

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD A. SCHROEDER

Appeal No. 2002-1408
Application No. 09/228,076

ON BRIEF

Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a system for suspending a net such as a volleyball net over a floor. The structure of the invention is readily apparent from claim 1, the sole independent claim, which has been reproduced below.

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

Steele	1,778,173	Oct. 14, 1930
Albach	1,919,494	Jul. 25, 1933
Townsend	2,865,634	Dec. 23, 1958
Barnes	3,065,964	Nov. 27, 1962
Allbright	5,215,310	Jun. 1, 1993
USSR Inventor's Certificate ¹ (Dyagesis)	SU 1535549 A1	Jan. 15, 1990
QUIK SET Retractable Volleyball System Advertisement (QUIK SET)		Jan. 1, 1999 ²

Claims 1-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over QUIK SET in view of Albach and Allbright.

Claims 1-12 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Dyagesis in view of QUIK SET, Townsend and Allbright.³

¹Our understanding of this foreign language document was acquired by means of a PTO translation, a copy of which is enclosed.

²The appellant has not disputed the examiner's position that this is a proper reference under 35 U.S.C. § 102.

³A rejection of claims 1-12 on the basis of Dyagesis in view of QUIKSET, Albach and Allbright
(continued...)

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 19) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 18) and Reply Brief (Paper No. 21) for the appellant's arguments thereagainst.

OPINION

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

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or

³(...continued)

which was present in the final rejection (Paper No. 9), was not repeated in the Answer and therefore we shall consider it as having been withdrawn.

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from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Claim 1

An overhead supported system to suspend a net over a floor, the system comprising:

a net having a longitudinal axis;

a spaced pair of masks pivotally connected to an overhead structure to pivot about an axis parallel to the longitudinal axis of the net between a stored position and a play position; and

a pair of braces, each brace coupled to the overhead structure adjacent a first end, and coupled to the masts adjacent a second end to lock the masts in the play position, wherein the system does not contact and is not secured to the floor.

The Rejection Based Upon QUIK SET, Albach And Allbright

This rejection is applied to claims 1-12. The examiner is of the view that QUIK SET discloses all of the elements in independent claim 1 except for the mast pivotally connected to an overhead structure, but that it would have been obvious to one of ordinary skill in the art "to have employed the mast of Albach with the apparatus of Quik Set in order to permit the apparatus to be easily stored in the ceiling girder system of the sports area" (Answer, page 3). Allbright is cited for its disclosure of a net height adjustment device, a feature that is not recited in claim 1. The appellant argues that there is no suggestion for modifying the QUIK SET system by providing Albach's

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mast and mounting system, and that even if such were done it would not result in the invention recited in claim 1.

QUIK SET discloses a retractable volleyball net that is suspended between two masts (legs). Although not shown in the drawing, it would appear that the masts are attached in some fashion to an overhead structure, for it is stated that “you just push a button and the system lowers itself to the gym floor,” and then “just snap the tension braces and you’re ready to play.” As shown in the drawing and explained in the text, “Rubber Pads are installed on bottom of the legs to completely protect your gym floor. Won’t scratch or mar floor.” It is clear that the QUIK SET legs are in contact with the floor when the net is in the play position, and therefore the structure fails to disclose or teach the limitation in the claim that “the system does not contact and is not secured to the floor.” In addition, QUIKSET does not show or explain how the structure is supported, and therefore does not disclose or teach the limitation in claim 1 that the masts be “pivotally connected to an overhead structure to pivot about an axis parallel to the longitudinal axis of the net between a stored position and a play position.”

Albach is directed to a basketball backstop supported by a frame B and a frame brace C. Frame B is pivotally attached to overhead rails D in such a manner as to be lowered from a stored position where it is essentially parallel to the rails to a play position where it is perpendicular thereto. The components of the system do not contact the floor. Considering that the “net” in the Albach device is a basketball net, the

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longitudinal axis of which is essentially vertical, frame B pivots perpendicularly to the axis of the net between storage and playing positions, rather than parallel thereto, as required by the language of claim 1.

It is conventional to support a basketball backboard entirely from above so that there is no structure to prevent the players from passing beneath the backboard, which regularly occurs in the playing of the game. This is not a requirement in volleyball, however, and the QUIK SET system takes advantage of this by utilizing contact with the floor for positioning the net and for providing it with stability. We fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the QUIK SET volleyball support system in the manner proposed by the examiner, for to do so would necessitate a substantial, if not total, reconstruction of its components and operation, which would in our view be a disincentive for the artisan to do so. Moreover, as is pointed out by the appellant on page 6 of the Brief, neither reference teaches pivoting the masts about an axis parallel to the longitudinal axis of the net. We are not persuaded by the examiner's assertion on page 3 of the Answer that suggestion for the proposed modification is present because such would allow the volleyball net to easily be stored in the ceiling girder system of the sports area, for this goal already is achieved in QUIK SET.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In

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re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). According to our reviewing court:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" (citations omitted). In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 199).

It is our view that this is exactly what occurred in the present case. In passing, we point out that Allbright, which was cited for teaching vertical adjustment of a volleyball net, supports the net by "one-piece standards mounted in the ground," so it fails to eliminate the deficiency in the combination of QUIK SET and Albach.

It therefore is our conclusion that the teachings of the applied references fail to establish a prima facie case of obviousness with respect to the subject matter recited in claim 1, and we will not sustain this rejection of claim 1 or of claims 2-12, which depend therefrom.

The Rejection Based Upon Dyagesis, QUIKSET, Townsend And Allbright

In this rejection the examiner finds that Dyagesis discloses all of the elements recited in claim 1 except for the platform and ladder, the vertical adjustment means for the net, and the pivotal mounting of the masts to an overhead structure. The first two of these limitations are not recited in claim 1. The examiner concludes that in view of Townsend it would have been obvious to one of ordinary skill in the art to modify

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Dyagesis so that the pivot attachment to the overhead is present. We agree with the appellant that this conclusion is in error.

Dyagesis discloses a volleyball net in which the masts, while pivotally attached to the ceiling in the building, are secured in position by being screwed into threaded sockets in the floor (translation, page 1; Figures 1 and 3). Townsend discloses a ceiling-mounted support system for a basketball backboard that is similar in basic structure and operation to that of Albach. On the basis of the same reasoning set out above with regard to the other rejection of claim 1, we conclude that the combined teachings of Dyagesis and Townsend fail to establish a prima facie case of obviousness with regard to the subject matter of claim 1. Further consideration of QUIK SET and Allbright, which were cited for limitations not present in claim 1, fail to alter this opinion.

This rejection of claims 1-12 is not sustained.

CONCLUSION

The rejection of claims 1-12 as being unpatentable over QUIK SET in view of Albach and Allbright is not sustained.

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The rejection of claims 1-12 as being unpatentable over Dyagesis in view of
QUIK SET, Townsend and Allbright is not sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

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