

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD A. SCHROEDER

Appeal No. 95-0575
Application 07/921,645¹

HEARD: June 10, 1997

Before FRANKFORT, STAAB, and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1 through 10, 13 through 20 and 22 through 24, all of the claims pending in the application.

The invention relates to "an adjustable height basketball backboard support system wherein the basketball backboard is mounted to a support post through a parallelogram linkage and

¹ Application for patent filed July 30, 1992. According to the appellant, the application is a continuation-in-part of Application 07/889,124, filed May 27, 1992, now abandoned.

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wherein a counter-weight is utilized to allow for easy raising and lowering [of] the height of the basketball backboard" (specification, page 2). Claims 1, 14, 20 and 24, the four independent claims on appeal, are illustrative. Copies of these claims as submitted with the appellant's main brief (Paper No. 10) are appended hereto.

The prior art items relied upon by the examiner as evidence of obviousness are:

Cardarelli	452,211	May 12, 1891
Bottorff	3,341,197	Sep. 12, 1967
Sinner	3,722,886	Mar. 27, 1973
Bearson et al. (Bearson)	3,765,676	Oct. 16, 1973
Wilson et al. (Wilson)	4,145,044	Mar. 20, 1979
Haston et al. (Haston)	4,526,367	July 2, 1985
Barisa	4,702,450	Oct. 27, 1987
Grable	4,759,545	Jul. 26, 1988
Nye	4,781,375	Nov. 1, 1988
Friesen	4,801,142	Jan. 31, 1989
Lykens	4,941,661	July 17, 1990

Exhibit A - three photographs of an adjustable basketball backboard system which is alleged by the examiner "to have been

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in public use at least as early as March 19, 1991" (first Office action, Paper No. 3, page 2)²

The claims on appeal stand rejected under 35 U.S.C. § 103 as follows:

a) claims 1 through 3, 5 and 10 as being unpatentable over Exhibit A;

b) claims 3, 4, 20, 22 and 23 as being unpatentable over Exhibit A in view of Bearson and Barisa;

c) claims 1 through 3 and 6 through 10 as being unpatentable over Exhibit A in view of Bottorff, Haston, Wilson, Sinner and Grable;

d) claim 13 as being unpatentable over Exhibit A in view of Nye;

² The photographs were submitted in Design Application 07/672,595 on March 19, 1991, the filing date of the application. This design application is referred to on page 2 of the appellant's specification, and has since matured into U.S. Patent No. Des. 343,883, granted February 1, 1994. The appellant has not disputed that the adjustable basketball backboard support system shown in the photographs is prior art with respect to the subject matter recited in the appealed claims. Indeed, the appellant concedes that the system shown in the photographs is that illustrated in the design patent (see page 7 in the main brief), which patent is prior art with respect to the subject matter recited in the appealed claims under 35 U.S.C. § 102(e). In an apparent attempt to simplify his discussion of the system shown in the photographs, the examiner seems to have prepared a "Sketch A" of the system with reference numbers added (see the first Office action, page 2). Although the record before us does not contain a copy of the sketch, the examiner's discussion of the prior art system is clear enough for us to proceed and review the merits of the appealed rejections.

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e) claim 13 as being unpatentable over Exhibit A in view of Bearson and Barisa, and further in view of Nye;

f) claims 14, 15 and 18 as being unpatentable over Exhibit A in view of Nye, and further in view of Lykens, Friesen and Cardarelli;

g) claims 16 and 17 as being unpatentable over Exhibit A in view of Nye, Lykens, Friesen and Cardarelli, and further in view of Bearson and Barisa;

h) claim 19 as being unpatentable over Exhibit A in view of Nye, Lykens, Friesen and Cardarelli, and further in view of Bottorff, Haston, Wilson, Sinner and Grable; and

i) claim 24 as being unpatentable over Exhibit A in view of Lykens, Friesen and Cardarelli.

Reference is made to the final rejection (Paper No. 6) and to the main and supplemental answers (Paper Nos. 11 and 18) for the examiner's position in support of these rejections, and to the main and supplemental reply briefs (Paper Nos. 10 and 14) for the appellant's position thereagainst.³

Having carefully considered the scope and content of the applied prior art, the level of ordinary skill in the art as

³ The record (Paper No. 13) indicates that the examiner has refused entry of the appellant's reply brief (Paper No. 12). Thus, we have not considered the arguments advanced in the reply brief in reviewing the merits of the examiner's rejections.

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demonstrated by the applied prior art, the differences between the claimed invention and the applied prior art and the respective viewpoints advanced by the appellant and the examiner, we conclude that none of the appealed rejections is well founded.

Independent claim 1 recites an adjustable basketball backboard support system comprising, inter alia, a backboard, a support member, a parallelogram linkage system interconnecting the backboard and the support member, an adjustment means including an adjustment link, and a counter-weight means for applying a primary force to the parallelogram linkage system in opposition to and substantially equal to the force applied to the parallelogram linkage system by the weight of the backboard. The examiner concedes that the adjustable basketball backboard system shown in Exhibit A does not meet the limitation in claim 1 requiring the adjustment link to include the counter-weight means (see page 2 in the final rejection). In this regard, the examiner notes that the corresponding counter-weight means in the Exhibit A system is mounted at the end of an extension of one of the links in the parallelogram linkage system. Nonetheless, the examiner concludes that the prior art counter-weight means "could" be mounted on the adjustment link, and that it would have been an obvious matter of choice to so mount it, "this being no

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more than a change of form or design without a change of function" (final rejection, page 2).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In the present case, the examiner has failed to advance any factual basis to support the conclusion that it would have been obvious to one of ordinary skill in the art to modify the Exhibit A adjustable basketball backboard system in the manner proposed. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification (see In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Exhibit A contains no such suggestion.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 1, or of claims 2, 3, 5 and 10 which depend therefrom, as being unpatentable over Exhibit A.

Bearson, Barisa, Bottorff, Haston, Wilson, Sinner and/or Grable, applied by the examiner to meet other features of the

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claimed invention, do not overcome the foregoing deficiency in Exhibit A with respect to the subject matter recited in claim 1. Accordingly, we shall not sustain the standing 35 U.S.C. § 103 of claims 3 and 4, which depend from claim 1, as being unpatentable over Exhibit A in view of Bearson and Barisa, or the standing 35 U.S.C. § 103 rejection of claim 1, and of claims 2, 3 and 6 through 10 which depend therefrom, as being unpatentable over Exhibit A in view of Bottorff, Haston, Wilson, Sinner and Grable.

Independent claim 20 recites an adjustable basketball backboard support system comprising, inter alia, a parallelogram linkage system for interconnecting a backboard and a support member, adjustment means for adjustably connecting one of the links of the parallelogram linkage system to the support member, and a counter-weight means including a mass on the adjustment means. The examiner concedes that the adjustable basketball backboard system shown in Exhibit A does not meet the limitation in claim 20 requiring "varying means for adjusting the connection of said adjustment means to said one link to vary said forces applied by said mass" (see page 3 in the final rejection). According to the examiner, it would have been obvious to one of ordinary skill in the art to provide the system shown in Exhibit A with such a varying means in view of Bearson and Barisa (see page 3 in the final rejection).

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The examiner cites Bearson for its disclosure of an adjustable basketball backboard support system wherein the weight of the backboard is counterbalanced by a pair of adjustable torsion springs, and Barisa for its disclosure of an adjustable parallelogram support system for a viewing device wherein one of the parallelogram links has an extension which mounts an adjustably positioned weight to counterbalance the weight of the viewing device. There is nothing in these disparate teachings which would have suggested providing the adjustable basketball backboard system shown in Exhibit A with a varying means of the sort defined in claim 20.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 20, or of claims 22 and 23 which depend therefrom, as being unpatentable over Exhibit A in view of Bearson and Barisa.

