

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(2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIBALD KRAUS

Appeal No. 96-1303
Application 08/098,516¹

ON BRIEF

Before CALVERT, ABRAMS and McQUADE, Administrative Patent
Judges.

CALVERT, Administrative Patent Judge.

¹ Application for patent filed July 28, 1993.

Appeal No. 96-1303
Application 08/098,516

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 30, all the claims remaining in the application.

The claims on appeal are drawn to a device for holding a tube-shaped body, and are reproduced in Addendum A of appellant's brief filed August 9, 1995 (Paper No. 12).²

The references applied in the final rejection are:

Ellinwood	2,396,837	Mar. 19, 1946
Hopkins	3,126,183	Mar. 24, 1964
Cochran	3,163,712	Dec. 29, 1964
Nelson	4,264,047	Apr. 28, 1981
Santucci et al. (Santucci)	4,635,886	Jan. 13, 1987
Caveney et al. (Caveney)	4,919,373	Apr. 24, 1990
Kamiya et al. (Kamiya)	5,131,613	July 21, 1992
Milcent et al. (Milcent)	5,169,100	Dec. 8, 1992

The appealed claims stand finally rejected as follows:

² Any subsequent references in this decision to appellant's brief are to the brief subsequently filed on August 7, 1997 (Paper No. 17).

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(1) Claims 1 to 30, unpatentable for failure to comply with
35 U.S.C. § 112, second paragraph;

(2) Claims 1 to 9 and 13 to 30, unpatentable under 35 U.S.C.
§ 103 over the following combinations of references:

(a) Claims 1 to 3, 8, 9, 13 to 17, 21 and 22, Hopkins
in view of Caveney;

(b) Claims 4 and 5, Hopkins in view of Caveney and Nelson;

(c) Claims 6 and 7, Hopkins in view of Caveney and
Ellinwood;

(d) Claims 18 and 19, Hopkins in view of Caveney and
Kamiya;

(e) Claim 20, Hopkins in view of Caveney and Milcent;

(f) Claims 23 to 27, 29 and 30, Hopkins in view of Caveney
and Cochran;

(g) Claims 23 and 28, Hopkins in view of Caveney and
Santucci.

Rejection (1)

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The examiner finds claim 1, the only independent claim, to be indefinite because "the connected condition" in the last line of the claim lacks proper antecedent basis. She asserts on pages 3 and 4 of the answer that "there is no [prior] positive recitation of 'a connected condition'," and that "the connected condition" could be construed as being the connection of the attachment portion recited in lines 3 and 4 of the claim.

A claim is definite (complies with the second paragraph of § 112) if it "reasonably apprises those of skill in the art of its scope." In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). In the present case, the examiner focuses on "the connected condition," but this phrase cannot be read in isolation; the part of claim 1 in which it appears recites "when the catch means is in the connected position." Since claim 1 previously recites that the separate components of the attachment portion are "selectively connectable by a catch means" (line 14), it would be evident to one of ordinary skill

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in the art that "when the catch means is in the connected position" means "when the separate components of the attachment portion are connected by the previously-recited catch means." We do not consider that one of ordinary skill would have any doubt as to the meaning of "the connected condition," even though that precise wording does not appear elsewhere in claim 1, and would find the bounds of the claimed subject matter to be distinct.

We therefore will not sustain rejection (1).

Rejection (2)(a)

In considering whether it would have been obvious to combine Hopkins and Caveney in the manner proposed by the examiner, we note that:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)(original emphasis; footnotes omitted).

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The basis of the examiner's rejection is set forth on pages 3 and 4 of the final rejection (Paper No. 10), and need not be repeated here. The motivation for combining the references, i.e., for substituting Caveney's attachment portion for Hopkins', would be, according to the examiner, "to provide the latter's device with an alternate attachment portion" (final rejection, page 4), being "a mere substitution of equivalents" (answer, page 5).

We do not consider this rejection to be well taken. In Hopkins, the two parts 15,16 of the attachment portion are brought into engagement by pivoting them around hinges 13 until shoulders 24,25 hook together, while in Caveney, the end 40 of strap 24 is connected to head 26 by inserting it through slot 56 in the head for the teeth 30 on the strap to engage the teeth 66 on the head. The manner in which Hopkins connects the two parts of the attachment portion of his device together, by pivoting them into side-by-side position (Fig. 4), is so different from Caveney's insertion of the end of a strap through a slot to make the connection that it is not evident how one of ordinary skill would even approach

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substituting Caveney's connection means for that of Hopkins,
as proposed by the examiner. The structure and operation of
the devices of these two references are so disparate

that in our view one of ordinary skill would derive no
suggestion or motivation from Caveney to modify the attachment
portion of Hopkins.

The rejection accordingly will not be sustained.

Rejections (2)(b) to (2)(g)

None of the additional references applied in these
rejections overcomes the deficiencies noted above in the
combination of Hopkins and Caveney. These rejections will
likewise not be sustained.

Conclusion

The examiner's decision to reject claims 1 to 30 is
reversed.

REVERSED

IAN A. CALVERT)

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	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
	NEAL E. ABRAMS)	APPEALS AND
	Administrative Patent Judge)	
INTERFERENCES)	
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	JOHN P. McQUADE)	
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