

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD G. GILLIS and DANIEL JOHNSON

Appeal No. 97-1143
Application 08/115,881¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge and COHEN and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 through 11. These claims constitute all of the claims pending in this application.

We REVERSE and REMAND.

¹ Application for patent filed September 01, 1993.

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BACKGROUND

The appellants' invention relates to a mobile ladder stand of the type used in warehouses and stores to reach high shelves. Appellants' specification teaches that when it is desired to turn the stand of their invention around a tight corner, the stand may be pivoted about a set of wheels located below the center of the base of the stand using only about one-half the turning radius normally required of a prior art stand (pages 2 through 4). An understanding of the invention can be derived from a reading of exemplary claims 1, 10 and 11 which appear in the "Appendix" to the appellants' main brief (Paper No. 13).

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

Covert	321,342	Jun. 30, 1885
Shadel et al. (Shadel)	1,355,173	Oct. 12, 1920
Borgman	3,155,190	Nov. 03, 1964
Berry	3,685,851	Aug. 22, 1972
Rice	1 021 831	Nov. 29,
1977		
(Canadian Patent)		

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The following rejections are before us for review:²

(1) Claims 1, 2 and 4 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rice in view of Covert and Borgman;

(2) Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Rice in view of Covert, as applied to claim 1 above, and further in view of Berry;

(3) Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Rice, Covert and Borgman, as applied to claim 1 above, and further in view of Berry;

(4) Claims 7 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rice, Covert and Borgman, as applied to claim 6 above, and further in view of Shadel; and

(5) Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Rice, Covert, Borgman and Shadel, as applied to claim 7 above, and further in view of Berry.³

² For purposes of our review, we have listed the rejections in a different order from that found in the final rejection.

³ We note that at page 3 of the Office action mailed December 7, 1995, the examiner inadvertently referred to claim 10 as "claim 19." The examiner's answer correctly refers to claim 10. Also, the Office action included a rejection of claim 11. The rejection of claim 11 is not repeated in the

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Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Office action mailed December 7, 1995 (Paper No. 11) and to the answer (Paper No. 14) for the complete reasoning in support of the rejections, and to

the main brief (Paper No. 13) and reply brief (Paper No. 15) for the arguments thereagainst.

OPINION

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

Rejection (1)

examiner's answer. However, the examiner's answer indicates (page 2) that claims 1 through 11 stand rejected. Therefore, we have included the rejection of claim 11, as stated in the Office action mailed December 7, 1995, in the list of rejections before us for review.

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Claim 1 calls for a ladder stand comprising, inter alia, a base having a front and rear, a plurality of stair treads supported on and extending upward from the base, a first wheel set mounted at the front of the base, and a second wheel set mounted approximately midway between the front and rear of the base.

According to the examiner:

Rice shows the claimed stand with the exception of the location of the second wheel set, and the swivel front set of wheels, and the rear wheels as set forth in claim 2. Covert at (b') shows a second wheel set located as claimed which enables a turning radius of approximately half the length of his base. Borgman shows a stand with a front set of swivel wheels to facilitate steering, and a rear support wheel set to facilitate transporting. It would have been

obvious to one of ordinary skill in the art to modify Rice for his front wheels to be rotatable as claimed to facilitate steering, to comprise wheels at his rear support to facilitate transporting, and to locate his second wheel set as claimed to decrease his turning radius. [answer, pages 2 and 3]

It is appellants' position that Covert not only fails to suggest or provide any motivation for modifying Rice to include a second wheel set mounted on the base approximately midway between the front and rear thereof as called for in

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claim 1, but that Covert actually teaches away from such a modification. Appellants call attention to the fact that Covert discloses

a horse drawn fire truck having a base portion comprising a rear carrying frame (A) and a front carrying frame (B). The front carrying frame (B) carries the ladder sections (C). Disposed adjacent to the rear of the base portion is a first set of wheels (a¹) and disposed adjacent to the front of the base portion is a second set of wheels (b¹). Located approximately midway between the front and rear of the base is a pivot bolt (a) and a retractable wheel (I). After the horse brigade arrive at the fire, to effectuate moving of the ladder, the wheel (I) is dropped and frame (A) is uncoupled from the frame (B) and run off. (Column 3, lines 88-94). (emphasis original)[main brief, page 9].

As appellants see it, Covert teaches a fire truck in which the frame is split into two sections in order to establish a turning radius of approximately half the fire truck length and, thus, would direct a person of ordinary skill to modify Rice by providing a separable base in order to shorten the turning radius

of Rice's stand. Appellants also argue that since the midpoint of Covert's frame is located approximately at pivot bolt (a), the examiner's finding that the wheels (b¹) in

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Covert are located approximately midway between the front and rear of the frame is erroneous.

We agree with appellants that the examiner's analysis of the combined teachings of the references is fatally flawed. 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, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). There is simply no suggestion or motivation in Covert to provide a wheel set mounted

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below the center of Rice's base. The wheels (b¹) in Covert on which the examiner relies are actually the front wheels of Covert's fire truck. We do not find any teaching in Covert that wheels (b¹) are mounted approximately midway of the frame (B), see Covert's Figures 2 and 4, or any advantage that may be obtained by doing so. In fact, we would expect that the positioning of wheels (b¹) and (I) on frame (B) would be controlled more by the requirement for stability of frame (B) when a fire fighter is on the raised and extended ladder sections C, C¹ than on the turning radius of the frame and, therefore, that the wheels (b¹) and (I) would be set as far apart as possible to maximize the stability of frame (B). Thus, unlike the examiner, we conclude that Covert would not have been suggestive of positioning a second wheel set approximately midway of a frame as called for in claim 1.

The examiner has relied on Borgman for the teaching of a front set of swivel wheels to facilitate steering and a rear set of wheels to facilitate transporting (answer, page 2). Thus, even if we were to agree with the examiner that it would have been obvious to incorporate these features of Borgman into the scaffold structure of Rice, the basic deficiency of

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the combined teachings of Rice and Covert that we have noted above would not be overcome.

Since all of the limitations of claim 1 would not have been suggested by the applied prior art, we will not sustain the rejection of independent claim 1 under 35 U.S.C. § 103 over Rice in view of Covert and Borgman.

Claims 2 and 4 through 6 are dependent on claim 1 and contain all of the limitations of that claim. Accordingly, the examiner's rejection of claims 2 and 4 through 6 under 35 U.S.C.

§ 103 will not be sustained.

Rejection (2)

Claim 10 recites a ladder stand comprising, inter alia, a base having front and rear ends, a plurality of stair treads supported on and extending upward from the base, a first wheel set mounted proximate the front of the base, and a retractable second wheel set having a larger diameter than the first wheel set and mounted approximately midway between the front and rear of the base.

Berry teaches that carpeted areas present a problem for

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cabinets or support type structures in that the wheels or casters on the structures tend to dig holes in carpets and, when it is desired to move the structures, the holes present steep inclines that the wheels or casters must climb out of before normal

rolling is achieved (col. 1, lines 8-15). In order to overcome the problem, Berry teaches a pair of large retractable wheels (38) which are lowered to raise one end of the structure above the floor when it is desired to move the structure from one location to another (col. 2, lines 7-26).

It is the examiner's position that it would have been obvious in view of the teachings of Covert to modify Rice by mounting a second wheel set approximately midway between the front and rear of Rice's base and, in view of the teaching of Berry, to provide the second wheel set with a larger diameter than the first wheel set. Since Berry does not overcome the deficiency of the combined teachings of Rice and Covert noted above, we will not sustain the rejection of independent claim

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under 35 U.S.C. § 103 over Rice in view of Covert and Berry.

Rejection (3)

Claim 3 is dependent on claim 2 and, therefore, includes all of the limitations of claims 1 and 2. The examiner applies Berry in the rejection of claim 3 for the reason set forth above with respect to claim 10. Since we have found that neither Borgman nor Berry overcome the deficiency of the combined teachings of Rice and Covert noted above, we will not sustain the rejection of claim 3 under 35 U.S.C. § 103 over Rice in view of Covert, Borgman and Berry.

Rejection (4)

Claims 7 through 9 are dependent, directly or indirectly, on claim 6 and, therefore, include all of the limitations of claims 1 and 6. The examiner applies Rice, Covert and Borgman against claims 7 through 9 for the reasons set forth above in Rejection (1). Shadel is cited to show the details of the wheel mechanism set forth in claims 7 through 9. Shadel shows a collapsible shipping crate or hand truck with a folding running gear (lines 10-23). The folding running gear includes a first pair of wheels 17 and a second pair of casters 18

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mounted for movement between a folded condition (shown in broken lines in Figure 2) and an extended condition in which the wheels and casters are in contact with the floor.

As with Borgman and Berry, Shadel does not overcome the deficiency of the combined teachings of Rice and Covert noted above. Therefore, we will not sustain the rejection of claims 7 through 9 under 35 U.S.C. § 103 over Rice in view of Covert, Borgman and Shadel.

