

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RENATO ZALTRON

Appeal No. 2004-1922
Application No. 09/760,567

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 1-8 and 13-22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a trekking stick with a shock absorber. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

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

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|-------------------------------|--------------|---------------------------------------|
| Schwarting | 619,235 | Feb. 7, 1899 |
| Hyman | 3,730,544 | May 1, 1973 |
| Allsop <u>et al.</u> (Allsop) | 4,244,602 | Jan. 13, 1981 |
| Palinkas | 6,328,294 B1 | Dec. 11, 2001 (filed Nov. 2, 1999) |

The following rejections stand under 35 U.S.C. § 103(a):

- (1) Claims 14-18 on the basis of Allsop in view of Schwarting.
- (2) Claims 1-7, 13 and 19-22 on the basis of Allsop in view of Schwarting and Hyman.
- (3) Claim 8 on the basis of Allsop in view of Schwarting, Hyman and Palinkas.

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. 15) and the final rejection (Paper No. 9) for the examiner's reasoning in support of the rejections, and to the Brief (Paper No. 14) 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.

(1)

Independent claim 14 and dependent claims 15-18 stand rejected under 35 U.S.C. § 103(a) as being obvious¹ in view of the combined teachings of Allsop and Schwarting. In arriving at this conclusion, the examiner has found all of the subject matter recited in claim 14 to be disclosed or taught by Allsop, except for a means for activating and deactivating the shock-absorbing member. However, the examiner is of the view that to modify the Allsop device by adding this feature would have been obvious to one of ordinary skill in the art in view of the teachings of Schwarting "so as to

¹The 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 under 35 U.S.C. § 103, 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. Ex parte Clapp, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or 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, 1052 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

allow the [Allsop] stick to act strictly rigid when desired” (Paper No. 9, page 3). We do not agree, for the reasons set forth below.

Allsop is directed to a shock-absorbing ski pole. It is explained in the patent that in the course of skiing, substantial impact is transmitted through a skier's poles to the hands, arms and shoulders, a situation which is undesirable, and that the invention solves this problem by providing means to absorb these impacts while retaining the “feel” through the poles that a skier desires (columns 2 and 3). In furtherance of this aim, Allsop provides in the hand grip member a shock absorbing system comprising cylinder and piston means (16 and 18) interposed between the grip (24) and the shaft (14) of the ski pole (Figure 3). The piston is biased within the cylinder by a spring (20) and the cylinder is provided with a bleed orifice (33) to control exiting of air from the cylinder during compression caused by the impact of the end of the pole with the skiing surface. A guide pin (26) coacting with slots (52) prevents relative rotation between the piston and the cylinder. See columns 6 and 7. Allsop does not disclose or teach that the shock absorbing system be equipped with means for selective activation and deactivation; it is activated all of the time.

Schwarting discloses a crutch having a foot terminating at its distal end in a ring (15) that carries a plurality of teeth (16) which provide traction on slippery surfaces. Mounted for longitudinal movement within the ring is a retractable plug (18) that is spring-biased to an extended position beyond the teeth. A rotatable and longitudinally

slidable sleeve (15) surrounds the lower portion of the crutch, and operating in conjunction with a pin (23) and a slot (12) having branches (13 and 14), allows the retractable plug to be locked in the extended position or to be movable longitudinally outwardly (page 1, column 2). There is no teaching in Schwarting that the spring absorbs shocks applied to the crutch by impact with the walking surface, but only it outwardly toward its extended position.

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. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to provide the Allsop ski pole with the rotatable sleeve deactivating arrangement disclosed in Schwarting, for to equip the Allsop device with a mechanism that deactivates the shock absorbing means would render it incapable of operating in the manner intended and solving the problem to which it is directed, and would seem to provide no advantages. Moreover, Allsop desires to prevent rotational movement between the grip and the ski pole (column 6, lines 57-61), and if the Schwarting system were installed, this feature would be disabled and the grip portion of the Allsop pole would have to be extensively reconstructed. In our view, these factors would be disincentives for the artisan to make the examiner's proposed modification.

It therefore is our conclusion that the combined teachings of Allsop and Schwarting fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 14, and we will not sustain the rejection of claim 14 or of claims 15-18, which depend therefrom.

(2)

Claims 1-7, 13 and 19-22 stand rejected as being unpatentable over Allsop and Schwarting, applied as in the rejection of claim 14, taken further in view of Hyman, which was cited for teaching the use of a cam to inhibit the movement of a pin between two portions of a slot.

Independent claim 1 recites the same structure that was set forth in claim 14, and includes greater detail of the construction of the means for activating and deactivating the shock-absorbing member. This being the case, the same problems in combining Allsop and Schwarting that we discussed in the rejection of claim 14 et al. also are present in this rejection. Further consideration of the teachings of Hyman, which is directed to a collapsible ski pole, do not alleviate those problems, and on the same basis we therefore will not sustain the rejection of independent claim 1 or of dependent claims 2-7 and 13.

We reach the same conclusion, for the same reasons, with regard to the rejection of independent claim 19 and dependent claims 20 and 21. As was the case with the other independent claims, claim 19 includes a shock-absorbing member and means for

activating and deactivating it. It is our view, as stated above, that no suggestion exists for combining Allsop and Schwarting in the manner proposed by the examiner, a conclusion that also applies to claim 19. This being the case, we will not sustain the rejection of claims 19-22.

(3)

Claim 8, which depends from claim 1, adds the requirement that the shock-absorbing member be a molded spring made of polyurethane, which is not taught by Allsop or Schwarting. The examiner added Palinkas to the other two references for its teaching of such a spring, but Palinkas does not alleviate the problems in combining Allsop and Schwarting, and we therefore will not sustain the rejection of claim 8.

CONCLUSION

None of the three rejections is sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

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