 and 54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Leach in view of Dalmaso.
4. Claims 25 through 27, 30, 31, 36, 37 and 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Leach in view of Brda.
5. Claims 28, 29 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Leach in view of Brda, as applied above, and further in view of Dalmaso.

⁵ An English language translation of this reference, prepared by the Patent and Trademark Office, is appended hereto.

⁶ We note that the filing date of this application is December 13, 1994, its international filing date, under 35 U.S.C. § 363. Accordingly, the Leach patent, which was not patented until July 5, 1994, is not available as prior art to this application under 35 U.S.C. § 102(b). It is, however, available as prior art under 35 U.S.C. § 102(e). Our treatment of this rejection in the opinion section below will, thus, focus on whether Leach anticipates the claims.

The complete text of the examiner's rejections and response to the argument presented by the appellant appears in the answer (Paper No. 13, mailed September 14, 1998), while the complete statement of the appellant's argument can be found in the brief (Paper No. 11 ½, filed June 12, 1998).

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.

We shall not sustain the examiner's rejection of claims 42, 44 through 47 and 50 under 35 U.S.C. § 102(b) as anticipated by Leach.

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.), cert dismissed, 468 U.S. 1228 (1984).

The examiner asserts that Leach discloses all positively claimed elements, including "a harness, an anchorage point (36), a connection point (16,18), a connector (42,26,20)" (answer, page 4). We agree with the appellant's argument that the connecting strap 20 cannot be interpreted as both an essential part of the harness and a connector recited in addition to the harness (brief, page 6).

The connecting strap (20) of Leach is required, in combination with the waistband (12) and shoulder straps (22, 24), to form a harness "sized and configured to be secured about a person's body" in the manner set forth in claim 42. The connecting strap (20), as a necessary part of the recited harness, cannot also be interpreted, for purposes of anticipation, as any of the portions of the connector, which are recited in claim 42 as elements in addition to the harness. See In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

While Leach does disclose a tether strap (42) adapted to be secured to a support structure and a fastening strap (26) secured to the buckle rod (36), Leach does not disclose any additional element responding to the recited second portion of the connector.

For the reasons discussed above, we cannot sustain the examiner's rejection of independent claim 42, or claims 44 through 47 and 50 which depend therefrom, under 35 U.S.C. § 102(b).

Turning now to the rejection of claim 43 under 35 U.S.C. § 103 as being unpatentable over Leach in view of Dalmaso, we have reviewed the teachings of Dalmaso, but find nothing therein to overcome the deficiencies of Leach discussed above.⁷ It follows then that we must also reverse the standing rejection of claim 43, which depends from claim 42, under 35 U.S.C. § 103.

⁷ Furthermore, we note for the record that we agree with the appellant's argument that there is no teaching to combine Leach and Dalmaso as proposed by the examiner (brief, page 8). The energy absorbing lanyard of Dalmaso is disclosed for checking the fall of a worker (column 1, lines 11 through 16). The worker is decelerated gradually rather than being jerked to an abrupt halt (column 1, lines 16 through 35). As the harness of Leach is not disclosed for use in checking a person's fall, it is not apparent why one of ordinary skill in the art would have been led to add an energy absorbing unit on the Leach device.

We shall not sustain the rejection of claim 52 under 35 U.S.C. § 103 as being unpatentable over Leach.

Claim 52 recites that the first and second connectors be interconnected to form junctures which will withstand forces in excess of approximately 2.5 kN and that the forward and rearward segments of the belt be interconnected to form a juncture which will rupture when subjected to a force in excess of approximately 2.5 kN. Leach does not disclose the capacity of any of the junctures or connection points of the restraining device. The examiner submits that "[t]o form the juncture to withstand a force as desired, would have been an obvious mechanical expedient" (answer, page 3) and "[t]o substitute other conventional releasable fastener [*sic*], e.g., buttons, buckles, etc., which will withstand forces as desired is within the scope of one of ordinary skill in the art" (answer, page 4).

We note, however, that rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded

assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). Moreover, the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The device of Leach is intended for use in restraining a small child, either in an ambulatory state or seated in a grocery cart or chair (column 1, lines 7 through 13). As the device would not be expected to be subjected to forces even approaching 2.5 kN in either of these applications, it is not apparent to us why one of ordinary skill in the art would have been led to provide connections, such as the stitches (41) or the buckle (30), to withstand forces in excess of approximately 2.5 kN.

Therefore, we cannot sustain the standing rejection of claim 52 under 35 U.S.C. § 103 as being unpatentable over Leach.

With regard to the rejection of claim 54 under 35 U.S.C. § 103 as being unpatentable over Leach in view of Dalmaso, we have reviewed the teachings of Dalmaso, but we find nothing therein which overcomes the deficiencies of Leach discussed above with regard to claim 52. It follows then that we cannot sustain the standing rejection of claim 54, which depends from claim 52, under 35 U.S.C. § 103.

Turning now to the rejection of claims 25 through 27, 30, 31, 36, 37 and 39 under 35 U.S.C. § 103 as being unpatentable over Leach in view of Brda, claim 25 reads as follows:

25. A safety harness, comprising:

left and right leg loops;

left and right shoulder straps; and

a connecting means for connecting the harness to a support structure in such a manner that at least one relatively weaker juncture disposed between the support structure and the harness will rupture when subjected to a force in excess of a threshold amount, and at least one relatively stronger juncture disposed between the support structure and the harness will remain secure when subjected to a force in excess of the threshold amount . . .

We note that the "connecting means" is recited as part of the safety harness.

The examiner has identified the rear or free end (18) as the "relatively weaker juncture," the box stitch (41) or buckle rod (36) as the "relatively stronger juncture" and the tether strap (42) and strip (40) as at least part of the "connecting means" (answer, page 5). Since the "connecting means" is defined in claim 25 as part of the safety harness, as opposed to additional structure in combination with the safety harness, the tether strap (42) and strip (40) must be considered part of the harness when reading the claim on the Leach device. Consequently, the junctures (18) and (41) or (36) must be viewed, for comparison with the claimed invention, as being disposed between parts of the harness (e.g., between waistband 12 and shoulder straps 22,24 and between strip 40 and tether strap 42 or shoulder straps 22,24, respectively) and not between the support structure and the harness as required by claim 25. We find only one juncture disposed between a support structure and the harness as

defined in the claim. This juncture is disposed between the tether strap (42) of the harness and the support structure. Accordingly, even if the teachings of Leach and Brda were combined as proposed by the examiner to provide leg straps or loops on the Leach safety harness⁸, the resulting device would still not render the safety harness recited in claim 25 obvious.

For the reasons discussed above, we are constrained to reverse the standing rejection of claim 25, and of claims 26, 27, 30, 31, 36, 37 and 39 which depend therefrom, under 35 U.S.C. § 103 as being unpatentable over Leach in view of Brda.

We have reviewed the teachings of Dalmaso, but we find nothing therein which overcomes the deficiencies of the Leach and Brda combination as discussed above with regard to claim 25. It follows then that we must also reverse the examiner's rejection of claims 28, 29 and 41, which depend from claim 25,

⁸ As the thigh straps of Brda are designed to support the user in a suspended state during rappelling (see Figure 3) and as the Leach harness is not disclosed for use in supporting a child in a suspended state, it is not immediately apparent to us why Brda would have suggested to one of ordinary skill in the art the addition of leg straps to a child restraint of the type disclosed by Leach. However, as the appellant has not challenged the examiner's position on this issue and as it would not alter our ultimate disposition of this appeal, we shall accept the examiner's position on this issue.

under 35 U.S.C. § 103 as being unpatentable over Leach in view of Brda and Dalmaso.

NEW GROUND OF REJECTION UNDER 37 CFR § 1.196(b)

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

Claims 25 through 39 and 41 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.

In defining the "connecting means" as part of the safety harness and further requiring that the "relatively weaker juncture" and "relatively stronger juncture" be disposed between a support structure and the harness, claim 25 is misdescriptive of or inconsistent with the appellant's disclosed invention. Cf. In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971). Specifically, the record as a whole indicates that the "connecting means" of claim 25 corresponds to the transfer straps (20, 28) and the positioning strap (22) of the appellant's disclosure. If these straps are considered part of the safety harness, as recited in claim 25, the only

junction between a support structure (a building or pole) and the harness is between the positioning strap and the support structure and this junction is not disclosed as being rupturable when subjected to a force in excess of the disclosed threshold. The disclosed weaker/rupturable junction is at connection (16,18), which is disposed between the belt portion of the harness and the "connecting means" portion of the harness, not between the support structure and the harness.

CONCLUSION

To summarize, the decision of the examiner to reject claims 42, 44 through 47 and 50 under 35 U.S.C. § 102(b) and claims 25 through 31, 36, 37, 39, 41, 43, 52 and 54 under 35 U.S.C. § 103 is reversed and a new rejection of claims 25 through 39 and 41 is added pursuant to the provisions of 37 CFR 1.196(b).

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. 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 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).

REVERSED; 37 CFR § 1.196(b)

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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APJ BAHR

APJ ABRAMS

APJ NASE

DECISION: **REVERSED;**
37 CFR § 1.196(b)

Prepared By: Carolyn Whitfield

DRAFT TYPED: 13 Apr 00

FINAL TYPED: