

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 47

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUNO GIROUARD
and BERTHOLD FECTEAU

Appeal No. 2004-0921
Application 09/472,134

HEARD: June 10, 2004

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

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Bruno Girouard et al. originally took this appeal from the final rejection (Paper No. 26) of claims 1 through 49, 55, 57 through 61, 64 through 68, 73 and 77 through 92. As the appellants have since canceled claims 61, 89 and 91 and amended claims 60 and 92, the appeal now involves claims 1 through 49, 55, 57 through 60, 64 through 68, 73, 77 through 88, 90 and 92, all of the claims currently pending in the application.

THE INVENTION

The invention relates to "a snowmobile where, among other features, the steering control position, the seating position, and the position of the footrests are arranged in relation to one another so that the rider's center of gravity is closer to the center of gravity of the vehicle than on a conventional snowmobile" (specification, page 1). Representative claim 1 reads as follows:

1. A snowmobile, comprising:
 - a frame;
 - an engine disposed on the frame;
 - a drive track disposed below the frame and connected operatively to the engine for propulsion of the snowmobile;
 - two skis disposed on the frame;
 - a straddle seat disposed on the frame behind the engine, the seat being dimensioned to support a standard rider with a center of gravity in a standard position in which the standard rider straddles the seat while the snowmobile is heading straight ahead on flat terrain, the standard rider having dimensions and weight of a 50-percentile human male; and
 - a steering device disposed on the frame forward of the seat, the steering device being operatively connected to the two skis for steering the snowmobile,
 - wherein the snowmobile has a first center of gravity without the rider and a second center of gravity with the rider in the standard position, and
 - wherein a distance between a vertical line passing through the first center of gravity and a vertical line passing through the second center of gravity is between 0 cm and 14 cm.

THE REJECTIONS

Claims 1 through 49, 55, 57 through 60, 64 through 68, 73, 77 through 88, 90 and 92 stand rejected under 35 U.S.C. § 112,

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first paragraph, as being based on a specification which lacks an enabling disclosure of the claimed invention.

Claims 60, 73, 85, 88 and 92 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which lacks a written description of the claimed invention.

Claims 1 through 49, 55, 57, 58, 64 through 68, 77 through 84, 87, 88 and 90 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention.

Claim 73 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Document 2-274681 to Kitamura et al. (Kitamura).¹

Attention is directed to the main and reply briefs (Paper Nos. 35 and 39) and to the answer (Paper No. 38) for the respective positions of the appellants and the examiner regarding the merits of these rejections.²

¹ The record contains an English language translation of the Kitamura reference submitted by the appellants on February 14, 2003 (Paper No. 29).

² The record indicates that the inclusion of canceled claim 76 in the examiner's statement of the first rejection, the inclusion of canceled claim 89 in the examiner's statement of the second rejection and the omission of claims 58 and 88 from the examiner's statement of the third rejection stem from inadvertent oversights which have not prejudiced the appellants to any significant degree.

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DISCUSSION

I. Preliminary matter

The appellants raise as an issue in the appeal the refusal of the examiner to enter certain drawing corrections proposed during the prosecution of the application (see page 13 in the main brief). As this matter is not directly connected with the merits of issues involving a rejection of claims, it is reviewable by petition to the Director rather than by appeal to this Board (see In re Hengehold, 440 F.2d 1395, 1403-04, 169 USPQ 473, 479 (CCPA 1971)), and hence will not be further addressed in this decision.

II. The 35 U.S.C. § 112, first paragraph, enablement rejection of claims 1 through 49, 55, 57 through 60, 64 through 68, 73, 77 through 88, 90 and 92

The dispositive issue with respect to the enablement requirement of 35 U.S.C. § 112, first paragraph, is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the disclosure, the examiner has the

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initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

According to the examiner (see pages 4, 5 and 9 through 14 in the answer), the appellants' disclosure is non-enabling because the close spatial relationship illustrated in Figures 2 and 3 between the handlebars (132) and windshield (124) of the snowmobile would prevent any significant steering function, thereby making the claimed invention inoperative. The appellants, relying on the 37 CFR § 1.132 Declaration of Robert Handfield filed July 9, 2002 (Paper No. 25) and prior art items appended to the main brief, submit that Figures 2 and 3 are merely schematic representations of the snowmobile, and would be recognized as such by a person of ordinary skill in the art, and that such a person would have been able to make and use the snowmobile disclosed and claimed without undue experimentation notwithstanding the subject portions of Figures 2 and 3.

Considered in light of the appellants' entire disclosure, the Handfield declaration and the cited prior art items, the examiner's determination of non-enablement is not well founded. While the depiction of the handlebars and windshield in Figures 2 and 3 arguably is problematic, the evidence as a whole clearly indicates that it involves a relatively minor drawing glitch

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which would not have prevented a person of ordinary skill in the art from making and using, without undue experimentation, the invention disclosed and claimed by the appellants.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, enablement rejection of claims 1 through 49, 55, 57 through 60, 64 through 68, 73, 77 through 88, 90 and 92.