Rejection (5)

Independent claim 11 recites a ladder stand comprising, inter alia, a base having a front and rear and at least two side

beams, a plurality of stair treads supported on and extending upward from the base, a rotatable beam for connecting the side beams at the front of the base, a first wheel set mounted to the rotatable beam, an inner pipe secured to the side beams approximately midway between the front and rear of the base, an outer pipe rotatably mounted over the inner pipe, and a second wheel set mounted on the outer pipe.

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For the reason set forth above, we find that Rice, Covert, Borgman, Shadel and Berry, taken alone or in combination, fail to teach or suggest the inner pipe secured to the side beams approximately midway between the front and rear of the base, the outer pipe rotatably mounted over the inner pipe, and a second wheel set mounted on the outer pipe as called for in claim 11.

Since all of the limitations of claim 11 would not have been suggested by the applied prior art, we will not sustain the rejection of claim 11 under 35 U.S.C. § 103 over Rice in view of Covert, Borgman, Shadel and Berry.

Since we have determined that the prior art relied on by the examiner does not establish a prima facie case of obviousness, it is unnecessary for this panel to consider appellants' arguments (main brief, pages 11-14) regarding the objective evidence of nonobviousness.

REMAND TO THE EXAMINER

1. Written description requirement

The appellants' specification (page 2) states that

The base incorporates a pair of front legs and three

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(3) wheel sets, including a front wheel set located generally below the bottom step, a center set located below the center of the base, and a rear set located generally below the vertical rear legs.
(emphasis added)

The wheels (27) are referred to throughout appellants' specification as the "center wheels" and beam (25) on which the center wheels are mount is referred to as the "center beam" (page 6). Original claim 1 called for "a second wheel set mounted on said base between the front and rear thereof." Original claim 6 called for the second wheel set to be mounted on a "center beam mechanism."

On November 30, 1994, appellants filed an amendment (Paper No. 6) to claim 1 changing "a second wheel set mounted on said base between the front and rear thereof" to read --a second wheel set mounted on said base approximately midway between the front and rear thereof--. Claims 10 and 11 were also added including similar language. The accompanying "Remarks" stated that no new matter had been entered by the amendment and that the amendment was supported by the original specification and claims. However,

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the specific pages and lines relied on for support were not identified. An amendment to the claims or the addition of a new claim must be supported by the description of the invention in the application as filed. In re Wright, 866 F.2d 422, 424, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989).

We remand this application to the examiner to determine whether the recitation of "approximately midway" has appropriate descriptive support in the original disclosure.

2. Definiteness

Independent claims 1, 10 and 11 require the second wheel set or the center beam to be "approximately midway" between the front and rear of the ladder stand base. The word "approximately" is a word of degree. When a word of degree such as "approximately" is used in a claim, it must be determined whether the underlying specification provides some standard or guideline for measuring that degree. In other words, it must be determined whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. Seattle Box Co. v. Industrial Crating & Packing Inc., 731 F.2d 818, 826, 221 USPQ

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568, 574 (Fed. Cir. 1984). Accordingly, we remand this application to the examiner to consider whether appellants' specification provides any standard or guidance for determining

how close the second or center wheel set or center beam must be to the center of the base in order to be considered as "approximately midway."

3. Prior art

In the examiner's response (Paper No. 17) to appellants' reply brief, the examiner cited, inter alia, a published U.K. patent application of Kilenstam (copy attached). Kilenstam discloses a trolley for transporting building material, e.g., plaster board, including a pair of retractable wheels (15,16) located approximately at the center of the trolley which can be lowered in order to traverse door sills or other obstructions along the floor (page 1, lines 13-25). Accordingly, we remand this application to the examiner to consider the combined teachings of the prior art of record, e.g., Borgman and Kilenstam. If the examiner concludes that a prima facie case of obviousness is established by the combined teachings of the prior

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art, the examiner must also consider the objective evidence of nonobviousness.⁴

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 11 under 35 U.S.C. § 103 is reversed.

Additionally, we have remanded the application to the examiner for consideration of issues relating to appellants' compliance with the requirements 35 U.S.C. § 112, first and second paragraphs, and prior art of record.

REVERSED AND REMANDED

HARRISON E. McCANDLISH)

⁴ The examiner bears the initial burden of presenting a prima facie case of obviousness (see In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)). Once a prima facie case is established, any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant must be considered. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). All the evidence on the question of obviousness must be considered. In re Piasecki, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984).

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