

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2005-2435
Application No. 10/407,498

ON BRIEF

Before GARRIS, WALTZ, and JEFFREY T. SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-20¹.

The subject matter on appeal relates to a safety device for a ladder. With reference to the appellant's drawing, the safety device 34 comprises an arm 38 having two end portions including a first end portion for attachment to the upper portion of a ladder and a second end portion to which is joined a holding member 40 that is attachable to a portion of a structure to hold a ladder in place.

¹As the appellant is aware (see page 11 of the brief), the dependent claim 10 phrase "The safety device of Claim 8" should read -- The method of Claim 8 --.

Appeal No. 2005-2435
Application No. 10/407,498

The appealed subject matter also relates to a ladder in combination with the aforementioned safety device and to a method for securing a ladder to a structure via the aforementioned safety device. This appealed subject matter is adequately represented by independent claim 1 and claim 13 which depends from claim 1.

These claims read as follows:

1. A safety device for a ladder which ladder has an upper portion, said safety device comprising:

an arm for attaching to an upper portion of a ladder, said arm having two end portions comprising a first end portion for attachment to the upper portion of a ladder and a second end portion, wherein at least a portion of the arm is flexible; and

a holding mechanism joined to the second end portion of the arm, wherein said holding mechanism is attachable to a portion of a structure to hold a ladder in place.

13. The safety device of Claim 1 wherein the ladder has a pair of side rails and a plurality of rungs extending between said side rails, said safety device is configured so that said holding mechanism is spaced away from the rungs of the ladder when said safety device is holding the ladder to a structure.

The references set forth below are relied upon by the Examiner in the § 102 and § 103 rejections before us²:

² In his answer, the examiner cites a publication to Charlton on page 2 and discusses this publication on page 6. However, this publication has no relevance whatsoever to any of the issues raised by the rejections before us on this appeal. The examiner's answer is not an appropriate forum in which to present and discuss a reference which is irrelevant to the involved appeal, and therefore we admonish the examiner and his appeal conferees to no longer engage in such a practice.

Appeal No. 2005-2435
Application No. 10/407,498

Allred

5,529,145

June 25, 1996

Micro Mark Catalogue, "Ratchet Action Clamps", (date unknown: cited by applicant), page 65

Claim 13 is rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellant regards as his invention.

Claims 1-3, 5, 7-10 and 13-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Allred.

Claims 4, 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Allred, and claim 6 is correspondingly rejected over this reference and further in view of Micro Mark Catalogue.

We refer to the brief and reply brief and to the answer for a complete discussion of the contrary viewpoints expressed by the appellant and by the examiner concerning these rejections.

OPINION

For the reasons which follow, we cannot sustain any of the rejections advanced by the examiner in this appeal.

The examiner considers dependent claim 13 to violate the second paragraph of § 112 because, in his view, it is unclear whether this claim is intended to be drawn to a "safety device"

Appeal No. 2005-2435
Application No. 10/407,498

alone or in combination with a "ladder." According to the examiner, this lack of clarity arises because claim 13 begins with the phrase "The safety device of Claim 1" (i.e., indicating a "safety device" alone) whereas the body of the claim positively recites "the ladder" (i.e., indicating the combination of a "safety device" and a "ladder"). The appellant, on the other hand, unambiguously states repeatedly that claim 13 is directed to the subcombination of a "safety device" and that the claim recitation concerning "the ladder ..." merely defines the environment with which the safety device is configured to interact.

Consistent with the appellant's above noted explanation, one having ordinary skill in this art would consider the language of claim 13 as defining a "safety device" alone. The examiner's opposing viewpoint appears to be based solely on his implicit presumption that positive recitation of an element such as "the ladder" in claim 13 necessarily indicates that the element is a part of the claimed subject matter. We are aware of no authority for such a presumption, and the examiner cites none. To the contrary, the non-claimed environment was positively recited in the claims of Orthokentics v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1 USPQ2d 1081, and these claims were held to comply with the second paragraph requirements of § 112.

Appeal No. 2005-2435
Application No. 10/407,498

In light of the foregoing, we hereby reverse the examiner's § 112, second paragraph, rejection of claim 13.

