

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANDY LAATS and KIRK JAMES

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Appeal No. 2003-1363  
Application No. 09/608,985

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ON BRIEF

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Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3 through 10, 12, and 16 through 19. These claims constitute all of the claims remaining in the application.

Appellants' disclosed invention pertains to a fastening and retention system for a strap, to a fastening and retention system, and to a system. A basic understanding of the invention can be derived from a reading of exemplary claims 1, 18, and 19,

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respective copies of which appear in the APPENDIX to the brief  
(Paper No. 11).

As evidence of anticipation and obviousness, the examiner  
has applied the documents listed below:

Miller	1,100,389	Jun. 16, 1914
Wollman	4,664,533	May 12, 1987

The following rejections are before us for review.

Claims 1, 3 through 10, 12, and 16 through 19 stand rejected  
under 35 U.S.C. § 112, first paragraph (enablement).

Claims 6 through 10, 16, 17, and 19 stand rejected under  
35 U.S.C. § 112, first paragraph (description).

Claims 1, 3 through 10, 12, and 16 through 19 stand rejected  
under 35 U.S.C. § 112, second paragraph (indefiniteness).

Claims 1, 3, 5 through 10, and 19 stand rejected under  
35 U.S.C. § 102(b) as being anticipated by Miller.

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Claims 4, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller.

Claims 12 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Wollman.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 16), while the complete statement of appellants' argument can be found in the brief (Paper No. 11).

#### OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the Board has carefully considered appellants' specification, drawings,<sup>1</sup> and claims,<sup>2</sup> the applied

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<sup>1</sup> The matter of the disapproval by the examiner of the "clarification drawings and substitute specification" (brief, pages 3 through 5) is an issue reviewed by petition not appeal. We would only add that 37 CFR § 1.83(a) should be complied with relative to the claimed subject matter.

<sup>2</sup> In claim 19, line 5, "loops" should be --loop-- for consistency with its antecedent basis. This matter should be addressed during any further prosecution before the examiner.

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teachings,<sup>3</sup> and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

#### Enablement

We do not sustain the rejection of claims 1, 3 through 10, 12, and 16 through 19 under 35 U.S.C. § 112, first paragraph, as being based upon a disclosure lacking enablement.

The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure, coupled with information known in the art, and without undue experimentation. See United States v. Teletronics, Inc.,

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<sup>3</sup> In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); and In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In the present case, it is quite apparent to us, from a reading of appellants' specification, that one skilled in the art would be able to practice, i.e., make and use, the now claimed invention on the basis thereof. More specifically, we readily discern that the written description of the invention instructs as to the necessary elements of the claimed fastening and retention system for a strap, and their interaction with one another. Of particular importance is appellants' specific examples of mating structures of a strap and retention loop such as a protruding member and a slot or recessed area, or hook and loop fasteners, for securing the retention loop and preventing it from sliding off the strap. For the above reasons, we determine that the now claimed subject matter is enabled by the underlying specification. Thus, the enablement rejection under 35 U.S.C. § 112, first paragraph, cannot be sustained.

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Description

We sustain the rejection of claims 6 through 10, 16, and 17 under 35 U.S.C. § 112, first paragraph, as lacking descriptive support in the original disclosure, but we do not sustain the rejection of claim 19 on this same ground.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. Further, the content of the drawings may also be considered in determining compliance with the written description requirement. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and See In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Like the examiner (answer, page 5), it is quite clear to this panel of the Board that the underlying original disclosure does not descriptively support the language "at least" added to

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claims 6 and 16 subsequent to the filing of the application. With the inclusion of the language "at least", the clear inference is that the device of claim 6 can be more than just one of the specified entities, and the strap of claim 16 can be comprised of more than just one of the specified materials. However, this is not what one skilled in the art would have understood from a reading of the original specification (page 3) wherein it is clear that the strap is of one selected material and the device is one selected entity. Thus, the addition of "at least" adds new matter to the application, and the description rejection of claims 6 through 10, 16 and 17 under U.S.C. § 112, first paragraph, is sound and sustained.

The argument of appellants (brief, pages 6 and 7) fails to persuade us that the new matter rejection of claims 6 and 16 is unsound.

As to the rejection of claim 19 under 35 U.S.C. § 112, first paragraph, as lacking descriptive support in the original disclosure, we conclude that there is descriptive support for this broad claim. The examiner appears to be of the view that the omission of a "securing means" in claim 19 establishes a

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broader claim which lacks descriptive support in the disclosure, as filed (answer, page 5). However, it is our opinion that the fact that claim 19 omits a "securing means" is not fatal under the current circumstances. In this mechanical case, broad claim 19 sets forth what can fairly be assessed as a subcombination system. It is worthy of noting that the examiner has appropriately not referenced the "securing means" as absolutely essential, since clearly it is not. From our perspective, claim 19 is just broad, and is not lacking description in the supporting original disclosure of this mechanical invention. Thus, the examiner's rejection of claim 19 cannot be sustained on a new matter ground.

#### Indefiniteness

We do not sustain the rejection of claims 1, 3 through 10, 12, and 16 through 19 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of

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precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner's concern in this rejection seems to be directed to matters of description and enablement, not indefiniteness (answer, page 6). Simply stated, in the present case, we do not perceive that the claims before us are indefinite to the extent that they cannot be understood. Since the metes and bounds of the claimed subject can be ascertained, the indefiniteness rejection under 35 U.S.C. § 112, second paragraph, cannot be sustained.

#### Anticipation

We do not sustain the rejection of claims 1 through 3, 5 through 10, and 19 under 35 U.S.C. § 102(b) as being anticipated by Miller.

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477,

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44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., 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 specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found 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).

Independent claim 1 is drawn to a fastening and retention system for a strap with a feature of one or more retention loops comprising a first component of a mating structure and a strap comprising a complementary component of the mating structure, wherein the mating structure comprises a protruding member and an aperture sized to mate with the protruding member, and wherein the mating structure prevents the loop from sliding freely along the strap when the two components are mated. Independent claim 19 sets forth a system with the feature of first and second

straps passing through the opening of a retention loop wherein the retention loop comprises a first component of a mating structure and the second strap comprises a complementary component of the mating structure, wherein the mating structure prevents the loop from sliding freely along the straps when the two components are mated.<sup>4</sup>

In this rejection, the examiner references a protruding (bowed downwardly) member or body 13 and an aperture (interstice) 2 in Miller (answer, pages 6 and 7), ostensibly as responding to the claimed mating structure. However, as we see it, one versed in the art simply would not comprehend this from the Miller teaching. In fact, the aperture or selected interstice 2 of Miller is expressly indicated to receive the tongue 4 of open frame member 3 of a buckle-device, not the protruding member. From our standpoint, it would be pure conjecture or speculation

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<sup>4</sup> It is particularly worthy of pointing out that appellants have expressly stated the following in their specification (page 4).

As used herein, "mating structures" means any structure that will provide for the temporary attachment of excess strap material in a retention loop. Accordingly, the structure will have a first component and a complementary component that mates with the first component.

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as to whether the bowed downwardly body 13 of the spring arm 12 of Miller would be capable of mating with an interstice 2 to prevent movement of the open yoke frame (loop) relative to the bracelet (strap). Conjecture and speculation is not a sound basis for any conclusion of anticipation under 35 U.S.C.

§ 102(b). As explicitly stated by the patentee (page 2, lines 78 through 110), the spring arm 12 bears upon the body portion 1 of the bracelet to force it into frictional engagement with the bottom bar 6 of the yoke frame, while end portion 5 of the bracelet is held in frictional engagement with the top-bar 7 of the yoke frame under the spring tension of gripping-device 15. It is clear to this panel of the Board that Miller fails to teach first and complementary components of a mating structure for preventing a loop from sliding freely along a strap. For the above reasons, the anticipation rejection based upon the Miller patent cannot be sustained.

#### Obviousness

We cannot sustain the rejection of claims 14, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Miller, nor

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can we sustain the rejection of claims 12 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Wollman.

Irrespective of the conclusions reached by the examiner relative to dependent claims 4 and 16 (answer, page 7), dependent claim 12, and independent claim 18 (answer, page 8), and consistent with our above understanding of the overall Miller teaching, it is quite clear to us that Miller alone, and in combination with Wollman, would not have been suggestive of the claimed mating structure that prevents a retention loop from sliding freely (claims 1 and 18). It is for this reason that the obviousness rejections cannot be sustained.

In summary, this panel of the Board has not sustained the enablement rejection, the description rejection of claim 19, the anticipation rejection, and the obviousness rejections. However, we have sustained the description rejection of claims 6 through 10, 16, and 17.

The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	

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