

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID MALONE

Appeal No. 1999-1761
Application No. 08/889,872

HEARD: November 13, 2000

Before CALVERT, COHEN, and GONZALES, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 through 20, all of the claims in the application, as amended subsequent to final rejection.

Appellant's invention pertains to a motion transmitting remote control assembly for transmitting motion in a curved path. A basic understanding of the invention can be derived

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from a reading of exemplary claim 1, a copy of which appears in a new APPENDIX to the brief (Paper No. 17).

As evidence of obviousness, the examiner has applied the document specified below:

Boike et al. 1995 (Boike)	5,477,745	Dec. 26,
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The following rejections are before us for review.

Claims 1 through 20 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a specification which lacks descriptive support for the claimed subject matter (new matter).

Claims 1 through 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1 through 3 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Boike.

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The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 13), while the complete statement of appellant's argument can be found in the main and reply briefs (Paper Nos. 12 and 14).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims, the applied teachings,¹ and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

¹ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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The description issue

We reverse the examiner's rejection of claims 1 through 20 under 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. Further, the content of the drawings may also be considered in determining compliance with the written description requirement. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

At issue is the question of whether appellant's underlying disclosure descriptively supports the recitation in independent claim 1 of release tabs of a locking button for "moving independently of button teeth" in a direction parallel

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to a longitudinal axis of a slider member to release the locking button from a locked position in response to forces applied thereto in a direction parallel to the longitudinal axis.

Appellant's disclosure indicates (specification, page 4) that a locking button 34 (Fig. 2) includes release tabs each comprising a leg 38 and shelf 40 for releasing the locking button from a locked position in response to forces applied thereto in a direction parallel to a longitudinal axis. The locking button 34 provides button teeth 36 on the inside of U-shaped legs for engaging slider teeth 20 in a locked position and also includes "U-shaped end surfaces 48" (Fig. 2) extending transversely to the longitudinal axis and intersecting the lateral surfaces 44 and top 46. As further explained in the specification (page 5),

the shelves 40 may be manually grasped and forced together toward the end surfaces 48 to clear the ramps 58 from the cross beams 56 to remove the locking button 34, 134 from the locked position to the unlocked position.

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While the specification does not expressly state that the release tabs are for moving independently as now claimed, it is quite apparent to us that one skilled in this art would fully appreciate from appellant's overall disclosure that the configuration of the locking button is such that the release tabs, in response to forces applied thereto, are for moving independently of the button teeth to release the locking button from its locked position. Thus, it is fair to say that the claimed subject does not address new matter since it is descriptively supported by the originally filed disclosure. The examiner's rejection under 35 U.S.C. § 112, first paragraph, cannot therefore be sustained.

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The indefiniteness rejection

We reverse the rejection of claims 1 through 20 under 35 U.S.C. § 112, second paragraph, as being indefinite.

In the examiner's opinion (answer, page 4), the same language of claim 1 discussed above in the rejection under 35 U.S.C. § 112, first paragraph, is imprecise. We disagree.

As we see it, the language at issue in this rejection, when read in light of the disclosure in appellant's application (in particular, those portions of the specification referenced above relative to the new matter rejection) reveal that the claim language is precise and definite in meaning. Consistent with our earlier analysis, the release tabs do move independently of the button teeth when they are manually forced together toward the end surfaces

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The anticipation rejection

We reverse the rejection of claims 1 through 3 under 35 U.S.C. § 102(e) as being anticipated by Boike.

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As explained by the examiner (answer, page 5), the tabs and teeth of Boike are formed as one-piece like appellant's tabs and teeth and, therefore, if appellant's tabs move independently of the button teeth, the tabs of Boike inherently move independently of the button teeth. The examiner's position is not well taken.

Simply stated, the examiner has failed to appreciate that the locking means 20 of Boike (Fig. 2) is structurally different from appellant's locking button 34 and that the respective locking and release arrangements differ one from the other. Unlike the claimed release tab for movement independently of the button teeth, Boike has no release tab structure on the locking means for moving independently as now claimed. The release of the locking means of Boike is effected by a screwdriver engaging notches 66 to pop the locking member out of its locking position after deflecting the bridge members 80 outwardly; see column 5, lines 1 through 44. Thus, appellant's claims 1 through 3 are not anticipated by the Boike teaching.

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In summary, this panel of the board has not sustained any of the examiner's rejections.

The decision of the examiner is reversed.

REVERSED

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IAN A CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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DECISION:

Prepared By:

DRAFT TYPED: 09 Jun 01

FINAL TYPED: