

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN REXROAD and MERLE KINGHAM

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Appeal No. 96-3543  
Application No. 08/153,623<sup>1</sup>

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HEARD: August 2, 1999

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Before COHEN, ABRAMS and FRANKFORT, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 1-7, 9-12 and 14-16, which constitute all of the claims remaining of record in the application.

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<sup>1</sup> Application for patent filed November 17, 1993.

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The appellants' invention is directed to a climbing net that presents a diagonal stripe of contrasting color. The claims on appeal have been reproduced in an appendix to the Brief.

**THE REFERENCES**

The references relied upon by the examiner to support the final rejection are:

Gullen 1965	3,170,611	Feb. 23,
Dilbey 1976	4,000,344	Dec. 28,
Lockney 1994	5,328,310	Jul. 12,

(filed Jan. 4, 1993)

**THE REJECTIONS**

Claims 1, 2, 4, 5, 7, 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dilbey in view of Gullen.

Claims 3, 6, 11, 12 and 14-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dilbey in view of Gullen and Lockney.

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The rejections are explained in the Paper No. 12 (the final rejection).

**OPINION**

*New Rejection Entered By The Board*

We are mindful that the appellants are free to claim their invention in broad terms, and that they are entitled to the broadest reasonable interpretation of the claim language. However, because a patentee has the right to exclude others from making, using and selling the invention covered by the patent, the public must be apprised of exactly what the patent covers, so that those who would approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. It is to this that the second paragraph of 35 U.S.C. § 112 is directed (see *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970)), and with regard to which we find the claims not to be in compliance.

Therefore, pursuant to our authority under 37 C.F.R.

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§ 1.196(b), we enter the following new rejection:

Claims 1-7, 9-12 and 14-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in that they fail to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

We begin by pointing out that in the second paragraph of the body of claim 1, first, second, third and fourth border "sections" are set forth, whereas in the remainder of the claim what appears to be the same elements are recited as border "portions." This also appears in independent claims 9, 14 and 16. Furthermore, these same elements are labeled as border "lengths" in claims 2 and 10, and merely as "borders" in claim 5.

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The second problem of indefiniteness occurs in the third paragraph of the body of claim 1, which sets forth a plurality of weft members along one of the first, second, third and fourth length portions of the border. This is followed by the statement that the weft members are connected to "the involved ones of said . . . length portions . . . of said border" (emphasis added). There is no antecedent basis for the term "involved ones," and the meaning of this phrase thus is not clear. This is repeated again in the fourth paragraph of the claim with regard to the warp members (where it is recited as being the involved "one"). The same situation occurs in independent claims 9, 14 and 16.

Independent claims 1 and 9 contain an indefiniteness with regard to understanding the limitations regarding the coloring of certain of the elements. In each of these two claims it is established that at least one of the weft members, and at least one of the warp members, is "differently colored from the remaining ones" of like kind. The final lines of each of these claims also focus on the color of the weft and warp elements, but what is meant there is unclear to us. The language in question reads as follows:

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at least one of said weft and warp members being of a different color displaying a diagonally directed path along the net relative to the differently colored ones of the warp and weft members.

The issue here is whether it is the intention of this paragraph merely to refer back to and confirm what has been recited in the previous paragraphs regarding the color of the weft and warp members, adding only that it causes a diagonal pattern to be presented, or to add the further limitation that the selected one of the weft members is a different color than the selected one of the warp members. We must confess that our confusion is heightened by considering Figure 1 of the colored version of the drawings that was attached to the Brief, where the three colors used for the wefts are repeated in the warps, and which thus would appear not to represent that the selected weft cannot be the same color as the selected warp.

A problem exists in independent claims 14 and 16 in the paragraph that begins on line 38. Early in these claims it is established that first and second corners define "a first border section," and so on through second, third and fourth corners and second, third and fourth border sections. Weft

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and warp members connected to the border sections are then set forth. The paragraph in issue states "the weft members being connected at one end thereof along said first border length [sic, section] and said warp members being connected at one end thereof along said fourth border length." The explanation that follows relates the weft and warp members to one another and to the other border sections. However, as one proceeds through this paragraph, it would appear that the terms "weft" and "warp" have been interchanged throughout, noting that line 51 states that "said first warp member is downwardly turned," when in fact it seems to be the first weft member that is downwardly turned.

~~The Examiner's Rejections Under 35 U.S.C. § 103~~

Notwithstanding the new rejection that we have entered above, we find ourselves able to understand the invention to the extent necessary to evaluate the examiner's rejections of the claims, and we have done so in the interest of judicial economy. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In

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establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellants' disclosure. See, for example, ***Uniroyal ,Inc. V. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

Independent claims 1 and 9 stand rejected as being unpatentable over Dilbey in view of Gullen. Among the appellants' arguments against this rejection is that neither of these references teaches that at least one of the weft members be differently colored from the remaining ones, and at least one of the warp members be differently colored than the remaining ones, as is required by both of these claims. The

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appellants point out that their invention is particularly useful as a climbing net for children, and that the color requirements of these claims taken in conjunction with the manner in which the net is constructed result in a diagonally oriented "lightening bolt" pattern of color which is very attractive. The examiner acknowledges that this teaching is lacking in the references, but takes the position that it would have been obvious to form diagonally extending color patterns "because the net would be more aesthetically pleasing to the eye" (Answer, page 5).

We do not agree with the examiner. These claims set forth a specific arrangement of weft and warp members which constitute the net construction, and recite a color requirement for one of the weft members and one of the warp members which results in a particular pattern of color across the net. From our perspective, the issue is not simply whether using color in a net would have been obvious to one of ordinary skill in the art, but is much more limited, that is, whether incorporating it into the structure in the manner recited in these claims would have been obvious. Based on the evidence and argument the examiner has provided on the record,

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we think not. This being the case, we will not sustain the rejection of independent claims 1 and 9 or, it follows, of dependent claims 2, 4, 5, 7 and 10.

Dependent claims 3, 6, 11 and 12 stand rejected as being unpatentable over the references cited against claims 1 and 9, taken further with Lockney, which is added for its teaching of forming a net of polypropylene. Be that as it may, Lockney does not alleviate the problem discussed above with regard to the color relationship between certain of the net members that is established in the independent claims, and therefore we also will not sustain the rejection of claims 3, 6, 11 and 12.

Independent claim 16 also stands rejected on the basis of Dilbey, Gullen and Lockney. As was the case with claim 1, this claim also requires that at least one of the weft and warp members be of a different color, so as to display a diagonally directed path along the net relative to the other warp and weft members. As we explained above, it is our view that the combined teachings of these references fail to render this feature obvious and therefore, as was the case above, fail to establish a *prima facie* case of obviousness with

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regard to the claim. This rejection therefore cannot be sustained.

The combined teachings of Dilbey, Gullen and Lockney form the basis for the examiner's rejection of independent claim 14. This claim does not, however, include the limitations regarding the color of the various members from which the net is constructed, and for this reason we find ourselves in agreement with the examiner that a *prima facie* case of obviousness is established by the references. We begin our analysis by noting that the Dilbey net is constructed in the same fashion as is required by claim 14, that is, both weft and warp members (in the terminology of the appellants) are so disposed and oriented with respect to one another that each weft member and each warp member forms at least one rung and one rail of the net. While many of Dilbey's figures illustrate the net as having the weft and the warp members in a diagonal relationship with the border member, in Figure 5 they are in the same relationship as is required by the claim, except at the corner portions (54). Moreover, Gullen teaches weft members and warp members that intersect the border member perpendicularly. It is our opinion that it would have been

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obvious to one of ordinary skill in the art to orient the various members of the net in the manner recited in claim 14, in view of the disclosures in these two references. Making the net members of elongate extruded multifilaments of polypropylene also would have been obvious to one of ordinary skill in the art, as is evidenced by Lockney (column 3, line 15). Finally, Dilbey states that the net "includes a border cord 4 extending around its periphery" (column 5, lines 28-29), and in Lockney the entire net, including the border member, is fabricated of a single length of rope (column 3, lines 15 and 16). We agree with the examiner that it would have been obvious to make the border member of a continuous length of material, in view of these teachings, and we further view splicing the ends of the material together to be a notoriously old and well-known manner of working with ropes and the like, which would have been obvious to one of ordinary skill in the art

In the final analysis, while we have carefully considered all of the arguments presented by the appellants that are applicable to the examiner's rejection of claim 14, we conclude that a *prima facie* case of obviousness has been

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established with regard to the subject matter thereof, and we will sustain the rejection.

Claim 15 adds to claim 14 the color feature discussed above with regard to claim 1 *et al.* As we explained there, we find this to be lacking in the applied prior art, and we therefore will not sustain the rejection of this claim.

#### **SUMMARY**

The examiner's rejection of claims 1-7, 9-12, 15 and 16 under 35 U.S.C. § 103 is not sustained.

The examiner's rejection of claim 14 under 35 U.S.C. § 103 is sustained.

Pursuant to 37 C.F.R. § 1.196(b), a new rejection of claims 1-7, 9-12 and 14-16 has been entered under 35 U.S.C. § 112, second paragraph.

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 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,

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122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellants, 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 (37 CFR § 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. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§

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141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED-IN-PART, 1.196(b)**

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

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