

**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(2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** VICKIE B. MILLER and TERRY A. MILLER

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Appeal No. 97-0972  
Application 08/399,571<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, ***Senior Administrative Patent Judge***, and  
MEISTER and FRANKFORT, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

***DECISION ON APPEAL***

Vickie B. Miller and Terry A. Miller (the appellants) appeal  
from the final rejection of claims 1-12, the only claims present  
in the application.

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<sup>1</sup>Application for patent filed March 7, 1995.

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We AFFIRM-IN-PART. Additionally, pursuant to our authority under the provisions of 37 CFR § 1.196(b), we will enter a new rejection of claims 5 and 9-12 under 35 U.S.C. § 112, first paragraph.

The appellants' invention pertains to a hold-down device for maintaining, in a substantially horizontal orientation, theater seats that are normally biased to a substantially vertically orientation. Independent claim 1 is further illustrative of the appealed subject matter and reads as follows:

1. A theater seat hold-down device for maintaining a seat member of at least one conventional theater seat in a substantially horizontal orientation, said conventional theater seat including an armrest assembly disposed on either side of a seat member, the armrest assembly including an armrest and an armrest support, the conventional theater seat further including a biasing device for biasing the seat member in a substantially vertical orientation when the seat member is not in use, said theater seat hold-down device comprising:

an elongated member adapted to extend between an armrest assembly and a seat member, said elongated member defining an armrest assembly engagement portion and a seat engagement portion, said armrest assembly engagement portion being configured to engage the armrest assembly and said seat engagement portion being configured to engage at least one seat member adjacent to the armrest assembly such that the seat member is maintained in a substantially horizontal orientation.

The references relied on by the examiner are:

Devney	1,276,735	Aug. 27, 1918
Gardels	2,618,497	Nov. 18, 1952

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Reyes

5,290,003

Mar. 01, 1994

Claims 1-12 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Devney.

Claims 1-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gardels.

Claims 1-4, 6-8 and 10-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Reyes.

The rejection under 35 U.S.C. § 112, second paragraph, is explained on pages 2 and 3 of the final rejection. The various rejections under 35 U.S.C. § 102(b) are explained on pages 3 and 4 of the answer.

#### **OPINION**

Considering first the rejection of claims 1-12 under 35 U.S.C. § 112, second paragraph, it is the examiner's position that:

There appears to be an inconsistency between the language in the preamble and certain portion or portions in the body of independent claims 1, 6, and 10; thereby making the scope of the claims unclear. For example, the claim language of "a theater seat hold-down device for maintaining a seat member . . . , said theater seat hold-down comprising", as recited in

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the preamble of claims 1 and 6, lines 1-7 and claim 10, lines 1-6, clearly indicates that a subcombination is claimed. This presents no problem as long as the body of the claim also refers to the seat member and armrest assembly functionally, such as, "adapted to extend in between a seat member and an armrest assembly" or "for attachment to a seat member and an armrest assembly."

The problem arises when the seat member and armrest assembly are positively recited within the body of the claim, such as "an elongated member . . . configured to engage said armrest assembly and . . . configured to engage at least one said seat member." In this case there is an inconsistency within the claim. The preamble indicates subcombination, while in the body of the claim there is a positive recital of structure indicating that the combination of a theater seat hold-down device, a seat member, and an armrest assembly are being claimed. [ Final rejection, pages 2 and 3.]

We do not agree with the examiner's position. The examiner apparently recognizes that the appellants, by setting forth functional recitations such as that of the hold-down device being "adapted" to engage the theater seat, have not positively recited the theater seat as a part of the claimed combination. Nevertheless, the examiner has taken the position that limitations such as that of the of hold-down device being "configured" (i.e, shaped) to engage a portion of a theater seat (previously set forth in the preamble), positively claim the theater seat as part of the claimed combination. We must point out, however, that by reciting such language the appellants have merely defined the hold-down member in terms of attributes it

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must possess and, therefore, this language is also functional in character. That is, the appellants are merely defining the shape or structural configuration of the hold-down device in terms of

its **functional** interrelationship with the theater seat when it is used in its intended manner, rather than positively reciting the theater seat as a part of the claimed combination. Since we are not of the opinion that the theater seat has been positively set forth as a part of the claimed combination, we find no inconsistency between the preamble and the body of the claim as the examiner asserts. This being the case, we will not sustain the rejection of claims 1-12 under 35 U.S.C. § 112, second paragraph.