III. The 35 U.S.C. § 112, first paragraph, written description rejection of claims 60, 73, 85, 88 and 92

The test for determining compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id.

In the examiner's view (see pages 5, 6 and 14 through 16 in the answer), the appellants' original disclosure does not support the recitation in claims 60, 85, 88 and 92 that the snowmobile comprises a "tunnel" or the recitation in claim 73 that the

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snowmobile comprises right and left toe-holds disposed respectively "above the rider's toes in a vertical plane."

Although the original disclosure on its face does not mention a "tunnel," it does incorporate by reference (see page 1) Canadian Patent Application No. 2,256,944³ which does disclose a snowmobile having a tunnel 27 housing a drive track 9. This incorporated disclosure of the tunnel is entirely consistent with the disclosure in the appellants' original drawings of drive track 120 extending from a partially enclosed area defined by the snowmobile. Taken together, these disclosures would reasonably convey to the artisan that the appellants had possession at the time the instant application was filed of a snowmobile having a "tunnel" as set forth in claims 60, 85, 88 and 92. Similarly, the disclosure in the original specification (see page 10) of toeholds disposed above the forward portions of the sideboards upon which rest the rider's feet would reasonably convey to the artisan that the appellants had possession at that time of a snowmobile having toeholds disposed respectively "above the rider's toes in a vertical plane" as recited in claim 73.

³ A copy of this document is appended to the main brief.

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Therefore, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, written description rejection of claims 60, 73, 85, 88 and 92.

IV. The 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 49, 55, 57, 58, 64 through 68, 77 through 84, 87, 88 and 90

35 U.S.C. § 112, second paragraph, 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 by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner (see pages 6, 7, 16 and 17 in the answer) considers claims 1 through 49, 55, 57, 58, 64 through 68, 77 through 84, 87, 88 and 90 to be indefinite due to the references therein to a "standard rider" and/or a "standard position" of the rider. According to the examiner, "a rider, a human being, cannot be standardized [and] even if the rider could be standardized, the position of the rider . . . depends on more than simply the dimensions of the rider" (answer, page 6). These

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concerns are unfounded and miss the point that the language in the claims relating to the standard rider and standard position merely set forth theoretical criteria by which the claimed snowmobile is defined. As the examiner has not disputed the detailed descriptions of the standard rider and standard position in the underlying specification, it is not apparent why the use of these terms in the claims to set forth the metes and bounds of the claimed snowmobile poses a definiteness problem.

Hence, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 49, 55, 57, 58, 64 through 68, 77 through 84, 87, 88 and 90.

V. The 35 U.S.C. § 102(b) rejection of claim 73 as being anticipated by Kitamura

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). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary 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).

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Kitamura discloses a snowmobile which includes footrests 9 and nearly vertical upright walls 10a and 10b extending upwardly from the forward ends of the footrests (see Figures 1 through 3).

Claim 73 recites a snowmobile comprising, inter alia, (1) right and left sideboards having forward portions disposed at an angle with horizontal that is -5° to -10° and (2) right and left toe-holds disposed respectively above the rider's toes in a vertical plane. The examiner (see pages 7 through 9 in the answer) finds that the former feature is met by Kitamura's footrests 9 which are illustrated in Figure 1 as being disposed at an angle to the horizontal of approximately -6° and that the latter feature is met by Kitamura's upright walls 10a and 10b. Although Figure 1 does show the footrests 9 disposed at an angle of approximately -6° to the horizontal, Kitamura makes no mention of footrest angles and does not indicate that Figure 1 is drawn to scale. Absent any written description in a reference of quantitative values or that the drawings are working drawings, arguments based on drawing measurements have little practical value. See Hockerson-Halberstadt Inc. v. Avia Group International Inc., 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000). Furthermore, Kitamura does not show or describe the sidewalls 10a and 10b as having any structure which one of

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ordinary skill in the art would view as embodying toe-holds disposed respectively above the rider's toes in a vertical plane. Thus, the examiner's finding that Kitamura discloses each and every element of the snowmobile recited in claim 73 is unsound.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 73 as being anticipated by Kitamura.

SUMMARY

The decision of the examiner to reject claims 1 through 49, 55, 57 through 60, 64 through 68, 73, 77 through 88, 90 and 92 is reversed.

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REVERSED

CHARLES F. FRANKFORT)	
Administrative Patent Judge)	
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JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

JPM/kis

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PILLSBURY & WINTHROP, LLP
P. O. BOX 10500
MCLEAN, VA 22102