

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

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID DOWNING

Appeal No. 2001-2338
Application 08/996,360

HEARD: March 4, 2003

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 23 through 43, which are all of the claims remaining in this application. Claims 1 through 22 have been canceled.

As set forth on page 1 of the specification, the problem addressed by appellant regards permanently constructed outdoor seating for places such as outdoor sports stadiums and the like.

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More particularly, appellant is specifically concerned with the problem of persons sitting in this type of outdoor seating in short sleeve shirts and facing the risk of the person's bare arms directly contacting the sun-heated armrests of such stadium seats. To overcome this problem, appellant has devised a portable cushioning and protection apparatus for the seat armrests (e.g., Fig. 2) which can be easily installed on and removed from the armrests and easily transported to and from the outdoor stadium by the user. Also of importance to appellant is the possibility of the outer surface of the cushioning and protection apparatus having indicia thereon, such as a team name or logo. Independent claims 23, 28, 33 and 36 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

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

Zapf	4,285,544	Aug. 25, 1981
Geraci	4,925,241	May 15, 1990
Coates	5,332,288	Jul. 26, 1994
Lofy	5,429,416	Jul. 4, 1995

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Claims 23 through 26, 28 through 31 and 33 through 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zapf in view of Geraci.

Claims 27 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zapf in view of Geraci as applied above, and further in view of Lofty.

Claims 23 through 25 stand rejected for a second time under 35 U.S.C. § 103(a) as being unpatentable over Zapf in view of Geraci.

Claims 33 through 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zapf in view of Coates and Geraci.¹

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant

¹ Claim 35 was amended subsequent to the final rejection in a paper filed September 15, 2000 (Paper No. 20). The advisory action following such amendment (Paper No. 23, mailed September 25, 2000) indicates that the amendment was approved for entry by the examiner and that the rejection of claim 35 under 35 U.S.C. § 112, second paragraph, in the final rejection was overcome.

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regarding those rejections, we make reference to the examiner's corrected answer (Paper No. 30, mailed December 3, 2001) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 24, filed November 20, 2000) and reply brief (Paper No. 27, filed April 3, 2001) for the arguments thereagainst.

OPINION

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

However, before looking to the prior art rejections put forth by the examiner, we note that it is an essential prerequisite that the claimed subject matter be fully understood. Accordingly, we initially direct our attention to appellant's independent claims 23, 28, 33 and 36 to derive an understanding of the scope and content thereof. Claims 23, 28 and 33 are each directed to a combination including, *inter alia*, "a substantially non-movable chair" having an armrest and a cushioning apparatus

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or cushioning arm protector for the armrest which is removably securable about the armrest. Claim 36 is directed to a method of simultaneously cushioning and protecting a person's arm and displaying advertising indicia, comprising (*inter alia*) providing an elongated cushioning body having advertising indicia on the outside surface thereof, providing "a substantially non-movable stadium chair" having an armrest, and installing the cushioning body over the armrest of the substantially non-moveable stadium chair so that the advertising indicia is viewable. In this case, it is important that we understand exactly what appellant means by the recitation of "a substantially non-movable chair" having an armrest and "a substantially non-movable stadium chair" having an armrest.

As we noted above, appellant's specification on pages 1 and 2 makes clear that the problem addressed by appellant regards permanently constructed outdoor seating for places such as outdoor sports stadiums and the like and, more specifically, the problem of persons sitting in such outdoor seating in short sleeve shirts and facing the risk of the person's bare arms directly contacting the sun-heated armrests of the seats. To overcome that problem, appellant has devised a portable

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cushioning and protection apparatus (e.g., Fig. 2) for the stadium seat armrests which can be easily installed on and removed from the armrest and easily transported to and from the outdoor stadium by the user. Also of importance to appellant is the possibility of the outer surface of the cushioning and protection apparatus having indicia thereon, such as a team name or logo. On page 9 of the reply brief (Paper No. 27) appellant specifically argues that he has defined outdoor seating as being "permanently mounted inside [an] arena" (specification, page 1, lines 18-19), such as an outdoor sports stadium, and used the recitation of a "substantially non-movable chair" in the claims on appeal to define such a stadium or outdoor seat permanently mounted in place.

Before the USPTO, when evaluating claim language during examination of an application, the examiner is required to give the terminology of a claim its broadest reasonable interpretation consistent with the specification, and to remember that the claim language cannot be read in a vacuum, but instead must be read in light of the specification as it would have been interpreted by one of ordinary skill in the pertinent art. See In re Sneed, 7120 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re

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Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In the present case, the examiner has not attempted to define or otherwise provide any reasonable interpretation of the claim language in question. In applying the above precepts to the present case, we would agree with appellant that the broadest reasonable interpretation consistent with the specification that may be applied to the terminology "substantially non-movable chair" as in claims 23, 28 and 33 on appeal and "substantially non-movable stadium chair" as in claim 36 on appeal is that such a chair is an outdoor stadium or arena seat permanently mounted in place.

With the above interpretation in mind, we look to the examiner's rejection of independent claims 23, 28, 33 and 36 under 35 U.S.C. § 103(a) based on the combined teachings of Zapf and Geraci. According to the examiner (answer, pages 3-4), Zapf "teaches the structure substantially as claimed including a substantially non-movable chair provided as a permanently mounted stadium chair" and having armrests with cushioning apparatus (12, 14) thereon which are removable from and securable about the chair armrests. The only difference identified by the examiner

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between the chair seen in Zapf and appellant's claimed subject matter is that Zapf "does not teach exposed readable indicia" disposed on the cushioning apparatus or cover thereon. To account for the above-noted difference, the examiner turns to the portable, foldable seat cushion of Geraci used for sporting events, urging that

It would have been obvious and well within the level of ordinary skill in the art to modify the cushioning apparatus and its cover, as taught by Zapf, to include exposed readable indicia comprising a team name or logo, as taught by Geraci on the cover of the cushioning apparatus, since the concept is very old in the art such as placement on mugs, drinking cups, insulated devices for placement around cans, cups, or mugs, and seat cushions is old and it is an old form of advertisement that allows one to put his company, business, store, or franchise name out in the public eye and to also have merchandise tie-ins with sports teams and allow fans at sporting events to show what team they support, as well as showing team spirit/support. [see examiner's answer, page 4]

One look at Figures 1 and 2 of Zapf belies the examiner's assertion that the chair seen therein is "a substantially non-movable chair provided as a permanently mounted stadium chair." To the contrary, it is abundantly clear that the chair of Zapf is an upholstered office chair that is intended to be movable via the casters base (24) thereon. The examiner's further assertions on page 8 of the answer that the chair of Zapf is

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"substantially non-movable" when it is not subjected to any outside force, or when it is "placed [sic, on] a grassy surface," are clearly contrived and wholly untenable.

As for the examiner's contention that it would have been obvious to one of ordinary skill in the art to provide the cushioning apparatus (12, 14) of Zapf's upholstered office chair with exposed readable indicia comprising a team name or logo, we agree with appellant's argument as set forth in the brief (pages 17-18) and reply brief (pages 7-8) that there is absolutely no teaching, suggestion, or incentive in the applied references for applying any form of written indicia to the armrest cushions of the office chair seen in Zapf. Moreover, like appellant, given the incomplete sentence on page 9 of the examiner's answer, it appears that even the examiner was unable to articulate any motivation for such a combination of the applied patents.

Also of concern here is the examiner's total lack of any specific treatment of the method claims on appeal (i.e., claims 36-43) and the examiner's clearly erroneous assertions (answer, page 8) that the method claims are "somewhat irrelevant" and that a § 103 rejection of the apparatus claims "basically covers a

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rejection of the method claims as well.” In this regard, we are wholly in agreement with appellant’s arguments as set forth in the brief (pages 12-16) and reply brief (pages 3-7). We also note the examiner’s apparent failure to treat or otherwise comment on the declaration filed by appellant on September 15, 2000 (Paper No. 22), even in the face of a specific argument in appellant’s brief (page 22) pointing this oversight out to the examiner.

In light of the foregoing, it is our determination that the examiner’s rejection of claims 23 through 26, 28 through 31 and 33 through 43 under 35 U.S.C. § 103(a) as being unpatentable over Zapf in view of Geraci and the examiner’s separate rejection of claims 23 through 25 under 35 U.S.C. § 103(a) as being unpatentable over Zapf in view of Geraci will both not be sustained.

Turning now to the examiner’s rejection of claims 27 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Zapf in view of Geraci as applied above, and further in view of Lofty, and the examiner’s rejection of claims 33 through 38 under 35 U.S.C. § 103(a) as being unpatentable over Zapf in view of Coates and

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Geraci, we have reviewed the patents to both Lofty and Coates, but find nothing therein which would provide for, or otherwise render obvious, that which we have found above to be lacking in the examiner's asserted combination of Zapf and Geraci. Thus, the examiner's rejection of dependent claims 27 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Zapf, Geraci and Lofty, and the examiner's rejection of claims 33 through 38 under 35 U.S.C. § 103(a) as being unpatentable over Zapf in view of Coates and Geraci, will also not be sustained.

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It follows from the foregoing that the decision of the examiner rejecting claims 23 through 43 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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