We shall not sustain the standing 35 U.S.C. § 103 rejections of claim 13, which depends from claim 1, as being unpatentable over Exhibit A in view of Nye, and as being unpatentable over Exhibit A in view of Bearson and Barisa, and further in view of Nye. Nye, Bearson and/or Barisa, applied by the examiner to meet other features of the claimed invention, do not overcome the above discussed deficiency in Exhibit A with respect to the subject matter recited in parent claim 1.

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Independent claim 14 recites an adjustable basketball backboard support system comprising, inter alia, a parallelogram linkage system for interconnecting a backboard and a support member, and adjustment means for adjustably connecting one of the links of the parallelogram linkage system to the support member. The examiner concedes that the adjustable basketball backboard system shown in Exhibit A, as proposed to be modified in view of Nye, does not meet the limitation in claim 14 requiring the adjustment means to include "a clamp mounted to said support [member] and having a plurality of holes defining a plurality of heights of said backboard for mounting to said support member" (see page 5 in the final rejection). According to the examiner, it would have been obvious to one of ordinary skill in the art to provide the system shown in Exhibit A with such a clamp in view of Lykens, Friesen and Cardarelli (see pages 5 and 6 in the final rejection).

The examiner cites Lykens for its disclosure of an adjustable basketball backboard support system mounted to a support member by clamps, Friesen for its disclosure of a winch-operated adjustable basketball backboard support system mounted to a support member, and Cardarelli for its disclosure of an adjustable electric lamp mounted to a support member by clamps. There is nothing in these disparate teachings which would have

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suggested providing the adjustable basketball backboard system shown in Exhibit A with a clamp of the type specifically defined in claim 14.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 14, or of claims 15 and 18 which depend therefrom, as being unpatentable over Exhibit A in view of Nye, and further in view of Lykens, Friesen and Cardarelli.

Since Bearson, Barisa, Bottorff, Haston, Wilson, Sinner and/or Grable, applied by the examiner to meet other features of the claimed invention, do not overcome the foregoing deficiency in Exhibit A, Nye, Lykens, Friesen and Cardarelli with respect to the subject matter recited in claim 14, we shall not sustain the standing 35 U.S.C. § 103 of claims 16 and 17, which depend from claim 14, as being unpatentable over Exhibit A in view of Nye, Lykens, Friesen and Cardarelli, and further in view of Bearson and Barisa, or the standing 35 U.S.C. § 103 rejection of claim 19, which depends from claim 14, as being unpatentable over Exhibit A in view of Nye, Lykens, Friesen and Cardarelli, and further in view of Bottorff, Haston, Wilson, Sinner and Grable.

Independent claim 24 recites an adjustable basketball backboard support system comprising, inter alia, a backboard, a support member, a parallelogram linkage system interconnecting the backboard and the support member, adjustment means for

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adjustably connecting one of the links of the parallelogram linkage system to the support member, and a mounting means including a clamp similar to the one recited in claim 14. As was the case with the rejection of claim 14, the examiner has concluded that it would have been obvious to one of ordinary skill in the art to provide the adjustable basketball backboard system shown in Exhibit A with such clamp in view of Lykens, Friesen and Cardarelli. Here again, however, there is nothing in the disparate teachings of these three references which would have suggested the proposed modification.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 24 as being unpatentable over Exhibit A in view of Lykens, Friesen and Cardarelli.

The following rejection is entered pursuant to 37 CFR § 1.196(b).

Claims 1 through 10, 13 through 20 and 22 through 24 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). The purpose of this

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requirement is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

The appealed claims fail to set out and circumscribe a particular area with a reasonable degree of precision and particularity for the following reasons.

In claim 1, the term "said one link" lacks a proper antecedent basis, and it is not clear whether the subsequent recitation of "one of said links" refers to "said one link."

