

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN S. CHINN
and RICHARD A. HAACK

Appeal No. 1999-1986
Application 08/677,776

HEARD: FEBRUARY 7, 2000

Before COHEN, McQUADE, and GONZALES, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 21 through 27 and 29 through 37, as amended subsequent to that rejection. These claims constitute all of the claims remaining in the application.

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Appellants' invention pertains to a street hockey puck and to a method of manufacturing a hockey puck resistant to rising from a face to its edge upon interaction with playing surface irregularities. An understanding of the invention can be derived from a reading of exemplary claims 21 and 37, a copy of which appears in the APPENDIX to the brief (Paper No. 25).

As evidence of obviousness, the examiner has applied the document specified below:

Bigornia et al. (Bigornia)	5,284,343	Feb. 8, 1994
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The following rejection is before us for review.

Claims 21 through 27 and 29 through 37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bigornia.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper No. 26), while the complete statement of appellants'

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argument can be found in the brief (Paper No. 25).

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As acknowledged by the examiner (answer, page 2), appellants have indicated that claims 21 through 27 and 29 through 37 stand or fall together. Accordingly, we select independent claim 21 for review on appeal, with the remaining claims standing or falling therewith. We do note, however, that the other independent claims 29 and 37, akin to claim 21, include limitations pertaining to the weight being substantially movable in three dimensions both parallel and perpendicular to faces of the puck, with sufficient freedom of movement to permit the weight to permit the central axis of the weight to become angularly offset from normal to the faces and to permit the weight to simultaneously contact both of the faces so that the puck will more readily topple when rolling on its side.

OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellants' specification and claim 21, the applied

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patent,¹ the declaration of Kevin S. Chinn dated June 5, 1997, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

We reverse the examiner's rejection of appellants' claims.

Initially, we note that appellants disclose (specification, pages 5 and 6) a weight 16 (Fig. 6) that is free to move in a cavity of a puck both parallel and perpendicular to faces of the puck. The center of mass of weight 16 may move such that the center of mass of the puck is variable in three dimensions in the cavity. Appellants additionally explain (specification, page 6) that

¹ In our evaluation of the patent relied upon, we have considered all of the disclosure thereof 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).

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by creating a variable center of mass, the weight having freedom to move within the cavity causes the puck to more readily topple

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when rolling on its side or corner and tends to maintain the puck in a position substantially parallel to the playing surface.

Claim 21 is drawn to a street hockey puck comprising, inter alia, a cylindrical body having a side and upper and lower faces, with the side and lower face defining a cavity, and a weight within the cavity and having at least one linear dimension greater than the distance between the faces and being substantially movable in three dimensions both parallel and perpendicular to the faces of the puck, with sufficient freedom of movement to permit the weight to permit the central axis of the weight to become angularly offset from normal to the faces and to permit the weight to simultaneously contact both of the faces so that the puck will more readily topple when rolling on its side.

The sole evidence of obviousness applied by the examiner is the patent to Bigornia. In particular, the examiner focuses upon Figs. 4A and 4B of the reference as a basis for reaching the conclusion that the hockey puck taught therein would have been suggestive of the present invention to one

having ordinary skill in the art. We disagree.

It is readily apparent to us that the clear objective of the patentee Bigornia is to provide a variable weight puck so as to effect a heavier puck for more experienced players and a lighter puck for less experienced players. With that objective in mind, the patentee discloses an embodiment (Fig. 6) that includes up to 6 thin, circular metallic disks stacked in a puck cavity to provide extra weight. To create a lighter puck, a puck cover 14 is unscrewed, and a number of the disks are removed.

The examiner, viewing the showing in Figure 4 of Bigornia, is of the opinion that it would have been obvious to one having ordinary skill in the art to provide the disks with larger holes to enable the weights to be more readily added and removed, which modification according to the examiner would allow the weight to be movable in three dimensions and inherently cause the puck to topple from the side when rolling (answer, page 3).

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This panel of the board readily perceives from its reading of the Bigornia document, as a whole, that only with impermissible hindsight and inappropriate reliance upon

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appellants' own teaching in this application, would one have been able to derive the specifically defined street hockey puck of claim 21. In other words, and consistent with the view of declarant Chinn (paragraph 8), the overall Bigornia disclosure lacks any suggestion whatsoever that would have motivated one skilled in the art to so alter the holes in the disks as to allow the disks to simultaneously contact both faces of the puck cavity, as now claimed. The Bigornia reference is simply not sound evidence of obviousness relative to the invention on appeal.

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In summary, this panel of the board has reversed the rejection of appellants' claims under 35 U.S.C. § 103.

The decision of the examiner is reversed.

REVERSED

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IRWIN CHARLES COHEN))
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

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