

**Keywords:** adapted to, configured to, means-plus-function, intended use

**General:** Claims reciting a product adapted to perform a particular intended use are not necessarily obvious over a reference disclosing a known product that is physically capable of performing said intended function

*In re Raymond Giannelli*

U.S. Court of Appeals Federal Circuit

Case No. 2013-1167

Decided January 13, 2014

**I. Facts**

Raymond Giannelli filed U.S. Patent Application No. 10/378,261 (“the ‘261 Application”) on March 3, 2003. Generally, the ‘261 Application describes a rowing exercise machine with an input assembly that defines a declining, substantially linear path, where the user’s forearms are parallel to the ground as the input assembly is drawn (e.g., pulled) by the user back toward the user. Independent claim 1, as amended and presented to the Federal Circuit, is reproduced below:

1. A row exercise machine comprising an input assembly including a first handle portion adapted to be moved from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion, the input assembly defining a substantially linear path for the first handle portion from the first position to the second position.

Specifically, the ‘261 Application describes how the input assembly of the rowing machine is adapted to be moved by a pulling force, as recited in the claim above. The written description includes disclosure of how the rowing machine “enables a user to maintain biomechanical alignment of the user’s wrist and forearm during performance of the exercise, while maintaining a consistent resistance applied to the muscles, in the stability of an exercise machine.” ‘261 Application, ¶ [0019]. For example, the written description describes how certain structural features (e.g., the handles and lever arms) of the input assembly may be adapted to accommodate the pulling force.

During prosecution of the ‘261 Application, the Examiner finally rejected all of the claims under U.S.C. § 102(b) and U.S.C. § 103(a) in view of U.S. Patent No. 5,887,447 (“the ‘447 Patent”). The ‘447 Patent generally relates to a chest press exercise machine. More specifically, the ‘447 Patent describes a chest press exercise machine which “simulates as natural a human musculoskeletal upward pushing motion as possible.”

'447 Patent, Abstract. The Examiner reasoned that the '447 Patent discloses an exercise machine physically capable of being used by a user in the same way as the rowing machine recited in independent claim 1 of the '261 Application (e.g., by positioning the user on the other side of the handles such that the user exerts a pulling force on the handles). The Examiner further reasoned that the claims in the '261 Application do not *explicitly* recite structure of the rowing machine that differs from the structure of the chest press machine disclosed in the '447 patent. Giannelli appealed the Examiner's rejections to the Board of Patent Appeals and Interferences ("the Board").

On appeal, the Board affirmed the Examiner's rejection under U.S.C. § 103(a), stating that the chest press machine of the '447 Patent is "capable of being used by exerting a pulling force on the handles in a rowing motion." In other words, the Board asserted that it would be reasonable for a user to face the handles of the chest press machine described in the '447 Patent and exert a pulling force on the handles in a rowing motion, instead of a pushing force in a chest press motion. The Board further asserted that reciting a new, intended use for a known product does not render a claim directed to the known product patentable. Accordingly, the Board affirmed the Examiner's rejection of the claims in the '261 Application as obvious over the '447 Patent. The Board did not address the Examiner's rejection under U.S.C. § 102(b).

Giannelli appealed the Board's decision regarding the Examiner's rejection under U.S.C. § 103(a) to the Federal Circuit. In the appeal, Giannelli essentially argued that the Board's decision to sustain the Examiner's rejection was in error because the Examiner had not met the burden of establishing a case of *prima facie* obviousness. Giannelli argued that the Examiner failed to explain *how* or *why* a user would possibly use the prior art chest press machine to perform a rowing (e.g., pulling) motion.

## **II. Issues**

A. Given the facts described above, is it valid for an Examiner to interpret the claim recitation "adapted to" to mean "capable of"?

B. Given the facts described above, is establishing physical capability of a known product sufficient evidence of *prima facie* obviousness against a claim reciting an element "adapted to" perform an intended use allegedly analogous to the physical capability of the known product?

## **III. Discussion**

A. No. The Federal Circuit held that, in this case, the claim recitation "adapted to" should not be broadly interpreted to simply mean "capable of," because the written description in the '261 Application provides sufficient support for how the rowing machine, and the first handle portion of the rowing machine in particular, would be "adapted to" perform the intended use. In other words, the claim recitation "adapted to," in this instance, should be interpreted to mean, e.g., "designed to." The Federal Circuit pointed to a portion of the '261 Application that states that the exercise machine "enables

a user to maintain biomechanical alignment of the user's wrist and forearm during performance of the exercise, while maintaining a consistent resistance applied to the muscles, in the stability of an exercise machine." '261 Application, ¶ [0019]. In particular, the Federal Circuit commented that, "[t]he location of the handles relative to the other components is one of their structural attributes that enables performance of the rowing motion against the selected resistance." The Federal Circuit held that the '447 Patent does not disclose an analogous structural limitation to the location of the handles, nor is the chest press machine designed for a user to perform a rowing motion, nor is it adapted to (e.g., designed to) emulate a rowing motion via a pulling force.

B. No. For one, per the point made in (A) above, the claim recitation "adapted to" may be supported by structural limitations in the written description that describe how certain elements recited in the claim are adapted to, or designed to, perform a certain function, thus differentiating the structure of the rowing machine from the structure of the chest press machine. However, the Federal Circuit further held that, in this case, the mere physical capability of a known apparatus (e.g., the chest press machine) to perform a new intended use is not sufficient evidence for a *prima facie* case of obviousness against a claim reciting the new intended use. In this instance, "the mere capability of pulling the handles is not the inquiry that the Board should have made; it should have determined whether it would have been obvious to modify the prior art apparatus to arrive at the claimed rowing machine." In other words, setting aside the fact that the Federal Circuit held that the Examiner's interpretation of "adapted to" was incorrect per the discussion in (A) above, the Federal Circuit also held that the Examiner failed to establish a *prima facie* case of obviousness because the Examiner failed to point out, accordingly to the Federal Circuit, "whether it was obvious to modify the chest press machine to contain handles 'adapted to' perform the rowing motion by pulling on them." Instead, the Examiner attempted to point out that the chest press machine was merely physically capable of performing an analogous intended use as the rowing exercise machine in question.

The Federal Circuit also commented that, in this case, "it is not obvious to modify a machine with handles designed to be pushed to one with handles adapted to be pulled. A chest press machine is not a rowing machine ... In fact, anyone who has used exercise machines knows that a sure-fire way to cause injury is to use a machine in a manner not intended by the manufacturer."

#### **IV. Conclusion**

In some cases, "adapted to" may properly be interpreted to simply mean "capable of." However, when a claim element "adapted to" perform a particular function or intended use is supported by limitations in the written description that obviate how the claim element is adapted to perform the particular function or intended use, the recitation "adapted to" may more properly be interpreted to mean "designed to," and the limitations in the written description may be considered to differentiate the claim being examined from prior art references.

Furthermore, in establishing a *prima facie* case of obviousness, physical capability alone of a prior art apparatus, e.g., does not render obvious a claim reciting one or more elements specifically adapted for an intended use allegedly equivalent to the physical capability of the prior art apparatus. Instead, the Examiner should establish *how* or *why* it would have been obvious to modify the prior art apparatus to match the claim(s) being examined.