

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT T. BASS

Appeal No. 98-2721
Reexamination Nos. 90/004,403 and 90/004,127

HEARD: February 10, 1999

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS
and McQUADE, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 4 under 35 U.S.C. § 103 in the merged reexamination proceedings involving appellant's Patent No. 4,473,026¹. The examiner has confirmed that claims 5

¹ Appellant's patent issued on September 25, 1884 and was based on application 06/228,309 filed January 26, 1981 in the name of Robert T. Bass.

(continued...)

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through 8, the only other claims still pending in the merged proceedings, contain patentable subject matter. Claims 1 through 8 are the original patent claims obtained with the issuance of appellant's patent. No amendments have been made to any of the patent claims in any of the reexamination proceedings.

The first reexamination (Control No. 90/004,127) involving appellant's patent was requested by a third party on January 31, 1996. After this request was granted by the examiner, a second reexamination (Control No. 90/004,403) involving appellant's patent was requested by the same third party on October 3, 1996. Upon granting the second request, the examiner merged the two proceedings on February 7, 1997.

The subject matter defined in appealed claim 1 (the only independent claim on appeal) is "[a] low-profile motorized sports boat comprising a hull (10) having a forward cabin fitted in the bow thereof and covered by a generally flat foredeck (11) whose level is substantially equal to that of the sheer line of the hull at the upper edge thereof . . ."

(...continued)

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Claim 1 additionally recites, inter alia, that the foredeck terminates at the bulkhead (B) of the cabin, that a center control console (18) on the foredeck "constitutes the sole control means for the boat," that a cockpit (13) between the bulkhead and the stern of the boat has a sole (14) below the sheer line of the hull, that "an adult standing on the sole can see above the foredeck," and that the low profile arrangement is "such that had the control console been placed against the bulkhead, the pilot would then be in the cockpit and have limited visibility."²

Special definitions for the terms "motorized sport boat" and "low-profile" are set forth in appellant's patent specification. In particular, the specification states that

² With respect to the description requirement in the first paragraph of 35 U.S.C. § 112, we note that the original specification (including the original claims) as filed in the Bass application contains no apparent descriptive support for (a) the recitation in claim 1 that the center control console "constitutes the sole control means for the boat" (emphasis added), (b) the recitation in claim 1 that "an adult standing on the sole can see above the foredeck," and (c) the recitation in claim 1 that had the control console been placed against the bulkhead, the pilot would then be in the cockpit and have limited visibility." It therefore follows that if it is determined that the original drawings also do not provide descriptive support for these claim limitations, then patent claims 1 through 8 are based on a disclosure which, as filed, does not satisfy the description requirement in the first paragraph of § 112. These observations are made pursuant to 37 CFR § 1.552(c).

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the term "'motorized sports boat' is intended to cover a boat which includes a cabin and has a length in the range of about 20 to 50 feet" (column 1, lines 10-12) and that "'low-profile' refers to a motorized sports boat whose cabin has a height that is roughly at the level of the sheer line of the boat hull" (column 1, lines 18-20). In addition, the specification defines the term "sheer line" as being "the line made by the upper edge of the hull" (column 1, lines 20-21).³ As will be discussed infra, these definitions play a significant role in determining the patentability of the appealed claims.

A copy of claim 1 is appended to this decision. A copy of all of the appealed claims is found in the appendix to appellant's brief.⁴

³ This definition differs from that in Webster's Third New International Dictionary (G. & C. Merriam Company, 1971). According to this dictionary authority a sheer line is "the stretched rope of a trail bridge to which a boat or raft is attached and along which it passes." We nevertheless will accept the definition in appellant's specification.

⁴ Copies of the two volumes of the appendix were located subsequent to the oral hearing in this case. We make this observation in view of our remark at the oral hearing concerning the whereabouts of the appendix.

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In addition to contesting the examiner's rejection on its merits, appellant argues that the examiner is barred from relying upon the applied references under the holding in In re Portola Packaging Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997).⁷

In Portola, the request for reexamination was originally based on new art, i.e., prior art not before the examiner during the examination of the original application which matured into the Portola patent. However, the ultimate rejection which led to the Portola appeal was based solely on old art, namely prior art that was before the examiner during examination of the original application. The court held that the appealed rejection did not raise a substantial new question of patentability under 35 U.S.C. § 303(a) (1994) and was therefore improper because it was supported only by prior art that was previously considered by the Patent and Trademark Office (PTO) in the prior proceeding (namely, the original examination of the application for the patent in issue) in

⁷ The decision in Portola was published after the two requests for reexamination were filed in the present case.

