

IN RE GIANNELLI, Appeal No. 2013-1167 (Fed. Cir. January 13, 2014). Before Rader, Lourie and Moore. Appealed from the Patent Trial and Appeal Board.

Background:

Giannelli filed an application directed to a rowing machine having handles "adapted to" be moved by a pulling force in a rowing motion. The Examiner rejected all the claims as obvious over a chest press machine that is used by pushing on the handles to overcome a selected resistance. On appeal, the Board characterized the dispositive issue as being whether the chest press machine was "capable of being used by exerting a pulling force on the handles in a rowing motion." The Board affirmed the Examiner's rejection, and stated that it was reasonable that a user could face the handles of the prior art chest press machine and exert a pulling force on its handles in a rowing motion. Giannelli appealed to the Federal Circuit.

Issue/Holding:

Did the Board err in premising its conclusion of obviousness on its theory that the chest press machine is "capable of" having its handles pulled? Yes, reversed.

Discussion:

First, the Federal Circuit noted that although the phrase "adapted to" may simply mean "capable of" or "suitable for," it is frequently used to mean "made to," "designed to" or "configured to." In view of Giannelli's written description, the Court found that in this instance, the phrase "adapted to" has the narrower meaning, i.e., that the claimed machine is designed or constructed to be used as a rowing machine whereby a pulling force is exerted on the handles. Consequently, the Federal Circuit found that the relevant question before the Board was whether the chest press machine apparatus was "made to," "designed to" or "configured to" allow the user to perform a rowing exercise by pulling on the handles as claimed.

The Court held that there is no question that the chest press machine does not have handles that are adapted to be pulled in a rowing motion. Thus, whether the handles were merely *capable* of being pulled is not the inquiry that the Board should have made. Instead, the Board should have determined whether it would have been obvious to modify the prior art apparatus to arrive at the claimed rowing machine. Because the Board determined that the machine claimed would have been obvious by merely showing that a rowing exercise *could* be performed on the machine, and not whether it would have been obvious to modify the chest press machine to contain handles "adapted to" perform a rowing motion by pulling on them, the Board erred in concluding that the Examiner had established a case of *prima facie* obviousness.

With regard to the relevant obviousness determination, the Federal Circuit noted that "physical capability alone does not render obvious that which is contraindicated." Thus, the Court held that it would not have been obvious to modify a machine with handles designed to be pushed to one with handles adapted to be pulled.