

PRECEDENTIAL OPINION

Pursuant to the Board of Patent Appeals and Interference's Standard Operating Procedure No. 94-02, the opinion below has been designated as precedential on the sole issue of the construction of 35 U.S.C. § 134.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIPPE LEMOINE

Appeal No. 94-0216
Application 07/884,875¹

DECIDED: December 27, 1994

Before McKELVEY, Chief Administrative Patent Judge, and STONER, MEISTER, McQUADE and SCHAFER, Administrative Patent Judges.

DECISION ON APPEAL

Per curiam

This appeal was initially argued on March 23, 1994, before a merits panel consisting of Judges Stoner, Meister, and McQuade. The panel was unable to reach a decision. Judge Stoner would have reversed, Judge Meister would have affirmed, and Judge

¹ Application for patent filed May 18, 1992. According to applicant, the application is a continuation of Serial No. 07/639,095, filed January 9, 1991, abandoned.

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McQuade would have dismissed for lack of jurisdiction. Thereafter, an expanded five-member panel consisting of Chief Judge McKelvey and Judges Stoner, Meister, McQuade, and Schafer voted to rehear the appeal. The appeal was reheard on June 20, 1994.

The expanded panel has reached a split decision.

By a vote of 4-1, the expanded panel determines that the Board has jurisdiction. Judge McQuade dissents.

By a 3-1 vote, the expanded panel affirms on the merits. Judge Stoner dissents. Judge McQuade declines to participate on the merits.

Judge Schafer's majority opinion, Judge Stoner's dissent on the merits, and Judge McQuade's dissent on jurisdiction follow.

SCHAFFER, Administrative Patent Judge.

Applicant appeals the final rejection of claims 24 to 52 and 54 to 58, all the claims in the application. Claims 54 and 36 are representative. Claims 54 and 36 are set forth below:

54. An apparatus for mounting a boot upon a ski, the boot adapted to be maintained between a front safety binding and a rear safety binding, said apparatus comprising:

(a) an intermediate support plate for affixation to the ski for vertically supporting the boot and for

having secured thereon at least one of said front safety binding and said rear safety binding;

(b) at least one support element having a predeterminate size and shape to enable said at least one support element to be positioned between said intermediate support plate and an upper surface of the ski, to enable at least vertical forces to be transmitted between said intermediate support plate and the ski;

(c) means for longitudinally displacing said at least one support element beneath said intermediate support plate and between said intermediate support plate and the ski for selectively adjusting longitudinal positions of said at least one support element; and

(d) means for immobilizing said at least one support element in predeterminate longitudinal positions between said intermediate support plate and the ski.

36. The apparatus of claim 54, further comprising means for vertically retaining said intermediate support plate relative to said ski.

The examiner made three rejections:

1. The rejection of claims 24, 25, 31-52, and 54-55 under 35 U.S.C. § 112, second paragraph as indefinite;
2. The rejection of claims 24-27, 31-33, 43-45 and 54-58 under 35 U.S.C. § 103 as unpatentable over the combination of the teachings of the Kuchler² and Smolka³ patents; and

² Kuchler 4,804,200 February 14, 1989

³ Smolka et al. 3,797,844 March 19, 1974

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3. The rejection of claims 28-30, 36 and 42 under 35 U.S.C. § 103 as unpatentable over the combined teachings of the Kuchler, Smolka and Weigl⁴ patents.

The board also sua sponte raised the question of whether "any of [applicant's] claims had been twice rejected" as required by 35 U.S.C. § 134 and thus whether the jurisdiction of this board was properly invoked.

Procedural History

Because of the jurisdictional issue, we review the relevant procedural history of this application and its parent application 07/639,095.

The parent application was originally filed with claims 1-22. In the first Office action the examiner made a variety of formal objections, rejected all the claims for indefiniteness under 35 U.S.C. § 112, ¶ 2, and rejected claims 1-8, 16 and 17 under 35 U.S.C. § 103. In the latter rejection the examiner relied upon a combination of the teachings of Kuchler and Smolka, as evidence that the claimed subject matter would have been obvious.

In response to the rejection applicant, inter alia, canceled all the claims (claims 1-22) and submitted new claims

⁴ Weigl 4,251,090 February 17, 1981

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23-53. The examiner issued a final Office action, rejecting claims 23-53 as indefinite under 35 U.S.C. § 112, ¶ 2, and rejecting claims 23-27, 31-33, 43-45 and 53 as being directed to subject matter which would have been obvious over the combined teachings of the Kuchler and Smolka references. Claims 28-30, 36 and 42 were also rejected under 35 U.S.C. § 103 as unpatentable in view of the combined teachings of Kuchler, Smolka and Weigl. The examiner noted that applicant had not separately argued the features of the dependent claims and that the patentability of the dependent claims stood or fell with independent claims.

Applicant responded to the final rejection with a notice of appeal and a proposed amendment. The examiner denied entry of the amendment on the basis that the amendments raised new issues and did not simplify or reduce the number of issues on appeal.

Applicant filed another proposed amendment. The examiner again denied entry of the amendment on the basis that the amendment was not in compliance with 37 CFR § 1.116(b), raised new issues and did not materially reduce or simplify the issues for appeal.

Rather than submitting an appeal brief, applicant chose to refile the application as a "file wrapper continuation" (FWC)

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under 37 CFR § 1.62. By a preliminary amendment, applicant canceled claims 23 and 53, added claims 54-58 and made minor amendments to claims 24-26, 28, 29, 31-33, 36, 37, 39, and 43-46.

The examiner essentially repeated the three grounds of rejection. Claims 24, 25, 31-52, 54 and 55 were rejected as indefinite under 35 U.S.C. § 112, ¶ 2. Claims 24-27, 31-33, 43-45, and 54-58, were rejected under 35 U.S.C. § 103 as unpatentable over the combination of the Kuchler and Smolka disclosures. Claims 28-30, 36 and 42 were rejected under 35 U.S.C. § 103 as unpatentable in view of the combined teachings of Kuchler, Smolka and Weigl. The Office action was not made final.

In response applicant filed a notice of appeal and subsequently filed a proposed amendment. The examiner held the application to be abandoned. He felt the notice of appeal was improper at the particular stage of the prosecution, citing 35 U.S.C. § 134 and 37 CFR § 1.191. He also felt that the amendment was untimely under 37 CFR §§ 1.135 and 1.136.

Applicant filed a paper captioned "Request to Withdraw Holding of Abandonment and Provisional Petition to Revive." With respect to the request to withdraw the holding of abandonment, applicant argued that an appeal was authorized under 35 U.S.C.

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§ 134 since applicant "has had his claims rejected at least twice."

The Director of Patent Examining Group 3100 reviewed the request and found that at least applicant's claims 24-53⁵ were twice rejected in that they had been rejected in both the parent and the FWC applications. Paper # 29, p.1. He concluded that it was appropriate to transmit the appeal to the board, thus facially transferring jurisdiction to us. 37 CFR § 1.191(e).

Applicant filed his brief and the examiner responded with an answer.

An oral hearing was held March 23, 1994, before a panel consisting of Administrative Patent Judges Stoner, Meister and McQuade. As noted earlier, one judge felt that the board lacked subject matter jurisdiction because the rejection was not a final rejection and no claim had been twice rejected as required by 35 U.S.C. § 134. He declined to participate in a decision on the merits. The remaining judges, while believing jurisdiction was present, disagreed as to the merits. The panel was expanded so that a majority decision could be reached. Applicant was given

⁵ We note that this should be claims 24-52, claim 53 having been canceled.

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an opportunity to submit a brief addressed to the following
issue:

Does the Board of Patent Appeals and Interferences have jurisdiction (35 U.S.C. § 134) under the circumstances of this case, including the fact that an appeal in this continuing application was taken from a first Office action which was not designated by the Primary Examiner as a final rejection.

Applicant briefed the issue and appeared at an additional hearing held before the expanded panel on June 20, 1994.

Jurisdiction

Section 134 of Title 35 gives applicants the statutory right to an administrative appeal. The section provides:

An applicant for a patent, any of whose claims have been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences

Jurisdiction for this appeal depends on whether appellant is an applicant "any of whose claims has been twice rejected." We conclude that appellant had the right to appeal the rejections and we have jurisdiction.

To reach a decision requires to construe the word "claims" as used in § 134. The word is susceptible to at least two interpretations. It can refer to the claims of an application, i.e., the "one or more claims particularly pointing out

and distinctly claiming the subject matter" of the invention required by 35 U.S.C. § 112, ¶2. Or the word can be used in a more general sense to refer to claims "for a patent" as it is used in 35 U.S.C. § 132. In this latter sense, the word is synonymous with a request or demand for a patent.

Section 134 merely uses the word "claims." We must, therefore, decide which construction to give to the statute. We conclude that "claims" in § 134 should be construed consistently with its use in § 132 to mean "claims for a patent" rather than particular "claims of an application."

Section 134 is part of Chapter 12 of Title 35. Chapter 12 is titled "Examination of Application" and sets forth the general procedures to be followed in the Office for examination. Sections 131 to 134 provide the general procedures relating to ex parte examination. In relevant part, these sections specify that (1) an examination shall be made (§ 131); (2) if "any claim for a patent" is rejected, the applicant shall be informed of the bases of the rejection (§ 132); (3) if the applicant persists in the "claim for a patent, with or without amendment," the application shall be reexamined (§ 132); and (4) if applicant's claims have been twice rejected, the applicant may appeal (§ 134). Considering these sections together, we conclude that the "claims"

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as used in § 134 is a reference to the repeated "claim for a patent" as used in § 132 rather than a reference to a particular claim "of an application." Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed. So construing the statute, we conclude that applicant's claims for a patent have been twice rejected. Applicant has been denied a patent three times. Applicant, therefore, had the right to appeal and we, accordingly, have jurisdiction.

Judge McQuade's dissent on jurisdiction

Judge McQuade's dissent argues that we have failed to provide authority for our interpretation of § 134. This is incorrect since the authority is Chapter 12, of Title 35. We have construed "claims" in § 134 in pari materia with the other sections of that Chapter and the examination scheme of Chapter 12 as a whole. Sections 132 and 134 were promulgated at the same time and both are part of the statutory framework setting forth the procedures for the patent examination process. Accordingly, the two sections should be interpreted in pari materia.

Erlenbaugh v. United States, 409 U.S. 239, 243, 93 S.Ct. 477, 480 (1972). It is appropriate, therefore, to give the word the same meaning in both sections. Our construction is also consistent with the principle that statutes giving the right to appeal are to

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be liberally construed. United States v. Mobay Chemical Corp.,
576 F.2d 368, 374 (CCPA 1978).

The dissent argues that our construction is
inconsistent with the "construction which traditionally has been
accorded 35 USC 134." The dissenter relies on In re Szajna, 422
F.2d 443, 164 USPQ 632 (CCPA 1970) and In re Hengehold, 440 F.2d
1395, 169 USPQ 473 (CCPA 1971). In Szajna the court noted:

Those sections [132 and 134] do not require
that each and every claim presented during
the prosecution of an application must be
twice examined and twice rejected on the same
ground. Section 134 appears to imply the
contrary since it permits an appeal to be
taken when any claim has been twice rejected.
Nevertheless, the claims here in question
have been twice rejected, contrary to
appellants' allegations, since the examiner
rejected them on the grounds of undue
multiplicity and as being based on new matter
prior to the rejection in his Answer.
[Emphasis original.]

422 F.2d at 446, 164 USPQ at 635. In Hengehold, the court noted
that

it is clear that, for the board to have some
jurisdiction in a case, only one claim need
be twice rejected, and that event occurred
here. [Emphasis original.]

440 F.2d at 1403, 169 USPQ at 479.

We do not view these cases as being inconsistent with
our interpretation of the statute. In each case, the applicant's

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claim for a patent was twice denied. We believe the dissent errs in interpreting the court's rationale as stating necessary rather than sufficient conditions for jurisdiction. The Federal Circuit has cautioned against extending legal principles to cases having different fact situations. FMC Corp. v. Manitowac, 835 F.2d 1411, 1417 n.12, 5 USPQ2d 1112, 1117 n.12 (Fed. Cir. 1987).

The dissent also errs in construing "any of whose claims has been twice rejected" to mean "any of whose claims, which do not differ in substance and scope from previously rejected claims, has been twice rejected." There is simply no support for this limited view in the statute.

The § 112 rejection

The examiner has rejected claims 24-25, 31-52, 54 and 55 under 35 U.S.C. § 112, second paragraph as indefinite. The examiner indicates that these claims only positively and distinctly claim the interconnection of one binding leaving the positive interconnection of the other safety binding unknown.

We reverse this rejection. At the outset we note that the examiner has apparently interpreted the claims as requiring a binding or bindings. However, none of the claims positively require that bindings be attached to the intermediate support

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plate. For example, claim 54 recites that the intermediate support plates is "for" having a binding secured thereon.

In any event, we fail to see how lack of a reference to a second binding makes the claim indefinite. A claim is indefinite if it fails to clearly delineate the boundary between the claimed and unclaimed subject matter. See In re Vogel, 422 F.2d 438, 442, 164 USPQ 619, 622 (CCPA 1970). ("A claim is a group of words defining only the boundary of the patent monopoly.") See also, In re Vamco Machine & Tool, Inc., 752 F.2d 1564, 1577 n.5, 224 USPQ 617, 625 n.5 (Fed. Cir. 1985) (The claim sets forth the metes and bounds of the rights which the applicants seek to obtain). In determining if claims are indefinite, claim language is analyzed in light of the teachings of the prior art and in light of the particular application disclosure as it would be interpreted by one having ordinary skill in the art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). The fact that only one binding is recited does not obscure the boundary line between the claimed and unclaimed subject matter or otherwise make the claimed subject matter unclear. The ordinary person working in this art would not, in our view, have any problem ascertaining the scope of the claimed subject matter. In order to fall within the literal scope of the claim, the inter-

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mediate support plate need only be "for" securing a single binding.⁶

The 35 U.S.C. § 103 rejections

The invention is directed to an apparatus for attaching a ski boot to a ski. In use, the apparatus is attached (1) to the ski boot through the safety bindings and (2) to the upper surface of the ski. The apparatus includes a boot supporting device or plate for attaching the boot both to the ski and to at least one safety binding. The apparatus further includes at least one support element to be positioned between the plate and the ski. In use, the support element transmits forces between the boot and upper surface of the ski. The apparatus also includes a means for mounting the support element for selective positioning relative to the plate.

The examiner presents two rejections directed to two groups of claims: (1) Claims 24 to 27, 31 to 33, 43 to 45 and 54 to 58 under 35 U.S.C. § 103 as unpatentable over the combination of the teachings of Kuchler and Smolka; and (2) Claims 28

⁶ We also note that the examiner's concern seems to be more in the nature of a lack of enablement under 35 U.S.C. § 112, first paragraph, or inoperativeness under 35 U.S.C. § 101. We express no comment, in this opinion, on any grounds of rejection which were not brought before us.

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to 30, 36 and 42 under 35 U.S.C. § 103 as unpatentable over the teachings of these same patents combined with the disclosure in Weigl.

In presenting the appeal, applicant has separately addressed each rejection, but has not separately asserted the patentability of the claims within each group. Accordingly, the claims in each group stand or fall together. 37 CFR § 1.192(c)(5); In re Goodman, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2013 (Fed. Cir. 1993); In re King, 801 F.3d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernakar, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983); In re Kaslow, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Albrecht, 579 F.2d 92, 93-94, 198 USPQ 208, 209 (CCPA 1978). Where an applicant does not "point out what relevance the additional limitations have to the patentability of the narrower claims," the claims will stand or fall together even if applicant asserts that the claims do not stand or fall together. In re Herbert, 461 F.2d 1390, 1391, 174 USPQ 259, 260 (CCPA 1972).

The 35 U.S.C. § 103 rejection based on Kuchler and Smolka

The closest prior art of record is the Kuchler patent. Kuchler relates to a ski which is said to be both shock absorbing and have improved sliding performance. Col. 1, lines 45-48.

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Kuchler's ski includes two separated portions which are joined together to form a torsion-resistant "box." Col. 1, lines 52 to 55. Figures 1, 2, 5 and 6 show examples of the box. The box can be an integral part of the ski structure as shown in Figure 5 or attached to the top surface of the ski as shown in Figure 1. The box has an upper portion or surface 2. This upper portion can be used, totally or partially, as a binding plate for the ski bindings. Col. 4, lines 63-66.

The box includes torsion-resistant connections made by spacers 6 and 7. E.g., col. 3, lines 49-55. In the summary of the invention section of the patent, Kuchler describes the function of the spacers (Col. 2, lines 16-32):

The torsion-resistant connection between the body portions, according to the invention, is effected by spacers which are arranged correspondingly at intervals, in front and in the back of the binding. Preferably, these spacers are displaceable, and namely in the longitudinal direction of the body portion. Thus, a simple, individual adjustment of the gliding device is possible.

The spacers can be detachably connected to the body portions. Through the modification of the distance between the displaceable spacers or of the height of the spacers, by corresponding replacing thereof, the damping characteristics can also be modified. This is of particular importance in the case of an alpine ski, since the ski can be adjusted optimally according to the weight and the skill of the skier.

(Emphasis added.)

Thus, Kuchler teaches the concept of utilizing displaceable spacers to adjust the characteristics of the ski. The difference between Kuchler and the claimed subject matter is the failure of Kuchler to disclose a specific mechanism for attaching the spacers at the desired location. However, based on the level of ordinary skill in the art as represented by the references before us, we feel that one having ordinary skill in the art would have no trouble adapting readily available attachment means to this end. The person of ordinary skill in the art is presumed to know something about the art apart from what the references expressly disclose. In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). We conclude that it would have been obvious to include a conventional means for mounting or securing the supports or spacers on Kuchler's apparatus.

The examiner relied on the Smolka patent for the teaching of the use of safety bindings on a raised intermediate support plate. Smolka shows a ski having binding parts 1 and 2 mounted on a rigid binding plate 3. Figures 1 to 6 and Col. 1, lines 46 to 47. In light of Kuchler's teaching that the upper portion of the torsion box may take up the function of the binding plate (Col. 4, lines 63-66), it would have been obvious

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to attach bindings to Kuchler's upper plate. In this regard, we note that applicant's claims do not require bindings. Rather, the claims indicate that the intended use of the intermediate plate is to support or act as a mounting for the bindings. See, for example, claims 26 and 56. In any event, to the extent the claims require or read on the inclusion of bindings, the subject matter would have been obvious over the combined teachings of Kuchler and Smolka.

In reaching this conclusion we have carefully considered applicant's arguments but have not been persuaded of error in the examiner's rejection. We fundamentally disagree with applicant's assertions as to the teachings of the Kuchler patent. Kuchler, in our view, teaches the use and positioning of spacers under a boot supporting plate or surface to affect the handling characteristics of the skis. Col. 2, lines 16-32.

The rejection of claims 24 to 27, 31 to 33, 43 to 45 and 54 to 58 is affirmed.

The rejection based on Kuchler, Smolka and Weigl

Claims 28 to 30, 36 and 42, recite an additional difference when compared with the Kuchler patent. These claims additionally require the inclusion of a means for restraining the amount of movement between the intermediate support plate and the

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ski. The examiner relies on the Weigl patent to show that the use of such means is old in the art. In the Answer the examiner states:

Weigl is solely relied upon by the examiner to show the old and well-known use of an assembly to limit the vertical movement of a ski binding plate assembly as set forth in the office action (paper [N]o. 21). Such centrally located pivoted support parts (3) are conventional in the art and widely utilized when a control or limit of the binding plate is necessary or desired for safety reasons.

The examiner concluded that it would have been obvious to employ such restraint with respect to Kuchler's system.

Applicant argues that the incorporation of means to limit vertical movement would not have been obvious since the support elements would need to be positioned between Weigl's plate and the upper portion of the ski body which would interfere with the operation of the Weigl arrangement. It is also argued that incorporation of the Weigl arrangement would not enhance torsional resistance. Thus, it is argued one of ordinary skill in the art would not have incorporated Weigl's arrangement into Kuchler's support structure.

We agree with the examiner that the subject matter of claims 28 to 30, 36 and 42 would have been obvious from the

combined teachings of the references. The nature of the ski arts and the references cited by the examiner demonstrate the high level of mechanical ingenuity demonstrated by those working in the art. We find that the level of ordinary skill in the art includes the ability to make the adaptations necessary to incorporate Weigl's device into Kuchler's ski while retaining its desirable control functions. The person of ordinary skill in the art would desire to add Weigl's arrangement to obtain the benefits described in the first two columns of Weigl's patent.

Applicant in effect argues that Weigl's arrangement could not be physically incorporated into Kuchler's ski. However, the test for obviousness is not whether the disclosures of the references could be physically combined. The test is whether the invention is rendered obvious by the combined teachings of the references. In re Etter, 756 F.2d 852, 859, 225 USPQ 1, 6 (Fed. Cir. 1985). Accordingly, we affirm the rejection of claims 28 to 30, 36 and 42.

Judge Stoner's dissent on obviousness

Judge Stoner dissents from our conclusion of obviousness. He errs in (1) giving essentially no weight to Kuchler's express teaching that the spacers are displaceable in the longitudinal direction to provide a simple individual

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adjustment, that the spacers can be detachably connected to the body portions, and that the spacers allow optimal adjustment for the particular skier (Col. 2, lines 16-32) and (2) limiting the disclosure to the specific embodiments and drawings. As noted by the CCPA:

It is axiomatic that a reference must be considered in its entirety, and it is well established that the disclosure of a reference is not limited to specific working examples contained therein.

In re Fracalossi, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982). A reference must be considered for everything it teaches by way of technology. EWP Corp, v. Reliance Universal Inc., 755 F.2d 898, 907, 225 USPQ 20, 25 (Fed. Cir.), cert. denied 474 U.S. 843 (1985). Consideration of the reference in its entirety, including both the summary of the invention and the specific examples, leads us to conclude that the claimed subject matter would have been obvious.

Conclusion

For the above-stated reasons (1) we conclude that we have jurisdiction to decide this appeal; (2) we do not sustain the examiner's rejection under 35 U.S.C. § 112, ¶ 2; and (3) we affirm the examiner' rejections under 35 U.S.C. § 103. The

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rejection of claims 34-35, 37-41 and 46-52 is reversed. The rejections of claims 24-33, 36, 42-45 and 54 to 58 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. 1.136(a). 37 C.F.R. § 1.136(a)(3).

AFFIRMED-IN-PART

FRED E. McKELVEY, Chief)	
Administrative Patent Judge)	
)	
)	
)	
JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
)	
RICHARD E. SCHAFER)	
Administrative Patent Judge)	

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STONER, Administrative Patent Judge, concurring-in-part and dissenting-in-part.

I agree with the view stated in the majority opinion that the jurisdiction conferred on the Board of Patent Appeals and Interferences by 35 U.S.C. § 134 has been properly invoked in this appeal by the patent applicant Philippe Lemoine ("Lemoine" or "appellant"), although my agreement is based on different reasons than those expressed in the majority opinion. I share the view of the majority opinion that the rejection of claims 24, 25, 31 through 52, 54 and 55 for indefiniteness under 35 U.S.C. § 112, second paragraph, must be reversed. I disagree, however, with the majority's determination that the subject matter of claims 24 through 27, 31 through 33, 43 through 45 and 54 through 58 would have been obvious from the teachings of Kuchler and Smolka and that the subject matter of claims 28 through 30, 36 and 42 would have been obvious from the teachings of Kuchler, Smolka and Weigl. Accordingly, I would reverse the rejections of those claims under 35 U.S.C. § 103 as unpatentable over the prior art. My views on the jurisdictional issue and the § 103 rejections follow.

Jurisdiction

As the majority opinion has noted, appeals to this

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Board are governed by 35 U.S.C. § 134, which reads as follows:

Appeal to the Board of Patent Appeals and Interferences.

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

Apart from the fee requirement, the literal words of the statute simply require that at least one claim be twice rejected for a right of appeal to exist. I consider the provisions of § 134 satisfied in this instance.

The present application is a file wrapper continuation (FWC) application of Serial No. 07/639,095 (the '095 application). As filed, the '095 application included claims 1 through 22 directed to an apparatus for mounting a boot upon a ski. After receiving an Office action¹ rejecting claims 1 through 22 under 35 U.S.C. § 112, second paragraph, and some of the claims under 35 U.S.C. § 103 as unpatentable over Kuchler in view of Smolka (along with an indication that some of the claims would be allowed if rewritten to avoid the § 112, second paragraph rejection), Lemoine canceled claims 1 through 22 and submitted

¹ Mailed April 3, 1991.

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claims 23 through 53, likewise directed to an apparatus for mounting a ski upon a boot.² In the final Office action in the '095 application,³ claims 23 through 53 were finally rejected under 35 U.S.C. § 112, second paragraph. Additionally, claims 23 through 27, 31, 32, 33, 43, 44, 45 and 53 were rejected under 35 U.S.C. § 103 as unpatentable over Kuchler in view of Smolka, while claims 28, 29, 30, 36 and 42 were rejected under 35 U.S.C. § 103 as unpatentable over Kuchler in view of Smolka and Weigl. Claims 23 through 53 were identified in the Notice of Appeal submitted by Lemoine in the '095 application.⁴

Ultimately, the appeal in the '095 application was not perfected by the filing of a brief; instead, Lemoine filed the present FWC application. By preliminary amendment⁵ in this FWC application, Lemoine added independent claim 54, from which claims 24 through 52 were made to directly or indirectly depend, as well as claims 55 through 58. At the same time, Lemoine canceled claims 23 and 53. As was true in the '095 application,

² Amendment filed July 3, 1991.

³ Mailed October 18, 1991.

⁴ Filed February 18, 1992.

⁵ Filed May 18, 1992.

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the claims on this FWC application are drawn to an apparatus for mounting a ski upon a boot. It is from the rejection of these claims under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103 that Lemoine has appealed.

Throughout, the claims have remained drawn to substantially the same subject matter which was defined in claims 1 through 22 initially filed in the '095 application, that is, to an apparatus for mounting a boot upon a ski. At least claims 24 through 52 have survived the filing of the FWC and have been rejected in both applications on the same grounds and on the same evidence. As indicated above, in the '095 application, claims 23 through 27, 31, 32, 33, 43, 44, 45 and 53 were finally rejected under 35 U.S.C. § 103 as unpatentable over Kuchler in view of Smolka, the same rejection applied to claims 24 through 27, 31, 32, 33, 43, 44, 45 and 54 through 58 in the present application. Likewise, claims 28, 29, 30, 36 and 42 were finally rejected under § 103 over Kuchler in view of Smolka and Weigl in the earlier application, the same rejection applied to the like numbered claims in the present application. That no claim, including none of claims 24 through 52, has retained identical

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wording through two separate Office actions⁶ should not and does not, in my view, deprive Lemoine of his right to appeal from the Office action mailed July 17, 1992.⁷

Where, as here, the examiner's rejection (and underlying evidence in the form of references) remains unchanged through at least two actions on the merits, despite amendments to the claims, there is no reasonable purpose served by forcing an applicant like Lemoine to request reconsideration without further amendment prior to exercising the right to appeal conferred by 35 U.S.C. § 134.⁸ In my view, to read the statute as though it requires this futile act ill serves the applicant, for whom the right of appeal has been created by statute. Additionally, such a reading departs from a common sense understanding of what "any of whose claims has been twice rejected" means in this context.

⁶ By virtue of a change to the language of the independent claim from which it depends, the language of a dependent claim may be likewise considered to have changed, even though the dependent claim is otherwise not amended.

⁷ While one might envision situations in which the only thing remaining from an earlier claim is its claim number, with all the language and claimed subject matter having been changed, that is not the case here.

⁸ Indeed, the fact that the examiner has seen no need to alter the basis for rejection demonstrates that virtually the same subject matter has been repeatedly claimed and rejected.

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It is on this basis that I would hold that we possess jurisdiction to decide the present appeal.

I see no need to take the view, expressed in the majority opinion, that the word "claims" in § 134 means something other than what that term is ordinarily understood to mean in the patent application examination process, that is, those claims "particularly pointing out and distinctly claiming the subject matter which the inventor regards as his invention" with which a specification is required by 35 U.S.C. § 112, second paragraph, to conclude. Construing the word "claims" in § 134 as though synonymous with "requests or demands for a patent" may lead to appeals in situations which are presently not envisioned and quite removed from the kind of situation now before us.

The § 103 rejections

With all due respect to my colleagues in the majority and to the examiner, I cannot agree that the combined teachings of Kuchler and Smolka render any of independent claims 54, 55 and 56 obvious. Nor do I see anything in the teachings of Weigl, applied only against certain dependent claims, which makes up for the deficiency of Kuchler and Smolka.

Claim 54 defines the invention as follows, with emphasis added to denote that structure which I believe finds no

response in Kuchler or either of the other prior art references relied upon:

54. An apparatus for mounting a boot upon a ski, the boot adapted to be maintained between a front safety binding and a rear safety binding, said apparatus comprising:

(a) an intermediate support plate for affixation to the ski for vertically supporting the boot and for having secured thereon at least one of said front safety binding and said rear safety binding;

(b) at least one support element having a predetermine size and shape to enable said at least one support element to be positioned between said intermediate support plate and an upper surface of the ski, to enable at least vertical forces to be transmitted between said intermediate support plate and the ski;

(c) means for longitudinally displacing said at least one support element beneath said intermediate support plate and between said intermediate support plate and the ski for selectively adjusting longitudinal positions of said at least one support element; and

(d) means for immobilizing said at least one support element in predeterminate longitudinal positions between said intermediate support plate and the ski.

The language of claim 55 parallels that of claim 54, with the exception of clause (c), for which claim 55 substitutes a recitation of "means for selectively adjusting longitudinal positions of at least one support element," a means likewise not taught by the art.

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Claim 56, perhaps the broadest independent claim, defines the invention as follows, again with distinguishing emphasis added:

56. An apparatus for mounting a boot upon a ski, said apparatus comprising:

(a) a boot-supporting device for supporting at least one ski binding for engagement of the at least one ski binding with the boot;

(b) at least one supporting element located between said boot-supporting device and an upper surface of said ski, when said apparatus is mounted upon a ski; and

(c) means for mounting said at least one support [sic, supporting] element with respect to said boot-supporting device for selective longitudinal positioning of said at least one support [sic, supporting] element relative to said boot-supporting device.

Of the three references upon which the examiner has relied, Kuchler is, without a doubt, the closest prior art. Each illustrated embodiment of Kuchler's skis includes, as recited in claim 56, "a boot-supporting device for supporting at least one ski binding for engagement of the at least one ski binding with the boot" defined by the "upper body portion" 2. Likewise, each illustrated embodiment of Kuchler's skis includes, as recited in claim 56, "at least one supporting element located between said

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boot-supporting device and an upper surface of said ski, when said apparatus is mounted upon a ski" defined by spacers 6 and 7.

The several embodiments discussed and illustrated by Kuchler contain no displaceable spacers, much less any means for mounting or securing these spacers in the manner required by Kuchler's independent claims. Kuchler is primarily concerned with connecting portions of a ski to one another in a torsion-resistant manner (column 1, lines 45-58).

With regard to the embodiments of figures 1, 5 and 6, Kuchler discloses that connection of the upper body portion 2 to the lower body portion is achieved:

. . . via the spacers 6, 7 whereby the two body portions 2, 3 are either directly connected through the spacers 6, 7 as in FIG. 1, or, as shown in FIG. 5, through an additionally provided transition of the upper body portion 2 into the lower body portion 3. A further possible construction of the torsion resistant box 49 is shown in FIG. 6. There, an additional body portion 48 is provided, which together with the upper portion 2 and the spacers 6, 7 form the torsion-restant [sic, torsion-resistant] box 49 [column 5, lines 49-60].

Kuchler makes no mention of adjustability of the spacer location in connection with these embodiments.

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The embodiment disclosed in figure 4 of Kuchler provides that the spacers may be trapezoidally shaped. Kuchler makes no mention of adjustability of the spacer location in connection with this embodiment.

The embodiment disclosed in figure 7 of Kuchler simply provides that the space between body portions 2 and 3, occupied in part by spacers 4, 5, 6 and 7, may be closed by a sponge rubber plate 14. Kuchler makes no mention of adjustability of the spacer location in connection with this embodiment.

At first glance, Kuchler's figures 2 and 8 appear to have something to do with adjustment of spacers. The descriptions of these figures show that first impression to be erroneous. The description with regard to figure 8 reads as follows (emphasis added):

FIG. 8 shows an embodiment wherein the upper body portion 2 is given the possibility to move in longitudinal direction, with respect to the lower body portion 3. Here the spacers 6, 7 are provided with a guide peg 35 whose neck 36 passes through a longitudinal slot 19 of the upper body portion 2. This longitudinal slot 19 is formed in an elastic material 34, so that between the neck 36 and the lateral walls 33 of the longitudinal slot 19 there is practically no clearance left.

More specifically, when the two body portions 2, 3 are displaced longitudinally with respect to each other, this movement is

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purposely damped by the elastic material 34, respectively the conformation of the longitudinal slots 19 which results in a safe guidance of the upper body and in the preservation of the torsion-resistant box, as a whole [column 6, lines 28-44].

The description of the embodiment of figure 2 at column 5, line 61 through column 6, line 6 reveals nothing about any movement of the spacers, much less about the structure which appears to protrude from the top of each of spacers 6 and 7 in figure 2 and might be thought to resemble the peg 35 of figure 8.

It is unquestionably true that Kuchler's "SUMMARY OF THE INVENTION" makes reference to spacers which are "displaceable" in the longitudinal direction of the "body portion" and states that modification of the distance between displaceable spacers permits the damping characteristics of a ski to be adjusted to an optimal value according to the weight and skill of a skier (column 2, lines 16 through 32). In hindsight, knowing what we do of the appellant's disclosed invention, it is tempting to conclude that Kuchler's spacers are intended to be displaceable in the same manner as the appellant's claimed supporting element and that the spacers would be provided with the undisclosed but "conventional means for mounting or securing the

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supports on Kuchler's apparatus" posited by the majority (ante, at 14) required to meet claims 54, 55 and 56.⁹ It is also wrong.

The appellant's characterizations of Kuchler's disclosure as "ambiguous" concerning the displaceable spacers (brief,¹⁰ page 12) and deficient with regard to the required mounting means (brief, page 19) are well taken. When Kuchler is viewed without benefit of knowing the arrangement of elements desired by the appellant, when the entirety of Kuchler is read and appreciated for what it actually teaches the ordinarily skilled worker in the art, a conclusion contrary to that reached by the majority is required. Simply put, there is nothing whatsoever in Kuchler's specific description of the several embodiments, contained at column 5, line 44 through column 6, line 43 which remotely hints at the sort of construction claimed by the appellant.

I recognize that it is possible for a patent specification like Kuchler's to include a description of an unillus-

⁹ The majority has quietly abandoned most, if not all, of the position taken by the examiner in his statement of the rejection in the Office action mailed July 17, 1992, and the answer mailed October 4, 1993. The examiner appears to have bottomed his rejection on Kuchler's figure 8 embodiment, while mixing in comments pertaining to other embodiments.

¹⁰ Filed June 17, 1993.

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trated embodiment which would anticipate or render obvious the subject matter claimed by a later applicant. In my view, the portion of Kuchler to which the majority opinion directs attention does not do so. A reading of Kuchler's complete disclosure would have suggested to the skilled worker that the sort of change of spacing mentioned has more to do with constructing the torsion-resistant box in the first place than with any adjustability as claimed by the appellant. In this connection, I direct attention to the following statement in Kuchler:

The torsion-resistant box can be adjusted . . . to the respective conditions, namely the running characteristics and skills of each user, in a simple and suitable manner, by simply replacing it. This way, it can be manufactured as a finished part and also handled as such, preferably it can be mounted on available sliding devices, particularly skis [column 2, lines 57-63].

Similarly:

The absorption of such frontal shocks can also be achieved due to the fact that the spacers are rigidly connected to the lower body portion, while with respect to the upper body portion, they are longitudinally movable to a limited extent and laterally guidable. The upper body portion carrying the binding can thus move with respect to the lower body portion carrying the gliding surface, so that shocks can be intercepted not only in a vertical direction, but also in a horizontal direction The longitudinal mobility

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is achieved, for instance, by the fact that the spacers are held in slits in the upper body portion or have pegs guided in these slits, so that the torsion-resistant construction is preserved [column 3, lines 37-51; emphasis added].

I also recognize that we are to presume skill on the part of the worker, rather than the converse. See In re Sovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). We are not, however, authorized to speculate as to what one having ordinary skill in the art would have understood a reference to mean, particularly when that speculation is guided by the appellant's own disclosure. Our court of review has repeatedly cautioned against employing hindsight by using an applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). That court has also cautioned against focussing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole as § 103 requires. See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986),

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cert. denied, 480 U.S. 947 (1987). In my view, the majority has done just that in evaluating the teachings of Kuchler.

Apart from whatever else they teach, neither Smolka nor Weigl has anything to do with movable spacers of the type required by the appellant's claims and, accordingly, those references do not make up for the features lacking in Kuchler.

I would reverse the § 103 rejections.

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)	BOARD OF PATENT
BRUCE H. STONER, JR.)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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McQuade, Administrative Patent Judge, dissenting.

This appeal is premature and should be dismissed without a decision on its merits.

The pertinent facts are not in dispute. In parent application Serial No. 07/639,095, originally filed claims 1 through 22 were rejected in a first Office action dated April 3, 1991 (Paper No. 3). In response, the appellant canceled claims 1 through 22 and replaced them with new claims 23 through 53 (see Paper No. 4). Claims 23 through 53 were rejected in a "final" Office action dated October 18, 1991 (Paper No. 7). The parent application was subsequently abandoned in favor of the instant file wrapper continuation application. By way of a preliminary amendment, the appellant canceled claims 23 and 53, the two independent claims finally rejected in the parent application, and added new claims 54 through 58, with claims 54 through 56 being independent claims (see Paper No. 20). Claims 24 through 52 and 54 through 58 were rejected in a "non-final" Office action dated July 17, 1992 (Paper No. 21). The present appeal was taken from this "non-final" Office action (see Paper No. 24).

By virtue of the amendments made by the appellant in response to the Office actions issued in the parent application, the claims rejected in the "non-final" Office action appealed

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from differ in substance or scope from the claims which had been rejected in the parent application.¹ As conceded by the appellant,

[t]he independent claims entered in the parent application (claims 1, 23 and 53) and the independent claims entered in the instant continuation application (claims 54, 55 and 56) have been reviewed. The wording of the continuation claims is indeed different from the wording of the parent claims. The difference in the wording is believed to result in a claim scope that is somewhat different between the two applications. That is, although the scopes of the respective sets of independent claims are similar, the scopes are not the same [Paper No. 46 filed on June 20, 1994].

Thus, the "non-final" Office action dated July 17, 1992 (Paper No. 21) marks the first and only time that claims having the substance or scope of appealed claims 24 through 52 and 54 through 58 have been rejected. Stated differently, none of the claims on appeal has been twice rejected.

35 USC 134 confers on a patent applicant, "any of whose claims has been twice rejected," the right to appeal to this

¹ Although certain dependent claims may not have been amended in and of themselves, they nevertheless incorporate all the limitations of, and therefore the changes in, the claims to which they refer. 35 USC 112, fourth paragraph.

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Board from the decision of the primary examiner.² This statutory right of appeal is supplemented by 37 CFR 1.191(a) which provides in pertinent part that "[e]very applicant for a patent ... any of the claims of which have been twice rejected or who has been given a final rejection (§ 1.113), may ... appeal from the decision of the examiner to the Board of Patent Appeals and Interferences." Thus, in order for this Board to have jurisdiction in an appeal, at least one of the appealed claims must be twice rejected or the claims must be under final rejection. In the present case, none of the claims on appeal has been twice rejected and the decision of the examiner appealed from was not a "final" rejection. This appeal is therefore premature and this Board does not have jurisdiction to render a decision on its merits.

The majority's determination that they have jurisdiction to decide the appeal under 35 USC 134 is predicated on their construction of the word "claims" as it appears in this statutory provision as referring to a general request or demand for a

² 35 USC 134 **Appeal to the Board of Patent Appeals and Interferences**

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

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patent, rather than to claims of the type required by 35 USC 112, second paragraph. According to the majority, this interpretation is consistent with the usage of the term "claim" in 35 USC 132. In this light, it is rationalized that since the appellant's "claim" or demand/request for a patent has been denied or rejected at least twice (actually three times), 35 USC 134 affords the appellant the right to appeal to this Board.

The majority, however, has failed to advance any authority for what is, at best, a strained interpretation of the statutory language in question. The fact that this language includes the modifier "any" in conjunction with the plural term "claims" would seem to plainly and unambiguously indicate that 35 USC 134 refers to "claims" of the type required by 35 USC 112, second paragraph, not a general demand or request for a patent, and that at least one of such claims must be twice rejected for an applicant to have a statutory right to appeal the examiner's decision to this Board. This is the construction which traditionally has been accorded 35 USC 134.

For example, in In re Szajna, 422 F.2d 443, 164 USPQ 632 (CCPA 1970), the court stated that

[t]hose sections [132 and 134] do not require that *each and every* claim presented during

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the prosecution of an application must be twice examined and twice rejected on the *same ground*. Section 134 appears to imply the contrary since it permits an appeal to be taken when *any* claim has been twice rejected. Nevertheless, the claims here in question have been twice rejected, contrary to appellants' allegations, since the examiner rejected them on the grounds of undue multiplicity and as being based on new matter prior to the rejection in his Answer [164 USPQ at 635; emphasis in the original].

In the same vein, the court in In re Hengehold, 440 F.2d 1395, 169 USPQ 473 (CCPA 1971) commented on the Board's observation that 35 USC 134 "states that the purpose of an appeal is to afford review of claims which have been 'twice rejected' by decision of the primary examiner" and that "[c]laims 1, 3 and 9 have not been so rejected" (169 USPQ at 477) by saying that

[o]f course, not *all* claims in the application have to have been twice rejected [169 USPQ at 477, footnote 7; emphasis in the original].

The court in Hengehold also stated that

it is clear that, for the board to have *some* jurisdiction in a case, only *one* claim need be twice rejected [169 USPQ at 479; emphasis in the original].

As noted above, due to the substantive changes encompassed by the appellant's cancellation and replacement of independent claims during the prosecution of the parent and instant

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applications, none of the claims on appeal has been twice rejected.

In addition, the majority's interpretation of 35 USC 134 is inconsonant with the above-noted long-standing provision in 37 CFR 1.191(a) granting a patent applicant who has been given a final rejection the right to appeal to this Board. A final rejection may be given only on the second or any subsequent examination (see 37 CFR 1.113). It therefore follows that if a patent applicant has been given a final rejection, his or her "claim" or demand/request for a patent has been rejected at least twice. If 35 USC 134 had been intended to be construed as the majority has construed it, there never would have been any need for the foregoing provision in 37 CFR 1.191(a) since an applicant would have had a statutory right to appeal to this Board upon any second or subsequent rejection of his or her demand/request for a patent irrespective of whether such rejection was a "final" rejection.

Finally, the majority has relied on the principles that related statutory provisions should be interpreted in pari materia and that statutes giving the right of appeal should be liberally construed to support their position on the jurisdictional issue. Neither of these principles, however, justifies

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interpreting 35 USC 134 in a manner which is completely inconsistent with the plain and unambiguous meaning of the language therein. That it might be desirable from a policy standpoint to expand the right of appeal to this Board to cover fact situations similar to that here involved is of no moment. Moreover, the implementation of such a policy is better left to the rule making authority of the Commissioner, rather than to dubious statutory constructions of the type engaged in by the majority.

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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision below (1) was not written for publication in a law journal or reporter and (2) is not binding precedent of the Board. The decision was entered March 25, 1995.

Paper No. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIPPE LEMOINE

Appeal No. 94-0216
Application 07/884,875³

HEARD: March 23, 1994 and June 20, 1994

Before McKELVEY, Chief Administrative Patent Judge, and STONER, MEISTER, McQUADE and SCHAFER, Administrative Patent Judges.

DECISION ON RECONSIDERATION

Per curiam

³ Application for patent filed May 18, 1992. According to applicant, the application is a continuation of Serial No. 07/639,095, filed January 9, 1991, abandoned.

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Pursuant to 37 C.F.R. § 1.197(b), applicant has requested reconsideration of the decision dated December 27, 1994. Applicant asks reconsideration of (1) Judge McQuade's dissent on jurisdiction and (2) the majority's decision on the merits.

The panel has considered the request with the following effect.

None of the panel members has been persuaded to change their respective views on jurisdiction as expressed in the various opinions. Applicant's jurisdictional points are addressed in this per curium opinion.

By a vote of 4-0, the rejection of claims 24-33, 36, 42-45, 54 and 55 is reversed. Judge Stoner concurs.

By a vote of 3-1, the rejection of claims 56-58 is affirmed. Judge Stoner dissents.

Judge McQuade continues to decline to participate on the merits.

Judge Schafer's majority opinion on the merits, and Judge Stoner's and Judge McQuade's opinions follow.

JURISDICTION

Applicant requests Judge McQuade to reconsider his "decision" on jurisdiction. Section 1.197(b) of 37 C.F.R. provides for a single request for reconsideration or modification of "the

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decision" of the Board. The only decisions in this appeal are those of the majority. The concurrences and dissents are opinions not decisions. Accordingly, requesting reconsideration of a dissenting opinion is inappropriate. We will, however, construe applicant's request as a request to modify the basis of the majority's decisions.

Applicant urges that the Commissioner, through the decision of a Group Director that a notice of appeal was timely filed, has already decided that the Board has jurisdiction. In effect, applicant asserts that, under the circumstances of this case, we are without authority to address the jurisdiction issue.

The jurisdictional issue raised sua sponte by this Board related to our statutory jurisdiction. In the Decision Ordering Rehearing, mailed May 6, 1994, we stated the jurisdictional issue as follows:

Does the Board of Patent Appeals and Interferences have jurisdiction (35 U.S.C. § 134) under the circumstances of this case, including the fact that the appeal in this continuing case was taken from a first Office action which was not designated by the Primary Examiner as a final rejection.

Our authority to decide an appeal is set out in 35 U.S.C. § 7(b). That section mandates that the Board

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shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents Each appeal shall be heard by at least three members of the [Board]

Thus, our statutory authority to review adverse decisions flows directly from the statute. Our statutory jurisdiction does not depend on a delegation of the Commissioner's statutory responsibilities. In acting under our statutory authority we must determine whether our statutory authority has been properly invoked. See, Federal Power Comm'n v. Louisiana Power & Light, 406 U.S. 621, 647, 92 S.Ct. 1827, 1842 (1972) (While an agency's determination of it's jurisdiction is not the last word, it must be the first); Equal Employment Opportunity Comm'n v. South Carolina Nat'l Bank, 562 F.2d 329, 332 (4th Cir. 1977) (The administrative agency is responsible in the first instance for determining the coverage of the statutes it administers); California v. Fed. Trade Comm'n, 549 F.2d 1321, 1324 (9th Cir. 1977) (As a general rule, the agency should make the initial determination of its own jurisdiction); Marshall v. Able Contractors, Inc., 573 F.2d 1055, 1057 (9th Cir. 1978) (Generally an agency should make the initial determination of its own jurisdiction). To decide whether we have statutory jurisdiction, we must determine whether the appellant is an applicant "any of whose claims have been twice rejected."

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35 U.S.C. § 134. On the matter of the jurisdiction placed on this Board by statute, the decision of a Group Director, while worthy of serious consideration, is not, and can not be, binding. The effect of the Group Director's decision, in this case, was merely to overrule the examiner's decision not to transmit the application to the Board because the application was abandoned.

We recognize that 37 C.F.R. § 1.191(e) provides that jurisdiction over an application vests in the Board when the application is transmitted to the Board. However, this provision does not create jurisdiction, it merely specifies timing. Normally, jurisdiction over a matter transfers to an appellate tribunal upon the filing of an appeal. Our jurisdiction does not attach until the examining corps has finished its job and transfers the application file to the Board. This permits, inter alia, examiners to allow the application to issue or enter new grounds of rejection without requesting a remand from the Board. While under appropriate circumstances, an examiner or a Group Director may refuse to transmit an application to the Board (see, 37 C.F.R. § 1.193(a)), they can not create jurisdiction where none exists.

All panel members adhere to the views on jurisdiction expressed in their original opinions.

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SCHAFFER, Administrative Patent Judge

THE MERITS

Applicant asks us to reconsider our decision on patentability in light of 35 U.S.C. § 112, ¶ 6 as construed by In re Donaldson Co. Inc., 16 F.3d 1189, 29 USPQ2d 1845 (in banc) (Fed. Cir. 1994). Applicant states at page 9 of the request for reconsideration:

Appellant respectfully submits that the interpretation of certain claim limitations in accordance with the provisions of §112, sixth paragraph, have been overlooked by the majority in its decision in affirming the rejection under §103.

Applicant points out (page 9) that the last two subparagraphs of claims 54 and 55 and the last subparagraph of claim 56 use means plus function format. Applicant argues that these limitations must be interpreted as required by 35 U.S.C. § 112, ¶ 6, and as so interpreted the rejection based on Kuchler should be reversed.

In our original decision, we did not apply 35 U.S.C. § 112, paragraph 6, to the means clauses in the claims.⁴ Applicant

⁴Construing the claims as required by 35 U.S.C. § 112, ¶ 6, was not raised in applicant's brief (which was filed prior to the Donaldson decision) or during either oral argument. Because of the particular circumstances of this case we have exercised our discretion to address a belatedly raised issue.

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specifically argues that Kuchler and the other references do not have

any disclosed structure or equivalent structure that corresponds to appellant's claimed "means of longitudinally displacing" and "means for immobilizing", in claim 54; "means for selectively adjusting" and "means for immobilizing", in claim 55; or "means for mounting said at least one support element with respect to said boot-supporting device for selective longitudinal positioning", in claim 56.

Recon., p. 9, lines 13-20. Applicant states that Kuchler "does not evidence a teaching or suggestion of the structure described by appellant or the equivalent thereof" (Recon., p. 10, lines 2-6, (emphasis original)) and that in "Kuchler, there is no disclosure of appellant's specifically disclosed means or equivalent(s) thereof" (Recon. p. 10, lines 16-17).

In Donaldson, the Federal Circuit gave the following guidance with respect to the application of paragraph 6 of § 112:

For the foregoing reasons, the PTO was required by statute to look to [the] specification and construe the "means" language recited in the last segment of claim 1 as limited to the corresponding structure disclosed in the specification and equivalents thereof.

16 F.3d at 1195, 29 USPQ2d at 1850 (emphasis added). See also, Valmont Indus. Inc. v. Reinke Mfg. Co. Inc., 983 F.2d 1039, 1042,

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25 USPQ2d 1451, 1454 (Fed. Cir.) (Paragraph 6 of Section 112 "limits the applicant to the structure, material, or acts in the specification and their equivalents."). Thus, we first look to the specification to determine the structure which corresponds to the recited means.

Applicant directs us to two specific embodiments which correspond to the "means of longitudinally displacing . . ." and "means for immobilizing . . ." set forth in claim 54. Thus, applicant states:

Specifically, in the embodiment shown in appellant's Figs. 2 and 3, e.g., described on page 6, lines 9-23, of the specification, there is a means for displacing and for immobilizing the support slide 13 in the form of lever 17 having a cam 18 for securing same against the support plate 5. In the embodiment of Fig. 5, appellant has provided, for this purpose, a screw 24 having a head 25 to permit turning the turning screw and the displacement of the support 23 which is positioned along the screw.

Recon., p. 10, lines 8-15. Applicant has not informed us of the structure which corresponds to the "means for selectively adjusting . . ." and "means for immobilizing . . ." of claim 55; or the "means for mounting said at least one support element with respect to said boot-supporting device for selective longitudinal positioning . . ." of claim 56.

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After reviewing the specification, we find that the specification describes two structures corresponding to the "means of longitudinally displacing . . ." and "means of immobilizing . . ." of claim 54 and "means for selectively adjusting . . ." and "means of immobilizing . . ." of claim 55. The first is the structure shown in Figures 2, 3 and 7 and the related description appearing at page 6, lines 9-23 of the specification. The second is the structure shown in Figures 5 and 6 and the related description appearing at page 7, lines 18-33 and page 8, lines 9-18. As noted by applicant (Recon. p. 10, lines 8-15), these two structures are a slide and cam mechanism and a slide and screw mechanism.

According to 35 U.S.C. § 112, ¶ 6, as construed by our reviewing court, the means clauses are limited to these two structures and equivalent structures. Donaldson, 16 F.3d at 1197, 29 USPQ2d at 1850; Valmont, 983 F.2d at 1042, 25 USPQ2d at 1454. A structure is an "equivalent" if it differs from the disclosed structure by an insubstantial change which adds nothing of significance. Valmont, 983 F.2d at 1042, 25 USPQ2d at 1455. We recognize that applicant's specification indicates that the specific structures disclosed are "non-limiting examples." E.g., specification, p. 2, line 33 to p. 3, line 3. However, the

language of paragraph 6, is unequivocal in mandating that means plus function "shall be construed to cover the corresponding structure, materials or acts described in the specification and equivalents thereof." Our reviewing court has instructed that means claims are limited to the structures disclosed by the specification and equivalents. Donaldson, 16 F.3d at 1197, 29 USPQ2d at 1850; Valmont, 983 F.2d at 1042, 25 USPQ2d at 1454.⁵

We must now compare the structures disclosed in the specification with the reference disclosures. The references do not teach either the slide and cam or the slide and screw structures or a structure that differs only insubstantially from applicant's structures. Nor do we see a basis for concluding that applicant's structures or their equivalents would have been obvious. The record before us provides no basis for modifying Kuchler's teachings by the addition of the cam or screw structures or structures which are insubstantially different from the cam and

⁵While not apparent from the court's opinions, the patents involved in both Donaldson and Valmont included language which indicated that the structure disclosed in the specification was also "non-limiting." Thus, the Schuler patent involved in the reexamination before the court in Donaldson indicated that the disclosure was "but illustrative" of the invention. U.S. Patent No. 4,395,269, col. 8, lines 29 to 33. The Seckler et al. patent involved in Valmont indicated that the specific control means described in the specification was merely a "preferred embodiment." U.S. Patent No. 3,802,627, col. 5, line 64 to col. 6, line 5.

screw structures. The subject matter of these claims would not, therefore, have been prima facie obvious. Accordingly, we reverse the rejection of claims 54 and 55 and dependent claims 24-33, 36, and 42-45.

We reach a different result with respect to the broadest claim, claim 56. It claims:

56. An apparatus for mounting a boot upon a ski, said apparatus comprising:

(a) a boot-supporting device for supporting at least one ski binding for engagement of the at least one ski binding with the boot;

(b) at least one supporting element located between said boot-supporting device and an upper surface of said ski, when said apparatus is mounted upon a ski; and

(c) means for mounting said at least one support element with respect to said boot-supporting device for selective longitudinal positioning of said at least one support element relative to said boot-supporting device.

Kuchler describes an apparatus, a torsion-resistant box, for mounting a boot on a ski. The box may be manufactured as a finished part for attachment to a ski (Fig. 1 and col. 2, lines 61-63) or incorporated as part of the ski itself (Fig. 5). The box has an upper portion or surface 2. The upper portion can be used, totally or partially, as a binding plate for the ski bindings. Col. 4, lines 63-66. Thus, the upper portion 2, is a "boot-

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supporting device" as required by part (a) of the claim. The box includes torsion-resistant connections, spacers 6 and 7. E.g., col. 3, lines 49-55. These spacers are located between the "boot-supporting device and an upper surface of said ski, when said apparatus is mounted upon a ski." E.g., Figs. 1 and 6. Thus Kuchler teaches element (b). According to Kuchler (Col. 2, lines 20-32):

Preferably, these spacers are displaceable, and namely in the longitudinal direction of the body portion. Thus, a simple, individual adjustment of the gliding device is possible.

The spacers can be detachably connected to the body portions. Through the modification of the distance between the displaceable spacers or of the height of the spacers, by corresponding replacing thereof, the damping characteristics can also be modified. This is of particular importance in the case of an alpine ski, since the ski can be adjusted optimally according to the weight and the skill of the skier. [Emphasis added.]

Thus, we find that Kuchler teaches the "selective longitudinal positioning of said at least one support element relative to said boot-supporting device."

Looking to applicant's specification for the structure corresponding to the "means for mounting," we find that the specification discloses five structures which correspond to this means. The first two are the cam and slide and cam and screw structures discussed above. The third is the slide and guidance

shaft structure shown in Figures 9 and 10 as described at page 9, line 26 to page 10, line 5 of the specification. The fourth is the slide and support plate structure shown in Figure 1 and described at page 5, line 21 to page 6, line 8. The last is the slide and support plate structure shown in Figure 11 and described at page 10, lines 10-14.

As we indicated above, the references do not teach or render obvious the slide and cam or the slide and screw or equivalent structures. We also hold that Kuchler does not teach or render obvious the slide and guidance shaft structure, the slide and support plate structure of the type shown in Figure 11 or equivalent structures. The references provide no suggestion to modify Kuchler's disclosed structure by including these features.

However, we do find that the mounting structure shown in Kuchler's Figure 5 is very similar to that shown by applicant's Figure 1. In both figures the support elements are shown secured to the ski by their respective support plates. We find that the only difference between the structure shown in Figure 1 as described at page 5, line 21 to page 6, line 8, is in the manner of attaching the support plate to the ski. Applicant attaches the support plate 5 to a ski by means of screws 6 and 8. Kuchler's Figure 5 shows a single-piece ski and support plate 2. Kuchler,

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however, also teaches that the torsion box may be manufactured as a finished part for attachment to existing skis. Col. 2, lines 61-63. Thus, one having ordinary skill in the art would know that a single-piece ski and support plate and an attachable support plate are workable alternatives. Accordingly, we conclude that it would have been prima facie obvious to substitute a separate support plate, attached to a ski by screws or other conventional attachment means, for Kuchler's combined ski and support plate. The rejection of claims 56-58 is affirmed.⁶

⁶Applicant has not separately argued the limitations of dependent claims 57 and 58. Accordingly, those claims fall with claim 56. 37 C.F.R. § 1.192(c)(5); In re Goodman, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2013 (Fed. Cir. 1993).

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CONCLUSION

The request for reconsideration is granted to the extent that the rejection of claims 24-33, 36, 42-45 and 54 to 55 is reversed. The request for reconsideration is denied to the extent the affirmance of claims 56 to 58 is not changed.

GRANTED-IN-PART

FRED E. McKELVEY, Chief)	
Administrative Patent Judge)	
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JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
)	
RICHARD E. SCHAFER)	
Administrative Patent Judge)	

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STONER, Administrative Patent Judge, concurring-in-part and dissenting-in-part.

I welcome the modification of the view formerly expressed by the majority with regard to the correctness of the rejection of independent claims 54 and 55 and claims 24 through 33, 36 and 42 through 45 dependent therefrom under 35 U.S.C. § 103. As to the rejection of independent claim 56 and claims 57 and 58 dependent therefrom, I remain of the view expressed in my dissenting opinion to the decision entered December 27, 1994. With the majority's modification of its earlier view, I need now dissent only from the determination that claims 56 through 58 are unpatentable under 35 U.S.C. § 103 based on the teachings of Kuchler and Smolka.

For reasons which should be clear from my earlier opinion, I do not find it necessary to engage in the sort of analysis under In re Donaldson Co., 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (in banc) which the majority has performed. The references upon which the examiner and the majority have relied fail to teach or make obvious the functions associated with the several "means plus function" clauses of independent claims 54, 55 and 56. A reference which in the first instance fails to respond to the functional portion of a "means plus function" limitation does not, without more, teach or make obvious that limitation. See, e.g., Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 4 USPQ2d 1737 (Fed. Cir. 1987). The references plainly do not

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contain any structure which necessarily performs the same functions as those recited in the claims. It is fundamental that a Donaldson "equivalents" analysis is unnecessary where the references relied upon fail to teach or make obvious any element performing the identical function specified in the claim.

BRUCE H. STONER, JR
Administrative Patent Judge

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McQuade, Administrative Patent Judge.

The appellant requests that I reconsider my position on jurisdiction as set forth in the decision dated December 27, 1994 (Paper No. 47) and join in the decision on the merits of this appeal. This request is based on the proposition that

... the issue of jurisdiction under 35 USC 134 of the instant appeal has already been raised by the examiner and the Commissioner has already decided, in the decision of June 10, 1993, that jurisdiction is proper [request, page 3].

The decision of June 10, 1993 (Paper No. 29) was a decision on petition by the Director of Examining Group 3100 granting the appellant's request to withdraw a holding of abandonment made by the examiner. Thus, the point of contention involved an action taken by the examiner and the exercise of supervisory authority by the Group Director to reverse such action. The Group Director's exercise of supervisory authority over the examiner in this regard is clearly not binding on this Board insofar as the issue of our jurisdiction under 35 USC 134 is concerned.

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I therefore decline to make any changes in my position as
set forth in the decision dated December 27, 1994.

JOHN P. McQUADE
Administrative Patent Judge

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) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
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