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relation to the same or broader claims. Id. at 791, 42 USPQ2d at 1300. In support of this holding, the Portola court cited In re Recreative Technologies Corp., 83 F.3d 1394, 1398, 38 USPQ2d 1776, 1779 (Fed. Cir. 1996)⁸ for its ruling that “[r]eexamination is barred for questions of patentability that were decided in the original examination.”

In the present case, the first request for reexamination, like Portola, was based on new prior art, namely the Lucander and Cargile publications which were not previously before the examiner in the examination of the application which matured into appellant’s patent. The second request for reexamination was based on additional prior art (identified as the “Closet” publications) as well as the Lucander and Cargile publications. The Closet publications were not before the examiner in either the examination of the application for appellant’s patent or the first reexamination proceeding. In addition to citing the Closet publications, the requester filed the declaration of Robert A. Schofield in the second

⁸ The opinion in Recreative Technologies was published after the first request for reexamination was filed in the present case, but before the second request for reexamination was filed.

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request for reexamination. This declaration deals with the Lucander publication. Although the Lucander publication was cited by the requester in the first reexamination proceeding, the examiner did not rely on this reference to support a rejection until after the two reexamination proceedings were merged.

In the second request for reexamination, the requester applied the Closet, Lucander and Cargile publications against patent claim 8 as well as applying the Lucander and Cragile publications against patent claim 1. Reliance upon the Closet publications was eventually withdrawn by the examiner in the ensuing reexamination with the result that the patentability of patent claim 8 is no longer in issue.

The second request for reexamination was filed after the examiner issued a "Notice of Intent to Issue Reexamination Certificate" (hereinafter NIRC) (see Paper No. 12 mailed October 9, 1996) in the first reexamination proceeding. Instead of issuing a certificate of reexamination in the first reexamination proceeding, however, the examiner issued an order (see Paper No. 13 mailed February 7, 1997) merging or

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consolidating the two reexamination proceedings under 37 CFR § 1.565(c).

In support of his position that the present case "is virtually identical to Portola" (main brief, page 4), appellant argues in substance that the rejection based on the Cargile patent, the Cargile publication and the Lucander publication does not raise a substantial new question of patentability under § 303(a) because all of these references were before the examiner in proceedings that, according to appellant, are now terminated. Appellant points out that the Cargile patent was before the examiner in the original examination of the Bass application. There is no dispute that the original examination of the Bass application has been terminated. The issue here concerns the status of the first reexamination proceeding in which the Lucander and Cargile publications were first cited. Appellant contends that the first reexamination proceeding has also been terminated as a result of the issuance of the NIRC.

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Reference is made to the arguments in pages 3-7 of the main brief.⁹

We disagree with appellant's position as outlined supra. Contrary to the impression left by appellant's fragmentary quotation of § 2287 of the Manual of Patent Examining Procedure (MPEP) on page 6 of the main brief, the issuance of the NIRC does not operate to terminate the reexamination proceeding in the sense of removing jurisdiction from the examiner. The pertinent portions of § 2287 are therefore worth reiterating in greater detail:

Upon conclusion of the reexamination proceeding, the examiner must prepare a "Notice of Intent to Issue Reexamination Certificate" (NIRC) by completing form PTOL-469. Where appropriate, an examiner's amendment will also be prepared. Where claims are found patentable, reasons must be given for each claim found patentable. See the discussion as to preparation of an examiner's amendment and reasons for allowance at the end of this section. The examiner must prepare the reexamination file so that the Office of Publications can prepare and issue a certificate in accordance with 37 CFR 1.570 and 35 U.S.C. 307 setting forth the results of the reexamination proceeding and the content of the patent following the proceeding. See MPEP

⁹ Appellant's citation of the 6th edition of the Manual of Patent Examining Procedure on page 3 of the main brief for part of the text of § 2258 is outdated. As evidenced by the current, 7th edition of the Manual, the text quoted by appellant on page 3 of the main brief has been deleted.

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§ 2288.

