

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(2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TALMADGE W. LIVEOAK

Appeal No. 97-0331
Application 08/359,562¹

ON BRIEF

Before MEISTER, ABRAMS and NASE, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

DECISION ON APPEAL

Talmadge W. Liveoak (the appellant) appeals from the final rejection of claims 1-14. Claim 15, the only other claim present in the application, stands allowed.

¹Application for patent filed December 20, 1994. According to appellant, this application is a Continuation-In-Part of design application 29/012,296 filed August 30, 1993, now U.S. Patent No. D353,573, issued December 20, 1994.

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We REVERSE and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), enter a new rejection of claims 1, 8 and 9.

The appellant's invention pertains to a hand-held paddle that is particularly adapted for use with a small, shallow draft recreational boat, such as a kayak. Independent claim 1 is further illustrative of the appealed subject matter and reads as follows:

1. A hand paddle comprising:

a paddle blade of a length shorter than its width and having an upper side and a lower side,

an extended-in-length brace having corresponding upper and lower sides as said paddle, with a generally flattened end opposed from said paddle blade for bearing against a forearm of a user at a point near an elbow thereof,

a first opening in said brace for receiving a hand of a user, so that in use said upper side of said paddle blade bears against a hand of the user, and a lower side of said brace bears against said forearm.

The references relied on by the examiner are:

Malm	2,109,429	Feb. 22, 1938
Whipple	2,745,119	May 15, 1956
Girden	3,529,313	Sep. 22, 1970

Claims 1, 2, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Malm.

Claims 3 and 10 stand rejected under 35 U.S.C. § 103 as

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being unpatentable over Malm in view of Whipple.

Claims 4-7 and 11-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Malm in view of Girden.

Each of the above-noted rejections is based on the examiner's view that

the part of the paddle of MALM designated as the brace - that part extending from opening 5 to the left end in figure 2 - has upper and lower sides and a generally flattened end. The generally flattened end is formed by the flat undersurface of the left end of the paddle. The paddle of MALM also has the opening 5 for receiving the hand of the user. Appellant may argue that the examiner is only speculating that the undersurface of the paddle shown in figure 1 of MALM just above the forearm will bear against the forearm if the swimmer's hand is pivoted upwardly by the force of the water, but such an argument ignores the dynamics of the water being pushed by the paddle and the dynamics of the pivoting of a swimmer's hand upwardly due to this force, or pivoted upwardly for any reason.

Observation of figure 1 of MALM and the position of both the hand and paddle makes it clear that pivoting of the swimmer's hand upwardly will bear the end of the paddle located above the forearm in figure 1 onto the forearm. [Answer, pages 7 and 8.]

As to the limitation in independent claims 1 and 8 that an end of the paddle bears "against a forearm of the user near an elbow thereof," the answer further states that

"near" is a term of relativity. Some of the definitions of "near" given in *The Random House Dictionary* are: at or to a place a **relatively** short distance away from a specified person or thing; being close by; and being **relatively** closer. This is why the

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examiner feels that the end of the paddle of MALM shown in figure 1 and above the forearm of the swimmer is at a point near the elbow. [Page 9.]

While we agree with the examiner that the paddle of Malm (when used in the manner depicted in Fig. 1) has the capability of being pivoted such that the end thereof will bear against the forearm of the user, it is readily apparent that the end of the paddle will bear against the user's forearm at a point a short distance above the wrist. While we appreciate the various dictionary definitions cited by the examiner, we must point out that the indiscriminate reliance on definitions found in dictionaries can often produce absurd results. **See In re Salem**, 553 F.2d 676, 682, 193 USPQ 513, 518 (CCPA 1977). Instead, terms in a claim should be interpreted in a manner consistent with the specification and construed as those skilled in the art would construe them (**see In re Bond**, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990), **Specialty Composites v. Cabot Corp.**, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and **In re Sneed**, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)). Here, viewing Fig. 1 of the appellant's drawing, it is readily apparent that the end of the paddle bears against the forearm of the user a very short distance from the elbow and the specification on page 8 states that the fact that the end of the

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paddle bears against the forearm of the user near the elbow provides (1) support for the wrist of the user and (2) leverage between the elbow and hand. Consistent with the appellant's specification, we do not believe that the artisan would consider the end of the paddle, in the arrangement depicted by Malm in Fig. 1 (wherein the end of the paddle would bear against the forearm of a user only a very short distance above the wrist when the wrist is flexed in the manner described by the examiner), to bear against the forearm "near" the elbow as claimed. This being the case, we will not sustain the rejection of claims 1, 2, 8 and 9 under 35 U.S.C. § 102(b) based on the reference to Malm for the reasons stated by the examiner.

As to the rejections under 35 U.S.C. § 103 of (1) claims 3 and 10 based on the combined teachings of Malm and Whipple and (2) claims 4-7 and 11-14 based on the combined teachings of Malm and Girden, we have carefully reviewed the references to Whipple and Girden but find nothing therein which would overcome the deficiencies that we have noted above with respect to Malm. Accordingly, we will not sustain the rejections of claims 3-7 and 10-14 under 35 U.S.C. § 103.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejection.

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Claims 1, 8 and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Malm. Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See *Verdegaal Bros., Inc. v. Union Oil Co.***, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently **see *Hazani v. Int'l Trade Comm'n***, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997)) and ***RCA Corp. v. Applied Digital Data Systems, Inc.***, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (**see *Kalman v. Kimberly-Clark Corp.***, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984)).

Viewing Fig. 2 of Malm, it is readily apparent that the hand of a user may be inserted through opening 5 in such a manner that

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the hand overlies the left-hand portion of the paddle and the right-hand portion of the paddle overlies the forearm. When used in such a manner, it is also readily apparent that the right-hand end of the paddle would bear against the user's forearm near the elbow when the user's wrist is flexed upwardly. While of course there is no teaching in Malm of using the paddle in this manner, it is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists regardless of whether there was a recognition that it could be used to perform the claimed function. **See, e.g., In re Schreiber**, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). **See also LaBounty Mfg. v. Int'l Trade Comm'n**, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992) (in quoting with approval from **Dwight & Lloyd Sintering Co. v. Greenawalt**, 27 F.2d 823, 828 (2d Cir. 1928)):

The use for which the [anticipatory] apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent; the statute authorizes the patenting of machines, not of their uses. So far as we can see, the disclosed apparatus could be used for "sintering" without any change whatever, except to reverse the fans, a matter of operation.

Here, the question of whether Malm's paddle actually is or might be used in the above-noted manner, merely depends upon the

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performance or non-performance of a future act of use, rather than upon a structural distinction in the claims. Stated differently, the paddle of Malm would not undergo a metamorphosis to a new paddle simply because it was used in the manner which we have noted above. **See In re Pearson**, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) and **Ex parte Masham**, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

We observe that on page 7 of the brief the appellant argues that the opening 5 of Malm is sized only to accommodate a portion of the hand of a user. We must point out, however, not only does Malm in Fig. 1 depict the hand of the user being accommodated in the opening 5, but it is expressly stated in Malm that "the opening [5] is to receive the hand of the user." Moreover, even if the opening 5 of Malm only accommodated a portion of the hand of the man depicted in Fig. 1, the hand of a smaller person, such as a woman or child, would obviously be accommodated by this opening.

In summary:

The examiner's rejections of claims 1-14 are all reversed.

A new rejection of claims 1, 8 and 9 under 35 U.S.C.

§ 102(b) has been made.

This decision contains a new ground of rejection pursuant to

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37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED
37 CFR § 1.196(b)

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