

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 STEVEN TSENGAS

Appeal No. 2006-1927
Application No. 11/009,164
Technology Center 3600

ON BRIEF

Before CRAWFORD, LEVY and HORNER, *Administrative Patent Judges*.
HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-8, all of the claims pending in the application.

We affirm in part.

BACKGROUND

The appellant's invention relates to a canine chew toy. Claim 1 is representative of the subject matter on appeal, and a copy of this claim can be found in the appendix to the appellant's brief.

The examiner relies upon the following as evidence of unpatentability:

Jiminez 6,634,970 Oct. 21, 2003

The appellant seeks our review of the examiner's rejection of claims 1-8 under 35 U.S.C. § 102(e) as being anticipated by Jiminez.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer (mailed March 20, 2006) for the examiner's complete reasoning in support of the rejection and to the appellant's brief (filed February 23, 2006) and reply brief (filed April 3, 2006) for the appellant's arguments.

OPINION

In reaching our decision in this appeal, we have carefully considered the appellant's specification and claims, the applied prior art, the evidence submitted by the appellant, and the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow. It is our view that, after consideration of the record before us, the disclosure of Jiminez anticipates the subject matter of claims 1-6. We reverse the examiner's rejection of claims 7 and 8.

In the rejection of independent claim 1, the examiner has determined that Jiminez discloses a generally spherical body (12) having a plurality of circumferential channels (14, 16, 18) for receiving and housing a plurality of rings (20, 22, 24). (Examiner's Answer, p. 3).

The appellant urges that the limitation of a "chew toy" as recited in the preamble of claim 1, gives "life and meaning" to the remainder of the claim and thus should be a structural limitation of the claim. (Appellant's Reply Brief, p. 3). The examiner has determined that the preamble is not limiting because the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

We agree with the examiner that the preamble of claim 1 is not necessary to breathe life or meaning to the remainder of the claim, and as such, the preamble is not a limitation of the claim. "[W]here a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation." *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). "The determination of whether preamble recitations are structural limitations or mere statements of purpose or use 'can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.'" *Rowe*, 112 F.3d at 478, 42 USPQ2d at 1553 (citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)).

Inspection of the written description, claims and figures reveals that “chew toy” is not a structural limitation of the claims. First, the body of the claim defines a structurally complete invention. Second, the “chew toy” recitation in the preamble does not provide antecedent basis for any elements in the claim body, nor does it set out any relationship among the elements in the claim body. As such, we hold that the phrase “chew toy” in the preamble is not a structural limitation of the claim but is merely a recitation of the intended use of the claimed structure.

The appellant further contends that the basketball disclosed in Jiminez is not capable of being used as a chew toy, because the standard size for a basketball (i.e., nine to ten inches in diameter) is not suitable for use as a chew toy. The appellant cites in support of his argument the FIBA (International), National Basketball Association and NCAA standards for basketball sizing. (Appellant’s Brief, p. 6). The examiner has determined that the basketball of Jiminez is capable of being employed as a chew toy, and the appellant has not provided any evidence to support his position that the basketball of Jiminez is incapable of such use. (Examiner’s Answer, pp. 4-5).

We find that the prior art basketball of Jiminez contains all of the limitations of claim 1 and is capable of performing the intended use of a chew toy and thus meets the claim. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (“It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.”) We do not find persuasive the appellant’s argument that the basketball of Jiminez must necessarily

conform to the size of a regulation basketball. As such, we sustain the examiner's rejection of claim 1.

With regard to claims 2-5, the appellant does not present arguments as to the separate patentability of these claims. As such, we sustain the examiner's rejection of these dependent claims on the grounds provided by the examiner in the Answer.

With regard to claim 6, the examiner has determined that Jiminez discloses rings defined by a toroidal form and snap-fit into a corresponding one of the channels. (Examiner's Answer, p. 3).

The appellant contends that "snap fit" means,

a mechanical joint system where part-to-part attachment is accomplished with locating and locking features (constraint features) that are homogenous with one or the other of the components being joined. Joining requires the (flexible) locking features to move aside for engagement with the mating part, followed by return of the locking feature toward its original position to accomplish the interference required to latch the components together. Locator features, the second type of constraint feature, are inflexible, providing strength and stability in the attachment. (Appellant's Brief, p. 6).

The examiner responds that the specification is silent as to the specific requirements of a "snap fit" as argued by the appellant in his brief, and that the specification discloses only that the "snap-fitting relationship relates such a fitting to a frictional fit." (Examiner's Answer, p. 5). The examiner has further determined that the elastic rings of Jiminez are removably received within the respective grooves and are flexible so that they can deform and then snap back into

their original shape to be held by a frictional snap-fit within the groove.
(Examiner's Answer, p. 5).

We agree with the examiner.

We first construe the meaning of the word “snap-fit” as used by the appellant in the claims. We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)). The specification does not provide any description of the specific elements of a “snap-fit.” In contrast, the specification generally describes the fit between the ring and channel as an “interference” or “frictional fit.” (Specification, page 5, line 3). As such, the broadest reasonable construction of “snap-fit” in light of the specification includes any connection made using an interference fit or frictional fit. The term “snap-fit” is not limited to the specific mechanical joint system as urged by the appellant.

Jiminez discloses an elastic ring 20 in the form of a wedge that is retained within its respective, similarly wedge-shaped slot “in a non-slip condition”. (Jiminez, Figures 5 and 7 and col. 5, lines 1-13 and 27-40). We understand the non-slip condition of Jiminez to refer to a frictional fit between the elastic ring and the slot in the ball. As such, we find that Jiminez discloses toroidal rings that are

snap-fit into corresponding channels as recited in claim 6. Accordingly, we sustain the examiner's rejection of claim 6.

With regard to claims 7 and 8, the examiner has determined that Jiminez discloses making the rings of elastic "which is known in the art to usually comprise a rubber material which is known to be a well known component of animal chew toys and therefore the rings of Jiminez are considered to comprise a tasteful flavor and an appealing scent attractive to canines." (Examiner's Answer, p. 4). As such, the examiner has determined, "Jiminez, while not positively stated, inherently discloses through the choice of material, a device having a scent and flavour considered appealing to a canine." (Examiner's Answer, p. 6).

The appellant contends that the examiner has failed to provide any evidence in support of the position that the elastomeric or rubber material of Jiminez inherently possesses a tasteful flavor and scent attractive to a canine and that the examiner's unsupported assertions are insufficient to support an anticipation rejection. (Appellant's Reply Brief, p. 3).

We decline to sustain the examiner's rejection of claims 7 and 8, because the examiner has failed to provide any evidentiary support for the assertion that an elastomeric or rubber material comprises "a tasteful flavor appealing and attractive to a canine" or "a pleasant and appealing scent attractive to a canine." We find unpersuasive the examiner's reasoning that because it is known to make canine chew toys from rubber material that such material is necessarily a tasteful flavor or a pleasant and appealing scent attractive to a canine.

CONCLUSION

To summarize, we sustain the rejection of claims 1-6, and we do not sustain the rejection of claims 7 and 8.

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

AFFIRMED IN PART

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| Administrative Patent Judge |) |
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| STUART S. LEVY |) |
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|) LINDA E. HORNER | |
| Administrative Patent Judge |) |

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