

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW H. RUST and RICHARD H. JACOBS

Appeal No. 1999-0281
Application No. 08/629,727¹

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 22, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

¹ Application for patent filed April 9, 1996.

BACKGROUND

The appellants' invention relates to a foldable compact molded stroller and trailer with flexible hitch. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims (i.e., the applied prior art) are:

Galasso et al. (Galasso) Sept. 7, 1993	5,242,178	
Chaw et al. (Chaw) 1993	5,224,720	July 6,
Miki et al. (Miki) 1996	5,503,430	April 2,
Pasin et al. (Pasin) 1996	5,538,267	July 23,
		(filed Oct. 14, 1994)
Kolbus et al. ² (Kolbus) 1997	5,599,033	Feb. 4,
		(filed Aug. 30, 1993)

² Brian D. Kolbus and Richard H. Jacobs (one of the two named inventors in the application under appeal) are the named inventors.

Claims 1 to 5, 7 to 11, 13 to 18 and 20 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kolbus in view of Chaw, Miki and Galasso.

Claims 6, 12 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kolbus in view of Chaw, Miki and Galasso and further in view of Pasin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed May 20, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 11, filed April 28, 1998) and reply brief (Paper No. 13, filed June 15, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art, and to the respective

positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Claims 8 and 21

With respect to claims 8 and 21, we agree with the appellants' argument (brief, p. 9) that the applied prior art would not have suggested a flexible hitch that is attachable between the rear, adjacent horizontal and inclined members of a bicycle frame. In that regard, we note that (1) Kolbus' hitch 120 is connected to the bicycle frame at the bicycle seat as shown in Figure 1, not between the rear, adjacent horizontal and inclined members of a bicycle frame, and (2) Galasso's hitch is attached to the chain stay of a bicycle, not between the rear, adjacent horizontal and inclined members of a bicycle frame.

Since the subject matter of claims 8 and 21 would not have been suggested by the applied prior art for the reasons stated above, the decision of the examiner to reject claims 8 and 21 under 35 U.S.C. § 103 is reversed.

Claims 1 to 7, 9 to 20 and 22

We agree with the examiner that the subject matter of claims 1 to 7, 9 to 20 and 22 would have been obvious to one of ordinary skill in the art at the time the invention was made from the teachings and suggestions of the applied prior art as set forth on pages 3-5 of the answer.

Both the appellants (brief, p. 5) and the examiner (answer, p. 5) agree that

the gravamen of this appeal is whether or not the Jacobs 37 C.F.R. § 1.132 Declaration removed Kolbus as the primary reference. If so, then the claims are allowable because the secondary references do not show all the elements of the claims.

It is our opinion that the Jacobs 37 CFR § 1.132 declaration³ fails to remove Kolbus as a reference available under 35 U.S.C. § 102(e) for the reasons that follow.

35 U.S.C. § 102 states, in pertinent part:

A person shall be entitled to a patent unless-

³ Filed December 22, 1997 (part of Paper No. 4).

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent .

The dispute herein involves the extent to which the Kolbus patent is prior art against the claims under appeal. The appellants do not dispute that the Kolbus patent was applied for "by another" (brief, p. 5). But as explained in In re DeBaun, 687 F.2d 459, 214 USPQ 933 (CCPA 1982), simply because a patent is issued to joint inventors does not mean that everything disclosed in that patent is necessarily joint work which would constitute prior art against a subsequent patent application by one of the two joint inventors. In DeBaun, a patent covering an air sampling system was issued to two inventors, Kenneth W. DeBaun and Robert W. Noll. DeBaun subsequently filed a patent application on his own which contained claims covering a specific cross section of an air duct disclosed but not claimed in the patent previously issued to DeBaun and Noll. DeBaun filed an affidavit to the effect that he was the inventor of the cross section and that the cross section had been included in the previous joint patent

on the advice of counsel. The Court of Customs and Patent Appeals found this affidavit sufficient to prevent the prior disclosure in the joint patent from being used as prior art against DeBaun's individual discovery. The court rejected the argument that all information disclosed in a joint patent was necessarily the product of a joint invention. The court stated: "The [joint] patent is silent with respect to who invented the [cross] section itself, and we do not presume that it is the invention of DeBaun and Noll jointly or of either of them." *Id.* at 463, 214 USPQ at 936. The DeBaun court explained that in such a case "the proper subject of inquiry was ... what the **evidence** showed as [to] **who** invented the [cross section disclosed in the patent]." *Id.* at 462, 214 USPQ at 935 (emphasis added).

Thus, DeBaun requires a factual determination as to which parts of the Kolbus patent were the product of joint work and, hence, would constitute prior art, and as to which parts were

the product of Jacobs' independent work and, hence, would not constitute prior art.⁴

The only evidence of record on this issue is set forth in the Jacobs 37 CFR § 1.132 declaration and the Kolbus patent itself. The Jacobs 37 CFR § 1.132 declaration states:

1. I am a co-inventor of U.S. patent application Serial Number 08/629,727, filed April 9, 1996.
2. I am a co-inventor of U.S. Patent Number 5,599,033, filed August 30, 1993.
3. I conceived or invented the subject matter disclosed in U.S. Patent Number 5,599,033.

⁴ We have assumed for purposes of this decision that the parts of the Kolbus patent which were the product of Jacobs' independent work would not constitute prior art against the claims of the instant application. Note however, In re Land, 368 F.2d 866, 880-81, 151 USPQ 621, 634 (CCPA 1966)(patent of one inventor is prior art against joint application of that inventor and another) and Manual of Patent Examining Procedure (MPEP)

§§ 715.01(a) and 2136.05 (when subject matter, disclosed **but not claimed** in a patent issued jointly to S and another, is claimed in a later application **filed by S**, the joint patent is a valid reference unless overcome by affidavit or declaration under 37 CFR 1.131 or an unequivocal declaration under 37 CFR 1.132 by S that he/she conceived or invented the subject matter disclosed in the patent and relied on in the rejection). In this case we point out that the subject matter relied upon by the examiner is disclosed and claimed in the Kolbus patent and that this application is filed by Jacobs and Rust.

The Kolbus patent itself establishes that Brian D. Kolbus and Richard H. Jacobs are the named inventors of the subject matter of claims 1 through 4 of the patent.

From this evidence, we are unable to conclude which parts of the Kolbus patent were the product of Jacobs' independent work and thus not available as prior art. In that regard, it is our determination that Jacobs' statement 3 that he "conceived or invented the subject matter disclosed in U.S. Patent Number 5,599,033" is not stating that **all** the subject matter disclosed in U.S. Patent Number 5,599,033 was conceived or invented by Jacobs alone since this would be inconsistent with both Jacobs' statement 2 (that Jacobs is a **co-inventor** of U.S. Patent Number 5,599,033) and the named inventorship of

U.S. Patent Number 5,599,033.⁵ Thus, the Jacobs 37 CFR § 1.132 declaration fails to remove Kolbus as a reference.

With regard to claims 2, 11 and 15, the appellants argue (brief, p. 9) that

none of the references (including Kolbus) disclose a substantially horizontal yoke portion extending between and attached to the trailer attachment end and the flexible hitch. The yoke 144 of Kolbus is not substantially horizontal over its extent from the trailer attachment end 48 to the hitch 154.

We agree with the appellants that Kolbus does not disclose a substantially horizontal yoke portion extending between and attached to the trailer attachment end and the flexible hitch. However, it is our determination that Galasso discloses a hitch having a substantially horizontal yoke

⁵ 35 U.S.C. § 112 requires that the specification describe the invention and that the specification conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention.

Under 35 U.S.C. § 116, a joint application for a patent is required if the invention was made "by two or more persons jointly." The inventors named in an issued patent are presumed to be correct. Canon Computer Systems Inc. v. Nu-Kote International Inc., 134 F.3d 1085, 1088, 45 USPQ2d 1355, 1358-59 (Fed. Cir. 1998).

portion extending between and attached to the trailer attachment end and the flexible hitch. Thus, it is our opinion that the combined teachings of the applied prior art would have been suggestive of modifying Kolbus' hitch to include a substantially horizontal yoke portion extending between and attached to the trailer attachment end and the flexible hitch.

For the reasons stated above, the decision of the examiner to reject claims 1 to 7, 9 to 20 and 22 under 35 U.S.C. § 103 is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 22 under 35 U.S.C. § 103 is affirmed with respect to claims 1 to 7, 9 to 20 and 22 and reversed with respect to claims 8 and 21.

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

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPEAL NO. 1999-0281 - JUDGE NASE
APPLICATION NO. 08/629,727

APJ NASE

APJ CALVERT

APJ STAAB

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 14 Jun 99

FINAL TYPED: