

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN ROLPH

Appeal No. 2006-1400
Application No. 10/649,128
Technology Center 3700

Decided: July 30, 2007

Before WILLIAM F. PATE, III, TERRY J. OWENS and JENNIFER D. BAHR,
Administrative Patent Judges.

PATE, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-13. These are the only claims remaining in the application. We have jurisdiction under 35 U.S.C.

§§ 134 and 6.

Appellant claims a cover for a tiki torch. The cover is a generally cylindrical outer housing and enclosed upper end with a drawstring in a conduit on the lower end.

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A torch cover comprising:

a generally cylindrical outer housing closed at an upper end by an upper housing cover opposite an entry orifice at a lower end;

a circumscribing conduit formed about a lower circumference of said outer housing near said entry orifice and having a conduit entry;

an internal retention volume formed within said housing of a dimension approximately 10" wide and 12" long;

a drawstring entering and exiting said conduit entry in a manner such as to entirely circumscribe said lower [end] of said cylindrical outer housing; and

drawstring retention means, said drawstring retention means comprising a spring clip, said spring clip for impinging movement of said drawstring.

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

Kumasaka	4,477,247	Oct. 16, 1984
Spector	5,135,222	Aug. 4, 1992
Moore	5,775,722	July 7, 1998
Romero	6,102,076	Aug. 15, 2000

Claim 8 stands rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter of Appellant's invention.

Claims 1-3 stand rejected under 35 U.S.C. § 103 as unpatentable over Moore in view of Spector.

Claims 9-13 stand rejected under 35 U.S.C. § 103 as unpatentable over Moore in view of Spector and further in view of Romero.

Claims 1-3 and 9-12 stand rejected under 35 U.S.C. § 103 as unpatentable over Romero in view of Moore and further in view of Spector.

Claims 4-8 stand rejected under 35 U.S.C. § 103 as unpatentable over Moore in view of Spector and further in view of Kumasaka or Romero in view of Moore, Spector, and further in view of Kumasaka.

ISSUES

As noted above the issues for our consideration in this appeal are the indefiniteness rejection of claim 8 and the obviousness rejections of claims 1-13. In addition, we enter a new rejection of claim 8 under 35 U.S.C. § 112, first paragraph.

FINDINGS OF FACT

The following are our findings of fact as to the scope and content of the prior art and the differences between the prior art and the claimed subject matter. Moore

discloses a protective cover for any protruding, vertically-extending post which remains when an automobile roof is removed by emergency responders after an accident. The protective cover has a generally cylindrical outer housing 12 and an upper housing cover 18. The cover is opposite the other open end or entry orifice 16. The Figure 3 embodiment has a circumscribing conduit 34 with a drawstring 35 therein. A drawstring retention means 38 is provided. The material disclosed is canvas, nylon fabric or vinyl-coated nylon fabric. Moore differs from the claimed subject matter in that it does not disclose the exact housing dimensions, and it does not expressly disclose that the fastener is a spring clip-type fastener.

Romero discloses an exhaust pipe cover for a vertically oriented exhaust pipe 12 of a truck 10 or similar vehicle. The cover is designed to prevent precipitation and dirt from entering the exhaust pipe while the truck is not being operated. Romero has a generally cylindrical outer housing 18, an upper housing cover 20, and an entry orifice at 22. A conduit, unnumbered, circumscribes the bottom of the cover and contains a drawstring 32. The drawstring has a retention means 49, 51 so that the drawstring may be snugged-up to give a tight fit. Romero is manufactured out of fire retardant material. Romero differs from the claimed subject matter in that Romero does not have the specific volume claimed, and Romero does not disclose a spring clip-type fastener.

Spector discloses a ball having an outer cover 10 and an inner balloon 11. The cover of Spector is pulled tight by a drawstring 14 which is held in position by a spring clip toggle 16. A button 17 is pressed to release the grip and slide the toggle along the drawstring. Thus, Spector discloses Appellant's spring clip. Spector differs from the claimed invention in that, while it shows a cover 10, the cover is not so much for article protection as it is to form a playable surface.

Finally, Kumasaka shows a conventional luau or tiki lamp with a metal snuffer or cap 40 attached to the tiki pole by a chain tether. Kumasaka does not disclose a cover for the entire tiki lamp.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be

obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact. *Regents of Univ. of Cal. v. Eli Lilly and Co.*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991)). To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention.” *Id.* (citing *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997) and *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (“[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”)). Thus, an applicant complies with the written description requirement “by describing the invention, with all its claimed

limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Id.* (citing *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966).

It is important to note that “[t]he invention is, for purposes of the ‘written description’ inquiry, whatever is now claimed.” *Vas-Cath*, 935 F.2d at 1564, 19 USPQ2d at 1117.

With regard to the second paragraph requirement for “particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention,” it has been stated that the “essence of that requirement is that the language of the claims must make it clear what subject matter they encompass.” *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). This has been frequently stated in a shortened form as a requirement that the claims set forth the “metes and bounds” of their coverage. See, merely for example, *In re Venezia*, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976); *In re Goffe*, 526 F.2d 1393, 1397, 188 USPQ 131, 135 (CCPA 1975); *In re Watson*, 517 F.2d 465, 477, 186 USPQ 11, 20 (CCPA 1975); *In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). This requirement has usually been viewed from the perspective of a potential infringer, “so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance.” *Hammack*, 427 F.2d at 1382, 166 USPQ at 208.

ANALYSIS

Turning to the rejection of claim 8 under 35 U.S.C. § 112, second paragraph, we will not sustain this rejection.

The second paragraph is concerned with the definiteness of the claim language, and the examiner has failed to identify a problem with the text of claim 8.

Under our authority pursuant to 37 C.F.R. § 41.50(b) we enter the following rejection. Claim 8 is rejected under 35 U.S.C. § 112, first paragraph, based on a lack of written description. The Specification identifies various materials that the cap 40 is made of. Listed are metal, stone, glass, plexiglass [sic, Plexiglas®], acrylic, ceramic, mortar, fire resistant nylon, and other similar materials. None of these materials is a fire resistant fabric. Nylon is a generic name for several rigid polymers that can be made into filaments and woven or knitted into fabric. Nylon by itself is not such a fabric. Thus, the Specification fails to demonstrate that Appellant was in possession of the subject matter of a cap made of fire resistant fabric.

Turning to obviousness, we are in agreement with the Examiner that one of ordinary skill in the protective covering art would have found it prima facie obvious to have replaced the drawstring fastener of Moore or Romero with a spring clip fastener as taught by Spector for the self-evident advantage of convenience in adjusting the drawstring length. We are further in agreement with the Examiner that it is within the skill in this art to fabricate the protective cover of an appropriate size according to the size of the object desired to be covered. Finally, the circumscribing conduit would have been an obvious modification, since both

Moore in Figure 3 and Romero teach such conduits for drawstrings. Appellant has provided no argument or evidence rebutting these conclusions of obviousness made by the Examiner. Consequently, we affirm the standing rejections of claims 1-3 based on the disclosure of Moore and Spector, claims 9-13 based on the disclosure of Moore, Spector, and Romero, claims 1-3 and 9-12 based on the disclosure of Moore, Spector and Romero, and claims 4-8 based on the disclosure of Moore, Spector and Kumasaka or Romero, Moore, Spector, and Kumasaka.

Appellant argues that the references cited, save for the reference to Kumasaka, are from nonanalogous arts. It is apparent that the old standard for analogous art has been put aside by the Supreme Court in *KSR*. As the court explained, and as we quoted previously, when a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it either in the same field or a different one. If a person of ordinary skill can implement a predictable variation § 103 likely bars its patentability. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

However, even under the old analogous art test, Romero, which is directed to preventing precipitation and dirt from entering an exhaust pipe while the pipe is not in use, is reasonably pertinent to the problem the claimed subject matter is concerned with. Additionally, we note that both Romero and Moore are concerned with protective coverings for vertically extending post-like objects in general. Due to their particular shape it is our conviction that they are reasonably pertinent to the particular problem which the present inventor was involved.

Concerning Appellant's arguments regarding motivation to combine the reference teachings, the teaching-suggestion-motivation test argued by Appellant was identified by the Supreme Court as only one test for the obviousness of a

claimed invention under § 103. As noted above, the examiner has provided a rationale for using the spring-clip disclosed by Spector on the covers of Moore and Romero and has concluded that the exact size of the cover depends on the dimensions of the article that is desired to be covered.

With respect to Appellant's arguments directed to claims 4-8, which claim a cap in combination with a cover, we note that the cap and cover are known elements which function in a known way and their use together would have yielded predictable results. Under *KSR*, their use together is likely to have been obvious to one of ordinary skill.

CONCLUSION

The rejection of claim 8 under 35 U.S.C. § 112, second paragraph is reversed. A new rejection of claim 8 under 35 U.S.C. § 112, first paragraph, has been entered by the Board pursuant to our authority under 37 C.F.R. § 41.50(b). The obviousness rejections of claims 1-13 have been sustained.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected,

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or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

AFFIRMED; 41.50(b)

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