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CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			VANTERPOOL, LESTER L	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PETER REINHART

Appeal 2018-008237
Application 13/232,693
Technology Center 3700

Before JENNIFER D. BAHR, EDWARD A. BROWN, and
CHARLES N. GREENHUT, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–17, which constitute all the claims pending in this application. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on March 4, 2020.

We AFFIRM IN PART.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Bayerische Motoren Werke Aktiengesellschaft, as documented in an assignment recorded on November 7, 2011 at Reel/Frame 027181/0870. Appeal Br. 1.

CLAIMED SUBJECT MATTER

The claims are directed to a luggage container for fastening to a vehicle, in particular to a motorcycle. Claim 1, reproduced below, is the sole independent claim before us:

1. A luggage container fastenable to a vehicle, comprising:
 - a case;
 - a first locking device of the case having a release position in which the luggage container is openable, and a locking position in which the first locking device blocks opening of the luggage container and the luggage container is not openable; and
 - a second locking device of the case having a locking position in which the luggage container is locked against opening and the luggage container is not openable even if the first locking device is in the release position.

REFERENCES

The prior art relied upon by the Examiner is:

Reference Name	Document ID	Pub. Date
Nakashima	U.S. 4,907,428 A	Mar. 13, 1990
Thompson	U.S. 2006/0112746 A1	June 1, 2006

REJECTIONS

Claims 1–4, 7, 12, 13, and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nakashima. Final Act. 2.

Claims 1–11 and 14–17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Thompson. Final Act. 4.

OPINION

Nakashima

In rejecting claim 1 as anticipated by Nakashima the Examiner found Nakashima to disclose, inter alia, “the second locking device (17B) of the

container (2) capably having the locking position (i.e.,) Resting not-depressed position of Fig. 2) in which the luggage container (2) is locked against opening.” Final Act. 2–3. Element 17b in Nakashima is a lever that is “operable [] to unlock the terminal lock mechanisms 4 and 5 of the trunk bag 2.” Nakashima col. 3, ll. 39–41. From this disclosure, which includes the use of the words “unlock” and “lock mechanisms” it would initially seem reasonable to regard element 17b of Nakashima as a “locking device” capable of making the container, the trunk bag 2, “locked against opening” according to claim 1. However, a closer review of the entirety of Nakashima’s disclosure indicates that when Nakashima’s key cylinder, the “first locking device” according to the Examiner’s rejection (Final Act. 2), is in the “release position” B, “the trunk bag 2 [is] capable of opening at all times, without operating the key, by operating each of the operating levers 17a, 17b, 17c with a single touch.” Nakashima col. 7, l. 65–col. 8, l. 1; App. Br. 12. Being “capable of opening at all times, without operating the key” cannot reasonably be regarded as “locked against opening and [] not openable even if the first locking device is in the release position,” as claimed.² Accordingly, we do not sustain the rejection predicated on Nakashima

Thompson

In rejecting the claims for lack of novelty based on Thompson, the Examiner relies on the electronic system having wireless transmitter 32 and

² It is noted that in Nakashima’s claims, Nakashima uses the word “latch” as opposed to “lock” to describe this arrangement which seems more consistent with ordinary and customary English-language terminology.

switch 28 as the recited “first locking device” of claim 1. Final Act. 4. According to the Examiner, the recited “release position” is satisfied when switch 28 completes circuit 20 (Final Act. 4. citing Thompson para. 20), and the recited “locking position” is satisfied when relay 36 receives a non-conditioning signal to open circuit 20 (Final Act. 4. citing Thompson para. 19).

The Examiner relies on the lock assembly 2 as the recited “second locking device” and indicates lock assembly 2 has a “manual lock position 94” that satisfies the “locked position” recitation because in the manual lock position 94, the container is “locked against opening” and “not openable” even if Thompson’s electronic locking device, the “first locking device,” is in the release position. Final Act. 5 (citing Thompson paras. 3, 16, 18, 19, 35 and Figure 3).

Appellant argues that “the remote-actuation portions of Thompson identified by the Examiner as the claimed ‘first locking device’ 10 cannot prevent opening of the container – there is no first locking device ‘locking position’ that ‘blocks opening’ of the container such that the container is not openable.” App. Br. 16. However, the Examiner correctly points out that the incomplete circuit 20, by virtue of the absence of current allowing spring 96 to maintain pushrods 97 and 98 in the extending position (Thompson paras. 25–26), effectively “blocks opening” within the broadest reasonable meaning of that term because due to the pushrods’ position “lock pin 52 remains unrotatable” when key 4 is in remote position 8. Ans. 9; Thompson para. 26.

Appellant asserts that Thompson’s container may be opened by manually turning *the lock cylinder* (the *second* locking device according to

the Examiner's rejection) to alternate positions. App. Br. 16–17; *see* Thompson paras. 20, 24. This is inapposite. The requirement that the first locking device “blocks opening” is broadly recited without any qualification as to what particular methods of opening must be blocked. Claim 1 does not require, for example, that the *first* locking device block opening “by actuating,” or “regardless of the position of,” the *second* locking device. If anything, the existence of an express recitation that the locking position of the *second* locking device maintains the locked state of the container “even if the *first* locking device is in the release position” implies, due to the absence of such a corresponding recitation pertaining to a locking position of the *first* locking device, that the locking position of the *first* locking device need not prevent opening *specifically by the second locking device* in any way. The fact that there is a position in Thompson where the electronic locking device prevents opening (circuit open, key in remote position 8) suffices to satisfy the broadly recited “blocks opening” limitation with regard to the first locking device because this limitation, in its present form, is satisfied by blocking opening in any way (Thompson para. 26).

Appellant could have included additional language to indicate that, consistent with the preferred embodiment, the first locking position of the first locking device serves to block opening of the container by, or regardless of the position of, *the second locking device*. *See, e.g.*, Figure 2. However, Appellant chose to incorporate a limitation similar in this regard with respect to only the *second* locking device and not the first. Our reviewing court has “cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.” *In re American*

Academy of Science Tech Center, 367 F. 3d 1359, 1369 (Fed. Cir. 2004) (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004) (“Even when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using ‘words or expressions of manifest exclusion or restriction.’”). “[R]eading a claim in light of the specification,’ to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” *In re Prater*, 415 F.2d 1393, 1404–05 (CCPA 1969).

Contrary to Appellant’s argument (App. Br. 17–18), which does not appear to find any support in Thompson’s disclosure, the manual lock position 94 of Thompson’s cylinder, interpreted by the Examiner as the recited “second locking device,” clearly has a position satisfying the claim language calling for the container to be “locked against opening and [] not openable even if the first locking device is in the release position.” *See* Thompson paras. 19 (“Turning key 4 to the manual lock position 94 will prevent the lock mechanism 2 from opening by preventing latch module 14 from being tripped even if there is a conditioning signal sent to relay switch 36”) and 35 (“This prevents electrical operation of the lock and provides manual lock override of the device for additional security”).

For the foregoing reasons, we sustain the Examiner’s rejection of claim 1 predicated on Thompson and that of those claims not separately argued under 37 C.F.R. § 41.37(c)(1)(iv).

CONCLUSION

The Examiner's rejections are AFFIRMED IN PART.

DECISION SUMMARY

Claims	35 U.S.C. §	Basis/References	Affirmed	Reversed
1-4, 7, 12, 13, 17	102(b)	Nakashima		1-4, 7, 12, 13, 17
1-11, 14-17	102(b)	Thompson	1-11, 14-17	
Overall Outcome			1-11, 14-17	12, 13

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART