

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAYNARD COWAN, JR.

Appeal No. 2001-2566
Application No. 09/655,092

HEARD: NOVEMBER 29, 2001

Before McQUADE, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to roadways and more particularly to the interface of vehicle wheels and an elevated vertical roadway along which a vehicle moves, the

improved vehicle/roadway interaction allowing steeper roadway grade, improved roadway lifetime, reduced construction and maintenance expense, higher vehicle acceleration and deceleration and a smoother vehicle ride (specification, page 1). Claims 1 and 12, the only independent claims on appeal, read as follows:

1. Apparatus for the interface of a vehicle wheel and roadway, said roadway being supported in a substantially fixed position with respect to the Earth by a support means, said apparatus being apparatus for achieving superior traction between said wheel and said roadway independently of the weight of said vehicle, and for minimizing oscillation of said wheel upon said roadway, said apparatus comprising:

said roadway having at least substantially vertical and concave sides;

a plurality of at least substantially horizontal wheels rotating about at least substantially vertical axles secured to said vehicle, said wheels having convex rims rolling along said concave sides of said roadway; and

a compression means, connected to said wheels, for causing said wheels to be compressed against said sides of said roadway with compression adequate to allow a desired amount of traction to be maintained between said wheels and said roadway, independently of said weight of said vehicle.

12. Apparatus for the interface of a vehicle wheel and roadway, said roadway being supported in a substantially fixed position with respect to the Earth by a support means, said apparatus being apparatus for achieving superior traction between

said wheel and said roadway independently of the weight of said vehicle, and for minimizing oscillation of said wheel upon said roadway, said apparatus comprising:

said roadway having at least substantially horizontal sides;

a plurality of at least substantially vertical wheels rotating about at least substantially horizontal axles secured to said vehicle, said wheels having rims rolling along said sides of said roadway; and

a compression means, connected to said wheels, for causing said wheels to be compressed against said sides of said roadway with compression adequate to allow a desired amount of traction to be maintained between said wheels and said roadway, independently of said weight of said vehicle.

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

Richter et al. (Richter)	5,014,864	May 14, 1991
Getsay	5,507,679	Apr. 16, 1996
Miller et al. (Miller)	5,662,045	Sep. 2, 1997

The following rejections are before us for review.

Claims 1-12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claims 1-8 and 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Getsay in view of Miller.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Getsay in view of Richter.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection and answer (Paper Nos. 8 and 13) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 10 and 14) for the appellant's arguments thereagainst.

OPINION

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

The indefiniteness rejection

The examiner contends that the claims are indefinite because "[i]t is unclear if the applicant's invention is the

¹ In that claim 9 depends from claim 1, it appears that the examiner's intended rejection of claim 9 is based upon Getsay in view of Miller and Richter.

features of the roadway, the features of the wheel or the subcombination [*sic*: combination] thereof" (final rejection, page 2). We do not agree. It is apparent to us that appellant's claims are directed to an apparatus comprising a combination of a roadway, a support means, a plurality of wheels and a compression means.

The examiner's position (answer, pages 3-4) that the claims are vague and indefinite because appellant does not distinctly recite in the body of the claim how the three parts (roadway, wheels and compression means) combine together is equally untenable. The interaction or interrelationship of the roadway, wheels and compression means is clearly set forth in the last two paragraphs of claims 1 and 12.

For the foregoing reasons, we shall not sustain the examiner's rejection of claims 1-12 under the second paragraph of 35 U.S.C. § 112.

The obviousness rejections

Each of claims 1 and 12, the only independent claims on appeal, requires, *inter alia*, a roadway having sides, a plurality of wheels rotating about axles and a compression means, connected to the wheels, for causing the wheels to be

compressed against the sides of the roadway. Getsay discloses a track and a plurality of spindles 90, 92, 94, 96 and a driven wheel 154 which engage the track. However, only one of the wheels, the driven wheel 154, is resiliently urged toward the track side by means such as a continuous rubber band 164. Getsay does not disclose any compression means for causing any of the spindles to be compressed against the sides of the track. Thus, Getsay lacks a compression means for causing a plurality of wheels to be compressed against the sides of the roadway, as recited in claims 1 and 12.

We have carefully reviewed the teachings of Miller but we find nothing therein which would have suggested providing a compression means for causing a plurality of wheels (e.g., the spindles 90, 92, 94, 96) of Getsay to be compressed against the sides of the track or roadway. It follows then that the combined teachings of Getsay and Miller are insufficient to establish a *prima facie* case of obviousness of the subject matter of claims 1 and 12.² Accordingly, we shall not sustain

² It is elementary that to support an obviousness rejection, all of the claim limitations must be taught or suggested by the prior art applied (see In re Royka, 490 F.2d 981, 984-85, 180 USPQ 580, 582-83 (CCPA 1974)) and that all words in a claim must be considered in judging the patentability of that claim against the prior art (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496

the examiner's obviousness rejection of claims 1 and 12 or claims 2-8, 10 and 11 which depend from claim 1.

The above-noted deficiency in the combination of Getsay and Miller finds no cure in Richter. Thus, we also shall not sustain the examiner's obviousness rejection of claim 9.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-12 under 35 U.S.C. §§ 103 and 112 is reversed.

REVERSED

JOHN P. McQUADE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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