

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 MARIO F. MONROY  
and CRAIG A. JUSTICE

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Appeal No. 1998-1924  
Application No. 08/642,907<sup>1</sup>

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ON BRIEF

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Before COHEN, FRANKFORT and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 6. Claims 7 through 10 are objected to as being dependent upon a rejected claim but would

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<sup>1</sup> Application for patent filed May 6, 1996.

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be allowable if rewritten in independent form including all of  
the limitations of the claim and any intervening claims.

The appellants' invention relates to an in-line roller skate frame. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art

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

Nielson	480,610	Aug. 9, 1892
Horton	1,822,657	Sep. 8, 1931
Gray	4,418,929	Dec. 6, 1983
Gierveld	5,046,746	Sep. 10, 1991

The rejections

Claims 1 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gierveld in view of Gray.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gierveld as modified by Gray and further in view of Nielson and Horton.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper

No. 10, mailed February 18, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellants'

brief (Paper No. 9, filed January 12, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 1 through 4 under 35 U.S.C. § 103 as being obvious over Gierveld in view of Gray. The examiner found that Gierveld substantially taught the invention as claimed except that Gierveld does not disclose slots that extend transversely of the frame and which span the distance between the frame side walls. The examiner relies on Gray for teaching slots that extend transversely of the frame and span the distance between the frame side walls. The examiner concludes:

Based on the teachings of Gray it would have been obvious to modify the skate frame of Gierveld to include mounting brackets that are oversized so as to at least spans [sic, span] the distance between the frame side walls and to provide a slot that extends beyond the frame side walls to provide a more versatile adjustable attachment for the boot. Since a larger slot allows for greater positioning of the boot relative to the mounting plates. [examiner's answer at pages 5 and 6].

Appellants argue that Gierveld does not disclose that the wall means of the mounting bracket means extends outwardly beyond both side walls. We do not agree. In our view, Figure 8 of Gierveld depicts that the mounting bracket 21 extends transversely beyond the side walls of the frame 13.

Appellants also argue that there is no suggestion to combine the teachings of Gierveld and Gray because there is no disclosure in Gray of a mounting bracket. Rather, appellants argue that Gray discloses wrappings to attach the skate to the foot. Appellants further argue that a person of ordinary skill in the art would be at a loss to attribute any significance to the slots disclosed in Gray and that even if the teachings of Gierveld and Gray were combined, there would

still be no teaching of slots which extend transversely of the frame.

We agree with the appellants that there is no teaching of slots when extend transversely of the frame and which provide passage for fastening means. The slots in elements 7 and 8 of Gray which extend transversely across the frame to span at least the spacing distance between the side walls do not provide "passage through said wall means of fastening means used to fasten the frame to the boot" as recited in claim 1. A fastening means in Gray is provided through the slots through which nuts and bolts 16 are disposed to fasten support strap 6 to elements 7 and 8. However, these slots do not extend transversely of the frame to span at least the spacing distance between the side walls and in any case do not attach a boot to the frame.

Therefore, even if Gierveld and Gray are properly combinable, the combination does not disclose, teach or suggest through-slots which extend transversely of the frame to span the distance between the side walls and which provide passage for fastening means to fasten the boot to the frame.

As such, we will not sustain the 35 U.S.C. § 103 rejection of independent claim 1, and of dependent claims 2 through 4.

In regard to the examiner's rejection of claims 5 and 6 under 35 U.S.C. § 103, we have reviewed the disclosures of Nielson and Horton and find that Nielson and Horton do not cure the deficiencies noted above for Gierveld and Gray. Therefore, we will not sustain the rejection of claims 5 and 6.

The decision of the examiner to reject claim 1 through 6 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

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George L. Boller  
36270 Hammer  
Livonia, MI 48152