

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte H. JAY SPIEGEL

Appeal No. 2005-0489
Application No. 10/144,987

HEARD: MAY 18, 2005

Before PATE, MCQUADE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 28-32. Claims 1-3, 8-11, 13, 16, 18, 20-23, 25 and 26 have been indicated as allowable and claim 33 stands objected to as depending from a rejected claim. No other claims are pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a flag holder for reducing fraying of a flag. The flag holder utilizes a lower fitting mounted on the flagpole with a lower mounting permitting free movement of the lower fitting along the length of the flagpole toward the upper fitting. Further understanding of the invention may be obtained from a reading of independent claim 28, which is reproduced *infra* in the opinion section of this decision.

The Prior Art

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

Hall	433,124	Jul. 29, 1890
Rohrbaugh	1,360,584	Nov. 30, 1920
Dobbins	5,697,321	Dec. 16, 1997
Fisher et al. (Fisher)	Des. 427,108	Jun. 27, 2000

The Rejections

The following rejections are before us for review.

Claim 28 stands rejected under 35 U.S.C. § 103 as being unpatentable over Fisher in view of Rohrbaugh.

Claims 29 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fisher in view of Rohrbaugh and Hall.

Claims 30 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fisher in view of Rohrbaugh and Dobbins.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer for the examiner's complete reasoning in support of the rejections and to the brief¹ and reply brief 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.

Claim 28, the only independent claim before us on appeal, reads as follows:

28. In a moving vehicle, the improvement comprising a flag holder, comprising:

a) an upper fitting and a lower fitting, each including coupling means for coupling to a separate attachment location on a leading edge of a flag, banner or pennant;

b) a flagpole mounted on said vehicle and having a body, an axis of elongation and a length;

c) said upper fitting mounted on said flagpole with an upper mounting, said upper mounting precluding said upper fitting from moving along said axis of elongation of said flagpole;

d) said lower fitting being mounted on said flagpole body with a lower mounting permitting free movement of said lower fitting along said length of said flagpole toward said

¹ The appeal brief was originally filed on August 12, 2003. A duplicate copy of the appeal brief was filed on November 4, 2003.

upper fitting, said lower mounting substantially precluding said lower fitting from lateral movement with respect to said axis of elongation, such lateral movement being limited by slight spacing between said lower mounting and said body, said slight spacing provided solely to facilitate said free movement;

e) whereby, when said upper and lower fittings are coupled to separate attachment locations on said flag, banner or pennant, and said vehicle is moving, relative wind speed above a desired threshold with respect to said flagpole causes said lower fitting to move up said flagpole toward said upper fitting, thereby causing said flag, banner or pennant to adopt a non-planar elongated U-shaped configuration reducing snapping of a trailing edge thereof remote from said flagpole.

Fisher merely discloses an ornamental design for a flag holder for vehicles, without providing any details as to the mounting of the flag thereon. Rohrbaugh discloses an endless flag halyard entrained around the pulley 2 at the top of a flag mast 1, the halyard provided with an upper flag attaching means 4, including a tubular part 5 through which the halyard may be threaded and in which the halyard is secured against relative movement by means of set screws 6 and further including a snap hook construction 7 adapted to engage the ring 8 in the upper corner of the flag, and a lower flag attaching means which consists of an elongated body member 9 to one end of which an enlarged ring 10 is integrally secured and to the other end of which a snap hook 11 is integrally secured. According to Rohrbaugh,

[t]he ring 10 is of a diameter which is materially greater than the diameter of the halyard with which it is intended to be

used so that it may be free to loosely slide up and down on the halyard and also free to move transversely relatively to the halyard.

When a flag is connected to its halyard according to my invention there is no possibility of its being frayed, whipped or torn because when the wind strikes it, the ring 10 of the fastener 9 is free to and will slide up and down on the halyard and thereby permit the flag to spill the wind and at the same time retain sufficient wind pressure to maintain it in extended position. Ordinary wind pressure will be taken care of by the relative transverse movement of the ring 10 while greater pressure will be taken care of by this transverse movement of the ring 10 plus the flexibility of the halyard [page 1, lines 82-103].

In rejecting claim 28, the examiner's position is that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to modify Fisher's flag holder for vehicles "so as to include movement of the lower fitting towards the upper fitting, as taught by Rohrbaugh, so as to provide a means for eliminating the whipping, fraying and tearing of the flag (column 1, lines 33-34) during striking of the wind" (answer, page 5). With respect to the limitation in claim 28 "said lower mounting substantially precluding said lower fitting from lateral movement with respect to the axis of elongation," the examiner contends that "the amount of movement due to the slight spacing from the axis of elongation of Rohrbaugh (Fig. 4, Rohrbaugh) is comparable to the amount of movement due [to] slight spacing from the axis of elongation of the applicant's invention (Fig. 4, applicant's drawings)" (answer, page 9).

The applicant argues, and we agree, that Rohrbaugh relies in part on the flexibility of the halyard to handle wind pressure and, thus, would not have suggested mounting a flag, even via a lower mounting which permits movement up and down in the direction of the axis of elongation of the flag pole, directly to the flagpole (or flag holder) of Fisher, rather than to a halyard. Moreover, in light of Rohrbaugh's expressed objective to size the ring 10 with a materially greater diameter than that of the halyard so that it is free to slide loosely up and down on the halyard and also free to move transversely relatively to the halyard to take up wind pressure, Rohrbaugh cannot reasonably be considered to teach or suggest a "lower mounting substantially precluding said lower fitting from lateral movement with respect to said axis of elongation, such lateral movement being limited by slight spacing between the lower mounting and said body, said slight spacing provided solely to facilitate said free movement" as called for in claim 28. It follows that we cannot sustain the examiner's rejection of claim 28 as being unpatentable over Fisher in view of Rohrbaugh.

The examiner's application of Hall and Dobbins in rejecting the dependent claims provides no cure for the deficiency of the combination of Fisher and Rohrbaugh discussed above. We therefore also cannot sustain the rejections of claims 29 and 31 as being unpatentable over Fisher in view of Rohrbaugh and Hall and claims 30 and 32 as being unpatentable over Fisher in view of Rohrbaugh and Dobbins.

REMAND TO THE EXAMINER

This application is remanded to the examiner, pursuant to our authority under 37 CFR § 41.50(a), to consider whether the present application, as originally filed, provides written descriptive support for the subject matter of claims 28-32 in compliance with the first paragraph of 35 U.S.C. § 112.

The description requirement found in the first paragraph of 35 U.S.C. 112 is separate from the enablement requirement of that provision. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1561-63, 19 USPQ2d 1111, 1115-17 (Fed. Cir. 1991) and In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1064, 197 USPQ 271 (1978). Moreover, as the court stated in In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983):

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 claimed language. The content of the drawings may also be considered in determining compliance with the written description requirement. (citations omitted)

Although the claimed invention does not necessarily have to be expressed in *ipsis verbis* in order to satisfy the description requirement (see In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976)), it is nonetheless necessary that the disclosed apparatus inherently perform the functions now claimed (note In re Smythe,

480 F.2d 1376, 1383, 178 USPQ 279, 284 (CCPA 1973)). The fact that one skilled in the art might realize from reading a disclosure that something is possible is not a sufficient indication to that person that the something is a part of an appellant's disclosure. See Barker, 559 F.2d at 593, 194 USPQ at 474. Precisely how close the original description must come to comply with the description requirement must be determined on a case-by-case basis. The primary consideration is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure. See Vas-Cath Inc. v. Mahurkar, 935 F.2d at 1561-63, 19 USPQ2d at 1115-17.

We note, at the outset, that claims 28-32 are not original claims. Each of these claims recites “said lower mounting substantially precluding said lower fitting from lateral movement with respect to said axis of elongation, such lateral movement being limited by slight spacing between said lower mounting and said body, said slight spacing provided solely to facilitate said free movement.” The appellant’s specification discloses that “[t]he lower fitting may freely reciprocate with respect to the flagpole and, if desired, may rotate with respect thereto” (page 4). The specification also states, on page 6, that

[i]n one embodiment of the present invention, the lower fitting has a fixed diameter opening therethrough sized to allow easy sliding along the flagpole. In another embodiment, the lower fitting consists of a known clamping mechanism which is placed about the flagpole in a manner not contemplated by that mechanism, to wit, so that the

lower fitting loosely fits about the flagpole without clamping it to allow easy sliding.

Further, on page 8, in describing the embodiment of Figures 1-4, the appellant's specification discloses that the lower fitting includes a sleeve 21 "having an internal passageway 23 having dimensions permitting it to easily slide up and down over the outer periphery of the shaft 2." In the embodiment illustrated in Figure 5, the appellant discloses an alternative construction of the lower fitting comprising a clamping mechanism 33 which includes two legs 35, 37 having facing teeth 39, 41. On pages 9 and 10, the appellant's specification states:

As the clamping mechanism 33 is designed, it is intended that the legs 35 and 37 be squeezed together until the surfaces 43 and 45 tightly clamp about the periphery of a shaft preventing any rotation or reciprocation with respect thereto. As the clamping mechanism 33 is used in accordance with the teachings of the present invention, it is oriented as shown in Figure 5 with the surfaces 43 and 45 clearly spaced away from the periphery of the shaft 2 so that the fitting 30 may freely reciprocate up and down the shaft in accordance with the teachings of the present invention.

The appellant's specification does not expressly teach that the lower mounting substantially precludes the lower fitting from lateral movement with respect to the axis of elongation, such lateral movement being limited by slight spacing between said lower mounting and said body, the slight spacing being provided solely to facilitate free movement of the lower fitting along the length of the flagpole, as recited in claims 28-32. In the portions cited above, the specification refers to dimensions permitting easy sliding, a loosely fitting lower fitting, and surfaces of a clamping mechanism "clearly spaced" from the periphery of the shaft. We question whether this disclosure, even coupled with the illustrations in Figures 1-3 and 5, is sufficient to convey to one of

ordinary skill in the art that the disclosed lower fitting structure inherently precludes lateral movement of the lower fitting with respect to the axis of elongation of the shaft so as to provide written description support for the cited claim limitations in compliance with 35 U.S.C. § 112, first paragraph.

CONCLUSION

To summarize, the decision of the examiner to reject claims 28-32 under 35 U.S.C. § 103 is reversed and the application is remanded to the examiner for consideration of whether claims 28-32 have written descriptive support in the application as originally filed, as explained above.

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

REVERSED AND REMANDED

WILLIAM F. PATE, III)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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