

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS A. CHIMENTI, DANIEL
K. NG and RAYMOND R. RAABER

Appeal No. 95-2768
Application 08/019,700¹

HEARD: December 8, 1997

Before CALVERT, COHEN and STAAB, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 14, 17, 18 and 28 to 30.² Claims 20 to 25, the other claims remaining in the application, stand withdrawn from consideration under 37 CFR § 1.142(b) as being directed to a

¹ Application for patent filed February 19, 1993. According to appellants, the application is a division of Application 07/829,282, filed February 3, 1992.

² Claims 14, 16 to 19 and 27 to 29 were finally rejected, but in an amendment filed on October 25, 1994 (Paper No. 13), claims 16, 19 and 27 were cancelled, and claim 30 was added.

Appeal No. 95-2768
Application 08/019,700

nonelected invention.

The subject matter in issue concerns a bicycle carrier adapted to be mounted on the rear of a vehicle. The claims on appeal are reproduced in the appendix hereto.

The references applied by the examiner in rejecting the appealed claims are:

Kamaya	4,770,329	Sep. 13, 1988
Blackburn et al. (Blackburn)	5,056,700	Oct. 15, 1991
Piretti	5,118,020	Jun. 2, 1992

Claims 14, 17, 18 and 28 to 30 stand rejected under 35 USC § 103 as unpatentable over Kamaya, Blackburn and Piretti.

The basis of the rejection, as stated on pages 4 to 5 of the supplemental examiner's answer (Paper No. 25), is:

As seen in figure 1, Kamaya discloses a cradle (support 3) for retaining articles on a carrier with a strap which will normally extend upward, however, Kamaya does not show the cradle on a bicycle carrier with extending arm members. Blackburn et al and Piretti show that cradle members are used on bicycle carriers to support bicycles. It would have been obvious to utilize the cradle of Kamaya on other carriers such as those shown by Blackburn et al and Piretti for securing the held article with a one piece retaining member which provides for easier manufacture. When tightened, the cradle will have a frictional grip on the carrier as

claimed. Alternatively, it would have been obvious to construct the cradles of Blackburn et al and Piretti with an integral securing strap as shown by Kamaya for easier manufacture of the component.

After fully considering the record in light of the arguments presented by appellants and the examiner, we conclude that this rejection should not be sustained.

All of the claims on appeal, except for claim 29, require that the retaining strap on the base is normally extending upwardly from said base (claim 14) or normally extend[s] away from said base (claim 30). Even assuming that it would have been obvious to utilize the cradles 3 disclosed by Kamaya on the supporting arms of the bicycle carriers disclosed by Blackburn or Piretti, we do not consider that the quoted limitations would have been present in, or obvious from, the resulting combination. Kamaya's disclosure concerning carriers (supports) 3 is very cryptic; all the specification states is that horizontal struts 2 are provided with a plurality of supports 3 which fix in position skis or other objects to be carried (col. 1, lines 61 to 63). Figure 1 shows the carriers to be mounted on rectangular-section struts 2. The carriers have straps 3 which are extended over rectangular-section objects (evidently skis) and holes in the straps are engaged with tabs to fix the objects

in position.

It is fundamental that in considering the disclosure of a reference, not only its specific teachings, but also the reasonable inferences which one skilled in the art would logically draw therefrom, are considered. In re Shepard, 319 F.2d 194, 197, 138 USPQ 148, 150 (CCPA 1963). Here, the examiner recognizes that Kamaya does not disclose straps which extend upwardly from, or away from, the base of cradle 3, but states that (supp. ex. ans., page 6):

the drawings [of Kamaya] are considered to show the construction, thickness, and shape of the support to conclude that the strap portion will extent [sic] upward in the same manner as appellant's device in view of their similarity of shape.

We disagree with this conclusion. Just because Kamaya's straps may look the same as appellants' straps would look when in the fastened position (Fig. 4), it does not necessarily follow that they would extend upwardly away from the base when unfastened. The only drawing of Kamaya which shows the straps is Fig. 1, with the straps in their fastened position, and we see nothing therein which would indicate that the straps would extend away from the base of the carrier 3 when in their unfastened position. In

Appeal No. 95-2768
Application 08/019,700

summary, we find no teaching or suggestion in Kamaya which would lead one of ordinary skill to construct the straps in such a manner as to extend upwardly away from the base of the carrier. Any such suggestion would be derived solely by impermissible hindsight, based on appellants' own disclosure.

