

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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS-MARTIN MEHLERT and DIETMAR KRUGER

Appeal No. 2001-0484
Application No. 09/116,409

ON BRIEF

Before CALVERT, FRANKFORT, and NASE, 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 to 3, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to an outdoor escalator guide containing a heating cable to keep the handrail from freezing to the handrail guide in extreme cold outdoor conditions (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

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| Saito 1989 | 4,871,056 | Oct. 3, |
| Anttonen 1991 | 5,014,844 | May 14, |
| Huber 1998 | 5,798,038 | Aug. 25, |

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Saito.

Claims 1 to 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Saito in view of Anttonen or Huber.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted

rejections, we make reference to the answer (Paper No. 9, mailed September 28, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 8, filed August 28, 2000) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We will not sustain the rejection of claim 1 under 35 U.S.C. § 102(b).

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473,

1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Thus, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. See In re Oelrich, 666 F.2d at 581, 212 USPQ at 326; Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

Claim 1 reads as follows:

A method of preventing a handrail of an outdoor escalator from freezing which comprises heating a handrail guide associated with said handrail.

Saito discloses an escalator having a pair of handrails 2 driven in synchronism with an endless step structure 1. A pair of balustrades 3 are provided for guiding the respective handrails 2. Each of the balustrades 3 includes a balustrade panel 4 formed of transparent reinforced glass. The balustrade panel 4 is arranged vertically and has a lower portion thereof supported by a fixed member. A plurality of fixing instruments 5 are fixedly mounted to an upper end of the balustrade panel 4. A main deck 8 and a guide frame 9 are mounted to the fixing instruments 5. A guide 10 is fixedly secured to the guide frame 9 and is in sliding contact with an inner peripheral surface of the handrail 2.

As shown in Figures 2-5 of Saito, the main deck 8 has incorporated therein a pair of sockets 13 for a rod-like fluorescent lamp 18. Lead wires 15 extending from each of the sockets 13 are guided into the guide frame 9 through a wiring bore 16 which is formed through the main deck 8 and the guide

frame 9 at a location which does not overlap the fixing instrument 5. The lead wires 15 as well as other electric wires 17 are laid within the guide frame 9. A lamp cover 14 has a side wall portion which is confronted with the balustrade panel 4 with a gap left therebetween. Saito teaches (column 4, line 63, to column 5, line 16) that

Moreover, according to the invention, recirculation of cooling air makes it possible to prevent a rise in temperature due to heat generation of the rod-like fluorescent lamp 18. Heat is generated by turning-on the rod-like fluorescent lamp 18, and a rise in temperature is remarkable, in particular, at the sections adjacent the sockets 13. As described previously, however, since each of the non-contact sections h_1 is utilized to mount a corresponding one of the sockets 13, a non-contact section of the size of h_2 still remains at the non-contact section h_1 , even if the thicknesses of the respective brackets 11A and 11B are taken away from the non-contact section h_1 . Thus, air can freely communicate with the interior of the main deck 8 through the non-contact section h_1 or the non-contact section h_2 . Moreover, since the lamp cover 14 and the main deck 8 are maintained out of contact with the balustrade panel 4, air can freely flow as indicated by the broken lines in FIG. 3 so that heat can sufficiently be radiated. As a result, such inconveniences as heat damage and the like of the lamp cover 14 due to a rise in temperature within the main deck 8 can be eliminated.

The examiner's position (answer, page 4) is that the heat generated by Saito's lights 18 will inherently meet the

requirements of claim 1. Specifically, the examiner states that "[t]he heat from the lights 18 will heat deck 8, frame 9 and guide 10 via conduction through elements 8-10 or convection by the circulating air currents."

The appellants' position (brief, pages 3-4) is that the heat generated by Saito's lights 18 will not travel through the structures (e.g., deck 8, frame 9 and guide 10) with enough efficiency to heat the handrail, much less perform the function of preventing the handrail from freezing especially in view of Saito's teaching quoted above.

We find ourselves in agreement with the appellants' position in this matter. In our view, the heat generated by Saito's lights 18 will not inherently meet the requirements of claim 1. In that regard, we find the examiner's position on this matter to be based upon sheer speculation that the prior art necessarily functions in accordance with the claimed limitations (i.e., prevents a handrail of an outdoor escalator from freezing). As pointed out by the appellants, when the illuminating lamp is arranged within the main deck as taught

by Saito, it is possible to prevent a rise in temperature within the main deck due to heat generation of the illuminating lamp. Thus, there would be little, if any heat transmitted from the lights 18 to the handrail to prevent freezing of the handrail.

Since all the limitations of claim 1 are not disclosed in Saito for the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

We will not sustain the rejection of claims 1 to 3 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would

have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). 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 appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

The examiner's position (answer, page 5) is that "[i]t would have been obvious that one of the wires 17 in figure 4 of Saito could have been a resistance heating element like cable 14 of Anttonen or rod 13 of Huber to prevent or remove ice from the conveyor."

The appellants' position (brief, pages 5-7) is that the applied prior art lacks any suggestion or motivation to combine the references to arrive at the claimed subject matter absent the use of impermissible hindsight. We agree. Teachings of references can be combined only if there is some suggestion or incentive to do so. Here, it is our view that the applied prior art contains none. In fact, the advantage of utilizing a heating cable disposed within a handrail guide associated with a handrail of an escalator to prevent freezing of the handrail is not appreciated by the prior art applied by the examiner. Instead, it appears to us that the examiner relied on impermissible hindsight in reaching his obviousness determination.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 3 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 1 to 3 under 35 U.S.C. § 103 is reversed.

REVERSED

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| IAN A. CALVERT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
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| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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