Turning now to the various rejections under 35 U.S.C. § 102(b), we initially note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros., Inc. v. Union Oil Co.**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim

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when that reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. **See RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Additionally, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference. **See Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

Considering specifically the rejection of claims 1-12 under 35 U.S.C. § 102(b) as being anticipated by Devney, the examiner has taken the position that "the function of the appellant's elongate member is not considered to be patentable in a utility patent" (answer, page 5). This is incorrect. The various functional limitations in the claims (e.g., that the elongated member is "adapted to extend between an armrest assembly and a seat member" as set forth in claim 1) set forth a function which the apparatus must be structurally **capable** of performing (**see, e.g., In re Venezia**, 530 F.2d 956, 959, 189 USPQ 149, 151-52 (CCPA 1976)) and such a functional statement must be given full

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weight and may not be disregarded in evaluating the patentability of the claims (**see, e.g., Ex parte Bylund**, 217 USPQ 492, 498 (Bd. App. 1981)).

As to the examiner's contention that the device of Devney could be used to extend between an armrest assembly and a seat

member, Devney's invention is stated to relate

to advertising sign hangers, and has for its principal object to provide simple means for the quick attachment of advertising signs to door-knobs and the like, which means will **prevent the easy detachment of the sign by a breeze** and consequent loss of the same, but will allow ready removal by a person. [Lines 9-16; emphasis ours.]

Devney's advertising sign is thereafter described as being constructed of "resilient material, such as celluloid, cardboard, or paper" (lines 55 and 56). It is readily apparent from the above description that the sign hanger of Devney is made of a resilient material which is light-weight enough to be blown away by a breeze. This sign hanger is also depicted in the various cross-sectional views of Devney as being very thin in thickness.

Considering Devney's disclosure as a whole, we do not believe that there is a reasonable basis to include that the sign hanger disclosed therein has sufficient strength and rigidity so

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as to be inherently capable of functioning to maintain a biased theater seat in a "substantially horizontal orientation" as required by each of the independent claims on appeal. **See *Ex parte Levy***, 17 USPQ2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990). This being the case, we will not sustain the rejection of claims 1-12 under 35 U.S.C. § 102(b) as being anticipated by Devney.

Turning next to the rejection of claims 1-3, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Gardels, the answer states that:

Gardels teaches a member, as illustrated in Figures 1-4 comprising of an elongated section (10) . . . two wings (18, 24), and a slit (22) located between the upper end of the elongate section (10) and at a central location. [Page 4].

We also would add that, in the embodiment of Fig. 6 of Gardels, the plate-like structure at the upper end of the hold-down member 110 has portions that extend to either side of the hold-down member and, thus, these portions may be considered to form "wings" as broadly claimed. Additionally, the hold-down member of Gardels is described as being "strong" and "made of metal or other suitable material" (column 2, lines 18 and 19).

The appellants concede that they have not claimed a theater seat as a part of the claimed combination (see brief, page 4) but, nevertheless, contend that the hold-down member of Gardels

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cannot be considered to anticipate the instant claims inasmuch as there is no teaching therein that portions of the hold-down member engage an armrest assembly and seat in the claimed manner. This contention is unpersuasive. It is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists regardless of whether there was a recognition that it could be used to perform the claimed function. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). *See also LaBounty Mfg. v. Int'l Trade Comm'n*, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992) (in quoting with approval from *Dwight & Lloyd Sintering Co. v. Greenawalt*, 27 F.2d 823, 828 (2d Cir. 1928)):

The use for which the [anticipatory] apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent; the statute authorizes the patenting of machines, not of their uses. So far as we can see, the disclosed apparatus could be used for "sintering" without any change whatever, except to reverse the fans, a matter of operation.

Here, in view of (1) the size of the hold-down member 10 or 110 of Gardels relative to the trunk of an automobile and (2) the fact that Gardels' hold-down member is stated to be "strong" and made of "metal," there is a reasonable basis to conclude that

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Gardels's hold-down member is inherently capable of holding down a theater seat in the claimed manner. Whether Gardels' hold-down member actually is or might be used to hold down a theater seat depends upon the performance or non-performance of a future act of use, rather than upon a structural distinction in the claims. Stated differently, the hold-down device of Gardels would not undergo a metamorphosis to a new device simply because it was used to hold down a theater seat in the claimed manner. **See In re Pearson**, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) and **Ex parte Masham**, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

It is also the appellants' contention that Gardels is non-analogous art since Gardels' device holds down the trunk of a car, rather than a theater seat. We must point out, however, that "the question whether a reference is analogous art is irrelevant to whether that reference anticipates," **Schreiber**, 143 F.3d at 1477, 44 USPQ2d at 1432.

As to claims 3 and 7 the appellants additionally argue that the portions 18 and 24 (which the examiner considers to be the wings) do not extend from opposing "sides" of the elongated member. We observe, however, that the terminology in a pending application's claims is to be given its broadest reasonable

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interpretation (**see In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (**see Sjolund v. Musland**, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)). Accordingly, we are of the opinion that the "wings" 18 and 24 of Gardels can be considered to extend from opposite "sides" (i.e., the top side and the bottom side) as broadly claimed. Moreover, as we have noted above, in the embodiment of Fig. 6 of Gardels the plate-like structure at the upper end of the hold-down member 110 has portions that extend to either side of the hold-down member which may be broadly considered to form "wings."

In view of the above, we will sustain the rejection of claims 1-3, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Gardels.

Considering next the rejection of claims 4, 5 and 8-12 under 35 U.S.C. § 102(b) as being anticipated by Gardels, we find nothing in Gardels which would fairly suggest "two beveled corners **diagonally opposed** one from the other" (emphasis ours) as set forth in claims 4, 8 and 12. With respect to claims 5 and 9-12, the examiner is of the opinion that Gardels shows a slit at 22, however, we do not believe that the square opening 22 can be

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fairly construed to be a "slit." Moreover, even if the opening 22 were construed to be a slit, these claims further require that the slit provide access **through an opening** for closely receiving the armrest support. Clearly, no such structure is taught by Gardels. Accordingly, we will not sustain the rejection of claims 4, 5 and 8-12 under 35 U.S.C. § 102(b) as being anticipated by Gardels.

Turning next to the rejection of claims 1-3, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Reyes, it is the appellants' contention that

Reyes teaches a folding book support including in one embodiment, among other things, a support leg 16 having a first end 38 for engaging a main support member 12 and a second end 44 defining an inverted "Y" shape for stability. However, Reyes does not anticipate an elongated member "adapted to extend between an armrest and a seat member." [Brief, pages 9 and 10.]

The appellants' arguments are unpersuasive. As the appellants recognize, in Reyes the "optional" support leg 16 has a first end 38 and a second end 44 which diverges into two spaced-apart angular portions, thereby forming a generally Y-shaped configuration (see Fig. 3). These spaced-apart angular portions can be considered to form "wings" as broadly claimed. Clearly the support leg 16 has the inherent **capability** to hold

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down a theater seat in the manner claimed. *See In re Schreiber, supra*, and *LaBounty Mfg. v Int'l Trade Comm'n, supra*. As in the case of the hold-down member of Gardels, the support leg 16 of Reyes would not undergo a metamorphosis to a new device simply because it was used to hold down a theater seat in the claimed manner. *See In re Pearson, supra*, and *Ex parte Masham, supra*. Therefore, we will sustain the rejection of claims 1-3, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Reyes.

Turning to the rejection of claims 4, 8 and 10-12 under 35 U.S.C. § 102(b) as being anticipated by Reyes, we find nothing in Reyes which would fairly suggest "two beveled corners **diagonally opposed** one from the other" (emphasis ours) as set forth in claims 4, 8 and 12. With respect to claims 10-12 we find nothing, nor does the examiner even allege there is anything, in Reyes which would suggest the limitation set forth in independent claim 10 of

a through opening and a slit, said slit being defined between an upper end of said elongated member at a central portion thereof and said through opening, said slit providing access to said through opening for closely receiving the armrest support.<sup>2</sup> [Footnote

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<sup>2</sup> Indeed, if the examiner actually believed that Reyes taught such structure, it seems strange to us that claims 5 and 9 were not also rejected under § 102 as being anticipated by Reyes inasmuch as these dependent claims only respectively add to

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added.]

In view of the above, we will not sustain the rejection of claims 4, 8 and 10-12 under 35 U.S.C. § 102(b) as being anticipated by Reyes.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejection.

Claims 5 and 9-12 are rejected under 35 U.S.C. § 112, first paragraph, as being based on a disclosure that fails to provide support for the subject matter now being claimed. The description requirement found in the first paragraph of 35 U.S.C. 112 is separate from the enablement requirement of that provision. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), *cert. denied*, 434 U.S. 1238 (1978). With respect to the description requirement, the court in *Vas-Cath Inc. v. Mahurkar* 935 F.2d at 1563-64, 19 USPQ2d at 1117 stated:

35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and

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parent claims 1 and 6, this exact same limitation.

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distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession **of the invention**. The invention is, for purposes of the "written description" inquiry, **whatever is now claimed**.

. . . drawings alone **may** be sufficient to provide the "written description of the invention" required by § 112, first paragraph.

Although the claimed invention does not necessarily have to be expressed in **ipsis verbus** in order to satisfy the description

requirement (**see In re Wertheim**, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976)), the mere fact one skilled in the art might realize from reading a disclosure that something is possible is not a sufficient indication to that person that the something is a part of an appellant's disclosure. **See Barker**, 559 F.2d at 593, 194 USPQ at 474. Precisely how close the original description must come to comply with the description requirement must be determined on a case-by-case basis. The primary consideration is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure. **See Vas-Cath Inc. v. Mahurkar**, *supra*.

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In the present case, we believe the appellants' disclosure fails to reasonably convey to one of ordinary skill in the art descriptive support for the limitation that the elongated member is fabricated from an "at least semi-rigid material." By the recitation "at least" the appellants have set forth an open-ended **range** which would include anything from semi-rigid material to rigid material. Here, the appellants have disclosed no range whatsoever but, instead, have merely disclosed a flexible, yet resilient, material that is sufficiently rigid to maintain the seat members in a substantially horizontal orientation (see, generally, page 6 of the specification).

In summary:

The rejection of claims 1-12 under 35 U.S.C. § 112, second paragraph, is reversed.

The rejection of claims 1-12 under 35 U.S.C. § 102(b) as being anticipated by Devney is reversed.

The rejection of claims 1-3, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Gardels is affirmed.

The rejection of claims 4, 5 and 8-12 under 35 U.S.C. § 102(b) as being anticipated by Gardels is reversed.

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The rejection of claims 1-3, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Reyes is affirmed.

The rejection of claims 4, 8 and 10-12 under 35 U.S.C. § 102(b) as being anticipated by Reyes is reversed.

A new rejection of claims 5 and 9-12 are rejected under 35 U.S.C. § 112, first paragraph, has been made.

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, 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))

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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. §§ 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.

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

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**AFFIRMED-IN-PART**  
**37 CFR § 1.196(b)**

HARRISON E. McCANDLISH )  
Senior Administrative Patent Judge )  
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JAMES M. MEISTER )  
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BOARD OF PATENT  
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