

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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BEV WOLFGRAM

Appeal No. 2004-1108
Application 09/756,833

ON BRIEF

Before WARREN, KRATZ and DELMENDO, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 18, all of the claims in the application. Claims 1, 2 and 14 are illustrative of the claims on appeal:

1. A backpack specifically adapted to contain and carry a scooter vehicle, said backpack comprising:

a rigid back support plate forms a linearly elongated vertical support and having a lower end, an upper end, and a vertical centerline along the vertically elongated midline;

a rigid bottom support plate perpendicularly affixed at said lower end of said back support plate;

a continuous, flexible sidewall extending outward from and connected to said bottom support plate and said back support plate, thereby forming a frontwall parallel to said back support plate and pair of spaced, vertical sides separating said back support plate from said frontwall such as to form an internal storage volume,

wherein said internal storage volume is specifically sized to receive and retain a conventionally available, foldable two-wheeled scooter.

2. The scooter of Claim 1, wherein said internal storage volume is at least seven inches (7") wide by five inches (5") deep by at least twenty four inches (24") high.

14. A portable transportation vehicle comprising:
a two-wheeled scooter of the type that is collapsible; and
a backpack specifically adapted to contain and carry said scooter.

The appealed claims, as represented by the above claims, are drawn to a backpack which can contain and carry a conventionally available, foldable two-wheeled scooter. The internal volume of the backpack can be as specified in appealed dependent claim 2. In appealed independent claim 14, a collapsible, two-wheeled scooter is claimed in combination with a backpack specifically adapted to contain and carry the scooter.

The references relied on by the examiner are:

Cannaday	4,324,012	Apr. 13, 1982
McDermott	5,743,447	Apr. 28, 1998
Mott (Mott)	5,806,742	Sep. 15, 1998
Kearl	6,193,118	Feb. 27, 2001 (filed Dec. 9, 1997)
Rota	6,332,566	Dec. 25, 2001 (filed Sep. 5, 2000)
Ogami (Japanese Patent)	10-119862	May 12, 1999

The examiner has advanced the following grounds of rejection on appeal:

claim 1 stands rejected under 35 U.S.C. § 102(e) as anticipated by Rota (answer, page 3);

claims 2 and 6 through 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rota (answer, page 4);

claims 3, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rota in view of McDermott (answer, pages 4-5);

claims 4, 5, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rota in view of Kearl (answer, page 5-6);

claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rota in view of Mott (answer, page 6);

claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rota in view of Cannaday (answer, page 7);

claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogami in view of Rota (answer, page 7);

claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogami in view of Rota as applied to claim 15 above, and further in view of McDermott (answer, page 8); and

claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogami in view of Rota and McDermott as applied to claim 16 above, and further in view of Kearl (answer, page 8).

Appellant groups the appealed claims as the claims appear in the grounds of rejection, stating “[e]ach group of claims can stand or fall independently of one another” (brief,¹ pages 6-7). Thus, we decide this appeal based on appealed claims 1, 2, 3, 4, 8, 9, 14, 16 and 17 as representative of the appealed claims in the respective grounds of rejection. 37 CFR § 1.192(c)(7) (2002).

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellant, we refer to the examiner’s answer and to appellant’s brief for a complete exposition thereof.

Opinion

In considering the ground of rejection of appealed claim 1 under § 102(e) as anticipated by Rota, we must first interpret the language thereof by giving the claim terms their broadest reasonable interpretation consistent with the written description provided in appellant’s specification as it would be interpreted by one of ordinary skill in this art, without reading into these claims any limitation or particular embodiment which is disclosed in the specification. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.”); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Priest*, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978).

¹ We consider the brief filed June 9, 2003 (Paper No. 10).

The plain language of claim 1 specifies a “backpack” comprising at least the limitations of any “rigid back support plate,” any “rigid bottom support plate” and any “continuous, flexible sidewall” which have the characteristics specified for each of these structural components in the claim. In this respect, we find that the “continuous, flexible sidewall” must “form an internal storage volume” that “is specifically sized to receive and retain a conventional available, foldable two-wheeled scooter,” and that the preambular language specifies that the claimed “backpack” must be “specifically adapted to contain and carry a scooter vehicle.” We determine that when the preambular language and the corresponding language in the body of the claim with respect to the backpack being capable of containing and carrying and receiving and retaining *any* conventional available, foldable two-wheeled scooter is considered in the context of the claimed invention as a whole, including consideration thereof in light of the written description in appellant’s specification, it must be given weight as a claim limitation which characterizes the claimed “backpack” in order to give meaning to the claim and properly define the invention. *See generally In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1781 (Fed. Cir. 1992) (citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), cert. denied, 469 U.S. 857 [225 USPQ 792] (1984), *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989), *In re Stencel*, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

Accordingly, appealed claim 1 encompasses any backpack having at least the three specified structural components and an internal storage volume that falls within the range of internal storage volumes based on the internal storage volumes necessary to “contain and carry” and “receive and retain” the smallest to the largest conventionally available, foldable two-wheeled scooter. We find no language in claim 1 or in the written description in the specification which otherwise defines or describes *all* “conventional” scooters or the range of internal storage volumes that will “contain and carry” and “receive and retain” such scooters. Indeed, all that the claim language requires is that the backpack must have the capability to “contain and carry” and “receive and retain” a “conventional” scooter, that is, receive, contain and retain the scooter such that the scooter does not fall out of the backpack when the backpack is reasonably carried. Thus, we find no basis in the language of appealed claim 1 or in the

written description in the specification on which to read the arbitrary approximations of suitable volumes set forth at page 6 of the specification into the claim as a limitation.

The transitional term “comprising” opens claim 1 to include backpacks that at least have the limitations specified in the claim and *any* additional component(s).² *See, e.g., Vehicular Technologies Corp. v. Titan Wheel Int’l Inc.*, 212 F.3d 1377, 1383, 54 USPQ2d 1841, 1845 (Fed. Cir. 2000); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”).

The examiner points out where in the Rota figures of a backpack, the rigid back and bottom support plates and the continuous, flexible sidewall structural components required of the claimed backpack by appealed claim 1 are found (answer, page 3). With respect to the claim limitations involving the specified “internal storage volume,” the examiner contends that the backpack of Rota “is capable of being used in the intended manner, i.e., the internal volume of the backpack of Rota [is] sized to receive and retain a scooter if so desired,” noting that “Applicant does not claim the scooter.”

We find, as a matter of fact, that as explained by the examiner, the disclosure of the backpack in Rota constitutes substantial evidence establishing that, *prima facie*, the claimed backpack encompassed by appealed claim 1, as we have interpreted this claim above, is anticipated by the backpack of Rota as a matter of fact because each and every limitation of the claimed backpack, arranged as required by claim 1, is found in Rota, either expressly or under the principles of inherency. *See generally, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

² To the extent that the cited language of appealed product claim 1 is intended by appellant as a method or process of *use* limitation of the claimed backpack, such a limitation has no place in a product claim. *Cf. In re Wiggins*, 397 F.2d 356, 359 n.4, 158 USPQ 199, 201-02 n.4 (CCPA 1968), and cases cited therein (“[A]ppellant’s discovery of the analgesic properties of ‘O₂’ and of a composition containing it could properly be claimed only as a method or process of using that compound or composition in accordance with the provisions of 35 U.S.C. 100(b) and 101.”).

Accordingly, since a *prima facie* case of anticipation has been established over Rota by the examiner, we have again evaluated all of the evidence of anticipation and non-anticipation based on the record as a whole, giving due consideration to the weight of appellant's arguments in the brief. *See generally, See generally, In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990).

Appellant submits that in determining anticipation under § 102(e), “a primary tenet is that only the CLAIMED designs are to be compared,” but does not cite authority for this proposition. Appellant points out that “distinguishing features and characteristics claimed in Rota . . . [are] for the purpose of proving [sic, providing] an urging force against the dorsal arch of the user” to aid “in maintaining proper posture,” and that “an ‘hourglass’ shaped back plate” is used in this respect (brief, pages 7-8). Thus, appellant argues that the three specified structural components of the claimed backpack “are unanticipated,” noting that the claimed feature of “a rigid back support plate that is vertically elongated” is “not ‘hourglass’ shaped” (*id.*, page 8). Appellant further contends that “any padding anticipated in the scooter storage and carrying backpack . . . is consistent with the shape of the backpack, and not in an ‘hourglass’ shape to accommodate . . . the user” (*id.*).

Appellant contends that “the present invention teaches *away* from the intent of Rota in that the present invention is NOT a ‘rucksack of the general type’ designed for ‘school use,’” and that “Rota is designed to accommodate heavily loaded rucksacks; however, the present invention is designed *specifically* to accommodate the shape and weight of a foldable, wheeled scooter” (*id.*; understrike and italics emphasis in original).

In response, the examiner submits that “the functional limitation of holding a scooter does not define appellant's” claimed invention encompassed by appealed claim 1 over Rota, finding that “[i]t is well known that there are numerous foldable or collapsible scooters that when folded or collapsed are of a size that would permit them to be held within a backpack”³ (answer, page

³ The examiner relies on evidence in “Banda (US 5,9278,733)” and Ogami, both of record, to support this ground of rejection but has not included these references in the statement of the ground of rejection (*see* answer, page 9). Accordingly, we have not considered the references as here applied by the examiner. *Cf. In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); *Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993).

9). Further finding that “conventional foldable scooters are of many different sizes,” the examiner contends that

Appellant’s backpack, as shown in figure 1, would be large enough to hold a foldable scooter, but there appears to [sic, be] considerable extra room or space depending upon the actual size of the scooter to be placed within the backpack and therefore it would appear that appellants [sic] backpack is as “specifically sized” to hold a foldable scooter as the backpack of Rota. [*Id.*]

The examiner further points out that, contrary to appellant’s arguments, no claim limitation excludes an “hourglass” back support plate, and that the back support plate is “vertically elongated” as claimed because it “is taller than it is wide” (*id.*).

We have carefully compared the disclosure of Rota, including the figures thereof, with the claimed backpack encompassed by appealed claim 1 as we have interpreted this claim above. We find that the examiner has correctly identified the structural components in the backpack of Rota which correspond to and satisfy each of the structural component limitations of the claim arranged as specified therein. Indeed, appellant does not explain how the language of claim 1 excludes the “hourglass” shape of the rigid back support plate or the “padding” of the backpack of Rota which appellant contends is distinguishing.

Appellant further argues the intended use of the claimed backpack in contending that the same “is designed specially to accommodate the shape and weight of a foldable, wheeled scooter,” and not “to accommodate heavily loaded rucksacks,” that is, backpacks, and that “the present invention teaches away from the intent of Rota” because the claimed backpack is not “designed for “school use”” (*see above*, page 6; all emphasis deleted).

We are not convinced by appellant’s arguments because “[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. [Citations omitted.]” *Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431. Furthermore, as the examiner points out, “the functional limitation of holding a scooter” does not distinguish the claimed backpack from the backpacks described in Rota which otherwise appear to be of the same structural components and have an internal volume that will receive, contain and retain the scooter such that the scooter will not fall out of the backpack when the backpack is reasonably carried, as specified in claim 1 as we have interpreted this language above. Thus, the burden has shifted to appellant to show that the backpacks of Rota do not inherently possess the

functionally defined limitations of the claimed backpack. *See Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432, and cases cited therein. This appellant has not done.

Finally, the argument that the claimed invention “teaches away” from Rota is not an argument that addresses the issue of anticipation. *Cf. Celeritas Technologies Ltd. V. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998) (“[T]he question whether a reference ‘teaches away’ from the invention is inapplicable to an anticipation analysis.”).

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of anticipation found in Rota with appellant’s countervailing evidence of and argument for no anticipation in fact and find that the claimed invention encompassed by appealed claim 1 is anticipated as a matter of fact under 35 U.S.C. § 102(e).

Turning now to the grounds of rejection under § 103(a), appealed claims 2, 3, 4, 8, 9 are rejected over Rota alone and as combined with McDermott, Kearl, Mott or Cannaday (*see above* pp. 2-3), and appealed claims 14, 16 and 17 are rejected over the combination of Ogami and Rota alone and as combined with McDermott or Kearl (*see above* p. 3). We find that claims 2 and 3 depend on appealed independent claim 1, while claims 4, 8 and 9 depend on claim 2, and that claims 16 and 17 depend on appealed dependent claim 15 which depends on independent claim 14. Claims 1 and 15 defined the claimed backpack in the same language. Claim 2 further limits claim 1 by specifying that the “internal storage volume” has “at least” the dimensions set forth therein. Claims 3, 4, 8 and 9, and claims 16 and 17 further limit claims 2 and 15, respectively, by specifying an additional component on the claimed backpack, e.g., “a plurality of legs” in claims 3 and 16.

The examiner finds with respect to appealed claim 2 that one of ordinary skill in the art following Rota would have made a backpack according to the reference having dimensions falling within the dimensions specified in this claim, because determine an optimum value for a result effective variable, such as the volume of a backpack is within the skill in the art, relying on the authority of *In re Boesch*, 617 F.2d 272, 275-76, 205 USPQ 215, 218-19 (CCPA 1980) (answer, page 4). The examiner finds with respect to appealed claim 14 that the combined teachings of Ogami and Rota would have reasonably suggested to one of ordinary skill in this art

that the backpack of Rota can be used as the bag to carry the scooter of Ogami which is constructed to be carried in a bag, in the reasonable expectation of successfully carrying the scooter (answer, page 7).

The examiner finds with respect to appealed claims 3 and 16 that the combination of references that includes McDermott would have reasonably suggested to one of ordinary skill in this art to include legs with castors on a backpack for their apparent advantage (answer, pages 4-5 and 8). The examiner finds with respect to appealed claims 4 and 17 that the combination of references that includes Kearn would have reasonably suggested to one of ordinary skill in this art to include a hand carrying strap on a backpack for its apparent advantage (*id.*, pages 5 and 8). The examiner finds with respect to appealed claim 8 that the teachings of Rota alone and as combined with Cannaday would have reasonably suggested to one of ordinary skill in this art to include padding along an inner surface of the shoulder straps on a backpack for apparent advantage (*id.*, page 7). And, the examiner finds with respect to appealed claim 9 that the combination of Rota and Mott would have reasonably suggested to one of ordinary skill in this art to include a top closure flap with a hook and loop fastness for closing the backpack for its apparent advantage (*id.*, page 6).

Based on the substantial evidence in the references as applied by the examiner, we determine that in each rejection, the examiner has made out a *prima facie* case of obviousness, and accordingly, we have again evaluated all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellant's arguments in the brief. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Appellant initially submits that "the issue date of [Rota] . . . and the issue date of [Kearn] . . . [are] subsequent to both the filing date of the present invention, as well as the invention date of the present invention," alleging that "the conception date of the present invention was prior to September 4, 1999" (brief, page 10). We observe that the alleged date of conception, even if it was established as fact by the filing of a declaration under 37 CFR § 1.131, Affidavit or declaration of prior invention (2000), and no such declaration is of record as the examiner points out (answer, pages 9-10), would appear to antedate only the filing date of Rota and not that of

Kearl. In any event, in the absence of the declaration under § 1.131, both Rota and Kearl are applicable prior art with respect to the claimed invention even though they issued subsequent to the filing date of the present application, because the applications maturing into these patents were filed prior to the filing date of the present application, thus satisfying the provisions for prior art under such circumstances set forth in 35 U.S.C. § 102(e) (2002).

Appellant describes the teachings of each of Kearl, McDermott, Mott and Cannaday, and concludes that the features relied on by the examiner in each reference could not be included in the claimed backpack for transporting a scooter (brief, pages 10-11). Appellant also describes Ogami as teachings “a portable motor-driven scooter board that is capable of being disassembled for purposes of carrying the components [sic] ‘into a bag’” (*id.*, page 11). Appellant further contends that “[t]here is no suggestion as to the desirability of any modification of the references to describe the present invention,” arguing that “[a]n analysis of the disclosures within the cited references fails to cite every element of the claimed invention” (*id.*, page 12). Appellant describes elements of the backpacks found in each of Kearl, McDermott, Mott and Cannaday which are alleged to be outside of the elements of the claimed backpack encompassed by the appealed claims (*id.*, pages 12-13). In this respect, appellant again describes Ogami in the same language as before (*id.*, pages 11 and 13). On this basis, appellant argues that “[n]one of these prior art reference [sic] suggest even the slightest motivation for making a specially adapted scooter storage and carrying backpack” (*id.*, page 13).

The examiner argues that each of Rota, McDermott, Kearl, Mott and Cannaday is analogous prior art “within appellant’s field of endeavor, i.e., backpacks,” citing *Oetiker, supra* (answer, page 10). With respect to Ogami, the examiner points out that “this reference teaches a collapsible scooter that can be knocked down in compact pieces and then put into a bag so that it can be manually carried when not” in use, and being “the same concept as appellant’s invention, . . . is clearly in appellant’s same field of endeavor” (*id.*). Thus, the examiner argues that the teachings with respect to backpacks “are pertinent to the particular problem with which appellant is concerned” (*id.*).

We agree with the examiner that each of the applied references is pertinent to both appellant’s field of endeavor and the problem which appellant addresses. *See also In re Clay,*

966 F.2d 656, 658, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). On this basis, we have carefully considered appellant's arguments that there is no motivation to combine the identified features of each of the references with respect to a backpack that accommodates a scooter. We reiterate again here that appellant has not established that the backpack of Rota, which has all of the structural components required by appealed claim 1, would not receive, contain and retain a conventionally available, foldable two-wheeled scooter such that the scooter does not fall out of the backpack when the backpack is reasonably carried as further required by the claim. Thus, because Rota is applied in all of the grounds of rejection under § 103(a) for such teachings, the issues are whether one of ordinary skill in this art would have modified the backpack of Rota with the feature shown in the backpacks described in each of McDermott, Kearl, Mott and Cannaday, and whether one of ordinary skill in this art would have used the backpack of Rota as the bag of Ogami to carry the scooter of Ogami. In these respects, appellant has not supported her conclusion that a particular modification of the backpack of Rota by a feature shown in the backpack of McDermott, Kearl, Mott or Cannaday could not be included in a backpack for transporting a conventionally available, foldable two-wheeled scooter, with reasons why this would be so for each modification. Indeed, unsupported allegations are entitled to little, if any, weight. *See In re Payne*, 606 F.2d 303, 315, 203 USPQ 245, 256 (CCPA 1979); *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972). We find with respect to Ogami that appellant has not addressed the combination of this reference with Rota with specificity, as only the teachings of Ogami are described (brief, pages 11 and 13).

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in Rota alone and as combined with other references with appellant's countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 2 through 18 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner's decision is affirmed.

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

AFFIRMED

Appeal No. 2004-1108
Application 09/756,833

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