In claims 2, 4 and 10, the term "said one link" lacks a proper antecedent basis.

In claims 3, 4, 16, 20, 22 and 23 the term "said forces" lacks a proper antecedent basis.

In claim 14, it is unclear whether the backboard and support member are intended to be part of the claimed combination. Although the preamble of claim 14 indicates that these elements are not part of the claimed combination, the body of claim 14

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recites "a clamp mounted to said support [member⁴]." Also in claim 14 and in claim 24, the recitation of "a pin adjustably securing said adjustment means in at least one of said holes" is confusing and appears to inaccurately depict the function of the pin as described in the specification (see page 6).

In claim 24, the recitation of the "adjustment means" and "mounting means" as separate elements is confusing since the underlying specification indicates that the mounting means, at least insofar as it is defined in claim 24, is part of the adjustment means.

Claims 5 through 9, 13, 15, 17 through 19 are indefinite by virtue of their dependency from indefinite parent claims.

In summary and for the above reasons:

a) the decision of the examiner to reject claims 1 through 10, 13 through 20 and 22 through 24 under 35 U.S.C. § 103 is reversed; and

b) a new 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 10, 13 through 20 and 22 through 24 is entered pursuant to 37 CFR § 1.196(b).

⁴ The term "said support" in claims 14, 17 and 23 should be --said support member-- for consistency with preceding claim terminology.

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Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR § 1.197). Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
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APPENDIX

1. An adjustable basketball backboard support system comprising:

a basketball backboard;

a support member;

a parallelogram linkage system including at least two parallel links pivotally interconnecting the basketball backboard and the support member;

adjustment means including an adjustment link interconnecting said one link and said support member for adjustably connecting one of said links to said support member to determine the height of the basketball backboard; and

wherein said adjustment link includes a counterweight means for applying a primary force to said parallelogram linkage system in opposition to and substantially equal to a force applied to said parallelogram linkage system by the weight of the basketball backboard.

14. An adjustable basketball backboard support system for mounting a basketball backboard to a support member comprising:

a parallelogram linkage system including at least two parallel links pivotally interconnecting the basketball backboard and the support member;

a bracket for mounting said linkage system to said support member;

adjustment means for adjustably connecting one of said links to said support member to determine the height of the basketball backboard;

said adjustment means including a clamp mounted to said support and having a plurality of holes defining a plurality of heights of said backboard for mounting to said support member and a pin adjustably securing said adjustment means in at least one of said holes; and

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a counter-weight means connected to one of said links for applying a force to said parallelogram linkage system in opposition to a force to be applied to said parallelogram linkage system by the weight of the basketball backboard.

20. An adjustable basketball backboard support system for mounting a basketball backboard to a support member comprising:

a parallelogram linkage system including at least two parallel links pivotally interconnecting the basketball backboard and the support member;

adjustment means for adjustably connecting one of said links to said support member to determine the height of the basketball backboard;

a counter-weight means including a mass on said adjustment means for applying a force to said parallelogram linkage system in opposition to a force to be applied to said parallelogram linkage system by the weight of the basketball backboard; and

varying means for adjusting the connection of said adjustment means to said one link to vary said forces applied by said mass.

24. An adjustable basketball backboard support system comprising:

a basketball backboard;

a support member;

a parallelogram linkage system including at least two parallel links pivotally interconnecting the basketball backboard and the support member;

adjustment means for adjustably connecting one of said links to said support member to determine the height of the basketball backboard; and

mounting means including a C clamp attached to said support member and having a plurality of holes defining a plurality of heights of said backboard and including a pin

adjustably securing said adjustment means in at least one of said holes.

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APJ McQUADE

APJ STAAB

APJ FRANKFORT

DECISION: **REVERSED 37 CFR § 1.196(b)**

3 MEMBER CONFERENCE

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FINAL TYPED: