

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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID R. FORBES and CARMAN S. FORBES

Appeal No. 2000-0500
Application No. 09/006,137

ON BRIEF

Before CALVERT, FRANKFORT, and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 14 and 15, which are all of the claims remaining in this application. Claims 1 through 13 and 16 through 20 have been canceled.

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Appellants' invention relates to a method of using hunting accessories and, more particularly, to a method of hanging hunting accessories carried in a vest-type accessory-holding apparatus from a tree, as generally depicted in Figure 2 of the application. Independent claim 14 and claim 15, which depends therefrom, are on appeal and a copy of those claims may be found in the Appendix to appellants' brief.

The sole prior art reference of record relied upon by the examiner is:

Williams et al. (Williams)	5,738,046	Apr. 14,
1998		(filed Jul. 22,
1996)		

Claims 14 and 15 stand rejected under 35 U.S.C. § 102(e) as anticipated by Williams.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we refer to the examiner's answer (Paper No. 11, mailed July 28, 1999) and to appellants' brief (Paper No. 10, filed June 28, 1999) for a full exposition thereof.

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OPINION

Having carefully reviewed the anticipation issue raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejection of the appealed claims under 35 U.S.C. § 102(e) will not be sustained. Our reasoning in support of this determination follows.

Independent claim 14 and dependent claim 15 are each directed to a method of using a hunting accessory and include multiple steps to define the method. As an example, independent claim 14 sets forth, inter alia, the steps of positioning a flexible member around a tree, removing the vest set forth earlier in the claim from around the human torso, and then hanging the vest around the tree from said flexible member so that the vest extends around at least a portion of the tree. Dependent claim 15 adds a pad on a back portion of the vest and the further step of "positioning said vest around said tree so that said pad can be used as a cushion by a

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person leaning against said tree." The examiner's treatment of the above-noted method steps in claim 14 on appeal is set forth on page 4 of the answer, and is essentially that the step of removing the vest is "viewed as an inherent function of the vest and the zipper therewith," and that the step of hanging the vest from a tree is "capable via member 60" in Williams. A similar treatment of the steps in claim 15 is found in the paragraph bridging pages 4 and 5 of the answer, wherein the examiner essentially urges that the safety jacket and harness system of Williams have the "capability" of being used in the manner required in appellants' claim 15 on appeal.

Appellants assert (brief, pages 5-8) that the Williams reference does not teach or suggest the steps of "removing said vest" and then "hanging said vest . . . around . . . said tree" as in claim 14 on appeal, or the step of positioning the vest and pad thereof in the manner set forth in claim 15 on appeal, and that the examiner has accordingly improperly rejected the claims on appeal under 35 U.S.C. § 102(e). We agree.

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It appears that the examiner has lost sight of the need for the applied reference to actually disclose or teach the recited steps of appellants' claimed method either expressly or under principles of inherency in order for the reference to anticipate the claimed subject matter. The mere fact that the jacket and harness of Williams may under some circumstance be capable of being used in the manner set forth in appellants' claims on appeal is irrelevant, since the reference does not disclose, teach or suggest any such use of the apparel therein, nor any steps to accomplish such a use. In this regard, we note that it is well settled that inherency may not be established by probabilities or possibilities, but must instead be "the natural result flowing from the operation as taught." See In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). In the present case, the disclosure of the Williams patent does not provide any factual basis to establish that the natural result flowing from following the teachings of that reference would be a method like that disclosed and claimed by appellants.

Since all the limitations of appellants' independent

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claim 14 are not found in Williams, either expressly or under principles of inherency, it follows that the examiner's rejection of claim 14 (and of claim 15 which depends therefrom) under 35 U.S.C. § 102(e) relying on Williams will not be sustained.

The decision of the examiner to reject claims 14 and 15 under 35 U.S.C. § 102(e) based on Williams is, accordingly, reversed.

REVERSED

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

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