

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte FREDERICK H. BARKER and RICHARD E. PERUGGI

Appeal No. 2004-2209
Application No. 09/406,445

ON BRIEF

Before FRANKFORT, PATE, and BAHR, Administrative Patent Judges.
PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 15-21, 23-31, 33 and 34. Claims 22 and 32, the only other remaining claims in the application, stand withdrawn from consideration as directed to a non-elected species.

The claims are directed to a guide rail safety device for an elevator car riding on a non-metallic guide rail formed of concrete. The guide rail safety device is comprised

of a housing and a wedge disposed in the housing. The wedge has a friction surface aligned for contact with the non-metallic guide rail. The friction surface, along with the non-metallic guide rail, has a coefficient of friction of approximately 1.0, and the friction surface is sized and shaped so that the friction surface contacts the guide rail with no more than approximately 50 psi of pressure.

The claimed subject matter may be further understood by reference to the appealed claims appended to appellants' brief.

The references of record relied upon by the examiner as evidence of obviousness are:¹

Pearson	5,065,845	Nov. 19, 1991
Kopman et al. (Kopman)	5,531,295	Jul. 2, 1996
Hladnik	DE 2,054,936 A	May 27, 1971
Winkler et al. (Winkler)	GB 2,190,356 A	Nov. 18, 1987

The Rejections

Claims 25-31, 33 and 34 stand rejected under 35 U.S.C. § 112, first paragraph.

Claims 15-20, 23, 25-30 and 33 stand rejected under 35 U.S.C. § 103 as unpatentable over the German laid open application to Hladnik in view of the UK patent application to Winkler.

¹Our understanding of the German application is via a translation provided by the USPTO.

Claims 21 and 31 stand rejected under 35 U.S.C. § 103 as unpatentable over German laid open application to Hladnik in view of the British application to Winkler and further in view of Kopman.

Claims 24 and 34 stand rejected under 35 U.S.C. § 103 as unpatentable over the German laid open application in view of the British application to Winkler and further in view of Pearson.

For the details of these rejections, reference is made to the final rejection, Paper No. 13. For the details of appellants' arguments with respect to the rejections, reference is made to the appeal brief. The examiner's response to the arguments can be found in the examiner's answer.

Opinion

We have carefully reviewed the rejections on appeal in light of the prior art and the arguments of appellants and the examiner. As a result of this review, we have determined that none of the rejections of the claims on appeal can be sustained. Our reasons follow.

The following represents our findings of fact with respect to the scope and content of the prior art and the differences between the prior art and the claimed subject matter. The German laid open application discloses an elevator shaft composed of prefabricated concrete segments. The concrete segments are provided with guide ribs 5 and rib-like guides 8 to guide the elevator car and the counterweight, respectively.

See translation, pages 3 and 4. Thus, the German laid open application teaches non-metallic or concrete guide rails for an elevator car. The German laid open application is completely silent with respect to friction surfaces, coefficients of friction between the friction surface and the guide rail, or the limit, *viz.*, 50 psi, on the pressure with which the friction surface contacts the guide rails.

The UK patent to Winkler discloses a guide rail safety device using a metallic guide rail as is common in the prior art. Winkler discloses wedges 9 and 10 with at least one horizontal locator 15 and an actuator 39. Figure 6 of Winkler illustrates the function of the catching device. The solid lines represent the friction force developed by the stopping device at various coefficients of friction. The dashed line represents the prior art stopping device. Note that Winkler offers improved friction force at coefficients of friction lower than 0.85. Winkler also expressly states that coefficients of friction above 0.85 are exceedingly difficult to attain. The differences between Winkler and the claimed subject matter include the fact that Winkler is directed to metallic guide rails, Winkler has no teaching of limiting the force by which the friction surfaces contact the guide rail, and Winkler teaches coefficients of friction above 0.85 are difficult to attain.

Turning first to the rejection of claims 25-31, 33 and 34 under 35 U.S.C. § 112, first paragraph, it is understandable that appellants have difficulty responding to this rejection, for it is unclear exactly the basis for the examiner's reasoning. Initially, the

examiner states that this is a lack of enablement rejection. See paragraph 2, page 2 of the Final Rejection, Paper No. 13. And yet, in the next two paragraphs, the examiner twice states that the claims are unpatentable under the written description requirement of 35 U.S.C. § 112. Finally, in the examiner's answer at page 4, the examiner states that it would be almost impossible to determine whether one would infringe the claimed invention This, of course, is an argument bottomed on 35 U.S.C. § 112, second paragraph, that the claims are so indefinite that an infringement analysis would be in doubt.

Taking each in turn, and looking at enablement first, we note that the examiner has not addressed the issue of undue experimentation. Accordingly, the examiner has not established a *prima facie* case of unpatentability with respect thereto. If the examiner's intention was to raise the issue of whether the scope of enablement was broad enough to include *any* non-metallic guide rail, we merely point out that it is well settled that if an invention pertains to an art where the results are predictable, e.g., mechanical as opposed to chemical arts, a broad claim can be enabled by disclosure of a single embodiment, *In re Cook*, 439 F.2d 730, 735, 169 USPQ 298, 301 (CCPA 1971); and such a claim is not invalid for lack of enablement simply because it reads on another embodiment of the invention which is inadequately disclosed, see *Gould v. Mossinghoff*, 711 F.2d 396, 400, 219 USPQ 393, 396 (D.C. Cir. 1983). *Spectra-Physics Inc. v. Coherent Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737 (Fed. Cir. 1987).

With respect to written description, it is our finding that appellants have established that the application and claims as originally filed convey that appellants were in possession of the subject matter of the rejected claims. Additionally, in *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1475, 1478, 45 USPQ2d 1499, 1503 (Fed. Cir. 1998), the patentee had amended its claims to a sectional sofa so as to remove a limitation that controls for a pair of parallel recliners be located on a console between the recliners. The Federal Circuit held that the broadened claims failed to satisfy the written description requirement because the written description clearly described the central console as the only location for the controls. *Id.* at 1479, 45 USPQ2d at 1502. “In *Gentry*, we applied and merely expounded upon the unremarkable proposition that a broad claim is invalid when the entirety of the specification clearly indicates that the invention is of a much narrower scope.” *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1323, 62 USPQ2d 1846, 1851(Fed. Cir. 2002). In the present case, appellants have not stated that concrete is the only material for non-metallic guide rails, nor have appellants stated that the use of concrete is essential or necessary or is the only material contemplated for the invention. Thus, no rejection under the written description requirement is tenable.

With respect to any rejection contemplated under the second paragraph of

35 U.S.C. § 112, as appears to be mentioned in the examiner's answer, we hold that such a rejection is not before us on appeal.

With respect to the obviousness rejection of the first group of claims, i.e., claims 15 -21, 23, and 24, we point out that neither cited reference discloses the claimed friction surface to guide rail pressure of less than 50 psi. We note that the examiner has stated that this limitation is a result effective variable. We recognize the examiner's reliance on *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) wherein it was held that "discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." We agree with the holding in this case, but we must emphasize that the prior art must recognize the process and the place of the variable in the process. The examiner has not cited any evidence that the prior art recognizes the importance or criticality of limiting the pressure by which the friction surface acts on the non-metallic guide rails. Without such evidence, we are unable to agree that contact pressure of less than 50 psi in the present case is a result effective variable.

With respect to the second group of claims, i.e., claims 25-31, 33, and 34, we note that these claims require the coefficient of friction between the guide rail and the friction surface to be approximately 1.0. As our findings, *supra*, indicate, the UK patent to Winkler expressly teaches that a coefficient of friction above 0.85 is exceedingly difficult to attain. Thus, not only is there no apparent teaching or suggestion that would

have given one of ordinary skill motivation to combine the teachings of the two basic references, we find that the reference to Winkler expressly teaches away from such a high coefficient of friction. It must be recognized that although the German laid open application contains a teaching of a non-metallic guide rail, it is silent with respect to using such a guide rail as a friction component with a friction surface on a wedge of a catching device. Accordingly, any teaching or suggestion to combine this reference with the Winkler catching device must be based on impermissible hindsight.

The other cited references offer little to bolster the examiner's case of *prima facie* obviousness. Consequently, all obviousness rejections on appeal are reversed.

Summary

The rejection of claims 25-31, 33 and 34 under 35 U.S.C. § 112, first paragraph is reversed.

The rejections of claims 15-21, 23-31, 33 and 34 on obviousness grounds are also reversed.

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
WILLIAM F. PATE, III)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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