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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/328,201	12/16/2011	Jeff H. VerHoef	2989-001-05	7351
31740 LOOP IP 2014 Boyer Ave E Seattle, WA 98112	7590 02/27/2017		EXAMINER HAYES, KRISTEN C	
				ART UNIT 3647
				PAPER NUMBER ELECTRONIC
		NOTIFICATION DATE 02/27/2017		DELIVERY MODE

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEFF H. VERHOEF

Appeal 2015-005270
Application 13/328,201
Technology Center 3600

Before CHARLES N. GREENHUT, MICHAEL L. HOELTER, and
ANNETTE R. REIMERS, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1–5. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

CLAIMED SUBJECT MATTER

The claims are directed to a dog mobility device. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A dog mobility device for assisting with a forward movement of a hind leg of a dog and with an upward movement of the dog's toes, the dog mobility device comprising:

at least one elastic cord connectable to a dog harness, wherein the at least one elastic cord includes an upper forward end portion and a lower rearward end portion; and

a paw loop connectable to the lower rearward end portion of the elastic cord, wherein the paw loop is configured to engage one of the dog's paws, and wherein the paw loop is defined by a material strip looped into a figure eight configuration, and wherein the material strip figure eight configuration further defines a metatarsal strap section and a toe strap section, and wherein the metatarsal strap section is configured to receive and fit about the dog's metatarsus, and wherein the toe strap section is configured to receive and fit about the dog's two innermost toes.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Tee	US 4,909,505	Mar. 20, 1990
Lamb	US 2013/0152870 A1	June 20, 2013

REJECTIONS

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tee.

Claims 1–5 stand rejected under 35 U.S.C. § 102(f) as Appellant did not himself invent the subject matter sought to be patented.

OPINION

Rejection of claims 1 and 2 as anticipated by Tee

Claim 1 recites, *inter alia*,

[a] paw loop [] defined by a material strip looped into a figure eight configuration, and wherein the material strip figure eight configuration further defines a metatarsal strap section and a toe strap section, and wherein the metatarsal strap section is configured to receive and fit about the dog's metatarsus, and wherein the toe strap section is configured to receive and fit about the dog's two innermost toes.

App. Br. 16, Claims App.

The Examiner finds that Tee discloses a paw loop (79) defined by a material strip looped into a figure eight configuration, and wherein the material strip figure eight configuration further defines a metatarsal strap section (85) and a toe strap section (85). Ans. 2–3 (citing Tee, Figs. 1D, 3D); *see also* Final Act. 2 (citing Tee, Fig. 3D).

Appellant asserts that it is self-evident that the human foot strap component taught by Tee is structurally very different than the claimed paw loop component. App. Br. 7–9 (citing Tee, Figs. 1B and 3D). Appellant points out that the claimed metatarsal strap section is configured to receive and fit about the dog's metatarsus, and wherein the toe strap section is configured to receive and fit about the dog's two innermost toes, “all of which is configured for assisting with a forward movement of a hind leg of a dog and with an upward movement of the dog's toes.” *Id.* at 9.

It is clear from Tee that the straps 79 (*see* Tee, Figs. 1B, 3D) are designed to accommodate the human foot rather than a dog's paw (*see* Tee, Figs. 4A, 4D, 4E, 4F, 4G). Tee is silent regarding use of foot straps 79 with anything other than a human foot (or hand, *see* Figs. 4H, 4I). Furthermore, as Appellant notes, the foot straps 79 of Tee are not defined by a material

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strip looped into a figure eight configuration including a metatarsal strap section configured to receive and fit about a dog's metatarsus, and a toe strap section configured to receive and fit about the dog's two innermost toes. In addition, the straight resilient tubes 82 (*see Tee, Figs. 1B, 3D*) surrounding the strap or ribbon 79 would straddle a dog's toes rather than fit about a dog's two innermost toes, as recited. Accordingly, the Examiner has not provided sufficient facts or technical reasoning explaining how the dedicated human foot straps 79 of Tee are "capable of performing the intended use" (Ans. 3) and thus would be reasonably regarded as the paw loop recited in claim 1.

The Examiner further reasons that "it is conceivable that the strap [of Tee] would have some degree of adjustability and would therefore be able to receive a dog's metatarsus." Ans. 3. From the foregoing, the Examiner appears to assert that the strap of Tee inherently possesses characteristics that would render it suitable for receiving a dog's metatarsus. As to that assertion, Appellant's contention that merely because it may be "conceivable" that the unrelated Tee human foot strap "could possibly be changed, or reconfigured away from its intended purpose, to arrive at a new configuration (such as the novel figure 8 configuration of the paw loop recited in claim 1)" is neither a teaching nor a suggestion of the claimed paw loop. Reply Br. 3. We agree with Appellant. "Inherency [] 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 Oelrich*, 666 F.2d 578, 581 (CCPA 1981) (quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939)).

For the foregoing reasons, we do not sustain the Examiner's rejection of claims 1 and 2.

Rejection of Claims 1–5 under section 102(f)

Under 35 U.S.C. § 102(f), a person shall be entitled to a patent unless he did not himself invent the subject matter sought to be patented. “Where it can be shown that an applicant ‘derived’ an invention from another, a rejection under pre-AIA 35 U.S.C. § 102(f) is proper.” MPEP § 2137 (citing *Ex parte Kusko*, 215 USPQ 972, 974 (Bd. App. 1981) (“most, if not all, determinations under section 102(f) involve the question of whether one party derived an invention from another”)).

A patentable invention may be the work of two or more joint inventors. 35 U.S.C. § 116. Because “[c]onception is the touchstone of inventorship,” each joint inventor must generally contribute to the conception of the invention. *Burroughs Wellcome Co. v. Barr Lab., Inc.*, 40 F.3d 1223, 1227–28 (Fed. Cir. 1994). For the conception of a joint invention, each of the joint inventors need not make the same type or amount of contribution to the invention. 35 U.S.C. § 116. The statute does not set forth the minimum quality or quantity of contribution required for joint inventorship.

All that is required of a joint inventor is that he or she (1) contribute in some significant manner to the conception or reduction to practice of the invention, (2) make a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention, and (3) do more than merely explain to the real inventors well-known concepts and/or the current state of the art. *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed Cir. 1998).

“Conception exists when a definite and permanent idea of an operative invention, including every feature of the subject matter sought to be patented, is known.” *Sewall v. Walters*, 21 F.3d 411, 415 (Fed. Cir. 1994) (citing *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985) (“It is

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settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception.”); *see also Davis v. Reddy*, 620, F.2d 885, 889 (CCPA 1980) (“A party claiming conception must show possession of every feature recited in the counts. This means that every limitation of the counts must be shown to have been known to the inventor at the time the invention is alleged to have been conceived.”) (citations omitted).

An essential element of claim 1 on appeal is the paw loop, which is defined as follows:

a paw loop connectable to the lower rearward end portion of the elastic cord, wherein the paw loop is configured to engage one of the dog's paws, and wherein the paw loop is defined by a material strip looped into a figure eight configuration, and wherein the material strip figure eight configuration further defines a metatarsal strap section and a toe strap section, and wherein the metatarsal strap section is configured to receive and fit about the dog's metatarsus, and wherein the toe strap section is configured to receive and fit about the dog's two innermost toes.

The Examiner has rejected claims 1–5 under 35 U.S.C. § 102(f) “because the applicant did not invent the claimed subject matter” as “[e]videnced by 2013/0152870 to Lamb.”¹ Final Act. 3. Elaborating on this rejection, the Examiner asserts:

¹ “2013/0152870 to Lamb” cited by the Examiner is the published version of United States Patent Application No. 13/328,683 (“’683 application”) filed by Dr. Alycia Lamb on December 16, 2011 (the same filing date as the instant application) listing Dr. Lamb as the sole inventor. The ’683 application is addressed at paragraph 44 of Appellant’s Declaration under 37 C.F.R. § 1.132, discussed below.

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From the 37 CFR 1.132 declaration [of Appellant], it appears that Dr. Lamb is a joint inventor and should be added to the list of inventors. The declaration states that the figure 8 configuration was Dr. Lamb's idea. Since the embodiment of Figure 8 is clearly in the claims, VerHoef is not the sole inventor.

Ans. 4.

Appellant submitted a Declaration under 37 C.F.R. § 1.132 (“Declaration”) for the purpose of establishing that he is the original, first and sole inventor of the subject matter set forth in the claimed invention. In his Declaration, Appellant states that on or around June 30, 2011, during a second therapy session of his dog with Dr. Alycia Lamb

I formed in my mind a definite and permanent idea of a complete and operative dog mobility device that comprised, among other elements, an elastic cord connected to a dog harness at one end, and a paw strap connected to one of the dog's rear paws at the toes at the other end. I thought that my configuration, unlike the configuration employed by the Biko Brace, would not only assist with a forward movement of the dog's hind leg but also with an upward movement of the dog's toes.

Decl. ¶ 8.

In that same paragraph of his Declaration, Appellant remarks that “the Biko Brace was poorly designed and would work better if it connected to the dog's toes, instead of the dog's leg above the paw” and that Appellant said to Dr. Lamb “[t]here has to be a way to connect the cord to the toes.”

Following this acknowledgement that Appellant was unaware of a way to connect the cord to the dog's toes, Appellant states:

At the end of our appointment, Dr. Lamb suggested that a strap configured in a figure “8” that fit around the toes and wrapped around the lower part of the leg, above the paw, might be something to consider. In response, I said that I would try to figure out a way to make that work.

Decl. ¶ 8.

Appellant subsequently describes how he adopted Dr. Lamb's suggestion and fashioned from a small nylon dog collar a strap configured in a figure "8" which included a toe loop section and a metatarsal loop section, and how he incorporated the strap into a working version of a dog mobility device. Decl. ¶ 9.

Further, according to Appellant:

On or about December 9, 2011, I consulted with Mr. Loop [Appellant's patent attorney] about my situation and provided additional facts that weren't known to him previously.^[2] More specifically, I explained to Mr. Loop further details regarding Dr. Lamb's contributions to my dog mobility device. Based on my further explanations and additional facts, Mr. Loop advised me that an inventor may in certain situations consider and adopt the ideas, suggestions and material received from others such as, for example, an employee, a hired consultant, or a friend, so long as the inventor maintains intellectual domination and control of the work of making the invention. I then came to the realization that because I had at all times maintained intellectual domination and control of the work of making the invention that I was the sole inventor, and Dr. Lamb was not, in fact, a co-inventor as I had once thought.

Decl. ¶ 40.

At paragraph 45 of his Declaration, Appellant states: "I, at all times, maintained complete intellectual domination and control over the inventive process including the work associated with making my dog mobility device (which device is disclosed and claimed in my U.S. Patent Application No. 13/328,201 entitled 'Dog Mobility Device' filed December 16, 2011)."

Appellant argues that:

as evidenced by Appellant's Rule 132 Declaration, Dr. Lamb's contributions were, at best, nothing more than the mere aiding by

² Appellant does not identify in the record what specific facts were communicated to Mr. Loop that were not previously known to him.

an outside hire consultant^[3] of the real inventor (Appellant) to assist in the reduction of an idea to practice. Moreover, and as also evidenced by Appellant's Rule 132 Declaration, Appellant has at all times maintained intellectual domination of the work of making the invention.

App. Br. 11.

Appellant further contends that:

it is well established that an inventor may consider and adopt ideas, suggestions and material derived from others such as for example, an employee, a hired consultant, or a friend even if the adopted material proves to be the key that unlocks the problem, so long as the inventor maintains intellectual domination of the work of making the invention.

Id. at 14 (citing *Morse v. Porter*, 155 USPQ 280 (BPAI 1965) and MPEP § 2137.01); *see also* Reply Br. 5.

Appellant admits at paragraph 8 of his Declaration that prior to discussing the problem of assisting with a forward movement of a dog's hind leg but also with an upward movement of the dog's toes with Dr. Lamb, he was not aware of a solution. Appellant further admits at paragraph 8 of his Declaration that Dr. Lamb suggested that "a strap configured in a figure '8' that fit around the toes and wrapped around the lower part of the leg, above the paw, might be something to consider." Appellant further admits at paragraph 9 of his Declaration that he adopted Dr. Lamb's suggestion and fashioned from a small nylon dog collar a strap configured in a figure "8", which included a toe loop section and a metatarsal loop section,

³ Appellant's Declaration at paragraphs 3 and 4 indicates that Dr. Lamb was an animal rehabilitation specialist hired by Appellant to conduct weekly therapy sessions on Appellant's dog. Appellant's Declaration does not otherwise indicate that Dr. Lamb was hired to consult to assist in the invention.

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and how he incorporated the strap into a working version of a dog mobility device.

As noted above, conception requires that every feature of the subject matter sought to be patented be known to the inventor. *See, e.g., Sewall v. Walters*, 21 F.3d at 415. Prior to discussing his problem of constructing a working dog mobility device with Dr. Lamb, the concept of a figure “8” strap including a toe loop section and a metatarsal loop section was unknown to Appellant. In other words, Appellant did not conceive this feature, Dr. Lamb did. As a consequence, Appellant’s “conception” of the claimed invention was incomplete until Dr. Lamb provided the missing piece to the puzzle.

Despite Appellant’s contention that he at all times maintained complete intellectual domination and control over the inventive process including the work associated with making his dog mobility device, he in fact did not. Appellant may have engaged Dr. Lamb for veterinary services but did not “hire” her to work on his invention. As such, there does not appear to be any evidence Appellant had control over Dr. Lamb’s ideas or her decision to contribute them. While Appellant may have dominated many aspects of the disclosed invention, he does not appear to have had any control over the conception of the figure “8” strap, a critical part of the claimed subject matter contributed by Dr. Lamb. Accordingly, since Appellant did not control conception of the figure “8” strap, to the extent domination is a relevant factor in light of the more recent case law of our reviewing court discussed above, we cannot agree that Appellant at all times maintained complete intellectual domination and control over the inventive process.

As such, the prevailing law compels us to conclude that Dr. Lamb is a co-inventor of at least claim 1 of the present application. That is, Dr. Lamb (1) contributed in some significant manner to the conception or reduction to practice of the invention, (2) made a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention, and (3) did more than merely explain to Appellant well-known concepts and/or the current state of the art.⁴ See *Pannu v. Iolab Corp.*, 155 F.3d at 1351.

Appellant has thus not apprised us of Examiner error. On the totality of the record before us, we agree with the Examiner that the inventorship listed is incorrect.

Accordingly, for the foregoing reasons, we sustain the Examiner's decision rejecting claims 1–5 under 35 U.S.C. § 102(f).

DECISION

The Examiner's rejection of claims 1 and 2 under 35 U.S.C. § 102(b) is reversed.

The Examiner's rejection of claims 1–5 under 35 U.S.C. § 102(f) is affirmed.

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

⁴ As to the third factor, nothing in Appellant's Declaration or arguments suggests that Dr. Lamb's contribution was a well-known concept and/or the current state of the art.