A NIRC informs the patent owner and any third party requestor that the reexamination proceeding has been terminated. The rules do not provide for an amendment to be filed in a reexamination proceeding after prosecution has been terminated. 37 CFR 1.312 does *not* apply in reexamination. Any amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding filed after prosecution has been terminated must be accompanied by a petition under 37 CFR 1.182 to have the amendment considered.

From the forgoing quotation of § 2287, it is apparent that the statements concerning the conclusion or termination of the reexamination proceeding merely signify that further prosecution as a matter of right is closed. In fact, § 2287 does not even prohibit further amendments by the patentee if accompanied by a petition under 37 CFR § 1.182. Furthermore, contrary to appellant's quotation in the first line on page 6 of the main brief, the actual NIRC issued in this case does not state that the reexamination proceeding itself has terminated. Instead, the NIRC simply states that "[e]xamination has been terminated in this reexam proceeding . . ."

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Inasmuch as jurisdiction over a reexamination proceeding is statutorily retained by the PTO until a reexamination certificate is issued, it follows that the pending status of the reexamination proceeding is preserved up to the time that the certificate issues. Appellant has presented no authority to show otherwise. On the contrary, we find nothing in the governing statute or regulations that would prohibit the examiner from reopening prosecution after issuance of a NIRC if it became necessary to give further consideration to the patentability issue. In fact, § 2283 of the MPEP (7th Ed., July 1998) pertaining to mergers of reexamination proceedings expressly provides that “[i]f the first reexamination is in ‘issue’ for publication of a certificate, it will be withdrawn from issue” and that “[t]he second reexamination proceeding will be merged with the first reexamination proceeding and prosecution will continue . . .” Like an Ex parte Quayle action¹⁰ in an application for a patent, a NIRC simply operates to prohibit the patentee in a reexamination proceeding from amending claims as a matter of right.

¹⁰ See Ex parte Quayle, 1935 C.D. 11.

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As a result, both the first reexamination proceeding and the second reexamination proceeding are still pending and simply have been merged together for continued prosecution. This status is even evidenced by the fact that both control numbers for the two proceedings are still individually used in the PTO papers to identify the merged proceedings. Thus, unlike Portola, the proceeding in which the prior art at issue was first cited (namely the Lucander and Cargile publications in the present case) is still pending and has not been terminated in the sense that occurred in Portola. While the Cargile patent is "old art" due to its consideration in the now terminated original examination of the Bass application, the Lucander and Cargile publications both constitute "new art" because they were first cited in the still pending first reexamination proceeding. The Lucander and Cargile publications therefore raise a substantial new question of patentability to satisfy the statutory criterion for reexamination.

Furthermore, contrary to appellant's argument in the first full paragraph on page 7 of the main brief, the examiner did continue the prosecution in the merged proceedings from

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the point reached in the first reexamination proceeding pursuant to the guidelines in MPEP § 2283. At the point reached in the first reexamination before the merger, the examiner had not applied the Lucander publication to the claims. Thereafter, on the record before him in the merged proceedings, he applied this publication in the rejection of the appealed claims. In any event, even if the examiner did not follow the guidelines in MPEP § 2283, his failure to do so would not have magically transformed "new art" into "old art." A failure to follow the guidelines in MPEP § 2283 is a merely a procedural matter which is reviewable by way of a petition to the Commissioner of the PTO, not by way of appeal to this Board.

Turning now to the merits of the standing rejection, the examiner has made the following findings regarding the scope and content of the Lucander publication:

On page 11-C of the article "Fishing Vessel Designed For Engine Aft" of National Fisherman magazine published June 1976 and hereinafter referred to as **Lucander**, a fishing boat is disclosed. The fishing boat is a low-profile motorized sports boat, as defined in the **Bass Patent**, column 1, lines 10-13, ("...the term motorized sports boat is intended to cover a boat which includes a cabin and has a length

in the range of about 20 to 50 feet...") and 18-25, ("...low profile refers to a motorized sports boat whose cabin has a height that is roughly at the level of the sheer line of the boat hull, this being the line made by the upper edge of the hull. Thus, in a low-profile boat, the foredeck over the cabin is at about the same level as the sheer line or slightly raised thereabove.") The hull of the **Lucander** boat includes a forward cabin fitted in the bow and covered by a generally flat foredeck whose level is substantially equal to that of the sheer line of the hull at the upper edge thereof, the foredeck terminates at the bulkhead of the cabin.

A bow rail is secured to the boundary of the foredeck.

The hull [sic, boat?] is also provided with a center control console, which constitutes the sole control means for the boat. The center control console is mounted on the foredeck at a position displaced from the bow rail to define in the space between the bow rail and the center control console a walk-around passage which surrounds the console.

A cockpit is defined between the bulkhead of the cabin and the stern of the boat; the cockpit includes a sole located at a level such that an adult standing on the sole can see above the foredeck. The boat is provided with stairs leading from the sole to the walk-around passage on the foredeck whereby passengers in the cockpit have unobstructed access to the foredeck and to the walk-around passage thereon.

The boat of **Lucander** discloses at least one seat on the foredeck facing the console. It should be noted that the drawings in **Lucander** show in addition to the rail at the foredeck, a bulwark mounted along the periphery of the hull which in essence could be considered a railing. Thus, this bulwark does not

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form part of the hull proper and the foredeck is, in fact, substantially level with the hull sheer line. [answer, pages 3-5.]

Appellant does not take issue with the examiner's finding that Lucander's hull has a forward cabin fitted in the bow of the hull and covered by a generally flat foredeck whose level is substantially equal to that of the sheer line of the hull as recited in clause A of claim 1. To the contrary, it is unequivocally admitted in the reply brief that "[a]ppellant is in agreement that the *Lucander* boat includes a forward cabin fitted in the bow and covered by a generally flat foredeck whose level is substantially equal to that of the sheer line of the hull at the upper edge thereof . . ." (underlined emphasis added) (reply brief, page 4). Appellant also unequivocally admits on page 4 of the reply brief that Lucander's "foredeck terminates at the bulkhead of the cabin." In light of these unequivocal admissions, clause A of claim 1 does not distinguish from the Lucander reference.¹¹

¹¹ This matter will be the subject of further comment later on in light of a reference at oral hearing to a part of the record not relied on by appellant in the briefs.

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Appellant also does not take issue with the examiner's finding that Lucander's boat has a bow rail secured to the boundary of the foredeck as recited in clause B of claim 1. In addition, appellant does not appear to take issue with the examiner's finding that Lucander's boat has a center control console which constitutes the sole control means for the boat and which is mounted on the foredeck at a position displaced from the bow rail to define in the space between the bow rail and the console a walk-around passage which surrounds the console as recited in clause C of claim 1. According to our analysis of the Lucander publication, the console is located in the pilothouse on the foredeck. Certainly, the Lucander boat has a center control console regardless of the presence or absence of the pilothouse enclosure on the foredeck. Furthermore, appellant does not appear to take issue with the examiner's finding that the limitations recited in clauses E and F of claim 1 are disclosed in the Lucander publication. Lucander's boat clearly has stairs leading from the sole to the walk-around passage, as well as a seat in front for the console as recited in claim 1.

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Appellant also does not take issue with the examiner's finding that Lucander's boat has a cockpit between the bulkhead of the cabin and the stern of the boat and that the sole of the cockpit is at a level which permits an adult standing on the sole to see above the foredeck as recited in clause D of claim 1. In fact, appellant admits on page 12 of the main brief that "an adult could conceivably stand on the sole of the *Lucander* cockpit and see above the rails . . ." Since the rails are elevated above the foredeck, it follows that an adult standing on Lucander's sole could also see above the foredeck as recited in clause D of claim 1. Moreover, this limitation is not limited to a horizontal line of sight and instead is broad enough to encompass any sight above the foredeck, such as the sight of the sky above the foredeck.

In fact, the only limitation in clause D which is argued as a difference over the Lucander publication resides in the recitation that had the control console been placed against the bulkhead, the pilot would have "limited visibility" from the cockpit. Appellant contends that if the control console were placed against the bulkhead in Lucander's boat, the pilot would have "no useful visibility" (reply brief, page 6) rather

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than "limited visibility" because of Lucander's pilothouse (see pages 6-7 of the reply brief). On page 6 of the reply brief appellant attempts to distinguish "limited visibility" from "no useful visibility."

Aside from the limitation concerning "limited visibility" in clause D of claim 1, only two other features of claim 1 are argued as distinctions over the Lucander publication. First, appellant argues that the Lucander boat is a high profile boat, not a low profile boat (main brief, pages 8, 10 and 11) as recited in the preamble of claim 1. Second, appellant argues that the Lucander boat is a commercial boat, not a sports boat (main brief, pages 8 and 13) as also recited in the preamble of claim 1.

Appellant contends that Lucander's boat is a high profile boat because it has a second cabin in the form of the pilothouse located above the sheer line of the hull (see pages 10 and 11 of the main brief). Appellant also contends that Lucander's boat is a commercial boat because "it includes a large fish hold for storing commercial quantities of fish caught out at sea" and also because it is "designed to serve

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commercial functions, not personal sports craft functions”
(citation omitted) (main brief, page 13).

Appellant’s arguments concerning patentability are not persuasive. It is well settled that claims in reexamination “will be given their broadest reasonable interpretation consistent with the specification.” In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). It also is well settled that words in a claim are to be given their ordinary and accustomed meaning unless it appears that the inventor used them differently in his specification. Lantech, Inc. v. Keip Machine Company, 32 F.3d 542, 547, 31 USPQ2d 1666, 1670 (Fed. Cir. 1994). See also In re Barr, 444 F.2d 588, 597, 170 USPQ 330, 339 (CCPA 1971).

In the present case, the inventor has chosen to be his own lexicographer by setting forth special definitions for the terms “motorized sports boat” and “low-profile” in column 1 of the specification as discussed supra. As a result, the claim language must be interpreted in light of these definitions. If the references in appellant’s main brief to the “file history” in the prosecution of the original application constitute an attempt to narrow the scope of the appealed claims, such an

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attempt must fail. In In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985), our reviewing court reiterated the rule that limitations may not be read into claims in a reexamination proceeding. In short, it is well settled that features not claimed may not be relied upon to support patentability. See In re Self, 671 F.2d 1344, 1348, 231 USPQ 1, 5 (CCPA 1982) and In re Richards, 187 F.2d 643, 645, 89 USPQ 64, 66 (CCPA 1951).

In view of the forgoing, appellant may not now on a post hoc basis attempt to modify the definitions stated in the patent specification for the terms "motorized sports boat" and "low-profile" by reference to "file history" as set forth, for example, on pages 9, 10, 12 and 13 of the main brief . See Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 889, 221 USPQ 1025, 1031 (Fed. Cir. 1984) (The place to redefine or modify terms is in the specification of the inventor's application, and the time to do so is prior to that application acquiring its own independent life as a technical disclosure through the issuance as a United States patent) and General Electric Co. v. United States, 572 F.2d 745, 753, 198 USPQ 65, 71 (Ct. Cl. 1978) (Words used in a patent cannot be

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given their ordinary and accustomed meaning where it appears from the patent that the inventor has attached a specific meaning to them). Thus, while it is recognized that an inventor may be his own lexicographer, the patent specification nevertheless must support the definition which is now asserted. Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571, 7 USPQ2d 1057, 1064 (Fed. Cir. 1988).

As noted from column 1, lines 10-12 of appellant's patent specification, only two requirements must be met to satisfy the stated definition for the term "motorized sports boat." First, the boat must be one that "includes a cabin." Second, that boat must have "a length of about 20 to 50 feet."

The Lucander boat meets both of the foregoing requirements for a "motorized sports boat." It has, as is conceded by appellant on page 4 of the reply brief, a cabin, namely the forward cabin fitted into the bow of the boat's hull. In addition, the disclosed length of the Lucander boat is 40 feet and hence is within the range of 20 to 50 feet. By the definition set forth in appellant's patent specification, the Lucander boat is therefore a "motorized sports boat."

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The definition set forth in column 1, lines 18-20, of appellant's patent specification for the term "low-profile" has only one requirement, namely that the cabin included in the definition for the motorized sports boat has "a height that is roughly at the level of the sheer line of the boat hull." As noted supra, appellant admits that the forward cabin in the Lucander boat is "fitted in the bow [of the hull]" and is "covered by a generally flat foredeck whose level is substantially equal to that of the sheer line of the hull at the upper edge thereof" (emphasis added) (reply brief, page 4). The Lucander boat therefore meets the single requirement for the term "low-profile" as defined in column 1, lines 18-20, of appellant's patent specification.

We do not agree with appellant's argument that Lucander's pilothouse is a "cabin." The terms "pilothouse" and "cabin" have not been specifically defined in appellant's patent specification. Therefore, these terms are to be given their ordinary and accustomed meaning, See Lantech, 32 F.3d at 547, 31 USPQ2d at 1670.

According to its applicable, common, ordinary meaning in Webster's Third New International Dictionary (G. & C. Merriam

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Company, 1971) a pilothouse, which is also called a "wheelhouse," is simply a forward deckhouse containing the steering wheel, compass and navigating equipment. According to the same dictionary authority, a cabin, on the other hand, is "a small room on a ship providing private accommodations for one or a few persons," particularly, "a compartment below deck for passengers or crew on a small boat" (emphasis added). By definition, therefore, a cabin differs from a pilothouse in that it provides "private accommodations" and is "below deck for passengers or crew." A pilothouse, on the other hand, is a house on a deck to perform the function of housing the steering wheel, compass and navigating equipment. The words "pilothouse" and "cabin" therefore are not interchangeable terms as appellant seems to argue.

Thus, contrary to appellant's arguments, Lucander's pilothouse is not a "cabin." Lucander's boat therefore does not have a "cabin" above the sheer line of the hull. Instead, the enclosure above the sheer line of Lucander's hull is a pilothouse, and the definition stated in appellant's patent specification for a "low-profile" boat does not exclude a pilothouse above the sheer line of the hull.

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Furthermore, we have difficulty in reconciling appellant's foundation argument, on the one hand, that the presence of pilothouse enclosure on the foredeck of Lucander's boat transforms the boat into a "high profile" boat, while disclosing, on the other hand, that a low profile boat is still considered to be a low profile boat even with the addition of an elevated Tuna Tower as described in column 2, lines 1-6 of appellant's patent specification. Page A-68 of appellant's appendix contains a photograph of the low profile "Dusky" boat disclosed in column 2, lines 1-3, of appellant's patent specification. The Tuna Tower shown in this photograph of the Dusky low profile boat is relatively high and even appears to be higher than the pilothouse on the foredeck of the Lucander boat. From this disclosure, it appears that appellant is treating the term "low profile" as the proverbial nose of wax, first stating the Dusky boat with the high Tuna Tower is a low profile boat, and then arguing that because of Lucander's pilothouse, Lucander's boat is a high profile boat notwithstanding the fact the Lucander's boat literally meets the definition for a low profile boat in appellant's patent specification.

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Moreover, by stating in column 1, line 11, of the specification that a motorized sports boat "includes a cabin" (emphasis added), the stated definition for a motorized sports boat is open ended in the sense that is not limited to a single cabin and consequently does not exclude an additional cabin above or below the sheer line of the hull. Thus, even if it is assumed arguendo that Lucander's pilothouse is a "cabin," the stated definition for a low profile motorized sports boat is still met because of the breath that the inventor chose to give to the definitions for the terms "motorized sports boat" and "low-profile."

It is understood from the arguments in appellant's briefs and the demonstration at the oral hearing in which the inventor removed and replaced the pilothouse in a model of the Lucander boat,¹² that if Lucander's pilothouse enclosure were eliminated, Lucander's boat would concededly meet all aspects of the definition for a low profile boat as set forth in appellant's patent specification.

¹² It is understood that a similar demonstration was made in an interview with the examiner.

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In the present case, however, the removal of Lucander's pilothouse enclosure does not amount to a patentable distinction inasmuch as it is well-established patent law that the elimination of an element with its function would have been an obvious expedient. See In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975). Therefore, a specific prior art teaching or suggestion of removing Lucander's pilothouse enclosure is not required under the Kuhle principle to support a § 103 rejection.

Applying the Kuhle principle to the present case, it would have been an obvious expedient to eliminate Lucander's pilothouse enclosure and its self-evident function of providing shelter for the pilot or other occupants of the boat. Furthermore, it would have been obvious from the Cargile publication and/or the Cargile patent to remove Lucander's enclosure for the control console for the self-evident purpose of enhancing the visibility of a pilot positioned at the console.

Contrary to appellant's arguments concerning the commercial nature of Lucander's boat, the definition stated in appellant's patent specification for a "motorized sports boat"

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contains no limitations to distinguish it from a boat that may be used for commercial purposes. Moreover, it is evident that the stated definition for a "motorized sports boat" does not exclude a "large fish hold" (main brief, page 13) for storing fish. What must be borne in mind here is that we are not concerned with some post hoc meaning of a "motorized sports boat". Instead, we are concerned with the special definition which the inventor, in the course of electing to be his own lexicographer, has chosen for the term in the patent specification.

In any event, the Lucander boat is inherently capable of serving as a sports boat, certainly for at least some purposes, which is all that is required to meet the recitation in the preamble of claim 1. Furthermore, the preambular recitation of a "sports" boat in claim 1 is merely a statement of intended use and thus is not germane to the patentability of claim 1. See Loctite Corp. v. Ultraseal Ltd. 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985), In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967) and In re Lemin, 326 F.2d 437, 440, 140 USPQ 273, 276 (CCPA 1964). In any event,

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the Cargile publication recognizes the advantageous features of utilizing a boat as a "sports" boat.

Thus, when the claim language is given its broadest reasonable interpretation, the preambular recitation in claim 1 does not patentably distinguish the claimed invention from the Lucander publication, and even if it is assumed *arguendo* that the Lucander boat differs from the invention defined in claim 1 because of the presence of the pilothouse enclosure, the removal of that enclosure would have been an obvious expedient for the reasons stated supra.

With regard to the limitation in clause D of claim 1 concerning the "limited visibility" from the cockpit, appellant's arguments focus on "forward visibility while piloting from the cockpit" (reply brief, page 5), and the pilot's capability "to maneuver the boat from the cockpit [in spite of the limited visibility]" (reply brief, page 5). In contrast to these arguments, the recitation concerning "limited visibility" in claim 1 is broad enough to encompass visibility for any purpose and therefore is not limited to the purpose of maneuvering or piloting the boat. Since visibility for the purpose of operating the boat has not been claimed,

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such feature may not be relied upon to support patentability of the claimed invention. See In re Self, 671 F.2d at 1348, 231 USPQ at 5 and In re Richards, 187 F.2d at 645, 89 USPQ at 66.

Appellant's post hoc attempt to draw a distinction between "limited visibility" in the Bass boat and "no useful visibility" in the Lucander boat is not persuasive. In the first place, a pilot standing on the sole of Lucander's boat would have useful, albeit somewhat limited, visibility for a variety of purposes, even for the purpose of maneuvering the boat because the pilot would be able to see laterally to opposite sides of the boat as well as straight ahead to one side of the pilothouse when standing in the cockpit to one side of the pilothouse.

Appellant's patent specification contains no disclosure of the extent of visibility from the cockpit at the position defined in clause D of claim 1, let alone any guidelines for determining the scope of "limited visibility." The recitation of "limited visibility" is therefore broad enough to cover visibility that is limited to any extent. In any case, it would have been obvious to eliminate the pilothouse enclosure

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to enhance visibility from the cockpit for the reasons stated supra.

With regard to the level of the sole in Lucander's boat, we agree with the statement on page 2 of the reply brief that Lucander's sole cannot be level with the foredeck contrary to the examiner's finding on page 5 of the answer. In fact, it is apparent from the various views in the drawing of Lucander's boat in the cited publication that the sole is at a level below the sheer line not only in the vicinity of the foredeck, but also in the vicinity of cockpit itself as one would expect it to be. In any event, even if it is assumed *arguendo* that the sole in Lucander's boat is level with the sheer line (presumably in the vicinity of the cockpit), appellant has not taken issue with the examiner's determination on page 5 of the answer that it would have been obvious in view of the Cragile publication to lower the level of the sole for the purpose of providing greater safety for occupants in the cockpit.

One further matter requires our consideration. At the oral hearing, a suggestion seem to have been made that there is a discrepancy between the admission on page 4 of the reply

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brief and the Bass affidavit (Paper No. 20) filed September 23, 1997 in the merged proceedings.

As noted supra, the admission in question is the unequivocal statement that "[a]ppellant is in agreement that the *Lucander* boat includes a forward cabin fitted into the bow and covered by a generally flat foredeck whose level is substantially equal to that of the sheer line of the hull at the upper edge thereof and wherein the foredeck terminates at the bulkhead of the cabin" (emphasis added), namely the "forward cabin" which is the only cabin mentioned in the sentence. The Bass affidavit states on page 4, lines 1-2, that the foredeck in Lucander's boat terminates at the forward portion of the pilothouse. The Bass affidavit also refers to an "Exhibit 2" (see page 4) which purportedly accompanied a declaration proffered by Mr. Lucander in a patent infringement action. Affiant has chosen not to furnish us with a copy of the Lucander declaration.

It appears from an attachment to the Bass affidavit that Exhibit 2 is a photocopy of the scale drawing contained in the Lucander publication and showing the Lucander boat. According the Bass affidavit, notes (in the form of printed letters) on

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the photocopy of the Lucander drawing were applied to Exhibit 2 by Mr. Lucander. These notes therefore do not constitute part of the original drawing shown in the Lucander publication.

The Bass affidavit was not even mentioned, let alone relied upon, in any of appellant's briefs in this appeal. Reliance upon the Bass affidavit, as an authority in support of appellant's position, has therefore been waived. See 37 CFR § 1.192(a) which provides in pertinent part that "[a]ny arguments or authorities not included in the brief will be refused consideration by the Board . . ." See also Ex parte Hindersinn, 177 USPQ 78, 80 (Bd. App. 1971). In the present case appellant had ample opportunity to rely on the Bass affidavit in the appeal briefs, but chose not to do so.

Had appellant relied on the Bass affidavit in the appeal briefs, we would have stated, among other things, that the Lucander drawing does not support the affiant's conclusionary statement that the foredeck terminates at the forward portion of the pilothouse, that the written notes on Exhibit 2 do not support this conclusion, and, in any case, that those written notes constitute hearsay statements and thus are entitled to

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little weight. See In re Mageli, 470 F.2d 1380, 1384, 176 USPQ 305, 308 (CCPA 1973). In the type of boat, such as the Lucander boat, where the foredeck covers the forward cabin in the bow of the boat, the decking defining the foredeck extends in an uninterrupted fashion around the sides of the pilothouse to terminate in the manner shown in the Lucander drawing at the bulkhead located at the aft end of the forward cabin. The placement of the pilothouse enclosure on the foredeck to cover the control console does not transform the portion of the decking extending along the sides of the pilothouse into something other than a foredeck. The Schofield declaration (see attachment B) is evidence that the foredeck extends to the bulkhead at the aft end of the forward cabin. As confirmed at the oral hearing, the term "forward deck" (which is noted on Exhibit 2) is understood to be an outdated term for a foredeck.

In any case, the admission appearing on page 4 of the reply brief and quoted supra operates as a recantation of any contrary statement made in the Bass affidavit or any other previously filed paper. We disagree with the argument made by appellant's counsel at the oral hearing that the sentence

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following the admission on page 4 of the reply brief in some way qualifies the admission. In anything, this following sentence broadens the application of the admission in that it states that the "characteristic" (i.e., the boat structure described in the admission as quoted supra) is found "in both high and low profile boats . . ."

For the foregoing reasons, we will sustain the § 103 rejections of claim 1 on Lucander in view of the Cargile patent and/or the Cargile publication. We will also sustain the § 103 rejections of dependent claims 2 through 4 because the patentability of these claims has not been argued separately of claim 1. See In re Nielson, 816 F.2d 1567, 1570, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and In re Burckel, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979).

The examiner's decision rejecting the appealed claims is therefore affirmed.

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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

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
))	
)	
)	
)	
)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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APPENDIX

1. A low-profile motorized sports boat comprising:

A. a hull having a forward cabin fitted in the bow thereof and covered by a generally flat foredeck whose level is substantially equal to that of the sheer line of the hull at the upper edge thereof, the foredeck terminating at the bulkhead of the cabin;

B. a bow rail secured to the boundary of the foredeck;

C. a center control console which constitutes the sole control means for the boat mounted on the foredeck at a position displaced from the bow rail to define in the space between the bow rail and the console a walk-around passage which surrounds said console, whereby a pilot navigating the boat from said console has added height as well as excellent visibility fore and aft and on either side of the boat;

D. a cockpit defined between the bulkhead of the cabin and the stern of the boat, said cockpit having a sole below the sheer line of the hull at a level such that an adult standing on the sole can see above the foredeck, the low-profile arrangement being such that had the control console been placed against the bulkhead, the pilot would then be in the cockpit and have limited visibility;

E. stairs leading from the sole to the walk-around passage on the foredeck to connect the cockpit to the foredeck whereby passengers in the cockpit have unobstructed access to the foredeck and to the walk-around passage thereon; and

F. at least one seat on the foredeck in the front of the console.