The examiner argues that since appellants were permitted to claim the upward extension of the straps without such limitation being considered new matter, then the Kamaya straps must be also interpreted as extending upward. We do not consider this argument to be pertinent to the question of obviousness. Moreover, the argument is not well taken in any event because appellants do disclose the (unfastened) straps 90 extending upward away from the base 92 in their Figs. 1, 2, 9 and 10, whereas there is no such disclosure in the Kamaya patent.

We therefore conclude that claims 14, 17, 18, 28 and 30 are patentable over the references applied.

Claim 29 does not recite that the strap extends upwardly or away from the base, but does recite that the cradle is rotatable about the axis of its respective supporting arm and held in

Appeal No. 95-2768
Application 08/019,700

position by a friction-fit therewith.³

We do not consider that claim 29 would have been obvious over the combination of Kamaya with either Piretti or Blackburn. In the bicycle rack shown in Piretti, the cradle 250 is a unitary structure which supports several bicycles and essentially covers the entire supporting arm 252. In our view, it would not have been obvious to substitute therefor the individual supports (cradles) 3 of Kamaya. As for Blackburn, the cradles (brackets) 100 are held in place on the supporting arms 60,62 by bolts 112 which pass through holes 110 in the brackets and are threaded into holes 114 in the arms. Thus, it does not appear that Blackburn's cradles are rotatable about the arms or held in position by a friction-fit, and one of ordinary skill would not have been motivated to substitute Kamaya's supports 3 for them, since one would thereby lose the specific orientation of each bracket of the Blackburn carrier.

Rejection Under 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 28 to 30 are rejected

³ Although we have rejected claims 28 to 30, *infra*, pursuant to 37 CFR § 1.196(b) on the ground that there is no written description of the claimed rotatability limitation, that limitation cannot be ignored in evaluating the patentability of the claims over prior art. Ex parte Pearson, 230 USPQ 711, 712 (BPAI 1985), aff'd mem., 795 F.2d 1017 (Fed. Cir. 1986).

Appeal No. 95-2768
Application 08/019,700

for failure to comply with the written description requirement of the first paragraph of 35 USC § 112. In particular, we find no disclosure in the application as filed to support the recitation in these claims that the cradle is rotatable about the axis of the supporting arm (claim 28), or of its respective supporting arm (claim 29).

In the apparatus disclosed, each cradle 90 is mounted on a supporting arm 21 or 21'. The supporting arm passes through a through-hole 96 in the base 92 of each cradle, making a snug frictional fit with the hole 96, so the cradle 90 can be slid along the supporting arm and then be held in position by friction (page 10, lines 9 to 11). The specification then continues at page 10, lines 12 to 18 (emphasis added):

A wall of the through-hole 96 includes a projection 98 which is received in a longitudinal channel 100 formed in an outer surface of the supporting arm 21 (or 21'). The projection tends to retain the cradle in a prescribed circumferential position on the supporting arm, so that a bicycle-receiving surface 102 of the cradle faces upwardly.

Thus, rather than describing apparatus in which the cradle can rotate about the supporting arm, the specification discloses an arrangement in which such rotation of the cradle is prevented

from occurring.

At the hearing, appellants' counsel referred to original application claim 17, in conjunction with original claim 18, as providing support for the limitation in question.⁴ As we understand it, his position was that since claim 18 is dependent on claim 17 and recites the projection and groove connection (which prevents rotation of the cradle), claim 17, by virtue of the doctrine of claim differentiation, supports a construction in which the projection-and-groove is absent, i.e., the cradle would be rotatable. This argument is without merit. The doctrine of claim differentiation is applied in determining the scope of a claim, see U.S. v. Telectronics, Inc., 857 F.2d 778, 784, 8 USPQ2d 1217, 1221-22 (Fed. Cir. 1988); it cannot be employed as a basis for providing written description support for a specifically claimed limitation.

Counsel also argued at the hearing that the projection 98 and groove (channel) 100 did not preclude rotation of the cradle

⁴ Original claims 17 and 18 read:

17. A bicycle carrier according to claim 14, wherein said base includes a through-hole through which a respective one of said supporting arm [sic] extends, said base being slidable along said one supporting arm.

18. A bicycle carrier according to claim 17, wherein said base and said one arm form a projection-and-groove connection for locating said cradle with respect to said one supporting arm.

Appeal No. 95-2768
Application 08/019,700

on the supporting arm, but merely served as an indicia or detent, showing that the cradle was in a particular position on the arm. We find no basis in the application as filed for this argument. To comply with the written description requirement of § 112, first paragraph, the application must convey with reasonable clarity to those skilled in the art that, as of its filing date, the applicant was in possession of the invention now claimed. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The present application would not convey to one of ordinary skill that appellants were in possession of an invention which included a cradle rotatable about the axis of the supporting arm, but rather would convey the opposite, i.e., a cradle which was not rotatable about the supporting arm, but rather was retained ?in a prescribed circumferential position on the supporting arm?, as stated on page 10 of the specification (quoted above).

Conclusion

The examiner's decision to reject claims 14, 17, 18 and 28 to 30 is reversed. Claims 28 to 30 are rejected pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to

Appeal No. 95-2768
Application 08/019,700

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. . . .

(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)

Appeal No. 95-2768
Application 08/019,700

)	
IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
IRWIN CHARLES COHEN)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
LAWRENCE J. STAAB)	
Administrative Patent Judge)	

Tracy W. Druce
NOVAK, DRUCE, REYNOLDS & BURT
1900 Towerlife Building
310 S. St. Mary's Street
San Antonio, TX 78205-3108

Appeal No. 95-2768
Application 08/019,700

APPENDIX

14. A bicycle carrier adapted to be mounted on the rear of a vehicle comprising:

a mounting frame;

securing means for securing said mounting frame to a rear of a vehicle;

a pair of bicycle supporting arms projecting rearwardly from said mounting frame; and

at least one cradle mounted on each of said supporting arms for cradling a bicycle frame, each of said cradles comprised of a flexible material and including a base mounted on a respective supporting arm, and a retaining strap, said base forming a bicycle-engaging surface and including first fastening means, said strap being of one-piece construction with said base and normally extending upwardly from said base to permit a bicycle to be inserted onto said bicycle-engaging surface, said strap being flexible to be bent across said bicycle-engaging surface to retain a bicycle frame thereon, said strap including second fastening means engageable with said first fastening means for fastening said strap in its bicycle frame-retaining position.

17. A bicycle carrier according to claim 14, wherein said base includes a through-hole through which a respective one of said supporting arm extends, said base being slidable along said one supporting arm.

18. A bicycle carrier according to claim 17, wherein said base and said one arm form a projection-and-groove connection for locating said cradle with respect to said one supporting arm.

28. A bicycle carrier according to claim 14, wherein the cradle is rotatable about the axis of the supporting arm and held in place by a friction-fit therewith.

29. A bicycle carrier adapted to be mounted on the rear of a vehicle comprising:

a mounting frame;

securing means for securing said mounting frame to a rear of a vehicle;

Appeal No. 95-2768
Application 08/019,700

a pair of bicycle supporting arms projecting rearwardly from said mounting frame; and

at least one cradle mounted on each of said supporting arms for cradling a bicycle frame, each of said cradles comprised of a flexible material and including a base having a hole which receives a respective supporting arm, and a retaining strap, said base forming a bicycle-engaging surface and including first fastening means, said strap arranged to be extended across said bicycle-engaging surface to retain a bicycle frame thereon, said strap including second fastening means engageable with said first fastening means for fastening said strap in its bicycle frame-retaining position, each cradle being rotatable about the axis of its respective supporting arm and held in position by a friction-fit therewith.

30. A bicycle carrier according to claim 29, wherein said strap is constructed to normally extend away from said base to permit a bicycle to be inserted onto said bicycle-engaging surface.