

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEERT LIEVENS

Appeal No. 2000-0534
Application No. 08/929,543

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, FRANKFORT
and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 5, 7, 8 and 20 to 23. Claims 11 to 13, 15 to 19 and 27 to 30 have been allowed. Claims 6, 9 and 24 to 26 have been objected to as depending from a non-allowed claim. Claims 10, 14, 31 and 32 have been canceled.

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

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BACKGROUND

The appellant's invention relates to a device for rebounding a ball to practice a ball sport, such as tennis, baseball, cricket, and the like (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Epply 1969	3,456,945	July 22,
Steen 1987	4,703,931	Nov. 3,
Tomczak 1989	4,852,889	Aug. 1,

Reference made of record by this panel of the Board is:

Ball 8, 1991	5,054,791	Oct.
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Claims 1 to 5, 7, 8 and 20 to 23 stand rejected under

35 U.S.C. § 103 as being unpatentable over Epply in view of Tomczak or Steen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 16, mailed August 21, 1998) and the answer (Paper No. 24, mailed September 13, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 23, filed June 11, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will

not sustain the examiner's rejection of claims 1 to 5, 7, 8 and 20 to 23 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require two sections of one net to intersect substantially vertically along the net between the top edge and the bottom edge of the net to form an

angle therebetween other than 0 degrees and other than 180 degrees so that the two sections are nonlinearly disposed. However, these limitations are not suggested by the applied prior art. In that regard, while Epply does teach in Figures 12-18 two sections of one net that intersect substantially vertically along the net to form an angle therebetween other than 0 degrees and other than 180 degrees so that the two sections are nonlinearly disposed, Epply does not teach or suggest that the vertical intersection of the two sections of the one net extend between the top edge and the bottom edge of the net. To supply this omission in the teachings of Epply, the examiner made a determination (final rejection, page 2) that this difference would have been obvious to an artisan from either Tomczak or Steen. We do not agree. In that regard, it is our opinion that Tomczak's teaching of two nets that intersect substantially vertically between their top edges and bottom edges to form an angle therebetween other than 0 degrees and other than 180 degrees so that the two nets are nonlinearly disposed would not have provided any motivation that would have led an artisan to arrive at the claimed invention. Furthermore, it is our belief that,

likewise, Steen's teaching of one net that is shaped very similar to the shape of the Figures 12-18 embodiment of Epply's net does not provide the necessary motivation that would have led an artisan to arrive at the claimed invention since Steen does not teach or suggest that the vertical intersection of the two sections of the one net extend between the top edge and the bottom edge of the net.

In our view, the only suggestion for modifying Epply in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 to 5, 7, 8 and 20 to 23.

New grounds of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new grounds of rejection.

1. Claims 1, 20 and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ball.

Ball's invention relates to a background shield for soccer practice designed to return the soccer ball back to the area from where the ball is kicked. The background shield is foldable for storage and for transportation.

As shown in Figure 1 of Ball 1, the background shield 1 includes a back panel 2 and side panels 3 and 4. Netting 5 has upper edging 7 and lower edging 7' and is fastened to posts 8 and 10. Netting 5 is stretched around middle posts 6 and 6' but is not fastened to these two middle posts. Thus, as shown in Figure 1, the netting is formed into a central section and two end sections wherein the end sections of the netting intersect with the central section of the netting substantially vertically along the netting between the top edge and the bottom edge of the netting to form an angle

therebetween other than 0 degrees and other than 180 degrees so that the two end sections are nonlinearly disposed relative to the central section. When it is desired to move or store the shield, posts 8 and 10 are lifted off of connectors 11 and 12 formed on the side panels 3 and 4 so that the netting may be folded and side panels 3 and 4 may be folded onto back panel 2.¹

2. Claims 22 and 23 are rejected under 35 U.S.C. § 103 as being unpatentable over Ball. The specific angle formed between the two end sections of Ball and his central section is not taught by Ball. Thus, the specific angle chosen is left up to the artisan to choose. Accordingly, it is our view that the specific angle formed between the two end sections of Ball and his central section is an obvious matter of designer's choice and that in view of the angle shown and

¹ In any further prosecution of the subject matter of claims 1, 20 or 21, the examiner should determine whether or not any of these claims are anticipated by Steen or obvious over Steen. In that regard, the examiner should determine if the claimed "one net" is readable on the rearward end 32 and the lateral sidewalls 28, 30 of Steen's net 16 since these claims are "comprising" type claims which do not exclude additional structure (e.g., Steen's other sidewalls 24, 26).

suggested by Figure 1 of Ball that an angle of "substantially 145 degrees or less" (claim 22) and an angle of "substantially 135 degrees or less" (claim 23) would have been obvious at the time the invention was made to a person having ordinary skill in the art.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 5, 7, 8 and 20 to 23 under 35 U.S.C. § 103 is reversed and new grounds of rejection of claims 1 and 20 to 23 have been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

ground of rejection to avoid termination of proceedings

(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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