

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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIEGFRIED DORNHOFER

Appeal No. 1998-1931
Application No. 08/395,411

HEARD: OCTOBER 11, 2000

Before COHEN, NASE, and JENNIFER D. BAHR, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal taken from the final rejection of claims 1 through 5, 7, 8, 10, 11, 13 through 15, 17, and 18. However, subsequent to the final rejection, claim 8 was canceled and claims 2 and 7 were amended. Claim 12 stands objected by the examiner, and claim 16 stands withdrawn pursuant to 37 CFR

Appeal No. 1998-1931
Application No. 08/395,411

§ 1.142(b). In light of the above, claims 1 through 5, 7, 10, 11, 13 through 15, 17, and 18 are before us for review.

Appellant's invention pertains to a roller-type skiing device and to a roller skiboard for two footed stand. A basic understanding of the invention can be derived from a reading of exemplary claims 1 and 15, a copy of which appears in the APPENDIX to the supplemental brief of June 12, 2000 (Paper No. 25).

As evidence of obviousness, the examiner has applied the documents listed below:

Peters	954,993	Apr. 12, 1910
Fowlkes	2,878,071	Mar. 17, 1959
Goodwin	3,622,172	Nov. 23, 1971
Hill 1994	5,356,209	Oct. 18,
		(filed May 19, 1993)
Parker, Jr.	5,388,350	Feb. 14, 1995 (filed Dec. 31, 1992)

The following rejections are before us for review.

Appeal No. 1998-1931
Application No. 08/395,411

Claims 1, 3 through 5, 11, 13, 17, and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goodwin in view of Parker, Jr. and Fowlkes.

Claims 2, 7, 10, and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goodwin in view of Parker, Jr. and Fowlkes, as applied to claim 1 above, further in view of Peters.

Claim 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goodwin in view of Parker, Jr. and Fowlkes, as applied to claim 1 above, further in view of Hill.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 17), while the complete statement of appellant's argument can be found in the main and first and second supplemental briefs (Paper Nos. 16, 18, and 25).

OPINION

Appeal No. 1998-1931
Application No. 08/395,411

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims, the applied teachings,¹ and the respective viewpoints of the appellant and the examiner. As a consequence of our review, we make the determination which follows.

We reverse each of the examiner's rejections under 35 U.S.C. § 103.

The skiing device of independent claim 1 and the skiboard of independent claim 15 each require an envelope with

¹ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Appeal No. 1998-1931
Application No. 08/395,411

wheels of varying length to conform to the contour² of the envelope, a terminal piece of hard material provided on an end face of a wheel and forming an edge, and a hollow cylinder in flush-mounted disposition to the terminal piece so that during negotiation of a turn the edge of the terminal piece is exposable to effect a firm grip.

² Each of claims 1 and 15, as indicated, expressly refer to the "contour" of the envelope. Consistent with the underlying specification (page 10, lines 4 through 11), we understand the "contour" of the envelope to broadly denote an outline of a curving figure. Webster's New Collegiate Dictionary, G. & C. Merriam Company, Springfield, Massachusetts, 1979.

Appeal No. 1998-1931
Application No. 08/395,411

We fully appreciate the examiner's assessment of the Goodwin, Parker, Jr., Fowlkes, Peters, and Hill patents, and the manner in which they are applied in the respective rejections on appeal. As more fully explained below, the difficulty that we have with, for example, the rejections of claims 1 and 15, respectively, is that only reliance upon appellant's own teaching and hindsight would have enabled one of ordinary skill in the art to seek out and combine the applied prior art, as proposed.

As can be discerned from a review of the Goodwin reference, the torsion land skier thereof utilizes barrel-shaped rollers having a convex periphery (column 1, lines 43 through 47). On the other hand, the Parker, Jr. patent addresses a roller shoe with rollers of varying length conforming to the contour of the shoe, while the patent to Fowlkes teaches a laminated skate wheel (Fig. 2) that includes outer discs 16, 18 of substantially greater hardness and durability than an annular member 14. Considering, in particular, the barrel-shaped roller intended by patentee Goodwin, it at once becomes apparent to us that

Appeal No. 1998-1931
Application No. 08/395,411

the selection of the type of wheel disclosed by Fowlkes for use with a roller skier like that of Goodwin comes not from the applied teachings themselves but from inappropriate reliance upon appellant's own teaching. It is for this reason that the respective rejections of appellant's claims must be reversed. Our review of the patents to Peters and Hill reveals to us that they do not overcome the deficiency of the other applied art already discussed.

In summary, this panel of the board has reversed each of the rejections under 35 U.S.C. § 103.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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) BOARD OF PATENT
JEFFREY V. NASE) APPEALS

Appeal No. 1998-1931
Application No. 08/395,411

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APPEAL NO. 1998-1931 - JUDGE

APPLICATION NO. 08/395,411

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DECISION: **REVERSED**

Prepared By:

DRAFT TYPED: 02 Jul 01

FINAL TYPED: