

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY G. KLEIN
and DARRELL W. VOSS

Appeal No. 99-0520
Application 08/519,160¹

ON BRIEF

Before CALVERT, FRANKFORT and CRAWFORD, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 7 and 11. The other claims remaining in

¹ Application for patent filed August 25, 1995.

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the application, claims 3 and 4, have been allowed.

The claims on appeal are drawn to a bicycle frame suspension system. They are essentially as reproduced in the appendix of appellants' brief, with the exceptions noted on page 3 (part (8)) of the examiner's answer.

The references applied in the final rejection are:

Riva	2,756,071	July 24, 1956
Trimble	5,403,028	Apr. 4, 1995

The claims on appeal stand finally rejected on the following grounds:

- (1) Claim 11, anticipated by Trimble, under 35 U.S.C. § 102(e);
- (2) Claims 1, 2 and 7, unpatentable over Trimble in view of Riva, under 35 U.S.C. § 103(a).

Rejection (1)

On page 4 of the answer, the examiner specifies how, in his opinion, claim 11 is readable on Trimble. The appellants argue only one claim limitation as not being disclosed by Trimble, namely, the recitation of "a single substantially longitudinally extending main tube" (emphasis added). According to appellants, Trimble does not meet this limitation because, in addition to down tube 14 of Trimble, on which the examiner reads the claimed "main tube," Trimble also discloses a longitudinally extending top tube 10. Appellants assert that if Trimble's top tube 10 were eliminated, tube 14 would fail.

In response to appellants' arguments, the examiner counters that (answer, pages 6 and 7):

It is first noted that there is no evidence to support the allegation that the bicycle

suspension of Trimble would fail if the top tube were eliminated. As evidenced by numerous cited references including Riva (U.S. Patent No. 2,756,071), it is common and well known in the art to construct a bicycle suspension frame having a single, longitudinally extending "main tube" which is pivotally attached to the rear wheel and pedal drive mechanism, the single tube being fully capable of supporting the rider and allowing the bicycle to be operated without failure.

However, even were the bicycle frame of Trimble found to fail with the removal of the top tube, the claims as written would still not define thereover. The claim language merely requires "a bicycle frame suspension *comprising* a single, longitudinally extending main tube" (emphasis added). The suspension assembly of Trimble comprises tube 14, which is shown as having every limitation claimed in connection with the main tube of the present invention, and further there is no language in the claims which precludes the use of a second tube for additional compressive support. In light of the open-ended recitation "comprising", that the term "main tube" has no specific structural significance in the art, and that the tube 14 contains every claimed limitation of the main tube, appellant's arguments are not deemed persuasive.

We first note that a claim is not anticipated unless every limitation thereof is described, expressly or inherently, in a single prior art reference. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Therefore, the entire argument as to whether the top tube of Trimble could be eliminated is not germane to the question of anticipation, since Trimble does not describe a bicycle frame which does not have a top tube.

As for the examiner's argument concerning the term "comprising," he is certainly correct that this term in a claim allows the addition of other, unrecited elements. Phillips Petroleum Co. v. Huntsman Polymers Corp., 157 F.3d 866 , 874, 48 USPQ2d 1161, 1167 (Fed. Cir. 1998). "However, the meaning of the word 'comprising' cannot be construed to extend so far as to eliminate the expressed limitations which the appellant has placed within his claims," In re Samiran, 86 F.2d 756, 758, 32

USPQ 57, 59 (CCPA 1936), and it is well settled that, before the PTO, claim language is to be given its broadest reasonable meaning, "taking into account whatever enlightenment . . . may be afforded by the written description contained in the applicant's specification." In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In the present case, the limitation "single" cannot be eliminated or ignored, and, looking to appellants' disclosure for enlightenment, we find no disclosure in the specification that the front frame unit may include a longitudinally extending tube in addition to the longitudinally extending tube 60. Therefore, giving weight to the term "single" in claim 11 while reading the claim in light of the appellants' disclosure, we construe claim 11 as excluding bicycle structures in which the front frame unit has more than one substantially longitudinally extending tube. Since the bicycle disclosed by Trimble has more than one such tube, it does not anticipate claim 11.

Rejection (1) will therefore not be sustained.

Rejection (2)

We will not sustain this rejection essentially for the reasons given above with respect to rejection (1). As noted above, the examiner cites Riva as being exemplary of bicycle frames with a single main tube. However, the examiner does not assert that it would have been obvious in view of Riva to use a single main tube in the Trimble bicycle instead of tubes 10 and 14, but rather contends that the "comprising a single, longitudinally extending main tube" language is readable on Trimble. Since we have held above that it is not, the rejection cannot stand.

Claims 2 and 7, which are dependent on claim 1, fall therewith. Also, as to claim 7 we note that, contrary to the examiner's statement on page 8 of the answer, the coaxially stacked elastomeric springs disclosed by Trimble at 91 are in series, not in parallel. In order to operate in parallel, as claimed, there would have to be some structure which would cause each elastomeric element to be compressed equally at the same time.

Remand to the Examiner

Pursuant to 37 CFR § 1.196(e), this case is remanded to the Examiner to consider the following:

- (a) Whether claims 1, 2 and 11 should be rejected under 35 U.S.C. § 103(a) as unpatentable over Trimble in view of a reference such as Owen (of record) or Riva which discloses a bicycle having a front unit with a single main tube or member.
- (b) Whether claim 7 should be rejected under 35 U.S.C. § 103(a) as unpatentable over the same combination of references as used for (a), above, taken with a reference such as Gaines et al. (of record) which discloses a compression spring or bumper for a vehicle having the elastomeric units arranged to operate in parallel.

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Conclusion

The examiner's decision to reject claims 1, 2, 7 and 11 is reversed, and the case is remanded pursuant to 37 CFR § 1.196(e).

REVERSED AND REMANDED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
)	APPEALS AND
CHARLES E. FRANKFORT)	INTERFERENCES
Administrative Patent Judge)	
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