

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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICOLAS PENICAUT

Appeal No. 2001-0038
Application No. 08/992,999

ON BRIEF

Before STAAB, NASE, and BAHR, *Administrative Patent Judges*.
STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-3. No other claims are currently pending. An amendment filed subsequent to the final rejection has not been entered.

Appellant's invention pertains to a brake for an in-line roller skate. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in

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the appendix to appellant's brief.

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The references applied in the final rejection are:

Charron et al. (Charron) 1994	5,330,208	Jul. 19,
Olson et al. (Olson) 1995	5,468,004	Nov. 21,
Babcock 1996	5,482,301	Jan. 09,

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Charron in view of Olson.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Charron in view of Olson and further in view of Babcock.

Reference is made to appellant's brief (Paper No. 21) and to the examiner's answer (Paper No. 23) for the respective positions of appellant and the examiner regarding the merits of these rejections.

With reference to drawing Figure 1, independent claim 1 calls for a composite rigid braking structure comprising a chassis 1 of an in-line skate, a rigid support 5, and a rubber block 4, wherein (a) the rubber block is rigidly and non-pivotally fixed to the rigid support, (b) the rigid support rigidly connects the rubber block and the chassis, and (c) the rigid support has a cut-out 13 into which a piece of elastic

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or viscoelastic material 14 is force-fitted in a position
isolating

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it from contact with other moving components and in a manner which permits the brake to absorb vibrations induced during braking.

Charron pertains to "shock absorbent in-line roller skates wherein the wheels are resilient mounted to navigate over rough, bumpy surfaces" (abstract). The examiner directs our attention to Figure 4c of Charron, and observes that the skate chassis

79 illustrated therein includes a rigid support 36, a rubber brake block 37 fixed to the rigid support, and a chassis cut-out 80 into which elastic discs 68 are positioned. The examiner finds that Charron "fails to show the elastic material force-fitted in a cut-out on the brake support" (answer, page 4). The examiner considers that Olson "teaches the use of an elastic material (42) force-fitted in a cut-out on the brake support (12)" (answer, page 4). Based on these findings, the examiner concludes that it would have been obvious to one of ordinary skill in the art to provide an elastic insert similar to element 42 of Olson in the rigid support 36 of Charron "because force fitting an elastic material on the brake support will reduce the amount of

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vibrations felt by the skater while braking" (answer,

page 4). Implicit in the rejection is the examiner's position that the modified Charron skate would correspond in all respects to the subject matter of claim 1. We do not agree.

The thrust of Olson is the provision of an anti-lock brake arm 26 for an in-line skate, said brake arm being adapted to apply a braking force to the ground engaging surface of the rear wheel when the braking skid pad 24 is caused to firmly engage the ground. To this end, the skid pad 24 and the brake arm 26 are mounted on a support 23 that is pivotally attached to the skate chassis by pivot pin 22. The sole disclosed purpose of the elastic element 42 noted by the examiner in the rejection is to bias the brake arm 26 of Olson to a neutral position so that the brake arm 26 does not engage the rear wheel until a large braking operation is performed (paragraph bridging columns 4 and 5). Thus, the skid pad 24 of Olson is not rigidly connected to the skate chassis, and the elastic element 42 is not mounted in a manner isolating it from contact with other moving components. Since the anti-lock brake arm 26 of Olson has no counterpart in Charron, and since the only disclosed purpose of Olson's elastic element is to bias the brake arm to a neutral position, it would not have

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been obvious to employ the elastic element 42 of Olson in Charron without also providing the remainder of Olson's anti-lock brake system. However, this would result in a skate chassis that does not respond to the requirement of claim 1 that the rubber block (i.e., skid pad) is rigidly connected to the skate chassis, or the requirement of claim 1 that the elastic material is mounted in a manner isolating it from contact with other moving components.

We are aware of the examiner's position to the effect that Olson's elastic material 42 will inherently function to reduce vibrations, at least to some degree. However, even if true, the rejection is not well taken. The examiner has pointed to no teaching in Charron or Olson, and we are aware of no such teaching, that would lead us to conclude that one of ordinary skill in the art would have appreciated Olson's elastic element 42 as acting to absorb vibrations induced during braking. Thus, the examiner's analysis of Olson appears to be based on the use of impermissible hindsight.

Where, as here, prior art references require a selective combination of elements to render obvious the claimed invention, there must be some reason for the combination other

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than hindsight gleaned from the invention disclosure, *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). In the fact situation before us, we are unable to agree with the examiner that one of ordinary skill in the art would have been motivated by the teachings of Olson to incorporate an elastic element into rubber block support 36 of Charron to absorb vibration induced during braking. It follows that the rejection of claim 1, as well as claim 2 that depends therefrom, as being unpatentable over the teachings of Charron and Olson cannot be sustained.

As to claim 3, the Babcock reference additionally applied in the rejection of this claim does not render obvious what we have found to be lacking in the combination of Charron and Olson. The rejection of claim 3 will therefore not be sustained.

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The decision of the examiner finally rejecting claims 1-3
is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	
JEFFREY V. NASE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
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LJS:hh

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