

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN H. KITE

Appeal No. 2001-1808
Application 08/987,487

HEARD: January 9, 2002

Before MCCANDLISH, Senior Administrative Patent Judge, ABRAMS,
and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

John H. Kite appeals from the final rejection of claims 1 through 5. Claims 6 through 9, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

THE INVENTION

The subject matter on appeal relates to a method of identifying (i.e., marking) perimeter points for lines on an athletic field, and to a rope for marking such a point.

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Representative claims 1 and 5 read as follows:

1. A method of identifying perimeter points for lines on athletic fields and the like, through use of a single strand of flexible rope, comprising,
locating two or more perimeter points on a line of an earthen athletic field comprising a ground surface,
drilling a vertical hole in the field at said points,
thence placing said flexible elongated single strand of making rope with a ground anchor on one end longitudinally into each of said holes so that said ground anchor is in the lower end of the hole, and so that the upper portion of said rope extends from said hole above said ground surface, and
packing loose material in said hole around said rope whereupon the upper portions of said ropes will serve as a visible indicator of the location of said points.

5. A rope for marking the perimeter points for athletic field lines, comprising,
a flexible moisture resistant elongated line having opposite ends, and a diameter,
an anchor element on one end of said line and concentrically mounted with respect to the line and having a diameter greater than the diameter of said line.

THE PRIOR ART

The reference relied on by the examiner to support the final rejection is:

Kuoksa

2,468,211

Apr. 26, 1949

THE REJECTIONS

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Claims 1 through 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kuoksa.

Claims 1 through 5 also stand rejected under 35 U.S.C. § 103(a) as being obvious over Kuoksa.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 11 and 14) and to the examiner's answer (Paper No. 13) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.¹

DISCUSSION

I. The Kuoksa reference

Kuoksa pertains to markers designed to be inserted into the ground to establish the boundary lines of an athletic field. Each marker 8 comprises a conical pointed foot 9 of wood or hard rubber and a plurality of strips 11 of soft white

¹ In the answer, the examiner refers to U.S. Patent Nos. 391,660 to Thayer and 1,263,198 to Brandt in apparent support of the appealed rejections. The statements of the rejections, however, do not include these patents. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342, n.3, 166 USPQ 406, 407, n.3 (CCPA 1970). Accordingly, we have not considered Thayer or Brandt in reviewing the merits of the appealed rejections.

rubber projecting radially from a central disc 12 affixed to the top of the pointed foot by a washer 13 and an eye screw 14. The outer ends of the strips are intended to project above ground level to delineate boundary lines on the field. As described by Kuoksa,

[a] tool 15 for inserting and removing the markers 8 is provided. This tool includes a vertical tubular cylindrical member or bar 16, open at its bottom end, to engage over the washer 13 and eye screw 14, as best shown in Figure 2. The top of the bar 16 carries a hook 17, to engage in the eye screw 14 for pulling the markers 8 out of the ground. A combined foot bar and handle 18 is provided near the bottom end of the bar 16, and this foot bar is at right angles to the bar 16.

When the tool 15 is used to insert a marker 8, the bottom end of the bar 16 is placed over the washer 13 and eye screw, as shown in Figures 2 and 3. The strips 11 are beneath the lower edge of the tool and rest upon the surface of the ground. The tool is pressed downwardly by placing a foot upon the bar 18 and guiding the bar 16 with the hands. When the bar 18 engages the ground surface 6, the markers are inserted to the proper depth, and the tool 15 is removed.

If it is desired to remove the markers from the ground, the bar 18 is used as a handle and the top of the bar 16, carrying the hook 17 is inserted between the upstanding strips 11. The hook 17 is engaged into the eye screw 14, and the marker may be readily pulled up [page 1, column 2, lines 21 through 48].

II. The 35 U.S.C. § 102(b) rejection

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Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Claim 1 recites the sequential steps of drilling a vertical hole in the field at perimeter points and "thence" placing a flexible elongated single strand of marking rope with a ground anchor at one end longitudinally into each hole. The claim also recites the further subsequent step of packing loose material in the hole around the rope. The method disclosed by Kuoksa simply does not include all three of these steps. Arguably, the disclosed use of the Kuoksa tool 15 to insert a marker 8 into the ground constitutes a drilling step as urged by the examiner. Nonetheless, the insertion of the marker 8, which corresponds generally to the recited marking rope, occurs simultaneously with this drilling step, not subsequent thereto as required by claim

1. Kuoksa provides no factual support for the examiner's assertion that "a pre-drilled hole is necessary" (answer, page

6). Kuoksa also fails to disclose a packing step as recited in claim 1. Here again, the reference lacks any support for the examiner's determination that "[w]hen the insertion device [15] is removed, the ground would return to its natural state and would pack the loose material around the elongated rope" (answer, page 6).

Claim 5 recites a marking rope comprising (1) a flexible line having a "diameter" and (2) an anchor element "concentrically mounted" on one end of the line and having a "diameter greater" than the diameter of the line. The examiner appears to have taken the alternative positions that the recitation of the line is met by one of Kuoksa's strips 11 (see pages 3 and 4 in the answer) or by all of the strips 11 arranged as shown in Figure 4 (see pages 8 and 9 in the answer). The former view is unsound because each strip 11 does not have a diameter and the anchor element (pointed foot 9) is not concentrically mounted relative thereto. The latter view is unsound because the flexible strips 11, connected only at one end through the central disc 12, do not reasonably constitute

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an elongated line having a diameter, even when oriented as shown in Figure 4.

Thus, Kuoksa does not disclose each and every element of the inventions respectively recited in claims 1 and 5.

Hence, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 1 and 5, and of claims 2 through 4 which depend from claim 1, as being anticipated by Kuoksa.

III. The 35 U.S.C. § 103(a) rejection

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In short, the examiner has not advanced any factual basis or evidence to support a conclusion that the above noted differences between the subject matter recited in claims 1 and 5 and Kuoksa are such that the subject matter as a whole would

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have been obvious at the time the invention was made to a person having ordinary skill in the art.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1 and 5, and of claims 2 through 4 which depend from claim 1, as being obvious over Kuoksa.

IV. New ground of rejection

The following rejection is entered pursuant to 37 CFR § 1.196(b).

Claim 1, and claims 2 through 4 which depend therefrom, are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted

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by one possessing the ordinary level of skill in the pertinent art. Id.

The language "athletic fields and the like" in the preamble of claim 1 is indefinite because it is not clear from the specification what additional matter the appellant intends to cover by the words "and the like." See Ex parte Remark, 15 USPQ2d 1498, 1500 (Bd. Pat. App. & Int. 1990); Ex parte Kristensen, 10 USPQ2d 1701, 1703 (Bd. Pat. App. & Int. 1989).

Also, the characterization of the claimed "method of identifying perimeter points" by the words "through the use of a single strand of flexible rope" in the preamble of claim 1 is inconsistent on its face and when read in light of the specification. In this regard, the specification indicates what is manifest: that the identification of plural perimeter points necessarily involves the use of a like plurality of flexible rope strands. The presence of the singular terms "hole," "strand," "anchor," "upper portion" and "rope" in the bodies of claims 1, 3 and 4 poses similar inconsistencies. These terms should be appropriately amended, as by being pluralized or modified by the term "each," so as to be

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consistent with the recited objective of identifying plural
"perimeter points."

SUMMARY

The decision of the examiner to reject claims 1 through 5
is reversed, and a new rejection of claims 1 through 4 is
entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant
to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final
rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203
Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).
37 CFR § 1.196(b) provides that, "A new ground of rejection
shall not be considered final for purposes of judicial
review."

37 CFR § 1.196(b) also provides that the appellant,
WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise
one of the following two options with respect to the new
ground of rejection to avoid termination of proceedings
(§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the
claims so rejected or a showing of facts relating to
the claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b).

HARRISON E. MCCANDLISH)
Senior	Administrative
Patent Judge))
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) APPEALS AND
NEAL E. ABRAMS)
Administrative Patent Judge) INTERFERENCES
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JOHN P. MCQUADE
Administrative Patent Judge

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