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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM JAMES LEWIS

Appeal 2015-002849
Application 13/253,122
Technology Center 3600

Before JAMES P. CALVE, BRANDON J. WARNER, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

William James Lewis (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–20, which are all the pending claims. Appeal Br. 2. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

Appellant’s disclosed invention “relates generally to a footing for a support and, more particularly, to a support footing for a pole for holding up a tarp or cover, such as for a boat.” Spec., p. 1, ll. 9–11. Claims 1, 12, and 18 are independent. Claim 1, reproduced below with emphasis added, is illustrative of the subject matter on appeal.

1. A footing for a boat cover support pole, comprising:
 - a base having an outer periphery and a top surface, *the base formed of a flexible polymer material*;
 - a support receiver connected to and extending above the top surface of the base within the outer periphery; and
 - the base including a slit extending from the outer periphery toward the support receiver, wherein the base is adapted to be set upon a surface of a boat and the support receiver is adapted to receive a boat cover pole.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Sweet	US 5,685,107	Nov. 11, 1997
Doeringer	US 5,901,525	May 11, 1999
Carnevali	US 8,505,861 B2	Aug. 13, 2013

REJECTIONS

The following rejections are before us for review:

- I. Claims 1–6, 9–13, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweet and Carnevali. Final Act. 2–7.
- II. Claims 7, 8, 14, 15, and 18–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweet, Carnevali, and Doeringer. *Id.* at 7–13.

ANALYSIS

All the claims recite, in relevant part, a base formed of a “flexible polymer” material that includes a slit therein. *See* Appeal Br., Claims App. In rejecting the claims, the Examiner takes the position that Sweet discloses such a base formed as claimed, because its base is “capable of being made out of stainless steel, other metals, hard plastics, fiberglass[,] or the like,” explaining that “[hard] plastics include flexible polymer materials and fiberglass is a flexible polymer material since it is made out of a plastic or polymeric material with glass inserts.” Final Act. 3 (citing Sweet, col. 5, ll. 12–16); *see id.* at 4–5, 8–9 (same position regarding Sweet’s disclosure).

Appellant persuasively asserts that the rejections are deficient because Sweet does not teach or suggest that its base is, or could be, formed from a “flexible polymer” material as the Examiner posits. *See* Appeal Br. 8–10; Reply Br. 2–3. Although the Examiner is obliged to apply the broadest reasonable interpretation to claim terms during prosecution, such an interpretation must remain reasonable in light of the Specification, and consistent with the interpretation that one of ordinary skill in the art would

reach. *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999); MPEP § 2111.01. Here, the Examiner’s position regarding the material of Sweet’s base is not supported by a preponderance of the evidence (indeed, all of the possible materials disclosed by Sweet are rigid rather than flexible), and essentially reads out “flexible” from the claimed structure.¹ Such a claim interpretation, which misconstrues the constraint of the recited “flexible polymer,” and effectively reads out this limitation from the claim, is unreasonable.² *See Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007) (denouncing claim constructions that render phrases in claims superfluous).

¹ A plain meaning of “flexible” is “capable of being flexed” (that is, capable of bending, especially repeatedly), or “pliant,” which is consistent with the use of this term within Appellant’s Specification. *See Merriam-Webster’s Collegiate Dictionary* (11th ed. 2003); *see also* Spec., p. 2, ll. 13–21; p. 3, ll. 1–4; p. 6, l. 14 – p. 7, l. 17. Accordingly, a “flexible polymer,” in the context of the claim language, would be a polymer that is capable of bending, as opposed to a rigid polymer. Appellant discloses a Shore A hardness range of “up to about 80, and desirably about 20 to 60,” for the flexible polymer. Spec., p. 7, ll. 5–7; *see also* Claims 4, 13, and 19 (each reciting “a Shore A hardness of about 80 or less”). But the Examiner does not present any findings regarding materials disclosed in the cited art that may fall within such ranges. *See* Final Act. 2–3; Ans. 13–16.

² The Examiner correctly notes that Appellant’s Specification lists various suitable materials for the base, which may include rigid polymers (indeed, Appellant’s Specification broadly discloses that such materials include “rigid and/or flexible polymers”). Spec., p. 6, ll. 16–18; *see* Ans. 13–16 (citing same). Nevertheless, Appellant is permitted to disclose broadly and then choose to claim more narrowly (here, by limiting the base to being formed only of “flexible polymer” materials).

Given a proper construction of the recited “flexible polymer,” as *excluding* rigid materials, we agree with Appellant that the Examiner has not established a finding supported by a preponderance of the evidence of any disclosure in Sweet of such a “flexible polymer” for its base, as relied on in the rejections.³ We note that Carnevali is relied on for disclosing a slit in the base, but not to cure the deficiency of Sweet identified above, despite the Examiner’s statement that Carnevali discloses a flexible base. *See* Final Act. 5–6 (citing Carnevali, col. 9, ll. 4–9; Fig. 14); *see id.* at 10–11 (reliance on same teachings from Carnevali). Accordingly, we do not sustain Rejection I.

Regarding Rejection II, we note that this rejection is premised on the same purported disclosure from Sweet, and that Doeringer (like Carnevali) is relied on for teaching additional features, but not to cure the deficiency of Sweet identified above. Thus, we also do not sustain Rejection II.

³ We note that any consideration of what one of ordinary skill in the art may deem obvious regarding use of other suitable materials for Sweet’s base, such as flexible polymer materials, is immaterial to the unsupported finding relied on in the rejections before us for review. We further note that the Patent Trial and Appeal Board is a review body, rather than a place of initial examination, and we therefore decline to make a determination of what one of ordinary skill in the art may conclude; rather, we leave it to the Examiner to determine the appropriateness of any further course of action based on such a conclusion should there be further prosecution of this application. *See Ex Parte Frye*, 94 USPQ2d 1072, 1075–77 (BPAI 2010) (precedential).

Appeal 2015-002849
Application 13/253,122

DECISION

We REVERSE the Examiner's decision rejecting claims 1–6, 9–13, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Sweet and Carnevali.

We REVERSE the Examiner's decision rejecting claims 7, 8, 14, 15, and 18–20 under 35 U.S.C. § 103(a) as being unpatentable over Sweet, Carnevali, and Doeringer.

REVERSED