

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIO BOSCHETTI and CLAUDIO BOSCHETTI

Appeal No. 2008-1397
Application No. 10/362,721
Technology Center 3600

Decided: September 29, 2008

Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and JOHN C. KERINS,
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 and 3-8. These are all the claims in the application. We have jurisdiction under 35 U.S.C. §§ 134 and 6(b) (2002).

The claimed invention is directed to a top pole support for supporting three aerial electric power lines on the top of a utility pole. Claim 1, reproduced below, is further illustrative of the claimed subject matter.

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1. Top pole support for supporting three aerial electric power lines with suspended wires, on the top of a pole comprising,

an elongated body with a shape that traces a continuous curve substantially passing through three mutually laterally displaced points, said curve being a continuous open curve having a bend and two arms,

three insulators each connected to said body at, and suspended beneath, a respective one of said points, one of said points being on one of said arms and another of said points being on the other of said arms,

said two arms having respective free ends separated by a space through which a segment of said wire intermediate its ends can be passed for separating said wire from said pole support without cutting said wire, and

a bracket adapted for being mounted on the top of said pole, said bracket being fastened to a lower one of said two arms for supporting said body substantially entirely above the top of said pole.

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

Scott	US 3,603,717	Sep. 7, 1971
Farmer	US 3,653,622	Apr. 4, 1972
Hardison	US 5,788,201	Aug. 4, 1998

Claims 1 and 3-7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claim 5 stands rejected under 35 U.S.C. § 112, first paragraph, as directed to subject matter which lacks an enabling disclosure.

Claim 7 stands rejected under 35 U.S.C. § 112, first paragraph, as directed to subject matter which lacks an enabling disclosure.

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Claims 1, 3, 4, 6 and 8 stand rejected under 35 U.S.C. § 102(b) as anticipated by Scott.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Scott in view of Farmer.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Scott in view of Hardison.

PRINCIPLES OF LAW

35 U.S.C. § 112, ¶ 2 requires that the specification of a patent “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” Because claims delineate the patentee’s right to exclude, the patent statute requires that the scope of the claims be sufficiently definite to inform the public of the bounds of the protected invention, i.e., what subject matter is covered by the exclusive rights of the patent. Otherwise, competitors cannot avoid infringement, defeating the public notice function of patent claims. *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996) (“[T]he primary purpose of the requirement is ‘to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their [respective] rights.’”) (quoting *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369, (1938)). The Supreme Court has stated that “[t]he statutory requirement of particularity and distinctness in claims is met only when [the claims] clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise.” *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942).

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“The enablement provision of the Patent Act requires that the patentee provide a written description of the invention ‘in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.’ 35 U.S.C. § 112, ¶ 1 (2000). The purpose of this requirement is to ensure that ‘the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims.’ *Nat’l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1195-96, 49 USPQ2d 1671, 1675 (Fed. Cir. 1999)(citation deleted). Accordingly, we have held that the specification must provide sufficient teaching such that one skilled in the art could make and use the full scope of the invention without undue experimentation. *CFMT, Inc. v. Yieldup Intl Corp.*, 349 F.3d 1333, 1338, 68 USPQ2d 1940, 1944 (Fed. Cir. 2003); *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1365 42 USPQ2d 1001, 1004 (Fed. Cir. 1997); *In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The key word is ‘undue,’ not experimentation. *Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. That is, the specification need only teach those aspects of the invention that one skilled in the art could not figure out without undue experimentation. See, e.g., *Nat’l Recovery Techs.*, 166 F.3d at 1196, 49 USPQ2d at 1675 (“The scope of enablement . . . is that which is disclosed in the specification plus the scope of what would be known to one of ordinary skill in the art without undue experimentation.”); *Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404 (“Enablement is not precluded by the necessity for some experimentation such as routine screening.”).”

Warner-Lambert Company v. Teva Pharmaceuticals USA, Inc., 418 F.3d 1326, 1337, 75 USPQ2d 1865, 1872 (Fed. Cir. 2005).

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A claimed invention is unpatentable if the differences between it 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.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[1] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739.

ANALYSIS

We have carefully reviewed the rejections on appeal in light of the arguments of the Appellants and the Examiner. As a result of this review, we have reached the conclusion that claims 1 and 3-7 are indefinite under the purview of 35 U.S.C. § 112, second paragraph. We have further reached the conclusion that the subject matter of claims 1, 3, 4, 6 and 8 does not lack novelty over Scott, nor are claims 5 and 7 prima facie obvious from Scott and Farmer or Scott and Hardison, respectively. Additionally, we conclude that claim 5 is not directed to subject matter which lacks an enabling disclosure under § 112, first paragraph, and claim 7 is directed to subject matter that lacks an enabling disclosure under that provision of the statute. We also enter a rejection of claims 6 and 7 under 35

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U.S.C. § 112, second paragraph, pursuant to our authority under 37 C.F.R. § 41.50
(b). The reasons for our determinations follow.

Turning to a consideration of independent claim 1, we agree with the Examiner that the limitation of a “lower one of said two arms” lacks sufficient antecedent basis in claim 1. The Examiner states that the Appellants have not distinguished that the two arms include a lower one and an upper one. We agree that claim 1 has not recited a spatial relationship between the two arms in a vertical direction or a vertical plane and certainly has not recited that one arm is positioned lower than another arm. Therefore, we are in agreement with the Examiner that one of ordinary skill could not determine what claim element “a lower one of said two arms” is referring to in claim 1. Claims 3-7 fall with claim 1 on this ground of rejection.

Appellants argue that similar claim language has been allowed in numerous issued patents. Appellants’ counsel provides no evidence that this is the case. Even if true, this argument is clearly irrelevant to the subject matter at hand. Whether some similar limitation in another claim appended to another specification has been allowed is simply irrelevant to the issue of whether this limitation is indefinite in this claim appended to this specification.

Appellants’ Appeal Brief does not mention the additional basis for rejection of claim 4 under 35 U.S.C. § 112, second paragraph. We summarily sustain this rejection as there is no antecedent basis for “the insulating means” as it appears in claim 4.

Turning to the rejection of claims 5 and 7 under 35 U.S.C. § 112, first paragraph, as lacking enablement, we do not sustain the rejection of claim 5.

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The rejection of claim 5 is based on a faulty claim construction. Claim 5 simply states that the top pole support comprises a tubular element. This open-ended claim merely requires one of the elements of the top pole support such as the elongated body to be tubular.

With respect to the rejection of claim 7 we will sustain the rejection of this claim as directed to subject matter lacking an enabling disclosure. While the Examiner fails to discuss the Wands factors in detail, the Examiner is convincing to the extent that there is a lack of guidance in the specification of how to construct a top pole support including a bracket and insulators wherein the support is a spiral. For example, Figure 3a is directed to a spiral, actually a helical embodiment, with two free ends. The bracket is not even shown, and the bracket and insulators, both claimed as part of the spiral top pole support, certainly cause the support to depart from a spiral profile. We must point out that the language here is different from the language of claim 5, which merely states one element is tubular. In claim 7, the top pole support, which includes the bracket and insulators, is said to be spiral-shaped.

Turning to the rejection of claims 1, 3, 4, and 6 as anticipated by Scott under § 102, the rejection of claim 5 as prima facie obvious from Scott and Farmer, and the rejection of claim 7 as prima facie obvious from Scott and Hardison, we reverse these rejections. Appellants' argument is that Scott does not show upper and lower arms. As noted above, this subject matter does not pass muster under § 112, second paragraph. There is no indication in the claimed subject matter that Appellants are claiming that the arms are in different horizontal planes from one another. The indication that one arm is lower *might* indicate that the "points" of

claim 1 are vertically spaced, but we should not base our decisions under §§ 102 or 103 on such an assumption. Since we are unable to properly construe claim 1 to apply the prior art, the rejections of claim 1, 3, 4, 5, 6, and 7 under §§ 102 or 103 are reversed. Note that this is a technical reversal not to be construed as a reversal on the merits.

With respect to the § 102 rejection as it pertains to independent claim 8, Scott shows an elongated body shaped in a continuous open curve having a bend and two arms with respective free ends. Scott further provides a bracket (support legs 14 and securing means 15) fastened to one of the arms (in fact, the bracket fastens to both arms) and three horizontally, laterally displaced insulating means 16 suspended beneath the curve. (Scott, fig. 1.) However, Scott does not show a top pole support providing a continuous open curve when fastened to the top of the pole, because the bracket, part of the top pole support, blocks a portion of the curve from being open. Thus the § 102 rejection of claim 8 as anticipated by Scott is reversed.

REJECTION UNDER 37 C.F.R. § 41.50(b)

Claims 6 and 7 are rejected under 35 U.S.C. § 112, second paragraph, in that they require a spiral-shaped top pole support. To the extent that claim 7 is directed to the embodiment shown in Figures 3a and 3b, it is not seen how the spiral-shaped top pole support 42A can be said to be an open curve as required in the first clause of claim 1. Furthermore, if claim 6, which claims a nonplanar continuous curve, is directed to the Figure 3a embodiment, claim 6 is also not directed to a continuous

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open curve as claimed in the first clause of claim 1. These inconsistencies render claims 6 and 7 indefinite.

SUMMARY

The rejection of claims 1 and 3-7 under 35 U.S.C. § 112, second paragraph, is affirmed.

The rejection of claim 5 under 35 U.S.C. § 112, first paragraph, as lacking an enabling disclosure, is reversed.

The rejection of claim 7 under 35 U.S.C. § 112, first paragraph, as lacking an enabling disclosure, is affirmed.

The rejection of claims 1, 3, 4, and 6 under 35 U.S.C. § 102 is not sustained.

The rejection of claim 5 under 35 U.S.C. § 103 is not sustained.

The rejection of claim 7 under 35 U.S.C. § 103 is not sustained.

The rejection of claim 8 under 35 U.S.C. § 102 is not sustained.

A new rejection of claims 6 and 7 under 35 U.S.C. § 112, second paragraph, has been entered by the Board.

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "[a]ppellants may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new

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ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 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, 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 the Appellants elect to prosecute further before the Examiner pursuant to 37 CFR § 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 rejection, 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 rejection is overcome.

If the Appellants elect 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 rejection, including any timely request for rehearing thereof.

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

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AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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