

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte TODD ANDERSON

Appeal No. 2004-2335
Application No. 09/867,495

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 4 and 5, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention is directed to a tie down which has a bungi cord that has a hook at one end for securing the bungi cord to a first object and a clasp at the other end. The clasp has a pair of pivoted jaws with teeth on at least one of the jaws for securing the other end of the bungi cord to an object (specification, p. 2). A copy of dependent claim 4 is set forth in the appendix to the appellant's brief. Claim 5 reads as follows:

A bungi cord comprising:
an elastic cord having a first end and a second end, said first end having a hook secured thereto, and
said second end having means for securing said second end to a support,
said means for securing said second end to a support comprising a first jaw and a second jaw,
said first and second jaws being secured together by a pivot, and said first and second jaws being movable from a first position to a second position about said pivot, and
wherein when said first and second jaws are in said first position, they are closely adjacent one another, and
when said first and second jaws are in said second position, they are remote from one another, and
means for holding said first and second jaws in said first position,
and
wherein said means for holding said first and second jaws in said first position is a spring, and
wherein said spring is wound around said pivot and has a pair of arms, one of said pair of arms engaging an outside surface of said first jaw, and another of said pair of arms engaging an outside surface of said second jaw.

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

Thurston	1,195,874	Aug. 22, 1916
De Witt	2,931,084	April 5, 1960
Vasilopoulos	5,722,125	March 3, 1998

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Vasilopoulos in view of Thurston.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Vasilopoulos in view of Thurston and De Witt.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed April 8, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (filed January 30, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The specification (p. 5) informs us that this invention

has a bungi cord 2 which has a hook 4 secured to an enlarged end 3 of the bungi cord in the conventional manner. The other end of the bungi cord is secured, in any conventional manner to a clasp 5. The clasp 5 is shown in more detail in FIG. 3. The clasp 5 has a pair of jaws 6, 7 which are pivoted together at 8, so the jaws can be moved toward and away from each other. Each of the jaws 6, 7 have a plurality of teeth 9 which will dig into an object from opposite sides and thereby secure the clasp firmly to the object. Since the clasp 5 of the present invention does not need an aperture or a ledge, or some other form of support that the conventional hook 4 needs in order to secure the hook to a support, the clasp 5 of the present invention, is much more versatile than the conventional hook 4.

It is axiomatic that, in proceedings before the USPTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). While the claim must be interpreted consistent with the specification, limitations should not be read into the claim from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

In applying this guidance to claim 5, we believe that the broadest reasonable interpretation consistent with the appellant's specification of the claim limitation that the second end of the elastic cord **has** means for securing the second end to a support is that the means for securing¹ is attached to the second end of the elastic cord, i.e., as disclosed, the other (i.e., second) end of the bungi cord 2 is secured to a clasp 5 as depicted in Figure 2. In our view, this interpretation does not read limitations from the specification into the claim, but rather interprets the claim language as it would be interpreted by one of ordinary skill in the art so as to be consistent with the specification.

In the rejection of claim 5 under appeal, the examiner found (answer, p. 3) that Vasilopoulos taught an elastic cord 30 with a hook 50 at a first end and an alligator clip 92 at the second end. In view of the clasp 2 taught by Thurston, the examiner determined (answer, pp. 3-4) that it would have been obvious to modify Vasilopoulos' alligator clip to have a spring that is wound around a pivot and has a pair of arms, one of the pair of arms engaging an outside surface of a first jaw of the alligator clip, and the other of the pair of arms engaging an outside surface of a second jaw of the alligator clip.

¹ The structure of the means for securing is spelled out in detail in claim 5.

The appellant argues (brief, p. 5, lines 10-12; p. 6, lines 13-14) that Vasilopoulos does not disclose "said second end [of the elastic cord] having means for securing said second end to a support." We agree. Given our interpretation of this claim language as set forth above, the decision of the examiner to reject claim 5 under 35 U.S.C. § 103 must be reversed. In that regard, we note that even if the alligator clip of Vasilopoulos were modified by the teachings of Thurston as set forth in the rejection, it would not arrive at the claimed subject matter since the modified alligator clip of Vasilopoulos is attached to a base ring 12 (a distinct additional component) and is not attached to the second end of the elastic cord 30, i.e., the alligator clip is not part of the elastic cord. The second end of the elastic cord 30 of Vasilopoulos does not have an alligator clip for securing the second end to a support. Instead, Vasilopoulos teaches that the second end of the elastic cord 30 has a hook as shown in Figure 2. In that regard, the bungi cord taught by Vasilopoulos is much like the conventional prior art bungi cord depicted in the appellant's Figure 1.

For the reasons set forth above, the decision of the examiner to reject claim 5 under 35 U.S.C. § 103 is reversed.

We have also reviewed the reference to De Witt additionally applied in the rejection of claim 4 (dependent on claim 5) but find nothing therein which makes up for

the deficiency of Vasilopoulos discussed above regarding claim 5. Accordingly, the decision of the examiner to reject claim 4 under 35 U.S.C. § 103 is reversed.

REMAND

We remand this application to the examiner under the authority provided by 37 CFR § 41.50(a)(1) to consider a rejection of claims 4 and 5 on appeal under 35 U.S.C. § 103(a) wherein Bozarjian (U.S. Patent No. 6,187,104) is used as the base reference along with Thurston and De Witt in a manner similar to the examiner's rejections discussed above. In that regard, the examiner should note the embodiment of the tie down or tether discussed in column 3, lines 60+ of Bozarjian, wherein an elastic cord or strap (column 3, line 9) is provided with a hook member (32) secured to one end (Figure 4) and a spring-loaded clamp/clip (column 3, line 14) secured at the other end (Figure 1).

CONCLUSION

To summarize, the decision of the examiner to reject claims 4 and 5 under 35 U.S.C. § 103 is reversed. In addition, this application has been remanded to the examiner for further consideration as set forth above.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

REVERSED and REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	BOARD OF PATENT
)	APPEALS
)	AND
)	INTERFERENCES
JEFFREY V. NASE)	
Administrative Patent Judge)	

Frankfort, Administrative Patent Judge, dissenting.

Although my colleagues in the majority have recognized on page 4 of their opinion that during patent examination limitations should not be read into the pending claims from the specification, it is my view that they have done exactly that in construing independent claim 5 on appeal to require the securing means recited therein to be "attached to the second end of the elastic cord, i.e., as disclosed" (decision, p. 5) and "part of the elastic cord" (decision, p. 6). For that reason, I must respectfully dissent from their decision reversing the examiner's rejections of claims 4 and 5 under 35 U.S.C. § 103(a).

In pertinent part, independent claim 5 is directed to a bungi (bungee) cord comprising: an elastic cord having first and second ends, said first end having a hook secured thereto, and said second end "having means for securing said second end to a support." Claim 5 goes on to specify exactly what structure constitutes the means for securing and, as found by the examiner (answer, pages 4-5), thereby removes the recited element from the purview of 35 U.S.C. § 112, sixth paragraph. More particularly, claim 5 essentially goes on to describe the means for securing as being a spring-biased clasp or clip of the type seen in Figure 3 of the application.

It is the proper interpretation to be accorded the language "said second end having means for securing said second end to a support" of claim 5, and the impact of that language on the invention as a whole, that is at issue. In my opinion, when such language is given its broadest reasonable interpretation consistent with the specification as such would be understood by one of ordinary skill in the art, it does not require the securing means to be attached to the second end of the elastic cord as depicted in Figure 2 of the pending application, i.e., "as disclosed" as the majority has determined. On the contrary, I consider that the language in question is susceptible to a much broader interpretation and is clearly readable on an arrangement like that seen in the Vasilopoulos patent applied by the examiner, wherein a means for securing (i.e., alligator clip 92) is indirectly secured to the second end (32) of an elongate elastic cord (30) via base ring (12) and a swivel fitting (40), thereby providing a bungi (bungee) cord having first and second ends with the first end having a hook (50, 52) secured thereto and a second end having securing means in the form of a clamp/clip (90, 92) capable of securing said second end to a support. This broader interpretation, in my view, is clearly supported by the specification of the present application (e.g., page 5), wherein it is indicated that the second end of the bungi (bungee) cord (2) of appellant's invention is secured "in any conventional manner" to a clasp (5). The arrangement of Vasilopoulos merely represents one conventional manner in which a securing or attachment means

in the form of a clasp or clip (90, 92) may be secured to a second end of the elastic cord (30).

Thus, looking to Figure 2 of the Vasilopoulos patent, I agree with the examiner that this patent discloses a bungee cord tie down structure which has different types of securing devices on opposite ends of the tie down and, more specifically, a tie down which has a bungee cord (30) that has a hook (50) at one end for securing the bungee cord to a first object and an opposite end having a clasp or clip, wherein the clasp/clip (92) includes a pair of pivoted jaws (97, 98) with teeth on at least one of the jaws for securing that end of the bungee cord to an object or support. I further agree with the examiner that the bungee cord tie down of Vasilopoulos differs from that defined in claim 5 on appeal only in the details of the form of clasp/clip associated therewith and that the patent to Thurston discloses a clasp/clip like that broadly recited in appellant's claim 5. Moreover, I concur in the examiner's assessment that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to have utilized a known alternative form of clasp/clip like that in Thurston in place of the alligator clip (92) of Vasilopoulos, thereby rendering the subject matter of claim 5 on appeal obvious under 35 U.S.C. § 103(a).

Appellant has not specifically contested the examiner's above-noted combination of Vasilopoulos and Thurston, but has urged instead (brief, pages 5-6) that the clip (92) of Vasilopoulos is not intended to be secured to a support and that it would not be obvious to use the clip (92) to secure to a support. In that regard, I believe appellant has lost sight of the fact that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). In this case, I agree with the examiner that the bungee cord structure resulting from the combination of Vasilopoulos and Thurston is structurally the same as that broadly set forth in claim 5 on appeal and is also fully capable of performing the intended use as recited in claim 5.

For the above reasons, I would sustain the examiner's rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Vasilopoulos in view of Thurston.

Given appellant's indication on page 5 of the brief that the claims on appeal "stand or fall together," I further conclude that dependent claim 4 should be considered to fall with independent claim 5 and that the examiner's rejection of claim 4 under 35 U.S.C.

§ 103(a) as being unpatentable over Vasilopoulos, Thurston and De Witt should therefore also have been sustained.

Concerning the remand to the examiner set forth on page 7 of the majority opinion, I share the view that the examiner should consider a rejection of claims 4 and 5 of the present application under 35 U.S.C. § 103(a) using Bozarjian (U.S. Patent No. 6,187,104) as the base reference along with Thurston and De Witt, noting that the particular bungee cord tether pointed to in Bozarjian appears to meet even the majority's more limited interpretation of the above-noted language of appellant's claim 5.

CHARLES E. FRANKFORT
Administrative Patent Judge

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