We also hereby reverse the examiner's § 102 rejection of claims 1-3, 5, 7-10 and 13-20 as being anticipated by Allred. As correctly argued by the appellant, Allred contains no teaching that his safety device includes an arm and a holding mechanism for performing the attachment functions defined by independent claim 1 as well as the other independent claims on appeal. In response to this argument, the examiner makes the following statements in the paragraph bridging pages 5-6 of the answer:

As concerns remarks pertaining to the use of the ladder attachment of Allred, the examiner takes the position that the "use" of a device is not given patentable weight within an "apparatus" claim, and since Allred clearly sets forth an "arm" having two ends with a flexible portion therebetween, and holding mechanism that *can be used* to attach to any kind of support or building, the reference and rejections (as advanced above) appear to the examiner to be appropriate.

It is well established, of course, that the patentability of an apparatus claim is based on the apparatus rather than the manner in which it is used. For example, see In re Casey, 370 F.2d 576, 579-80, 152 USPQ 235, 238 (CCPA 1967). Nevertheless, to anticipate an apparatus claim, the prior art apparatus must not only possess the claimed structure but also must possess at least the capability of performing the functions required by the apparatus claim, and it

Appeal No. 2005-2435
Application No. 10/407,498

is the examiner's burden to establish the reasonableness of believing that such functional limitations are an inherent characteristic of the prior art apparatus. See Ex parte Levy, 17 USPQ2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990) and Ex parte Skinner, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986).

Here, the examiner has not even attempted much less succeeded in establishing that Allred's safety device is capable of being attached to a ladder and a structure in the manner required by the appealed claims. Stated otherwise, the answer contains no discussion at all of any technique for attaching patentee's safety device to a ladder and to a structure in the manner required by the appellant's claims. Under these circumstances, we are compelled to determine that the examiner has failed to carry his burden of establishing a prima facie case of anticipation based on his implicit theory that the Allred device is inherently capable of performing the attachment functions of the claims before us. Compare In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

For analogous reasons, the § 103 rejection of claims 4, 11 and 12 over Allred likewise is hereby reversed. Even if the Allred safety device were modified in the matter proposed by the examiner in these rejections, there still would be lacking a prima facie

Appeal No. 2005-2435
Application No. 10/407,498

case for believing that the so-modified device would be inherently capable of performing the attachment functions defined by the appellant's independent claims. That is to say, the § 103 rejection under review is deficient in the same manner as the previously discussed § 102 rejection.

As for the § 103 rejection of claim 6 over Allred in view of Micro Mark Catalogue, the examiner concludes that:

"[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the holding mechanism of Allred by incorporating a clamp, as taught by the Micro Mark Catalogue, in order to more easily and securely removably attach the end of the safety device to a structure" (Answer, pages 4-5).

We cannot agree. As explained by the appellant, the here applied references contained no teaching or suggestion for the combination proposed by the examiner. Indeed, a clamp of the type taught by Micro Mark Catalogue is plainly incompatible with Allred's teaching of the manner in which his safety device is to be used. Under these circumstances, it is reasonably apparent that the examiner's conclusion of obviousness is based upon impermissible hindsight. See W. L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert denied, 469 U.S. 851 (1984).

Appeal No. 2005-2435
Application No. 10/407,498

It follows that we also hereby reverse the § 103 rejection of claim 6 over Allred in view of Micro Mark Catalogue.

OTHER ISSUES

We consider it appropriate to emphasize that our above noted opinion does not forestall the possibility that a prima facie case of anticipation may be established under an inherency theory against, for example, appealed claim 1 based on the Allred patent. As fully explained in this opinion, the § 102 rejection of this claim is deficient because the examiner had not even attempted to provide any analysis in support of a belief that patentee's safety device possesses the inherent capability of performing the attachment functions of claim 1. Therefore, upon return of this application to the jurisdiction of the Examining Corps, it would behoove the Examiner as well as the appellant to consider whether the safety device of Allred inherently possesses the functionally defined attachment limitations of, for example, appealed claim 1. See In re Schreiber, 128 F.3d at 1477, 44 USPQ at 1431-32.

Similarly, it would behoove the Examiner as well as the appellant to consider whether other prior art apparatus might render at least certain of the appealed claims unpatentable

Appeal No. 2005-2435
Application No. 10/407,498

based on an inherency theory. For example, the examiner and the appellant should consider whether such a theory would support a finding that appealed claim 1 is anticipated by such prior art apparatus as a bungee cord having a metal hook at each end. Again, see In re Schreiber, Id.

SUMMARY

We have reversed each of the § 112 (second paragraph), § 102 and § 103 rejections advanced on this appeal because in each rejection the examiner has failed to carry his burden of establishing a prima facie case of unpatentability. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Appeal No. 2005-2435
Application No. 10/407,498

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Appeal No. 2005-2435
Application No. 10/407,498

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