

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte LASLO L. BOLDIZAR

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Appeal No. 2002-0220  
Application No. 08/964,496

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ON BRIEF

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Before FRANKFORT, STAAB and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4, 6, 7, 9-12, 14, 15 and 17-20. Claims 5, 8, 13 and 16, the only other claims pending in this application, stand objected to as depending from a rejected base claim but have been indicated as containing allowable subject matter.

### BACKGROUND

The appellant's invention relates to a safety tool for preventing falling movement of an automobile window which has been disengaged from its normally attached window-height regulator (specification, page 2). Representative claims 1, 9 and 17 read as follows:

1. A tool for supporting and preventing sudden downward movement of a vehicle door window, the window including a glass panel disposed for free-moving vertical movement in a window channel bounded by inner and outer door panels, the window tool comprising

a frame,

first and second suction cups, mounted on the support frame in a spaced arrangement, for removably clamping the tool to the window glass panel; and

first and second slides, mounted on the frame in a spaced arrangement, for inserting a predetermined distance into the window channel between the glass panel and one of said door panels;

wherein the first and second suction cups, clamped to the window panel, cooperate with the slides, inserted into the window channel, and with the frame, to evenly support and prevent sudden downward movement of the glass panel.

9. A window-support tool for automobile door windows disposed for free-moving vertical movement in a linear channel in the automobile door, the tool comprising

a tool frame having a longitudinal dimension;

a pair of spaced suction cups mounted on the frame for removably attaching the tool to the window glass panel; and

a pair of slides, mounted on the frame, for engaging the linear channel;

wherein the window is evenly supported in the channel and prevented from sudden downward movement.

17. A tool for preventing sudden downward movement of a vehicle door window, the window including a glass panel disposed for free-moving vertical movement in a window channel bounded by inner and outer door panels, the window tool comprising

a frame;

attachment means disposed in the frame for removably attaching the housing to the glass panel; and channel support means disposed within the housing for preventing downward movement of the frame below the height of the window channel.

The following rejections are before us for review.

Claims 1-3, 7, 9-11, 15 and 17-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Taylor<sup>1</sup>.

Claims 4, 6, 12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 12) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 11) for the appellant's arguments thereagainst.

#### OPINION

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<sup>1</sup> U.S. Pat. No. 5,398,602, issued March 21, 1995 to Kim S. Taylor.

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

Independent claim 1 recites, in the preamble thereof, a tool for supporting and preventing sudden downward movement of a *vehicle door window* including a glass panel disposed for free-moving vertical movement in a *window channel* bounded by inner and outer door panels and, in the body of the claim, “first and second slides ... *for inserting* a predetermined distance *into the window channel between the glass panel and one of said door panels*” (emphasis ours). Independent claim 9, likewise, recites, in its preamble, a window-support tool for *automobile door windows* disposed for vertical movement *in a linear channel in the automobile door* and, in the body thereof, “a pair of slides ... for engaging the linear channel” wherein the window is evenly supported in the channel and prevented from sudden downward movement.

In this instance, the preambles of claims 1 and 9 help define what is meant by the “window channel” and “linear channel” referred to in the body of the claims and, thus, impart structural limitations to the “slides” recited in the body of the claims.<sup>2</sup> In particular, the recited slides must be capable of being inserted into the window channel

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<sup>2</sup> In so doing, the preambles of claims 1 and 9 are “necessary to give life, meaning, and vitality” to the claim. See *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

of a vehicle door window between the glass panel and one of the door panels (claim 1) or capable of engaging the linear channel of an automobile door (claim 9).

The examiner's reading of the claim elements on Taylor's device is set forth on page 3 of the answer. Appellant argues that the clamps 30 of Taylor's registration device for positioning a silk screen frame against a smooth, flat surface or panel have a different structure and function than the slides 30, 32 of appellant's invention and could not be used in the same manner to support the vehicle window from falling (brief, page 6). The examiner identifies Taylor's clamps 30 as slides but offers no rationale and points to no teaching in Taylor to show that the clamps 30 are dimensioned so as to be capable of insertion between the glass panel and door panels of a vehicle door to engage the window channel. Taylor certainly does not teach such a use of the clamps 30 of the registration device and we find nothing in the teachings of Taylor which would lead one skilled in the art to conclude that the clamps 30 of Taylor are inherently<sup>3</sup> capable of achieving the function set forth in claims 1 and 9.

Anticipation is established only when a single prior art reference discloses, expressly or under the 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). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary

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<sup>3</sup> Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Having determined that Taylor does not disclose, either expressly or under the principles of inherency, each and every element recited in claims 1 and 9, we are constrained to reverse the examiner's rejection of claims 1 and 9, as well as claims 2, 3, 7, 10, 11 and 15 which depend therefrom, as being anticipated by Taylor.

As discussed *supra*, the examiner has not set forth a basis to establish that Taylor's clamps 30 are capable of performing the functions called for in claims 1 and 9. We find no suggestion in Taylor, and the examiner has not pointed to any such suggestion, to modify the clamps 30 for such capability. Thus, we must also reverse the examiner's rejection of claims 4, 6, 12 and 14, which depend from claims 1 and 9, as being unpatentable over Taylor.

We also shall not sustain the examiner's rejection of claims 17-20. For the reasons discussed in the new ground of rejection, *infra*, claims 17-20 are indefinite. Therefore, the rejection of these claims as being anticipated by Taylor must fall because it is necessarily based on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 17-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

In claim 17, it is not clear what is meant by “attachment means disposed *in* the frame.” While this attachment means might appear to correspond to the suction cups disclosed in appellant’s specification, such structure is disclosed as being supported or disposed *on* the frame and not *in* the frame (see, for example, Figures 3 and 5). As such, this limitation presents an inexplicable inconsistency with the underlying disclosure and thus renders the claim indefinite.<sup>4</sup> Moreover, “the housing” lacks antecedent basis in the claim. While we might speculate that “the housing” is intended to refer to the tool or to the frame, this uncertainty renders the scope of the claim indefinite. Finally, the language “channel support means” would seem to describe a structure which supports a channel and thus does not appear to accurately describe any structure disclosed in appellant’s specification. Consequently, one of ordinary skill

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<sup>4</sup> See In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971).

in the art would not be able to determine with any certainty the metes and bounds of claim 17. Claims 18-20 depend from claim 17 and are likewise indefinite.

### CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4, 6, 7, 9-12, 14, 15 and 17-20 is reversed and a new rejection of claims 17-20 under 35 U.S.C. § 112, second paragraph, is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b), which 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. . . .

(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)

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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