

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MILFORD K. MASON

Appeal No. 2002-0234
Application No. 09/496,087

ON BRIEF

Before FRANKFORT, STAAB, and MCQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, all of the claims pending in this application.

As noted on page 1 of the specification, appellant's invention relates to a tractor-mounted forklift mechanism and, more particularly, to a forklift mechanism mounted on the front

Appeal No. 2002-0234
Application No. 09/496,087

of a conventional tractor which mechanism includes a wheeled frame means positioned forwardly of the tractor to which the weight carried by the forklift maybe transferred. A copy of claims 1 through 4 on appeal may be found in the Appendix to appellant's brief.

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

Ferris	4,079,798	Mar. 21, 1978
Granlind et al. (Granlind)	4,424,872	Jan. 10, 1984
Smith et al. (Smith)	5,823,629	Oct. 20, 1998

Claims 1 through 4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as his invention.

Claims 1 through 4 additionally stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Granlind in view of Smith or Ferris.

Appeal No. 2002-0234
Application No. 09/496,087

Rather than reiterate the details of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we refer to the examiner's answer (Paper No. 11, mailed June 29, 2001) and to appellant's brief (Paper No. 10, filed April 9, 2001) and reply brief (Paper No. 12, filed July 31, 2001) for a full exposition thereof.

OPINION

After careful consideration of appellant's specification and claims, the teachings of the applied prior art references and each of the arguments and comments advanced by appellant and the examiner, we have reached the determinations which follow.

Turning first to the examiner's rejection of claims 1 through 4 under 35 U.S.C. § 112, second paragraph, the examiner asserts that the subject matter of these claims is indefinite because independent claims 1, 3 and 4 fail to set forth a forklift structure (i.e., a mast, carriage moved by motive means, etc.) thus rendering these claims incomplete. In addition, the

Appeal No. 2002-0234
Application No. 09/496,087

examiner asserts that in lines 7-8 of claim 1, improper alternative claiming is present.

After reviewing appellant's specification and the above enumerated claims in light thereof, and also in light of appellant's arguments in their brief (pages 7-8), it is our opinion that the scope and content of the subject matter embraced by claims 1 through 4 on appeal is reasonably clear and definite, and fulfills the requirements of 35 U.S.C. § 112, second paragraph. In our view, the examiner's criticism of the language used in those claims, or the lack thereof, goes to the breadth of the claims and not to indefiniteness. It is well settled that breadth alone is not to be equated with indefiniteness and that in determining whether a claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity, the definiteness of the language employed in the claim 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 by one possessing the ordinary level of skill in the pertinent art. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977). When that standard of evaluation is applied to claims 1 through 4

Appeal No. 2002-0234
Application No. 09/496,087

on appeal, we are of the opinion that those claims set out and circumscribe a particular area with a reasonable degree of precision and particularity.

Nor do we see any reason to conclude that claims 1 through 4 are in any way incomplete. The forklift apparatus broadly set forth therein includes a wheeled frame (82) pivotally secured to the forward end of a tractor (12), a connecting means (28), a material handling attachment (120) mounted on the wheeled frame and a length adjustable member (76) for bringing the wheels on the wheeled frame into and out of contact with the ground as needed or desired. Based on appellant's disclosure, it is readily apparent that it is the "material handling attachment" (120) which incorporates the elements of concern to the examiner (i.e., a base mast section (122), a carriage or movable mast section (124) moved by motive means, tines (144), etc.). Again, we note that breadth alone does not equate to indefiniteness.

In addition, with regard to the examiner's assertion of "improper alternate claiming," after reviewing appellant's specification and claim 1 in light thereof, it is our opinion that the examiner's criticism of the alternative language used in

Appeal No. 2002-0234
Application No. 09/496,087

appellant's claim 1 is unwarranted. We know of no requirement that alternative embodiments like those set forth in appellant's claim 1, which are clearly disclosed in the specification (page 7) and readily apparent to one of ordinary skill in the art, must necessarily be set forth in separate independent claims. Again applying the standard set forth above in In re Johnson, we are of the opinion that claim 1 sets out and circumscribes a particular area with a reasonable degree of precision and particularity, and that one of ordinary skill in the art would clearly understand what is being claimed.

Given the foregoing, we will not sustain the examiner's rejection of appellant's claims 1 through 4 under 35 U.S.C. § 112, second paragraph.

Regarding the examiner's rejection of claims 1 through 4 under 35 U.S.C. § 103(a) as being unpatentable over Granlind in view of Smith or Ferris, we find that we are in agreement with appellant's position as set forth in the brief and reply brief. Apparently it is the examiner's position that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to somehow substitute what the examiner

Appeal No. 2002-0234
Application No. 09/496,087

characterizes as "an equivalent pivotably mounted frame" (answer, page 3) as taught by Smith or Ferris for the frame or cylinder arrangement supporting the extendible wheel (8) on the forklift truck of Granlind. However, in our opinion, the mere fact that pivotable mounting frames for tag axle wheel assemblies on concrete trucks or dump trucks like those in Smith or Ferris existed in the prior art at the time of appellant's invention provides no teaching, suggestion, motivation or incentive for the examiner's proposed modification of the forklift mechanism of Granlind. Moreover, we find no teaching or suggestion of a "tractor" and forklift apparatus combination like that claimed by appellant in any of the references applied by the examiner.

After reviewing the prior art relied upon, we are of the opinion that the examiner has taken appellant's disclosure and claims as a blueprint and used them to seek out and assemble disparate elements from the prior art in an effort to arrive at appellant's claimed subject matter. Thus, the examiner's position in this appeal represents a clear case of impermissible hindsight reconstruction of the claimed invention based upon appellant's own teachings. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1264,

Appeal No. 2002-0234
Application No. 09/496,087

23 USPQ2d 1780, 1784 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

Since we have concluded that the examiner has failed to set forth a prima facie case of obviousness, we will not sustain the rejection of claims 1 through 4 under 35 U.S.C. § 103(a).

In summary:

The examiner's decision rejecting claims 1 through 4 under 35 U.S.C. § 112, second paragraph, has not been sustained.

In addition, the examiner's decision rejecting claims 1 through 4 under 35 U.S.C. § 103(a) as being unpatentable over Granlind in view of Smith or Ferris has not been sustained.

Thus, the decision of the examiner rejecting claims 1 through 4 of the present application is reversed.

Appeal No. 2002-0234
Application No. 09/496,087

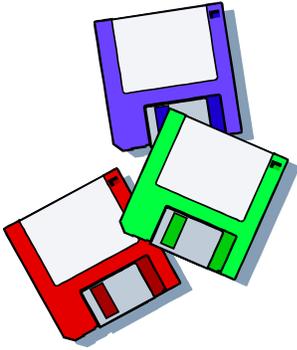
REVERSED

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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JOHN P. MCQUADE)	
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Appeal No. 2002-0234
Application No. 09/496,087

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Appeal No. 2002-0234
Application No. 09/496,087

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DECISION: REVERSED

Prepared: August 15, 2003

Draft Final

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