

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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL BELL

Appeal No. 96-3379
Application 08/248,775¹

ON BRIEF

Before CALVERT, MEISTER and FRANKFORT, ***Administrative Patent Judges.***

CALVERT, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 37, 45 to 50 and 71, all of the claims remaining in the application.

The appealed claims are reproduced in the appendix to

¹Application for patent filed May 25, 1994 under 37 CFR 1.60 as a divisional of application 07/910,157 filed July 17, 1992, now patent 5,360,082, issued November 1, 1994.

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appellant's brief.

The prior art relied upon by the examiner in rejecting the claims on appeal is:

Bernstein	383,432	May 29, 1888
Vinai	4,625,335	Dec. 02, 1986
Weiner et al. (Weiner)	4,674,596	Jun. 23, 1987
Green	4,687,074	Aug. 18, 1987
Lappe ² (German)	32 16 599	Nov. 17, 1983

SKY GENIE®, produced by Descent Control, Inc., Fort Smith, AR (disclosed prior art lowering device, pg. 2 of the specification).

Disclosed conventional harness per Paper No. 8, page 2 (amendment filed May 25, 1995).

The claims stand rejected under 35 USC § 103 as unpatentable over the following combinations of references:

(1) Claims 45 to 47 and 49, Weiner in view of Vinai and SKY GENIE®;

(2) Claims 48 and 50, Weiner in view of Vinai, SKY GENIE® and Bernstein;

(3) Claims 1 to 13, 17, 20 to 30, 33, 35 to 37 and 71, in view of Vinai, SKY GENIE® and Green;

(4) Claims 14, 16, 18, 19, 31, 32 and 34, Weiner in view of Vinai, SKY GENIE®, Green and Lappe;

²Our understanding of this reference is derived from a translation prepared for the PTO. A copy of the translation is enclosed.

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(5) Claims 1 to 37, 45 to 47, 49 and 71, Weiner in view of the disclosed conventional harness and SKY GENIE®;

(6) Claims 48 and 50, Weiner in view of the disclosed conventional harness, SKY GENIE®, and Bernstein.

The primary reference, Weiner, discloses a safety system in which a worker on a roof, standing on a horizontal safety line 60, wears a harness 68 attached to a lanyard 70. The lanyard is attached by a rope grab 72 to a line 73 hanging from a higher horizontal safety line 62. While Weiner does not disclose a harness ("body engagement means") with two connection means, or the use of a lowering device, the examiner takes the position as to rejections (1) to (4), that (answer page 3):

Vinai shows a harness with first(51a) and second (72s) connecting means to enable attachment of a plurality of suspension means. Sky Genie shows a lowering suspension means for lowering a person on a rope. It would have been obvious to one of ordinary skill in the art to provide Weiner with a harness as claimed to enable the attachment of plural suspension means at separate connecting points, and a lowering device to facilitate the lowering of a person after a fall. Furthermore, to provide any conventional severing means eg. a knife to sever or disconnect the rope grab means, would have been an obvious mechanical expedient. The claimed method of protecting a person, would have been obvious to one of ordinary skill in the art in view of the modified system of Weiner.

He takes the same position with regard to rejections (5) and (6), substituting the disclosed conventional harness for the

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disclosure of Vinai. Appellant, on the other hand, admits that the individual elements of his system, i.e., the safety line, rope grab, harness assembly, lanyard and lowering device, "have been commercially available and in use in the industry for years" (brief, page 3), but argues that it would not have been obvious to employ both a rope grab device and a lowering device in a single system, "to provide a fall prevention system that enables self-rescue" (brief, page 15; original emphasis).

Under 35 USC § 103, the teachings of the references can be combined only if there is some suggestion or incentive to make the combination. **ACS Hospital Systems, Inc. v. Montefiore Hospital**, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). While there is no requirement that the prior art contain an express suggestion to combine, there must be some suggestion, either from the references themselves or in the knowledge generally available to one of ordinary skill in the art. **Motorola Inc. v. Interdigital Technology Corp.**, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997).

In the present case, after fully considering the arguments of appellant and the examiner, we conclude that the subject matter recited in the claims on appeal would not have been

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obvious over the prior art applied.

Although, as appellant acknowledges, the two-connection harness and lowering devices such as the SKY GENIE® are known in the art, we do not consider that there is any suggestion in the art for combining them with the lanyard-rope grab safety system disclosed by Weiner. The examiner argues that (answer, page 6):

If after a fall, with the system of Weiner, the problem at hand to be resolved is the lowering of the user to a safe place, a skilled mechanic in the safety art would have appreciated the use of commercially available lowering devices to accomplish this task, also if a separate (second) connecting point to the harness for the lowering device would be desirable over the single connecting point disclosed by Weiner, a skilled mechanic would have appreciated the use of commercially available harness which comprises multiple connecting points, e.g. Vinai, and appellant's disclosed prior art harness in resolving the problem.

However, we find no suggestion in the disclosure of the prior art Weiner system of the possible problem (lowering of the user) postulated by the examiner. In fact, as appellant points out, Weiner discloses at column 3, lines 23 to 25, that "In the event of a fall on the roof surface, the free end 77 of the additional line may be grasped to enable the worker to move upwardly on the slope of the roof." In view of this disclosure that the worker can move upwardly after a fall, we see no reason or motivation for one of ordinary skill to provide the worker with a lowering

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device to enable downward movement after a fall. The fact that the prior art could be modified in the manner suggested by the examiner does not make the modification obvious unless the prior

art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

We find nothing in the Bernstein, Green or Lappe references which would supply the deficiencies noted with regard to the combination of Weiner in view of SKY GENIE® and either Vinai or the disclosed conventional harness.

Accordingly, a prima facie case of obviousness has not been made, and the rejections will not be sustained.³

Conclusion

The examiner's decision to reject claims 1 to 37, 45 to 50 and 71 is reversed.

REVERSED

³There being no prima facie case of obviousness, it is unnecessary to consider the declaration of Stefan D. Bright under 37 CFR 1.132 (Paper No. 7, filed May 25, 1995).

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