

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CHARLES W. PRIMEAU

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Appeal No. 97-0828  
Application 08/445,540<sup>1</sup>

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ON BRIEF

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Before CALVERT, STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1, 4 through 6, 8 and 10 through 12. Claims 7 and 13, the only other claims pending in the application, have been indicated

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<sup>1</sup> Application for patent filed May 22, 1995.

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as containing allowable subject matter but stand objected to  
as depending from rejected base claims.

The invention relates to a protective face mask/helmet  
assembly particularly designed for use by baseball and  
softball catchers. Claim 1 is illustrative and reads as  
follows:

1. A protective helmet and facemask assembly which  
comprises:

a helmet for covering at least a portion of a person's  
head, an open face area, and a top portion adjacent to said  
open face area, said top portion having a top edge bordering  
said open face area;

a facemask comprising a frame for fitting around a  
person's face, an open grid of protective elements secured to  
said frame and covering an area within said frame;

said facemask frame overlapping said top edge;

padding means between said facemask and said edge;

elastic strap means connected between opposite sides of  
said helmet adjacent to said face area and opposite sides of  
said facemask for permitting said facemask to be slid from a  
first position over said face area to a position over said top  
portion; and

said elastic strap means including means for adjusting  
the length of said elastic straps to assure snug engagement of  
said facemask to a person's face in said first position and  
frictional engagement with said top portion in said second

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position.

The references relied upon by the examiner as evidence of obviousness are:

Finken et al. (Finken)	2,903,700	Sept. 15, 1959
Bowen	3,262,125	Jul. 26, 1966
Hale 1973	3,732,574	May 15,
Zide 1987	4,651,356	Mar. 24,
Copeland et al. (Copeland)	5,093,936	Mar. 10, 1992

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

a) claims 1 and 8 as being unpatentable over Hale in view of Bowen and Finken;

b) claims 4, 5, 10 and 11 as being unpatentable over Hale in view of Bowen and Finken, and further in view of Copeland; and

c) claims 6 and 12 as being unpatentable over Hale in view of Bowen and Finken, and further in view of Zide.

Reference is made to the appellant's brief (Paper No. 7) and to the examiner's answer (Paper No. 10) for the respective positions of the appellant and the examiner regarding the

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merits of these rejections.

To begin with, we shall not sustain the standing 35  
U.S.C.

§ 103 rejections of claims 8 and 10 through 12. The scope of these claims is indefinite for the reasons expressed below. Accordingly, the standing prior art rejections thereof must fall since they are necessarily based on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

As for the standing 35 U.S.C. § 103 rejection of independent claim 1, Hale discloses a baseball catcher's head gear which is designed for quick and easy removal during the course of play. The head gear includes a helmet 10 and a face mask 18. The face mask is hingedly connected to the helmet at an upper central location by a belt strap 20 riveted to the helmet and looped around a securing bar 22 on the face mask. The face mask also is connected to the helmet at a lower

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position by an elastic strap 36 which extends around the helmet and is connected to the sides of the face mask by belt straps 38. The foregoing construction allows the head gear to be quickly and easily doffed by "hinging the face mask 18 forward and raising the protective head gear upward and backward to remove same" (column 2, lines 55 through 57).

As is implicitly conceded by the examiner, the Hale head gear does not meet the limitation in claim 1 requiring "elastic strap means connected between opposite sides of said helmet adjacent to said face area and opposite sides of said facemask for permitting said facemask to be slid from a first position over said face area to a position over said top portion" of the helmet. While Hale's elastic strap 36 and belt straps 38 arguably constitute elastic strap means connected between opposite sides of the helmet adjacent its face area and opposite sides of the face mask, these elements would not permit the face mask to be slid from a first position over the face area to a position over the top portion of the helmet, at least in part due to the presence of the belt strap 20.

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Bowen discloses a crash helmet 10 having goggles 32 attached thereto by a pair of elastic straps 34 and snap fasteners 30. The goggles are movable between a first position wherein they cover the eyes of the user (see Figures 1 and 2) and a second position wherein they rest on the top of the helmet (see Figure 3).

Finken discloses a safety helmet 15 having an eye shield 1 attached thereto by elastic bands 9 and snap fasteners 13. The bands include conventional sliders 10 which allow the effective lengths of the bands to be adjusted.

According to the examiner, it would have been obvious to one of ordinary skill in the art to replace Hale's means for attaching the face mask to the helmet with a pair of length-adjustable elastic straps in view of Bowen and Finken to allow the face mask to be stored on top of the helmet when not in use (see pages 3 and 4 in the answer). The examiner indicates that this modification would include the elimination of Hale's belt strap 20 (see page 5 in the answer).

We agree with the appellant, however, that this proposed modification of the Hale head gear is based on impermissible hindsight rather than on the fair teachings, suggestions and

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inferences of the prior art. Arguably, Bowen and Finken would have suggested replacing Hale's elastic strap 36 and belt straps 38 with a pair of length-adjustable elastic straps. The combined teachings of these references, however, would not have suggested the elimination of Hale's belt strap 20 so as to permit the face mask to be slid from a first position over the face area to a position over the top portion of the helmet as required by claim 1. For one thing, Hale's disclosure indicates that the belt strap 20 is integral to the structural relationship between the helmet and face mask which allows them to be quickly and easily removed during the course of play in a baseball game. Thus, Hale would appear to teach away from the proposed elimination of the belt strap 20. Moreover, the disclosure by Bowen, and apparently by Finken, of goggles or eye shields which are capable of being moved from a first position over the face area to a position over the top portion of their associated helmets would appear to have little, if any relevance, to Hale's baseball head gear and its intended manner of use.

Thus, the combined teachings of Hale, Bowen and Finken do not justify the examiner's conclusion that the subject matter

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recited in claim 1 would have been obvious at the time the invention was made to a person of ordinary skill in the art. Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of this claim.

Nor shall we sustain the standing 35 U.S.C. § 103 rejection of dependent claims 4 and 5 as being unpatentable over Hale in view of Bowen, Finken and Copeland or the standing 35 U.S.C.

§ 103 rejection of dependent claim 6 as being unpatentable over Hale in view of Bowen, Finken and Zide. In short, Copeland's disclosure of an adjustable helmet suspension means and Zide's disclosure of a helmet chin strap do not cure the above noted deficiencies of the basic Hale, Bowen and Finken combination with respect to the subject matter recited in parent claim 1.

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

Claim 8, and claims 10 through 13 which depend therefrom, 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

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scope of these

claims is indefinite due to the garbled manner in which claim 8 was amended in response to the first Office action (see Paper No. 4). More particularly, claim 8 as amended contains two periods. It is unclear whether the "whereby" clause which follows the first period is intended to be part of the claim. Also, the terms "said first position" and "said second position" in the clause immediately preceding the first period lack a proper antecedent basis.

In summary:

a) the decision of the examiner to reject claims 1, 4 through 6, 8 and 10 through 12 under 35 U.S.C. § 103 is reversed; and

b) a new 35 U.S.C. § 112, second paragraph, rejection of claims 8 and 10 through 13 is entered pursuant to 37 CFR 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

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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)

IAN A. CALVERT )

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Administrative Patent Judge	)	
	)	
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	)	
LAWRENCE J. STAAB	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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