

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 KEENAN LONGCOR and MARC HAYMAN

Appeal No. 97-0032
Application No. 08/095,295¹

ON BRIEF

Before SCHAFER, Vice Chief Administrative Patent Judge, and
FRANKFORT and NASE, Administrative Patent Judges.

PER CURIAM

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21 through 36, which are all of the claims pending in this application.

¹ Application for patent filed July 21, 1993. According to appellants, the application is a continuation-in-part of Application No. 07/973,306, filed November 9, 1992, now abandoned.

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The panel voted to reverse the rejection of all claims in a split decision. The panel has reached agreement with respect to the rejection of claims 21 through 32 and 34 through 36. Administrative Patent Judge Nase's opinion for the panel follows. Vice Chief Administrative Patent Judge Schafer and Administrative Patent Judge Frankfort agree that the rejection of claim 33 should also be reversed, but for different reasons. Their separate opinions follow. Administrative Patent Judge Nase would affirm the rejection of claim 33. His dissenting opinion follows.

CONCLUSION

The decision of the examiner to reject claims 21 through 36 under 35 U.S.C. § 103 is reversed.

REVERSED

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NASE, Administrative Patent Judge

BACKGROUND

The appellants' invention relates to an expandable and collapsible container assembly. Claims 26 and 33 are representative of the subject matter on appeal and a copy of those claims, as they appear in the appellants' brief, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Warren	1,382,446	June 21, 1921
Connell et al. (Connell)	4,415,106	Nov. 15, 1983
Touzani	4,492,313	Jan. 08, 1985
Worrall	446,742 (Great Britain)	May 05, 1936

Gershman, "Self-Adhering Nylon Tapes," Journal of the American Medical Association, Vol. 168, No. 7, p. 930, Oct. 18, 1953.

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Claims 21, 22, 24 through 28, 30, 33 and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Warren in view of Connell, Worrall and Touzani.²

Claims 23 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over the prior art applied to claims 22 and 28 above, and further in view of Gershman.

Claims 31 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Warren in view of Connell, Worrall, Touzani and Gershman.

Claim 34 stands rejected under 35 U.S.C. § 103 as being unpatentable over Warren in view of Worrall and Touzani.

Claim 35 stands rejected under 35 U.S.C. § 103 as being unpatentable over Warren in view of Connell, Worrall and Touzani.

² We note that the examiner failed to include Worrall in the statement of this rejection. However, appellants were aware that the examiner applied Worrall in the body of this rejection. See page 6, last line through page 7, line 5, of the brief. Accordingly, we will treat Worrall as being included in the statement of this rejection.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the § 103 rejections, we make reference to the examiner's answer (Paper No. 15, mailed January 26, 1996) and the examiner's response to appellants' reply brief (Paper No. 19, mailed June 24, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 13, filed July 28, 1995) and reply brief (Paper No. 18, filed March 29, 1996) for the appellants' arguments thereagainst.

OPINION

CLAIMS 21 THROUGH 32 AND 34 THROUGH 36

We will not sustain the examiner's rejection of claims 21 through 32 and 34 through 36 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the

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relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing

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Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

CLAIMS 21 THROUGH 30

With regard to the 35 U.S.C. § 103 rejections of claims 21 and 26 as being unpatentable over Warren in view of Connell, Worrall and Touzani, we agree with the appellants that the claimed invention would not have been rendered obvious by the applied prior art. In that regard, we agree with the appellants (brief, pp. 15-17) that the applied prior art does not suggest an elongated flexible flap extending under the bottom of the bellows compartment, up adjacent the outer wall of the bellows compartment and over the top opening of the bellows compartment to either the inner wall of the bellows compartment (claim 26) or the belt (claim 21).

As to these limitations³ the examiner stated that the size of the flap is dependent on the security desired and that a larger flap obviously creates better security for the articles placed therein. Assuming arguendo, that this is true, the

³ The specific limitations are found on lines 18-21 of claim 21 and lines 10-13 of claim 26.

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examiner has failed to provide any evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art, that it would have been obvious to one of ordinary skill in this art to modify the flap of Warren's purse to extend under the bottom of the purse, up adjacent the outer wall of the purse and over the top opening of the purse to either the inner wall of the purse or his garter. In our view, the examiner in this instance has resorted to the use of impermissible hindsight to reconstruct the claimed invention. Since all the limitations of claims 21 and 26 are not taught or suggested by the applied prior art, the examiner has failed to meet the initial burden of presenting a prima facie case of obviousness. Thus, we will not sustain the 35 U.S.C. § 103 rejection of independent claims 21 and 26, or of claims 22 through 25 and 27 through 30, which depend therefrom.⁴

CLAIMS 31, 34 AND 35

With regard to the 35 U.S.C. § 103 rejections of claim 31 as being unpatentable over Warren in view of Worrall, Connell,

⁴ We have also reviewed the Gershman reference additionally applied in the rejection of claims 23 and 29 but find nothing therein which would have suggested the limitation discussed above.

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Touzani and Gershman and claim 34 as being unpatentable over Warren in view of Worrall and Touzani, we agree with the appellants that the claimed invention would not have been rendered obvious by the applied prior art. In that regard, we agree with the appellants (brief, pp. 22-27) that the applied prior art does not suggest a bellows compartment having pleats comprising a long section and a short section and each side pleat being joined to the bottom pleat by a rounded pleated corner such that each pleat will be bistable.

As to this limitation⁵ the examiner stated that it would have been obvious to modify Warren's purse to be pleated as suggested by Worrall and to have each pleat include a long section and a short section such that each pleat will be bistable as suggested by Touzani. In our view, the examiner has in this instance resorted to the use of impermissible hindsight to reconstruct the claimed invention from disparate teachings in the prior art. In that regard, the examiner has not established why one of ordinary skill in this art would have been motivated to modify the pleats of Worrall provided on Warren's purse. While

⁵ The specific limitation is found on lines 10-16 of claim 31 and lines 9-16 of claim 34.

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Touzani does teach the use a pleated bottle wherein each pleat has a long section and a short section such that each pleat will be bistable, Touzani fails to include any suggestion or motivation to apply that teaching to a pleated purse. Since all the limitations of claims 31 and 34 are not taught or suggested by the applied prior art, the examiner has failed to meet the initial burden of presenting a prima facie case of obviousness. Thus, we will not sustain the 35 U.S.C. § 103 rejection of independent claims 31 and 34, or of claim 35 which depends therefrom.⁶

CLAIM 36

With regard to the 35 U.S.C. § 103 rejection of claim 36 as being unpatentable over Warren in view of Connell, Worrall and Touzani, we agree with the appellants that the claimed invention would not have been rendered obvious by the applied prior art. In that regard, we agree with the appellants (brief, pp. 17-18) that the applied prior art does not suggest the distal end of the flap extending over the top opening of the compartment and down adjacent the inner side of the belt and the distal end of the

⁶ We have also reviewed the Connell reference additionally applied in the rejection of claim 35 but find nothing therein which would have suggested the limitation discussed above.

flap containing fastening means for removably fastening the distal end of the flap to the inner side of the belt.⁷

As to these limitations⁸ the examiner stated that it would have been obvious to modify the flap of Warren's purse to open outwardly from the garter (instead of inwardly) as suggested by Connell. Again, the examiner, in our view, has resorted to the use of impermissible hindsight to reconstruct the claimed invention. In that regard, the examiner has not established why one of ordinary skill in this art would have been motivated to modify the flap on Warren's purse to extend down adjacent the inner side of the belt and to be removably fastened thereto. While Connell does teach the use a flap 22 that opens outwardly from his belt 11-14, Connell does not teach the use of a flap extending over a compartment having outer and inner walls,

⁷ We have determined that the broadest reasonable interpretation of the "fastening means" consistent with the specification requires a fastening device on both the distal end of the flap (see appellants' fastener 20 as shown in Figures 2A and 2B or fastener 32F as shown in Figures 6B, 6C and 7) and the inner side of the belt (see appellants' fastener 19 as shown in Figures 2A and 2B or fastener 32M as shown in Figures 6B, 6C and 7). See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

⁸ The specific limitations are found on lines 13-16 and 20-21 of claim 36.

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opposite sides, a bottom and a top opening as recited in claim 36. At best Connell would have suggested to an artisan to modify Warren's purse by providing the loops 31 and the fastening member 32 on the flap side of the purse so that the flap would engage the outer side (webbing 20) of the garter. Thus, Connell does not provide any suggestion or motivation to modify the flap on Warren's purse to extend down adjacent the inner side of the belt and to be removably fastened thereto. Since all the limitations of claim 36 are not taught or suggested by the applied prior art, the examiner has failed to meet the initial burden of presenting a prima facie case of obviousness. Thus, we will not sustain the 35 U.S.C. § 103 rejection of independent claim 36.

Based on the foregoing, the examiner's decision rejecting claims 21-32 and 34-36, under 35 U.S.C. § 103 is reversed.

The opinions of the panel members regarding the examiner's rejection of claim 33 under 35 U.S.C. § 103 follow.

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SCHAFFER, Vice Chief Administrative Patent Judge, concurring-in-part.

I join in Judge Nase's opinion reversing the rejections of claims 21 through 32 and 34 through 36 under 35 U.S.C. § 103.

I.

Claim 33 includes the following limitation (Brief, p. 40):

[P]ivot means pivotably attaching said inner wall of said bellows compartment to said strap, said pivot means enabling said bellows compartment to pivot with respect to said strap about an axis generally normal to said front surface of said strap and said inner wall of said bellows, said pivot means enabling said bellows compartment to be pivoted to a horizontal position independent of any orientation of said strap on said torso of said person.

This limitation is written using the word "means" followed by a statement of function, thus raising the issue of whether the provisions of 35 U.S.C. § 112, ¶ 6, have been invoked.

I recognize that the § 112, ¶ 6, issue has not been expressly raised by applicant or the examiner. However, the language of the statute, in using the word "shall" is mandatory in its application. The sixth paragraph states that a means-plus-function claim "shall be construed to cover the

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corresponding structure, material or acts described in the specification and equivalents thereof." (Emphasis added.)

35 U.S.C. § 112, ¶ 6. See also, Pennwalt Corp. v. Durand-Wayland Inc., 833 F.2d 931, 934, 4 USPQ2d 1737, 1738-39 (Fed. Cir. 1987), cert. denied, 485 U.S. 961 and cert. denied, 485 U.S. 1009 (1988) ("As Judge Rich, one of the drafters of the statute, stated in a 1952 address explaining the import of section 112, paragraph 6: 'If you adopt this practice, that element or step is to be construed -- shall be construed (it is mandatory) -- to cover the corresponding structure, material or acts described in the specification and equivalents thereof.'"). The Federal Circuit has also noted that "the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination." In re Donaldson Co. Inc., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc). See also In re Iwahashi, 888 F.2d 1370, 1375 n.1, 12 USPQ2d 1908, 1912 n.1 (Fed. Cir. 1989) ("Section 112 ¶6 cannot be ignored when a claim is before the PTO any more than when it is before the courts in an issued patent"); Data Line Corp. v. Micro Technologies Inc., 813 F.2d 1196, 1201, 1 USPQ2d 2052, 2055 (Fed. Cir. 1987) ("where a claim sets forth a means for performing a specific function, without reciting any specific

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structure for performing that function, the structure disclosed in the specification must be considered, and the patent claim construed to cover both the disclosed structure and equivalents thereof"). Thus, in my view both the statute and our reviewing court mandate application of the statutory claim interpretation where the language of the claim invokes it.

Additionally, the application of the sixth paragraph is a matter of claim construction. Claim construction is a question of law which is reviewed de novo. Donaldson, 16 F.3d at 1192, 29 USPQ2d at 1848; Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir.), cert. denied, 465 U.S. 1026 (1984). I therefore believe we are not bound by or in anyway obligated to adopt an erroneous construction of the claimed subject matter simply because the examiner and applicant appear to agree upon it. Indeed, in Iwahashi the Federal Circuit applied the sixth paragraph in deciding the appeal although it had not been briefed or argued during the proceedings in the PTO or briefed to the Court. Iwahashi, 888 F.2d at 1375, 12 USPQ2d at 1911-12.

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Administrative Patent Judge Nase states that 37 CFR § 1.192 appears to dictate against raising and considering such the § 112, ¶ 6 issue since it was not raised as a point of contention in the appeal. Section 1.192 sets out the requirements for an appellant's brief on appeal and states that any arguments and authorities not included in the brief will be refused consideration by the board. In my view, this is a limitation "on appellants" not a limitation on this board's authority to raise new issues. Indeed, such an interpretation is inconsistent with this board's statutory authority to examine and reexamine appealed claims and enter new grounds of rejection. See In re Loehr, 500 F.2d 1390, 1392-93, 183 USPQ 56, 58 (CCPA 1974). The interpretation is also inconsistent with the provisions of 37 CFR § 1.196(b) and (d).

Judge Nase also refers to § 2183 of the Manual of Patent Examining Procedure (MPEP), 6th Edition, Revision 2, July 1996, and to Guidelines on "Means Or Step Plus Function Limitation Under 35 U.S.C. § 112, 6th Paragraph."⁹ However, neither of these consider our reviewing court's most recent opinions on when the provisions of 35 U.S.C. § 112, ¶ 6, are invoked. Cole v.

⁹ Published at 1162 Off. Gaz. Pat. Off. 59 (May 17, 1994).

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Kimberly-Clark Corp., 102 F.3d 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996); Serrano V. Telular Corp., 111 F.3d 1578, 1582, 42 USPQ2d 1538, 1541 (Fed. Cir. 1997); Fonar Corp. v. General Electric Co., 107 F.3d 1543, 1551, 41 USPQ2d 1801, 1807 (Fed. Cir. 1997); Greenberg v. Ethicon Endo-Surgery Inc., 91 F.3d 1580, 1584, 39 USPQ2d 1783, 1786-87 (Fed. Cir. 1996); York Products Inc. v. Central Tractor Farm & Family Center, 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1623 (Fed Cir. 1996).

II.

A.

The Federal Circuit has stated that

the use of the term "means" has come to be so closely associated with "means-plus-function" claiming that it is fair to say that the use of the term "means" (particularly as used in the phrase "means for") generally invokes section 112(6)

Greenberg, 91 F.3d at 1584, 39 USPQ2d at 1786-87. See also, York Products Inc., 99 F.3d at 1574, 40 USPQ2d at 1623 ("the use of the word "means" triggers a presumption that the inventor used this term advisedly to invoke the statutory mandates for

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means-plus-function clauses.") However, the Federal Circuit has also noted that the use of the word means does not necessarily invoke the provisions of the sixth paragraph:

Merely because a named element of a patent claim is followed by the word "means," however, does not automatically make that element a "means-plus-function" element under 35 U.S.C. Section 112, Para. 6.

Cole, 102 F.3d at 531, 41 USPQ2d at 1006. In order to invoke the statute, the means-plus-function element must not recite a definite structure. Serrano, 111 F.3d at 1582, 42 USPQ2d at 1541 ("The 'determination means' limitation of that claim recites a means for determining the last digit without reciting definite structure in support of that function, and that limitation therefore is a "means plus function" limitation subject to the requirements of 35 U.S.C. § 112, ¶ 6"); Fonar Corp., 107 F.3d at 1551, 41 USPQ2d at 1807("An apparatus claim requires definite structure in the specification to support the function in a means clause. Because claim 12 does not recite such structure in support of the defined function, it is therefore subject to section 112, Para. 6."); Cole, 102 F.3d at 530-31, 41 USPQ2d at 1006. See also, Data Line Corp., 813 F.3d at 1201, 1 USPQ2d at

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2055; Radio Steel & Mfg. Co. v. MTD Products, Inc., 731 F.2d 840, 848, 221 USPQ 657, 663 (Fed. Cir. 1984), cert. denied, 469 U.S. 831 (1984); Lockheed Aircraft Corp. v. United States, 553 F.2d 69, 82, 193 USPQ 449, 460 (Ct. Cl. 1977); Decca Ltd. v. United States, 420 F.2d 1010, 1014, 164 USPQ 348, 351 (Ct. Cl.), cert. denied, 400 U.S. 865, 167 USPQ 321 (1970). But the mere recitation of some structure in a means-plus-function element does not preclude the applicability of § 112, ¶ 6. Laitram Corp. v. Rexnord, Inc., 939 F.2d 1533, 1536, 19 USPQ2d 1367, 1369 (Fed. Cir. 1991); Data Line Corp., 813 F.2d at 1201, 1 USPQ2d at 2055; York Products, 99 F.3d at 1574, 40 USPQ2d at 1623.

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B.

Where the provisions of § 112, ¶ 6, come into play, the applicant's claim is limited to the structure, materials and acts disclosed in the specification and their equivalents. Valmont Indus. Inc. v. Reinke Mfg. Co. Inc., 983 F.2d 1039, 1043, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993). "[A]n equivalent results from an insubstantial change which adds nothing of significance to the structure, material, or acts disclosed in the patent specification." Valmont, 983 F.2d at 1043, 25 USPQ2d at 1454. See also, Alpex Computer Corp. v. Nintendo Co., 102 F.3d 1214, 1222, 40 USPQ2d 1667, 1673-74 (Fed. Cir. 1996).

III.

A.

Looking to the "pivot means" clause of claim 33, it is apparent that there is no pivot structure recited in the clause (or anywhere else in the claim). The remainder of the clause after the phrase "pivot means" describes the pivot means by what it does or what is to be accomplished, not by what it is. Thus, the pivot means (1) pivotably attaches the inner wall of a bellows compartment to a strap; (2) enables the bellows compartment to pivot with respect to the strap about an axis

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normal to both the front surface of the strap and the inner wall of the bellows compartment; and (3) enables the bellows compartment to pivot to a horizontal position independent of the strap orientation. None of these inform the reader of the claim of any definite structure for the "pivot means." The provisions of the sixth paragraph therefore apply. Serrano, 111 F.3d at 1582, 42 USPQ2d at 1541; Fonar, 107 F.3d at 1551, 41 USPQ2d at 1807; Cole, 102 F.3d at 530-31, 41 USPQ2d at 1006. Appellants' "pivot means" is thus limited to the structure disclosed in the specification and equivalents. Valmont, 983 F.2d at 1042, 25 USPQ2d at 1454.

B.

Looking to the specification, applicants do not provide any textual description of the structure of the pivot means. Applicants refer to a pivot (designated by drawing reference numeral 25) on pages 5, and 7 - 8, but do not, in text, describe its structure. The structure of pivot 25 is, however, shown in Figure 4B as having two heads and a connecting shaft. I will refer to this structure as a "rivet-type pivot." Figure 4B also shows a washer, 26, placed between the strap and the bellows compartment. The washer is said to reduce friction

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(specification, page 8, first full paragraph, second sentence).
In my view the structure of the pivot means is the rivet-type
pivot combined with the washer. Thus, claim 33 is limited to
this structure and its equivalents.

I recognize that appellants' specification indicates that
"other pivoting means for container 10 may be used"
(specification, paragraph bridging pages 11 and 12, fourth
sentence). However, such statements do not remove the claim from
the provisions of the sixth paragraph of § 112. See Fonar, 107
F.3d at 1551, 41 USPQ2d at 1807 ("The '966 specification
discloses use of a generic gradient waveform. Although it states
that other waveforms may be used, it fails to specifically
identify those waveforms. Thus, under section 112, Para.6, claim
12 is limited to use of a generic gradient waveform and its
equivalents.") In any event, the language of § 112, ¶6, is
unequivocal in mandating that a means-plus-function limitation
"shall be construed to cover the corresponding structure,
materials or acts described in the specification and equivalents
thereof." Our reviewing court has instructed that means claims
are limited to the structures disclosed by the specification and

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equivalents. Donaldson, 16 F.3d at 1197, 29 USPQ2d at 1850;
Valmont, 983 F.2d at 1042, 25 USPQ2d at 1454.¹⁰

With appellants' claim 33 properly construed, the combined teachings of the references do not suggest a pivot means which has the structure or a structure equivalent to that disclosed in appellants' specification. The only reference relevant to the pivot means is the Warren patent. The Warren patent teaches a belt having a purse attached by means of conventional "snap fasteners" 32 and 33. Figures 3 and 4 and page 1, lines 101 to 108. I agree with Administrative Patent Judge Nase that the snap fastener disclosed by Warren is properly characterized as a pivot means. However, a conventional snap fastener is not the same structure or, in my view, a structure which is insubstantially different from the rivet-type pivot structure disclosed in appellants' specification. For example, the structure of

¹⁰ While not apparent from the court's opinions, the patents involved in both Donaldson and Valmont included language which indicated that other unidentified structure could be used. Thus, the Schuler patent involved in the reexamination before the court in Donaldson indicated that the disclosure was "but illustrative" of the invention. U.S. Patent No. 4,395,269, col. 8, lines 29 to 33. The Seckler et al. patent involved in Valmont indicated that the specific control means described in the specification was merely a "preferred embodiment." U.S. Patent No. 3,802,627, col. 5, line 64 to col. 6, line 5.

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conventional snap fasteners allows the two parts to be separated and reattached. On the other hand, appellants' structure shown in Figure 4B appears to be a permanent attachment without any shown structure which would allow separation and reattachment. Thus, the references in my view do not suggest the specific "pivot means" disclosed in the specification or a structure equivalent to that structure.

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FRANKFORT, Administrative Patent Judge, concurring-in-part.

I join in Judge Nase's opinion reversing the rejections of claims 21 through 32 and 34 through 36 under 35 U.S.C. § 103.

With particular regard to claim 33 on appeal, I vote to reverse the examiner's rejection under 35 U.S.C. § 103 based on Warren in view of Connell, Worrall and Touzani because I share appellants' view (brief, pages 17 and 31-32, and reply brief, pages 4-5) that none of the references applied by the examiner, whether considered individually or collectively, shows, teaches or suggests a container and strap combination which is responsive to that set forth in claim 33, considered as a whole. More specifically, none of the applied references teaches or suggests a container having a "pivot means" of the particular character required in this claim. The container defined in claim 33 on appeal is seen in Figures 4A-4C of the application drawings and includes a strap (12) which can be extended around the torso of a person and a bellows compartment (10, 11) attached to the strap by way of

"pivot means pivotably attaching said inner wall of said bellows compartment to said strap, said pivot means enabling said bellows compartment to pivot with respect to said strap

about an axis generally normal to said front surface of said strap and said inner wall of said bellows, said pivot means enabling said bellows compartment to be pivoted to a horizontal position independent of any orientation of said strap on said torso of said person."

The pivot means is identified in the specification (page 8) as a pivot (25), and is best seen in Figure 4B. The specification indicates that the container/bellows compartment (10, 11) may be rotated about the axis of the pivot. Figure 4C depicts an arrangement wherein the belt (12) is diagonally worn over a shoulder and hip of a person (28), with the compartments being rotated about the pivots (25) such that the containers are maintained in a horizontal position to thereby prevent their contents from accidentally spilling out, and to provide easy access to their contents.

Turning to the prior art applied by the examiner, even if one of ordinary skill in the art would have found it obvious to modify the garter and purse arrangement of Warren in the manner urged by the examiner based on teachings found in Connell, Worrall and Touzani, the container resulting from such

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modifications would not have been the container defined in appellants' claim 33. While I agree with my colleagues that the snap fastener members (32, 33) seen in Warren may broadly be considered to be a "pivot means," such pivot means in the context of the Warren patent does not, and can not, perform the function specified in appellants' claim 33.

As is made clear in Warren (page 1, lines 97-108) the purse (30) includes loops (31), affixed to the back of the purse, through which the leg band (10) passes to support the purse on the leg band. The fastener members (32, 33) in Warren are provided merely to hold the purse against sidewise movement on the leg band. Thus, while the snap fastener members (32, 33) may allow some minor degree of pivotal movement of the purse relative to the leg band (10), and therefore may be broadly considered to be a "pivot means," these fastener members are constrained by the loops (31) from enabling the purse (30) of Warren "to be pivoted to a horizontal position independent of any orientation of said strap on said torso of said person" as specifically required in appellants' claim 33 on appeal. For this reason, I would reverse the examiner's rejection of claim 33 under 35 U.S.C. § 103.

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As is apparent from our patent jurisprudence (e.g., Valmont Industries Inc. v. Reinke Manufacturing Co. Inc., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993)) and from the Manual of Patent Examining Procedure (e.g., § 2182), the application of a prior art reference to a "means plus function" limitation requires (1) that the prior art element or structure perform the identical function specified in the claim and (2) perform that function using structure which is the same as or equivalent to the structure disclosed in the specification. If the prior art fails to teach or suggest identity of function to that specified in the claim and the element or structure of the prior art as disclosed is not capable of performing such function, then the inquiry is over and the prior art reference does not meet the "means plus function" limitation specified in the claim. Since the snap fasteners (32, 33) of the Warren patent clearly do not and can not perform the function specified in appellants' claim 33, it is clear that the examiner's rejection of claim 33 can not be sustained.

Given my determination that the snap fasteners (32, 33) of Warren do not and can not perform the identical function specified in claim 33 on appeal, I see no need to reach the issue

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of equivalence under 35 U.S.C. § 112, sixth paragraph. However, regarding the positions expressed by my colleagues, I share Judge Nase's view, expressed infra, that it is unwarranted and unwise at this juncture in the prosecution of the present application to sua sponte raise for the first time the issue of whether the pivot means of Warren is equivalent to the structure of the pivot means disclosed in appellants' specification, given that neither the examiner nor appellants have raised such an issue in the appeal. At the very least, it would seem that fundamental fairness would dictate that the application be remanded to the examiner to consider the issue of equivalence, with the appellants then having an opportunity to contest the examiner's determination and a right to again appeal from any such rejection of claim 33.

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) BOARD OF PATENT
) APPEALS
CHARLES E. FRANKFORT) AND

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Administrative Patent Judge) INTERFERENCES

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NASE, Administrative Patent Judge, dissenting-in-part.

I join in the reversal of the rejection of claims 21 through 32 and 34 through 36 under 35 U.S.C. § 103. I respectfully dissent from my colleagues' reversal of the rejection of claim 33 under 35 U.S.C. § 103.

Upon evaluation of all the evidence, it is my conclusion that the evidence adduced by the examiner is sufficient to establish a case of obviousness with respect to claim 33. Accordingly, I would sustain the examiner's rejection of claim 33 under 35 U.S.C. § 103 as being unpatentable over Warren in view of Connell, Worrall and Touzani. After considering the collective teachings of Warren and Worrall, I agree with the examiner that the claimed invention would have been obvious to one of ordinary skill in the art at the time of appellants' invention.¹¹

Warren teaches the use a garter and purse which can be carried on a leg of a person. Warren's garter includes a leg

¹¹ I consider Connell and Touzani to be superfluous in the rejection of claim 33 since Warren and Worrall, taken together, would have suggested the claimed invention.

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band 10 having a front surface and a back surface. Warren's purse 30 has a compartment having an outer wall, an inner wall, a pair of opposite walls connecting the outer and inner walls, a bottom connecting the outer and inner walls and a top opening extending between the outer and inner walls. Warren provides fastening members 32 and 33 (preferably of the snap fastener type) on the inner wall of the purse and the front surface of the leg band. The fastening members are provided by Warren to hold the purse against sideways movement on the leg band. Lastly, Warren provides the purse with loops 31 through which the leg band passes to support the purse.¹²

Worrall discloses a purse having a bellows compartment having an outer wall, an inner wall, a pair of opposite walls connecting the outer and inner walls, a bottom connecting the outer and inner walls and a top opening extending between the outer and inner walls. Worrall's pair of opposite sides comprises a plurality of expandable pleats so that the bellows compartment can be compressed to a collapsed state where the outer wall is relatively close to the inner wall or extended to

¹² See page 1, lines 97-108, of Warren.

an expanded state where the outer wall is relatively far from the inner wall.¹³

Contrary to my colleague's positions, I believe that the only difference between Warren and the subject matter recited in claim 33 is the recitation that the compartment is a bellows compartment wherein the pair of opposite sides has a plurality of expandable pleats so that the compartment can be compressed to a collapsed state where the outer wall is relatively close to the inner wall or extended to an expanded state where the outer wall is relatively far from the inner wall. It is my opinion that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to modify Warren's purse to include pleated sides as suggested by Worrall's purse.

With respect to claim 33 appellants argue that none of the references show or remotely suggest the pivot means which enables the container to be pivoted to a usable horizontal position no matter what the angle of the supporting belt on the user's body (brief, pp. 15 and 17). Specifically, appellants point out that

¹³ See Figures 1 and 2 of Worrall.

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Warren's purse 30 is held to the garter belt by loops 31 which prevent the purse from pivoting.

While Administrative Patent Judge Frankfort finds this argument to be persuasive, I find this argument to be unpersuasive for the following reasons. First, the fastening members 32 and 33 of Warren do permit the purse to pivot with respect to the garter about an axis generally normal to the front surface of the garter and the inner wall of the purse. Thus, the function recited by the pivot means of claim 33 reads on Warren's garter and purse since Warren's purse 30 is fully capable of pivoting about the fastening members 32 and 33 to a horizontal position independent of any orientation of the garter. Second, claim 33 is drafted utilizing the transitional phrase "comprising." Therefore, claim 33 is open-ended and does not exclude additional, unrecited elements. Thus, the pivot means as recited in claim 33 does not define over Warren's purse which has additional structure (i.e., loops 31) which prevent Warren's purse 30 from fully pivoting about the fastening members 32 and 33 when the garter is passed through the loops 31.

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Appellants' arguments concerning the combination of four references in the rejection (brief, p. 8) and the use of Touzani (brief, pp. 8-13) are not persuasive with respect to claim 33 since only the references to Warren and Worrall are necessary to render claim 33 unpatentable under 35 U.S.C. § 103. The examiner has apparently relied upon Connell to show or teach a flap closing the top opening of a compartment and Touzani for bistable pleats, features not present in claim 33.

In regard to Vice Chief Administrative Patent Judge Schafer's opinion with respect to claim 33 and the position that this panel of the Board of Patent Appeals and Interferences (Board) should sua sponte raise the issue on appeal of whether the structure of the pivot means of Warren is equivalent to the structure of the pivot means disclosed in appellants' specification, I consider such action to be unwarranted and unwise at this juncture in the prosecution of the present application. In the first place 37 CFR § 1.192 would appear to dictate against our raising and considering such an issue since it was not raised by the appellants as a point of contention in this appeal. Specifically, 37 CFR § 1.192(a) states that

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Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

Additionally, 37 CFR § 1.192(c)(8) provides that the brief shall contain

The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on.

. . .
(iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

Thus, notwithstanding the mandates of the sixth paragraph of 35 U.S.C. § 112, under our rules of practice, it was incumbent upon the appellants to provide an argument in the brief if they believed that the examiner did not appropriately construe claim 33 under the sixth paragraph of 35 U.S.C. § 112 in applying the prior art under 35 U.S.C. § 103. Since the appellants did not raise the issue of equivalence in their brief, I believe it is

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inappropriate, in this case, for us to first raise, and then also review this issue.

Additionally, I believe that it is the examiner skilled in the art, not this Board, who should initially evaluate and determine (1) what structure is described in the specification that corresponds to the claimed means, (2) what structure is described in the reference that performs the function of the claimed means, and (3) if the structure described in the reference that performs the function of the claimed means is the same or equivalent to the structure described in the specification that corresponds to the claimed means. With respect to such considerations, the Manual of Patent Examining Procedure (MPEP), 6th Edition, Revision 2, July 1996, provides in section 2183 that

If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed limitation is anticipated by the prior art element.¹⁴

¹⁴ Guidelines on "Means Or Step Plus Function Limitation Under 35 U.S.C. § 112, 6th Paragraph" (published at 1162 Off. Gaz. Pat. Off. 59 (May 17, 1994)) were distributed to all patent examiners about April 1994 to provide guidance following the decision on this matter in In re Donaldson Co. Inc., 16 F.3d

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In this case, it appears that the examiner has not specifically stated on the record that the structure described in Warren that performs the function of the "pivot means" was the equivalent of the structure disclosed by the appellants that corresponds to the "pivot means." However, the examiner did state that Warren's pouch includes pivot means pivotally attaching the inner side of the pouch to the strap to enable the compartment to pivot with respect to the strap about an axis generally normal to the strap front surface. The examiner then referred the appellants to Figures 3 and 4 and the single rear snap of Warren.¹⁵ Thus, in accordance with the above-noted guidance in the MPEP, I presume that the examiner inferred that the structure described in Warren that performs the function of the "pivot means" was the equivalent to the structure disclosed in appellants' specification that corresponds to the "pivot means" since the structure described in Warren that performs the function of the "pivot means" is not excluded by any explicit

1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc). This guidance has been incorporated into the MPEP at sections 2181 through 2186.

¹⁵ See page 4 of the first office action (Paper No. 2, mailed August 26, 1994) and page 3 of the final rejection (Paper No. 8, mailed February 21, 1995).

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definition provided in the appellants' specification for an equivalent.

The MPEP further provides in section 2184 that

If the applicant disagrees with the inference of equivalence drawn from a prior art reference, the applicant may provide reasons why the applicant believes the prior art element should not be considered an equivalent to the specific structure, material or acts disclosed in the specification.

The appellants have never provided any reasons why they believe the prior art element should not be considered an equivalent to the specific structure, material or acts disclosed in the specification.¹⁶ Thus, in my view, the appellants have apparently acquiesced to the examiner's inference of equivalence drawn from Warren by their continuing failure to argue this matter.

I believe that permitting the examiner who is knowledgeable in the art to make the initial determination of equivalency and permitting an applicant the opportunity to challenge such a determination and then appeal from the examiner's rejection of

¹⁶ See page 9 of the appellants' response (Paper No. 5, filed November 30, 1994) to the first office action and page 17 of the appellants' brief.

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any claim containing such a means clause provides proper due process and provides the overall fairness that our patent system must maintain. Thus, for this panel of the Board to sua sponte raise and decide the issue of whether the structure of the pivot means of Warren is equivalent to the structure of the pivot means disclosed in appellants' specification, in my opinion, is fundamentally unfair to both the appellants and the examiner since their respective positions on this issue are not before us.

For the reasons stated above, I would sustain the examiner's rejection of claim 33 based on 35 U.S.C. § 103 as being unpatentable over Warren in view of Worrall, Connell and Touzani.

JEFFREY V. NASE
Administrative Patent Judge

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APPENDIX

26. A container which can be carried on a person, comprising:

a bellows compartment having an outer wall, an inner wall, a pair of opposite sides connecting said outer and inner walls, a bottom connecting said outer and inner walls, and an open top extending between said outer and inner walls, said opposite sides and said bottom comprising a plurality of pleats for allowing said bellows compartment to be expanded and collapsed,

a belt attached to said inner wall of said bellows compartment, and

a cover comprising an elongated flexible flap having a proximal end and a distal end, said proximal end of said flap being hingeably attached to said inner wall of said bellows compartment, said flap extending from said inner wall, under said bottom of said bellows compartment, up adjacent said outer wall of said bellows compartment, and over said top opening of said bellows compartment, to said inner wall of said bellows compartment, such that when said distal end of said flap is pivoted outwardly to an opened position extending away from said inner and said outer walls of said bellows compartment, the weight of said flap will cause said flap to remain in said opened position,

said distal end of said flap containing fastening means for removably fastening said distal end of said flap to said inner wall of said bellows compartment,

whereby said container can be opened with one hand and will remain open so that said person can access a large number of cards on the inside of said container with both hands after opening said flap.

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33. A container which can be carried on a torso of a person, comprising:

a strap which can be extended around said torso of said person, said strap having a front surface and a back surface, and

a bellows compartment having an outer wall, an inner wall, a pair of opposite walls connecting said outer and inner walls, a bottom connecting said outer and inner walls, and a top opening extending between said outer and inner walls, said pair of opposite sides comprising a plurality of expandable pleats so that said bellows compartment can be compressed to a collapsed state where said outer wall is relatively close to said inner wall or extended to an expanded state where said outer wall is relatively far from said inner wall, and

pivot means pivotably attaching said inner wall of said bellows compartment to said strap, said pivot means enabling said bellows compartment to pivot with respect to said strap about an axis generally normal to said front surface of said strap and said inner wall of said bellows, said pivot means enabling said bellows compartment to be pivoted to a horizontal position independent of any orientation of said strap on said torso of said person.

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APJ NASE

APJ FRANKFORT

VCAPJ SCHAFFER

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 02 May 97

1st Rev. 08 May 97

2nd Rev. 30 Jun 97

3rd Rev. 28 Jul 97

4th Rev. 30 Sep 97

FINAL TYPED: