

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN BERENDS and JURJEN J. DE JONG

Appeal No. 1999-0195
Application 08/507,424

ON BRIEF

Before FRANKFORT, PATE, and STAAB, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-8 and 14-16. Claims 9-13, the only other claims currently pending in the application, stand

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withdrawn from further consideration under 37 CFR § 1.142(b)
as not readable on the elected invention.

Appellants' invention pertains to a wheel blocking
device. Details of the invention can be readily understood
upon reading the appealed claims, a correct copy of which
appears in an appendix to appellants' brief.

The references of record relied upon by the examiner in
support of a rejection under 35 U.S.C. § 103 are:

Cone	4,207,019	Jun.
10, 1980		
Blunden	4,679,974	Jul. 14,
1987		

Claims 1-8 and 14-16 stand rejected under 35 U.S.C. § 103
as being unpatentable over Blunden in view at Cone.

The teachings of the applied references are fully set
forth on page 3 of appellants' brief and need not be repeated
here.

Claims 1-8

Considering first the § 103 rejection of claim 1, the
essence of the rejection is the examiner's position that it

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would have been obvious to one of ordinary skill in the art to have provided control and drive means in the device of Blunden for moving the chock bar 62 relative to the carriage 80 and for moving the carriage 80 relative to the track 46 in view of the teachings of Cone "so as to automate the system of Blunden" (answer, page 3).

While we appreciate that it might be possible, as a general proposition, to automate the system of Blunden, it would not have been obvious within the meaning of 35 U.S.C. § 103 to do so in light of the combined teachings of the applied references. In keeping with its intended use on a railroad car environment, the Blunden system is relatively simple in construction to thereby facilitate manual operation. In use, chock bar 62 is manually pivoted from the solid line position in Figure 5 to the position shown in Figure 4 as carriage 80 is simultaneously moved along 46 track in order to bring pin 100 into registry with one of the holes 104 in the opposite track to secure the chock bar in a vehicle blocking position. The complexity and accuracy that would be required of a

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control and drive means to coordinate the movements of the chock bar and carriage to bring pin 100 into registry with one of the holes in the opposite track, the apparent lack of any need for such complexity, and the question of how such a control and drive mean would be powered, would all act as disincentives to one of ordinary skill in the art in considering whether to automate the system of Blunden in light of Cone's teachings. In addition, it is not clear how one of ordinary skill in the art would go about automating the system of Blunden along the lines of Cone's system. Finally, the relatively infrequent engagement/disengagement cycle of the Blunden device as compared to the Cone device makes the need for the proposed automation of Blunden, at best, questionable.

The mere fact that the prior art could be modified does not make such a modification obvious absent suggestion of the desirability of doing so. *See, for example, In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive in the applied references which would have led one of ordinary skill in the art to modify the Blunden system in

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the manner proposed by the examiner. It appears to us that the only suggestion for doing so is found in the hindsight accorded one who first viewed appellants' disclosure. This, of course, is not a proper basis for a rejection under 35 U.S.C. § 103. See *In re Fritch*, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

In light of the foregoing, we will not sustain the standing rejection of claim 1, or claims 2-8 that depend therefrom.

Claims 14-16

Claim 14 requires, *inter alia*, that the wheel block be mounted "for substantially linear movement relative to [the] carriage in a direction substantially perpendicular to the lengthwise direction." The examiner, noting that the wheel blocking means of Blunden and Cone swing in an arcuate path through an arch of about 90° in the course of being deployed,

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contends that "[t]he rotational movements of the blocking means in both Blunden and Cone provide a 'substantially linear' movement 'relative' to a carriage to the broad degree claimed" (answer, page 4).

Claims in a patent application are to be given their broadest *reasonable* interpretation consistent with the specification during prosecution of a patent application (see *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989)). Moreover, terms in a claim should be construed as those skilled in the art would construe them (see *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988) and *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977)). Here, the examiner's position that the chock bar 62 of Blunden and the chock means 27, 29 of Cone, each of which pivot in a horizontal plane through an arch of about 90°, engage in "substantially linear movement" in the course of being deployed is simply unreasonable. We can think of no circumstances under which an artisan, consistent with the appellants' specification, would construe the movement of Blunden's or Cone's blocking means as corresponding to the

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claimed wheel block movement.

We therefore will not sustain the standing rejection of claim 14, or claims 15 and 16 that depend therefrom.

New rejections pursuant to 37 CFR § 1.196(b)

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejections.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Cone. Using claim 1 as a guide, Cone discloses a wheel blocking device comprising an elongated guide means 23 arranged upon a ground surface A, and a wheel block carrier 59 guided slidably in a lengthwise direction of the guide means (column 6, lines 19-23). The wheel block carrier includes wheel blocks 27, 29 guided for movement by linkage 73-81 transverse (i.e., crosswise) to the lengthwise direction. Cone further discloses control and drive means (hydraulic cylinder 33 and the hydraulic control circuit of Figure 4) for moving wheel block carrier 59 relative to guide means 23 (column 7, lines 40-47) and for moving wheel blocks 27, 29 relative to wheel block carrier 59 (column 7, lines 33-40). Since each and every element of the claim finds response in

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Cone, claim 1 is anticipated by Cone.

Claim 16 is rejected 35 U.S.C. § 112, second paragraph. In order to satisfy the second paragraph of § 112, a claim must accurately define the claimed subject matter in the technical sense. See *In re Knowlton*, 481 F.2d 1357, 1365, 178 USPQ 486, 492 (CCPA 1973).

Claim 14, from which claim 16 depends, requires that the wheel block be mounted "for substantially linear movement" relative to the carriage in a direction substantially perpendicular to the lengthwise direction of the guide. Clearly, this claim language is readable on the embodiment of Figure 4, where the wheel block 26 slides linearly in and out of block carrier 36 in a direction substantially perpendicular to the lengthwise direction of guide member 27. On the other hand, dependent claim 16 requires that the wheel block be mounted on a carrier that is "pivotally mounted" to said carriage. Appellants' Figure 2 embodiment is illustrative of a device for blocking wheels wherein the wheel block 6 is pivotally mounted to the carriage 9. In our opinion, a wheel block like that of appellants' Figure 2 that is "pivotally

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mounted" to a carriage, as called for in claim 16, cannot at the same time be accurately described as being mounted "for substantially linear movement" relative to said carriage, as called for in claim 14.¹ Accordingly, we consider that claim 16 is inaccurate and indefinite because it is inconsistent with and contrary to the requirements of claim 14 from which it depends.

Remand to the Examiner

This case is remanded to the examiner to determine whether dependent claims 2-8, which depend from newly rejected claim 1, should be rejected under 35 U.S.C. § 102(b) as being anticipated by Cone or under 35 U.S.C. § 103 as being unpatentable over Cone, either alone or further in view of other prior art.

Summary

The examiner's rejection of claims 1-8 and 14-16 as being unpatentable over Blunden in view of Cone is reversed.

Pursuant to 37 CFR § 1.196(b), new rejections of claims 1

¹We appreciate that our view in this regard may differ from that of appellants. See, for example, page 8, last paragraph, of the main brief.

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and 16 have been entered.

In addition, this decision is remanded to the examiner for consideration of the patentability of claims 2-8 in light of our new ground of rejection of claim 1.

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 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 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 (§ 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

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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) and Remanded

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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)
) BOARD OF PATENT
WILLIAM F. PATE III)
Administrative Patent Judge) APPEALS AND

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)
) INTERFERENCES
)
LAWRENCE J. STAAB)
Administrative Patent Judge)

LJS:pgg
Mark Zouko
36504 28th Avenue South
Federal Way, WA 98003