

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D FRUECHTENICHT

Appeal No. 2000-1474
Application No. 08/962,902

ON BRIEF

Before STAAB, NASE, and GONZALES, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-5 and 7 to 37, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to an adult two-wheel vehicle adapted for acrobatic use (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Fisher	1,689,916	Oct. 30, 1928
Stevenson	4,182,520	Jan. 8,
1980		
Mueller	Des. 292,221	Oct. 6, 1987
Okumura et al.	JP 2-246887	Oct. 2,
1990		
(Okumura)		
Kondo et al.	JP 3-248981	Nov. 6, 1991
(Kondo)		
Gojo	JP 5-221362	Aug. 31,
1993 ¹		

Claims 1, 3, 13, 19 and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mueller.

¹ In determining the teachings of the three Japanese references, we will rely on the translations provided by the USPTO. Copies of the translations are attached for the appellant's convenience.

Claims 20 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Mueller.

Claims 2, 8, 22, 24, 28, 30 and 34-37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mueller in view of either Kondo, Okumura, or Gojo.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mueller in view of either Kondo, Okumura, or Gojo and further in view of Stevenson.

Claim 27 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mueller in view of either Kondo, Okumura, or Gojo as applied to claim 24 above, and further in view of Stevenson.

Claims 4, 5, 9-12, 14-18 and 32 stand rejected under 35 U.S.C. § 103 as being obvious in view of Mueller.

Claims 25 and 26 stand rejected under 35 U.S.C. § 103 as being obvious in view of the combination of Mueller in view of either Kondo, Okumura, or Gojo as applied to claim 24 above.

Claim 33 stands rejected under 35 U.S.C. § 103 as being obvious in view of Mueller as applied to claim 32 above.

Claim 23 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mueller in view of Fisher.

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mueller in view of either Kondo, Okumura, or Gojo as applied to claim 24 above, and further in view of Fisher.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 21, mailed May 13, 1998) and the answer (Paper No. 27, mailed July 20, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 26,

filed May 14, 1999) and reply brief (Paper No. 28, filed September 20, 1999) for the appellant's arguments thereagainst.

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, to the appellant's video tape submitted with his declaration under 37 CFR § 1.132 (Paper No. 9, filed May 11, 1998) and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 1

We sustain the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Mueller.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 1 reads as follows:

A non-motorized adult scooter, comprising:
a first means for providing a steerable front wheel that is rotatable about first axis of rotation;
second means, connected with and supported by said first means, and including a wide upper platform for carrying substantially the entirety of both feet of a standing rider in a variety of positions and locations, and a lower portion having a generally smooth and snag-free face extending opposite from said upper platform for omni-directional sliding engagement with the ground and ground-supported object [sic], said generally smooth and snag-free face extending longitudinally with said upper platform to an upwardly sloping surface adjacent said front wheel, and
third means connected with and supporting said second means and carrying a rear wheel rotatable about a second axis of rotation.

The first issue raised by the appellant is whether or not the second clause (i.e., the second means . . .) of claim 1 invokes the sixth paragraph of 35 U.S.C. § 112.

As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the PTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function

without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The Court of Appeals for the Federal Circuit has established a framework for determining whether an element of a claim invokes means-plus-function treatment. See Al-Site Corp. v. VSI Int'l, Inc., 174 F.3d 1314, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999); Sage Prods. Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997. If the word "means" appears in a claim element in association with a function, the presumption is that Section 112, Paragraph 6 applies. See id. This presumption collapses, however, if the claim itself recites sufficient structure, material, or acts to perform the claimed function. See id. Without the term "means," a claim element is presumed to fall outside means-plus-function strictures. See id. Once again, however, that presumption can collapse when an element lacking the term "means" nonetheless relies on functional terms rather than structure or material to describe performance of

the claimed function. See Al-Site, 174 F.3d at 1318, 50 USPQ2d at 1167.

Because the second clause (i.e., the second means . . .) of claim 1 uses the word "means," we presume that Section 112, Paragraph 6 applies. We next look to whether the second clause of claim 1 specifies a function. In making this determination, we rely primarily on the claim language itself. See York Prods., Inc. v. Central Tractor, 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1624 (Fed. Cir. 1996). After reviewing the language of the second clause of claim 1, we reach the determination that no function is associated therewith. In that regard, the function of "for carrying substantially the entirety of both feet of a standing rider in a variety of positions and locations" is associated with the "wide upper platform" not the "second means" and the function of "for omni-directional sliding engagement with the ground and ground-supported object [sic]" is associated with the "lower portion" not the "second means." In sum, the second clause of claim 1 does not warrant interpretation under Section 112,

Paragraph 6 because it fails to associate a function with the "second means" recited therein.

The appellant argues that Mueller does not anticipate claim 1 since Mueller fails to disclose either the recited "wide upper platform for carrying substantially the entirety of both feet of a standing rider in a variety of positions and locations" or the recited "lower portion having a generally smooth and snag-free face extending opposite from said upper platform for omni-directional sliding engagement with the ground and ground-supported object [sic], said generally smooth and snag-free face extending longitudinally with said upper platform to an upwardly sloping surface adjacent said front wheel." We do not agree.

Mueller discloses a scooter. As shown in the Figures 1-6, the scooter includes a steerable front wheel assembly, a rear wheel assembly, and means interconnecting the steerable front wheel assembly and the rear wheel assembly. The interconnecting means includes a platform for carrying the feet of a standing rider in a variety of positions and

locations and a pair of tubular members which extend from the rear wheel assembly longitudinally along opposite sides of the platform to an upwardly sloping portion adjacent the front wheel assembly. In addition, we agree with the examiner's analysis (answer, pp. 9-12) that the structure of Mueller is capable of meeting the

functional language set forth in claim 1.² In that regard, we consider the platform of Mueller to be a wide upper platform since it is capable of carrying substantially the entirety of both feet of a standing rider in a variety of positions and locations (e.g., the left foot of the standing rider could be placed in front of the right foot of the rider and vice versa). We also consider each of the pair of tubular members to include a lower portion having a generally smooth and snag-free face extending opposite from the platform capable of omni-directional sliding engagement with the ground and ground-supported objects.

It is well settled that the burden of establishing a prima facie case of anticipation resides with the United States Patent and Trademark Office (USPTO). See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.

² A prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. See Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed. Cir. 1985). Rather, if a claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding anticipation. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d at 631-33, 2 USPQ2d at 1052-54.

1984). When relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990).

After the USPTO establishes a prima facie case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, in view of our determinations above, the appellant's burden before the USPTO is to prove that Mueller's scooter does not perform the functions defined in claim 1. The appellant has not come forward with any evidence to satisfy that burden. Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA

1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67
(CCPA 1971).³

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed.

Claims 3 and 31

The appellant has grouped claims 1, 3 and 31 as standing or falling together (brief, p.7). Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 3 and 31 fall with claim 1. Thus, it follows that the decision of the examiner to reject claims 3 and 31 under 35 U.S.C. § 102(b) is also affirmed.

Claims 4, 5, 7 and 13-21

The appellant states (brief, p. 7) that the patentability of dependent claims 13, 19, 20 and 21 depends on the

³ The appellant's mere argument in the brief and the reply brief that Mueller's scooter does not disclose the claimed functions is not evidence. See In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974)(attorney's arguments in a brief cannot take the place of evidence).

patentability of claim 1. In view of our affirmance of the decision of the examiner to reject claim 1 above, the decision of the examiner to reject claims 13 and 19 under 35 U.S.C. § 102(b), to reject claims 20 and 21 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103, and to reject claims 4, 5, 7 and 14-18 under 35 U.S.C. § 103 is also affirmed.

Claims 2, 8, 22, 24-30 and 34-37

We will not sustain the rejection of claims 2, 8, 22, 24-30 and 34-37 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellant's combination would have been

obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

As set forth in the examiner's rejection of claims 2, 8, 22, 24-30 and 34-37 (final rejection, pp. 5-15), the examiner determined that Mueller does not teach the claimed lower portion (final rejection, p. 5). To supply this omission, the examiner made determinations that the claimed lower portion would have been obvious to an artisan from either Kondo, Okumura, or Gojo. We do not agree.

In our view, the only suggestion for modifying Mueller in the manner proposed by the examiner stems from hindsight

knowledge derived from the appellant's own disclosure⁴ since the teachings of Kondo, Okumura, and Gojo do not relate a non-motorized scooter. Specifically, it is our opinion that neither Kondo's engine protector 1, Okumura's undercover 52, or Gojo's engine cover 100 would have provided any motivation or suggestion to have modified the non-motorized scooter of Mueller in the manner proposed by the examiner. Accordingly, the decision of the examiner to reject claims 2, 8, 22, 24-30 and 34-37 under 35 U.S.C. § 103 is reversed.⁵

Claim 32

We sustain the rejection of claim 32 under 35 U.S.C. § 103.

⁴ The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

⁵ We have also reviewed the references to Stevenson and Fisher additionally applied in the rejection of claims 27 and 29 but find nothing therein which makes up for the deficiencies of Mueller discussed above.

Independent claim 31 reads as follows:

In a steerable non-motorized two-wheeled adult vehicle, the improvement comprising a standing platform and an omni-directional lower sliding surface below said standing platform and between the two wheels, said lower sliding surface having a generally smooth and snag-free face extending under said standing platform, said standing platform having sufficient width and length to support both feet of the rider in a variety of positions on the platform to permit an acrobatic rider to engage the lower sliding surface with the ground and ground-supported objects while pointed in multiple directions.
and dependent claim 32 reads as follows:

The vehicle of claim 31 wherein the improvement further comprises front and rear wheels of said vehicle having diameters of from about 16 to about 20 inches, said standing platform having a width of about 8 to about 10 inches and a length of about 24 inches to about 27 inches and being supported by said wheels below their axes of rotation and several inches above the ground.

With regard to claim 32, the examiner determined (final rejection, pp. 10-11) that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Mueller's scooter to have all of the claimed dimensional limitations. The appellant argues (brief, pp. 20-21; reply brief, pp. 9-10) that the subject matter of claim 32 is not disclosed, taught or suggested by Mueller.

After reviewing the appellant's video tape submitted with his declaration under 37 CFR § 1.132 and the respective positions articulated by the appellant and the examiner, we find ourselves in agreement with the examiner that the subject matter of claim 32 would have been obvious at the time the invention was made to a person having ordinary skill in the art. In that regard, we first point out that the subject matter of claim 31 is anticipated by Mueller for the reasons provided above with respect to claim 1. Second, notwithstanding that Mueller fails to disclose the diameters of the front and rear wheels or the length and width of the platform, it is our opinion that appropriate diameters, length and width are obvious matters of designer's choice. Accordingly, we believe that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Mueller's scooter to include (1) front and rear wheels having diameters from about 16 to about 20 inches, and (2) a platform having a width of about 8 to about 10 inches and a length of about 24 to about 27 inches. See In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990) which provided that:

[t]he law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range [citations omitted].

In the present case, however, the appellant has not established, that the claimed dimensions produce unexpected results. In that regard, we note that there is no evidence that the scooter shown in the appellant's video tape has dimensions within the scope of claim 32. Moreover, we agree with the examiner's rationale (answer, pp. 17-18) as to why the appellant's video tape fails to establish unexpected results.

For the reasons set forth above, the decision of the examiner to reject claim 32 under 35 U.S.C. § 103 is affirmed.

Claims 9-12

The appellant has grouped claims 9-12 and 32 as standing or falling together (brief, p.7). Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 9-12 fall with claim 32. Thus, it follows that the decision of the examiner to reject claims 9-12 under 35 U.S.C. § 103 is also affirmed.

Claim 33

The appellant states (brief, p. 7) that the patentability of dependent claim 33 depends on the patentability of claim 31 [sic, claim 32 since claim 33 depends from independent claim 32). In view of our affirmance of the decision of the examiner to reject both claims 31 and 32 above, the decision of the examiner to reject claim 33 under 35 U.S.C. § 103 is also affirmed.

Claim 23

Dependent claim 23 has not been separately argued by the appellant. Accordingly, claim 23 will be treated as falling with its parent claim 1. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); and In re

Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978). Thus, it follows that the decision of the examiner to reject claim 23 under 35 U.S.C. § 103 is also affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 13, 19 and 31 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to reject claims 20 and 21 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 is affirmed; the decision of the examiner to reject claims 4, 5, 7, 9-12, 14-18, 23, 32 and 33 under 35 U.S.C. § 103 is affirmed; and the decision of the examiner to reject claims 2, 8, 22, 24-30 and 34-37 under 35 U.S.C. § 103 is reversed.

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

AFFIRMED-IN-PART

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
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