

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte EIZO TAKAHASHI

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Appeal No. 2000-0031  
Application No. 09/061,526

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ON BRIEF

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

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2 and 5 through 10, which are all of the claims remaining in this application. Claims 1, 3 and 4 have been canceled.

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Appellant's invention is directed to an improved foothold of the type used in a manhole, or on a quay. Independent claims 2 and 6 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Takahashi 1988	4,778,032	Oct. 18,
Watsham 1937 (published British Patent Application)	470,919	Aug. 24,

Claims 2 and 5 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Takahashi in view of Watsham.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellant

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regarding the rejection, we make reference to the final rejection (Paper No. 5, mailed September 23, 1998) and the examiner's answer (Paper No. 8, mailed April 13, 1999) for the reasoning in

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support of the rejection, and to appellant's brief (Paper No. 7, filed February 26, 1999) and reply brief (Paper No. 9, filed June 15, 1999) for the arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking at the examiner's rejection of independent claims 2 and 6 under 35 U.S.C. § 103, we note that Takahashi discloses a foothold or climbing step of the general type set forth in the independent claims on appeal, i.e., a foothold having an elongated tread portion (5) and side portions (4) extending from the tread portion, said foothold further comprising a core (2) and a synthetic resin layer (10) covering the core. What Takahashi lacks with regard to

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appellant's independent claims 2 and 6 is any teaching of increasing the thickness of the resin layer, or an upper portion thereof, from a central portion of the tread to end portions of the tread so as to define an upper surface that is inclined upwardly from the central portion toward the end portions at an angle in the range of 1 to 5 degrees from horizontal.

To account for the above-noted differences between Takahashi and appellant's claimed subject matter, the examiner has turned to the teachings of Watsham, noting that this reference teaches a foothold having a tread with an upper surface that is inclined upward from a central portion of the tread toward the end portions thereof. The examiner further urges that

[t]he angle of the incline is not specified; however, the reason given by Watsham for inclining the tread is in order to minimize the risk of an injury due to slippage. The applicant has disclosed that it is known that an incline of 3 degrees is stable for walking. Therefore, it would have been obvious to incline the tread of Watsham at an angle of 3 degrees, which is in the range of 1 to 5 degrees from horizontal, in order to minimize the risk of injury due to slippage while standing or walking on

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the foothold. It would have been obvious to combine the core of Takahashi with a synthetic resin wherein the thickness of the synthetic resin for covering the core was inclined upward from a central portion toward the end portions thereof in order to obtain the foothold design of Watsham while using a standard horizontal core. As discussed above, it further would have been obvious to utilize an angle of 3 degrees, which is in the range of 1 to 5 degrees in order to minimize the risk of injury due to slippage while standing or walking on the foothold.  
[Final rejection, page 2, bridging page 3.]

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As additional commentary on the rejection, the examiner has indicated in the paragraph bridging pages 3 and 4 of the final rejection that

[t]he crux of the applicant's design, a foothold having an upper surface inclined from a central portion towards end portions, is known. Having a core disposed on a foothold is known. In the examiner's view, the means by which the end product is obtained; i.e., by increasing the thickness of a known core versus utilizing a known pre-shaped frame, is irrelevant. In view of what is known to one of ordinary skill in the art, the two are not patentably distinct.

On page 4 of the answer, after pointing out that Takahashi coats the metal core therein by placing the core in a mold and injecting the resin into the mold, the examiner has expressed his view that

altering the shape of a mold to obtain an end product is so well known that it would have been as obvious to have utilized a linear core with a mold shaped to form a tread with increasing thickness, as it would have been to have disposed a uniform core on an angled core. Additionally the applicant presents, on page 2 of the present application, first and second modifications; wherein the first modification is the linear core with a tread of increasing thickness; and wherein the second modification is an inclined core disposed with a linear tread. The examiner believes this is evidence that the applicant considers the two modifications to be

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obvious alternatives to one another.

Appellant argues, and we strongly agree, that Takahashi and Watsham, whether considered alone or in combination, do not teach or even remotely suggest increasing the thickness of a resin covering of a tread of a foothold from the central portion of the tread to end portions of the tread, as required in the independent claims on appeal. In addition, appellant urges that it is only by looking to the disclosure of the present application that one of ordinary skill in the art would be taught what the shape of a mold should be to form appellant's claimed foothold, since both Takahashi and Watsham are silent with regard to an increasing thickness tread of the type set forth in the claims on appeal. Appellant denies that he considers or admits that the modifications or alternate embodiments set forth in the specification of his application are "obvious" modifications of each other, as the examiner seems to believe, and urges that the examiner has used impermissible hindsight derived from appellant's own teachings in attempting to reject the claims on appeal based on Takahashi in view of Watsham.

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Like appellant, it is our view that the examiner's position in this appeal represents a clear case of impermissible hindsight reconstruction of the claimed invention based on appellant's own teachings. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266 n.15, 23 USPQ2d 1780, 1783-84 n.15 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. Moreover, and more to the point in the present appeal, we observe that the mere fact that some prior art references may be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the prior art relied upon by the examiner contains no such suggestion.

Since we have determined that the teachings and suggestions found in Takahashi and Watsham would not have made

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the subject matter as a whole of independent claims 2 and 6 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103. It follows that the examiner's rejection of dependent claims 5 and 7 through 10 will likewise not be sustained.

Accordingly, the decision of the examiner to reject claims 2 and 5 through 10 under 35 U.S.C. § 103 is reversed.

In addition to the foregoing, we REMAND this application to the examiner for a more complete search of the prior art. In the examination of an application for a patent, the examiner is charged with the responsibility of conducting a thorough search of the prior art, which search should cover the invention as described and claimed, including the inventive concepts toward which the claims are directed. Noting that the "SEARCHED" box on the file wrapper of the present application indicates that the examiner only searched this case in Class 182, subclass 90, we observe that § 904.01(c) of the M.P.E.P. cautions the examiner that not only

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must the art be searched within which the invention claimed is classifiable, but also all pertinent and analogous arts regardless of where classified. In that regard, we see no reason why the concept of an increasing thickness tread covering of the type set forth in the claims on appeal would be limited to use on a wall- or floor-attached ladder arrangement having independent rungs or steps like that searched by the examiner thus far. Accordingly, we suggest the following areas as examples of those we think should additionally be searched: Class 182, subclasses 91 and 92; Class 182, subclass 228.2; and Design Class 25, subclass 69. Other pertinent areas where rungs or steps with increasing thickness coverings of the general type claimed could reasonably be found may be known to the examiner and should also be considered.

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This application, by virtue of its "special" status requires an immediate action. MANUAL OF PATENT EXAMINING PROCEDURE § 708.01 (7th ed., Rev. 1, Feb. 2000).

REVERSED and REMANDED

	)	
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

CEF:hh

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