

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 98-2771
Application 08/428,863¹

ON BRIEF

Before FRANKFORT, STAAB and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 20, all the claims pending in the application. In the examiner's answer, page 14, it is

¹ Application for patent filed April 25, 1995. According to appellant, the application is a continuation-in-part of Application 08/088,191, filed July 6, 1993, now abandoned, which is a continuation-in-part of Application 07/912,552, filed July 13, 1992, now U.S. Patent No. 5,277,675, issued January 11, 1994.

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indicated that claims 17 through 19 now stand objected to and would be allowable if rewritten in independent form. In addition, it has

been noted on page 2 of the examiner's answer that the rejection of claims 7 and 8 under 35 U.S.C. § 112, second paragraph, has been withdrawn. Accordingly, only the examiner's prior art rejections of claims 1 through 16 and 20 under 35 U.S.C. § 103 remain for our consideration on appeal.

Appellant's invention is directed to a resilient, portable, stand alone, exercise board that can be used for a variety of exercises such as running in place, aerobic exercise and jumping. Independent claims 1 and 14 are representative of the subject matter on appeal and a copy of those claims, as they appear in the Appendix to appellant's brief, is attached to this decision.

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

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Oaks		
4,037,834	Jul. 26, 1977	
Mansfield	4,199,136	Apr. 22,
1980		
Wilson	4,323,231	Apr. 6,
1982		
Puckett et al. (Puckett)	5,273,510	Dec. 28,
1993		
Gvoich	5,387,166	Feb. 7,
1995		

Marcolin	2,631,067	Jan. 20,
1977		
(German Offenlegungsschrift) ²		
Morozov et al. (Morozov)	700,149	Dec. 15,
1979		
(Soviet Union)		

Claims 1 through 3, 7 through 10 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morozov in view of Oaks.

² Our understanding of these foreign language documents is based upon a translation prepared by the U.S. Patent and Trademark Office. A copy of those translations accompanies this decision.

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Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Morozov in view of Oaks as applied to claim 1 above, and further in view of Mansfield.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morozov in view of Oaks as applied to claim 1 above, and further in view of Marcolin.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morozov in view of Oaks as applied to claim 10 above, and further in view of Puckett.

Claims 14 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gvoich.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Gvoich in view of Oaks.

Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Gvoich in view of Oaks as applied to claim 15 above, and further in view of Wilson.

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Reference is made to the examiner's answer (Paper No. 20, mailed July 21, 1997) and supplemental examiner's letters (Paper Nos. 22 and 24) for the examiner's reasoning in support of the above-noted rejections and to the appeal brief (Paper No. 19, filed April 25, 1997), reply brief (Paper No. 21, filed September 29, 1997) and letter (Paper No. 23) for appellant's arguments thereagainst.

OPINION

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art references, and the respective positions advanced by appellant and the examiner. As a consequence of our review, we have come to the conclusions which follow.

With regard to the examiner's rejection of claims 1 through 3, 7 through 10 and 13 under 35 U.S.C. § 103 based on Morozov in view of Oaks, appellant has argued (brief, pages 5-6) that the device shown in Morozov is not an exercise board,

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but rather is a section of acrobatic running track. In addition, appellant argues that if Morozov and Oaks were combined, the result would be an acrobatic running track section having a flat, rigid board supported by springs extending between a pair of longitudinally extending frame members, and not a stand alone, portable exercise board as appellant has provided. We find these arguments to be unpersuasive. In the first place, we view the entire acrobatic running track seen in Figures 1 and 2 of Morozov to be a "portable, stand alone exercise board" which comprises a plurality of sections, each of which sections includes a generally rectangular, "substantially rigid" platform (4) sized as required in appellant's claim 1 and a plurality of supports or feet (seen in Figure 2) affixed to the underside of the platform and positioned "toward corners of the platform." Each of the sections also includes at least a pair of arched springs (3) of resilient spring material extending between the feet adjacent opposing side margins of the platform and imparting an upwardly convex contour to the platform while permitting the platform to flex with a resilient action in response to the weight of a person who is

exercising on the board. As an alternative position, we note that, prior to assembly of the track sections into the formation seen in Figures 1 and 2, each of the individual sections of the acrobatic track in Morozov would, in our opinion, qualify as a portable, stand alone, exercise board as broadly set forth in appellant's claim 1 on appeal.

While it is true that Morozov does not expressly describe the rectangular platform of each of the sections therein as being "substantially rigid," we nonetheless conclude from the disclosure of Morozov as a whole that the platform (4) of each of the sections of the run-up acrobatic track therein would have been understood by one of ordinary skill in the art as being "substantially rigid." Note particularly, the translation of Morozov at page 3, lines 6-8, where it is noted that the carpet covering (7) of each track section is "stapled... on the edges of the panel" or platform (4); page 3, lines 11-12, where it is indicated that the panels or platforms (4) are capable of transferring the spring efforts of one panel to another during the athlete's push; and page 3, lines 17-20, where it is indicated that the weight of the

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athlete is "evenly spread through the panel 4 on the spring elements 3," all of which statements clearly convey the perception that the panel or platform (4) of Morozov is "substantially rigid." Moreover, we also agree with the examiner that it would have been obvious to one of ordinary skill in the art, considering the collective teachings of Morozov and Oaks, to make the platforms/panels (4) of the track in Morozov "substantially rigid" so as to provide a rigid, stable feel to the surface portion of the acrobatic running track during use thereof by an athlete.

Based on the foregoing, we will sustain the examiner's rejection of claim 1 on appeal under 35 U.S.C. § 103. In addition, we note that, in accordance with appellant's grouping of the claims (brief, page 4) and the statement of page 6 of the brief, claims 2, 3, 9, 10 and 13 will fall with claim 1.

Regarding the examiner's rejection of appellant's claims 7 and 8 under 35 U.S.C. § 103 on the basis of the combined teachings of Morozov and Oaks, we must agree with appellant

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(brief, page 6) that the applied references do not teach or suggest forming the arched bars and the platform "as a unitary one-piece structure" (claim 7), or forming the arched bars and the feet "as a unitary one-piece structure" (claim 8).

Accordingly, we will not sustain the examiner's rejection of these claims under 35 U.S.C. § 103 based on the teachings of Morozov and Oaks.

Claim 4 on appeal sets forth that the arched bars of resilient spring material are "fabricated of a material selected from the group consisting of spring steel, fiberglass and polyurethane." In rejecting this claim the examiner has relied upon Morozov and Oaks as applied to claim 1 above, taken further in view of Mansfield. In the examiner's opinion (answer, page 5), Mansfield teaches that it is known in the art to make spring elements out of aluminum, fiberglass or polycarbonate (col. 3, lines 5-13). From this purported teaching, the examiner urges that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to make the bars/springs (3) of Morozov out of fiberglass. Morozov specifically notes (translation, page 3)

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that the spring elements therein are "made of several layers of plywood glued together." Our review of Mansfield indicates that this reference discloses making the flexible, semi-rigid plate or platform (12) of the exercise device therein of aluminum (col. 2, line 60), or other material like plastics, such as fiberglass or polycarbonate (col. 3, lines 11-13). Like appellant, we see nothing in these references which would have been suggestive to one of ordinary skill in the art of making the springs (3) of Morozov out of fiberglass. If anything, it would appear to us that the collective teachings of the applied references would have led an artisan to make the platform (4) of Morozov out of a flexible, semi-rigid material such as fiberglass, not the spring elements (3). Thus, we will not sustain the examiner's rejection of claim 4 under 35 U.S.C.

§ 103.

We next look to the examiner's rejection of claims 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Morozov in view of Oaks as applied to claim 1 above, and further in view of Marcolin, the German reference. Recognizing that the

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exercise board/track of Morozov as modified by Oaks does not disclose, teach or suggest the formation of resilient feet as specified in claims 5 and 6 on appeal, the examiner turns to Marcolin (pointing specifically to Figure 6) and urges that this reference discloses that it is known in the art of exercise boards to provide bars of resilient spring material and to form the feet of such exercise boards by bending the bars to form resilient feet that are bent under the corner portions of the platform. Relying on this teaching, the examiner has concluded that it would have been obvious to one of ordinary skill in the art to provide the platform of Morozov in view of Oaks with resilient feet formed as in Marcolin, in order to have feet which provide the required reaction and bending necessary to the use of the platform, and which are easily manufactured. Appellant's arguments on page 7 of the brief appear to be directed to the embodiment of Marcolin seen in Figure 1, and not to the embodiment seen in Figure 6 that was relied upon by the examiner. As a result, the arguments presented by appellant do not address the rejection made by the examiner and are clearly not persuasive of any error on the examiner's part. Under the circumstances,

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we are compelled to sustain the examiner's rejection of claims
5 and 6 under
35 U.S.C. § 103.

Claims 11 and 12 on appeal stand rejected under 35 U.S.C.
§ 103 as being unpatentable over Morozov in view of Oaks as
applied to claims 1 and 10 above, further in view of Puckett.
In the examiner's opinion, it would have been obvious to one
of ordinary skill in the art, based on the applied references,
to use ethylene vinyl acetate for the pad (6) of Morozov.
Puckett discloses the use of ethylene vinyl acetate (col. 3,
lines 36-37) for the pad (70) of a platform-type exercise aid.
Appellant's argument regarding claims 11 and 12 is found on
page 7 of the brief, wherein it is urged that there is no
suggestion in the applied references of using that particular
material in an exercise board having the other features of
appellant's invention. We find this argument unpersuasive,
because it appears to put forth the position that the prior
art must expressly teach or suggest exactly what appellant has
done. We, of course, agree with appellant that there must be
some teaching or incentive in the prior art for suggesting the

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desirability of a combination under 35 U.S.C. § 103. However, contrary to appellant's position, we do not believe that it is necessary that a device shown in one reference must be physically inserted into the device shown in the other, or that the claimed invention must be expressly suggested in any one or all of the applied references. Rather, the test for obviousness is what the combined teachings of the references would have fairly suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

With respect to claims 11 and 12 of the present case, given the disclosure in Morozov that the soft pad (6) therein should be of "porlon type" (translation, page 3), i.e, made of a soft plastic foam material, the teaching in Oaks (col. 3, lines 22-24) of a pad (23) formed of closed cell soft foam rubber, and the teaching in Puckett of a pad formed of ethylene vinyl acetate, we must agree with the examiner that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to form the pad (6) of Morozov of a material of the type specified in appellant's

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claim 11 on appeal. Thus, we will sustain the examiner's rejection of claim 11 under 35 U.S.C.

§ 103. Appellant (brief, page 4) has grouped claim 12 with claim 11, from which it depends, accordingly, claim 12 will fall with claim 11.

Independent claim 14 and dependent claim 20 have been rejected by the examiner under 35 U.S.C. § 103 as being unpatentable over Gvoich alone. The examiner's position with respect to claim 14 is set forth on page 7 of the answer as follows

Gvoich teaches an exercise board comprising a platform 22 made of plastic with an upwardly convex arch and a plurality of feet 102, 103 on the under side of the platform (Figure 1, 2 and column 4 lines 1-16). Gvoich discloses the claimed invention except for the plastic being fiber reinforced. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the plastic fiber reinforced since it was known in the art that fiber reinforcement provides added strength to a material.

Like appellant (reply brief, page 5), we find the examiner's bare assertion in this regard to be without any factual underpinnings in the applied prior art and that the

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examiner's position is based on unfounded assumptions stemming from the use of impermissible hindsight. It is by now well settled that a rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection she advances. She may not, because she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Absent the required factual basis on the examiner's part, we refuse to sustain the rejection of appellant's claim 14 under 35 U.S.C. § 103. It follows that the examiner's rejection of claim 20, which depend from claim 14, will also not be sustained.

Having reviewed both Oaks and Wilson, as respectively applied by the examiner under 35 U.S.C. § 103 against dependent claims 15 and 16, we note that these references provide no teaching or suggestion regarding the deficiencies

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in the examiner's position with respect to independent claim 14 discussed above. Accordingly, we also find the examiner's position to be untenable with regard to dependent claims 15 and 16, and, for that reason, refuse to sustain the examiner's rejections of claims 15 and 16 under 35 U.S.C. § 103.

Pursuant to 37 CFR § 1.196(b), we enter the following new grounds of rejection against claims 14 through 16 on appeal.

Claim 14 is rejected under 35 U.S.C. § 103 as being unpatentable over Gvoich in view of Mansfield or Marcolin. In this regard, we observe that Gvoich discloses an exercise board which includes a resilient, upwardly arched platform (22) fabricated from a resilient and flexible plastic (col. 4, lines 5-14). Gvoich makes no mention of fiber reinforced plastic for making the arched resilient platform. However, Mansfield and Marcolin each disclose exercise boards similar to that of appellant wherein the flexible, resilient platform of the device is formed of plastic and, more specifically, is formed of fiberglass-reinforced plastic. Note Mansfield column 3, lines 5-13, and the translation of Marcolin at page

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5, lines 8-10. Given the similarity in the use and operation of the exercise boards and platforms thereof in Gvoich, Mansfield and Marcolin, we are of the opinion that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to make the flexible, resilient platform (22) of Gvoich out of fiberglass-reinforced plastic material as taught in either Mansfield or Marcolin, so as to gain the advantages of strength and enhanced elastic flexibility mentioned in Marcolin.

Claims 15 and 16 are rejected under 35 U.S.C. § 103 as being unpatentable over Gvoich in view of Mansfield or Marcolin as applied to claim 14 above, and further in view of Oaks and Morozov. Mansfield, Oaks and Morozov each disclose an exercise board wherein the platform is provided with a resilient pad on the upper side thereof so as to assist in relieving the impact of the user's feet on the otherwise hard surface of the relatively rigid platform and in providing the upper surface of the platform with a degree of frictional resistance. Note particularly, Oaks, column 3, lines 22-35, and Mansfield, column 2, lines 60-62. Thus, viewing the

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collective teachings of the applied references, we consider that it would have been obvious to one of ordinary skill in the art to provide the flexible, semi-rigid platform of Gvoich (as modified above) with a resilient pad on the upper surface thereof so as to gain the advantages taught or suggested in Mansfield, Oaks and Morozov. As for the dimensional limitations set forth in claim 15, we consider that providing a platform and pad in Gvoich (as modified) wherein the thickness of the pad and platform are each "on the order of 1/4 inch" would have been obvious to one of ordinary skill in the art given the teachings and suggestions of the applied prior art references. Note particularly, the showing in Figures 1 and 2 of Mansfield that the pad (14) and platform (12) are generally of the same thickness, and the discussion in Mansfield (col. 3, lines 44-48) concerning platforms (32, 34) made of fiberglass sheet having thicknesses of 3/16 inch or 5/16 inch, both of which are "on the order of 1/4 inch."

To summarize our decision, we note that 1) the examiner's rejection of claims 1 through 3, 7 through 10 and 13 under

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35 U.S.C. § 103 has been sustained with regard to claims 1 through 3, 9, 10 and 13, but has not been sustained with regard claims 7 and 8; 2) the examiner's rejection of claim 4 under

35 U.S.C. § 103 has not been sustained; 3) the examiner's rejections of claims 5, 6, 11 and 12 under 35 U.S.C. § 103 have been sustained; and 4) the examiner's rejections of claims 14, 15, 16 and 20 under 35 U.S.C. § 103 have not been sustained. Thus, the decision of the examiner has been affirmed-in-part.

In addition, this panel of the Board, pursuant to 37 CFR § 1.196(b), has entered new grounds of rejection against claims 14 through 16 on appeal.

In addition to affirming the examiner's rejection of one or more claims, 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)). 37 CFR § 1.196(b) provides, "A new

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ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

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 (37 CFR § 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. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in

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order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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

AFFIRMED-IN-PART, 37 CFR § 1.196(b)

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APPENDIX

1. A portable, stand alone exercise board, comprising a generally rectangular, substantially rigid platform having an upper surface of sufficient lateral extent to receive a person who is exercising, a plurality of feet positioned toward corners of the platform on the under side of the platform and

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engagable with a supporting surface, and a pair of arched bars of resilient spring material extending between the feet along opposing side margins of the platform and imparting an upwardly convex contour to the platform while permitting the platform to flex with a resilient action in response to the weight of a person who is exercising on the board.

14. An exercise board, comprising a platform of fiber reinforced plastic formed with an upwardly convex arch and an upper surface of sufficient lateral extent to receive a person who is exercising, and a plurality of feet on the under side of the platform and engagable with a supporting surface, the fiber reinforced plastic permitting the platform to flex with a resilient action in response to the weight of a person who is exercising on the board.