

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 RANDY OXLEY

Appeal 2007-1920
Application 09/731,437
Technology Center 3700

Decided: July 25, 2007

Before HUBERT C. LORIN, LINDA E. HORNER, and DAVID B. WALKER,
Administrative Patent Judges.

WALKER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Randy Oxley (“Appellant”) seeks our review under 35 U.S.C. § 134 of the Examiner’s final rejection of claims 1, 6-10, 13, 21, 22, 24-26, 28, and 29. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We reverse.¹

THE INVENTION

Appellant claims a holder adapted to support a stringed bow in a generally horizontal position outwardly from a hunter’s body at a position below the hunter’s waist (Specification 7:18-21). Claim 1, the only independent claim, is representative of the subject matter on appeal.

1. A holder adapted to support a stringed bow in a generally horizontal position outwardly from a hunter's body at a position below the hunter's waist comprising:
 - a support member;
 - a spacing member combined with the support member and extending generally inwardly and upwardly therefrom; and
 - an engagement member combined with said spacing member and being disposed generally above and inward from the support member;
 - the support member comprising an inward section and an outward section, said sections forming an upwardly concave surface.

¹ Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

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THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Jones	US 5,248,072	Sep. 28, 1993
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Claims 1, 6-10, 13, 21, 22, 24-26, 28, and 29 are rejected under 35 U.S.C. § 102(b) as anticipated by Jones.

ISSUE

The issue before us is whether Appellant has shown that the Examiner erred in rejecting claims 1, 6-10, 13, 21, 22, 24-26, 28, and 29 under 35 U.S.C. 102(b) as anticipated by Jones. The issue turns on whether Jones discloses a “spacing member” as required by each of the appealed claims.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Specification describes a spacing member that is “adapted to combine the engagement member and the spacing member so that the supporting member is held in a position generally below the engagement member and outwardly from the hunter’s body” (Specification 9:20-10:2).

2. According to the Specification, “[w]hat is clear is that the holder must provide for a means to support a bow, extend this support at a selected distance from a hunter's body and below the hunter's waist and allow for the direct or indirect engagement of the holder with the hunter or the hunter's apparel” (Specification 12:2-5).
3. Jones does not disclose a spacing member as required by each of the appealed claims (Jones, *passim*).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. 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) (en banc) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)). The properly interpreted claim must then be compared with the prior art.

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily

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present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted).

ANALYSIS

We first construe the meaning of the phrase “spacing member” as used by the Appellant in claim 1, from which all appealed claims depend. The Specification makes clear that the “spacing member” holds the support member in a position generally below the engagement member and outwardly from the hunter’s body (Finding of Fact 1). The Specification further includes language that the “spacing member” must “extend th[e] support at a selected distance from a hunter's body and below the hunter's waist and allow for the direct or indirect engagement of the holder with the hunter or the hunter's apparel.” (Finding of Fact 2). Giving the claims their broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art, we therefore construe “spacing member” to mean a member that extends the support member a selected distance from a hunter’s body and below the hunter’s waist. This is consistent with the plain language of the claim that the spacing member extends generally inwardly and upwardly from the support member.

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Based on the above claim construction, the rejection of claims 1, 6-10, 13, 21, 22, 24-26, 28, and 29 as anticipated by Jones is improper, because Jones does not disclose each and every limitation as set forth in claims 1, 6-10, 13, 21, 22, 24-26, 28, and 29, either expressly or inherently. In particular, Jones fails to anticipate independent claim 1, because it does not teach a spacing means (Finding of Fact 3). The Examiner marked up Figure 3 of Jones to show where he believes the engagement member, spacing member, and support member are disclosed (Answer, Appendix). However, the spacing member described by the Examiner in Jones does not hold the supporting member generally below the engagement member and outwardly from the hunter's body as required by each of the appealed claims. Because Jones fails to disclose each limitation of independent claim 1, it also fails to anticipate dependent claims 6-10, 13, 21, 22, 24-26, 28, and 29.

CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1, 6-10, 13, 21, 22, 24-26, 28, and 29 under 35 U.S.C. § 102(b) as anticipated by Jones.

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DECISION

The decision of the Examiner to reject claims 1, 6-10, 13, 21, 22, 24-26, 28, and 29 is reversed.

REVERSED

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James C. Nemmers
P.O. Boc 2107
Cedar Rapids, IA 52406