

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte H. JAY SPIEGAL

Appeal 2006-2155
Application 10/747,179
Technology Center 3700

Decided: March 26, 2007

Before TERRY J. OWENS, STUART S. LEVY, and ANTON W. FETTING,
Administrative Patent Judges.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant appeals from a rejection of claims 1-20, which are all of the pending claims.

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THE INVENTION

The Appellant claims a football kicking tee and a device for controllably altering the trajectory of a kicked American football. The device is a shaped appliance (40) that fits inside the kicking tee (10) and, due to its shape, alters the trajectory of a football that strikes the appliance after being kicked by a kicker's foot (Specification 11: 3-7; 12: 14-20). Claim 1 is illustrative:

1. A device for controllably altering a trajectory of a kicked American football, comprising:
 - a) a stationary body placed at a fixed location in front of an American football supported in an orientation permitting said football to be kicked by a kicker's foot;
 - b) said body having a portion located such that after said football is kicked, said football strikes said portion and is deflected into a substantially predictable trajectory.

THE REFERENCE

McKee 5,613,678 Mar. 25, 1997

THE REJECTION

Claims 1-20 stand rejected under 1) 35 U.S.C. § 112, first paragraph, written description requirement, and 2) 35 U.S.C. § 102(b) as anticipated by McKee.

OPINION

The rejection under 35 U.S.C. § 112, first paragraph, is reversed. The rejection under 35 U.S.C. § 102(b) is affirmed as to claims 1-3, 8, 10, 11, and 14-20, and reversed as to claims 4-7, 9, 12, and 13.

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner argues that the Appellant's original disclosure does not provide adequate written descriptive support for "stationary" and "fixed", added by amendment to the independent claims (1 and 14), because "stationary" and "fixed" require the body to be permanently stationary and fixed, whereas the original disclosure (figs. 3-5) shows that appliance 40, which is the body in the Appellant's claims, can be removably placed in three orientations on tee 10 (Answer 3 and 7).

As stated in *Hormone Research Foundation Inc. v. Genentech Inc.*, 904 F.2d 1558, 1563, 15 USPQ2d 1039, 1043 (Fed. Cir. 1990), "[i]t is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer [citation omitted], and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings. For this reason, an analysis of the specification and prosecution history is important to proper claim construction." If "the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof [of lack of adequate written description], must provide reasons why one of ordinary skill in the art would not consider the description sufficient." *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

The Appellant's original disclosure (figs. 3-5) shows that once appliance 40 is placed in tee 10, it is stationary and at a fixed location until it is removed. The

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Examiner does not provide the required reasoning as to why one of ordinary skill in the art, when interpreting the Appellant's claim terms "stationary" and "fixed" in light of the Specification and prosecution history, would have considered the terms to require the permanence argued by the Examiner and, consequently, lack adequate written descriptive support in the Appellant's original disclosure.

Accordingly, we find that the Examiner has not carried the burden of establishing a *prima facie* case of lack of compliance with the 35 U.S.C. § 112, first paragraph, written description requirement.

Rejection under 35 U.S.C. § 102(b)

The Appellant argues the claims in the following groups: 1) claims 1, 2, and 14; 2) claim 3; 3) claims 4 and 8; 4) claim 5; 5) claims 6, 7 and 15; 6) claims 9, 12, 13, 16, 19, and 20, and 7) claims 10, 11, 17, and 18 (Br. 16-22). We therefore, limit our discussion of the affirmed rejections to the one claim in each group, i.e., claims 1, 3, 8, 10, 15 and 16. The other claims in each group for which the rejection is affirmed fall with the discussed claim in that group. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Claim 1

McKee discloses a base (210) having received therein a tee (220) with a football tip-shaped indentation (230) and, in front of the indentation, a first surface (226) (col. 10, ll. 47-53). As shown in figure 13C, when a football placed in the indentation is kicked, at least the lower tip of the football necessarily will strike the first surface.

The Appellant argues that McKee's tee is pivotable in use (Br. 17). The pivotable embodiment (figs. 13A and B) is not relevant to the Appellant's claimed

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invention. The relevant embodiment is the one shown in figure 13C.

The Appellant points out (Br. 17-18) that in the description of figure 13C, McKee states that the tee merely supports the ball so a child can kick the ball directly (col. 11, ll. 4-7). The Appellant argues that “[o]nce the football leaves the tee 220, it does not strike any device or object that could cause the football to be deflected into a substantially predictable trajectory” (Br. 17). As shown in McKee’s figure 13C, once the football is kicked, at least its lower tip strikes first surface 226. The football’s trajectory would be substantially predictable, i.e., in substantially the direction in which the football is kicked. The Appellant’s Specification does not limit the term “substantially predictable trajectory” to any further degree of trajectory predictability, such as predictability of a trajectory between goal post uprights.

The Appellant argues that the claim requirement that the football strikes a body portion after the football is kicked excludes striking that is simultaneous with the kicking action (Br. 18-19). The claims are not limited to striking after the completed kicking action. All the claims require is that the football strikes a body portion after the football is kicked, i.e., after a foot has struck the football. McKee’s figure 13C indicates that when the football first begins to travel after it has been struck, it necessarily strikes first surface 226.

Claim 3

Claim 3 requires that the body is received on a tee.

The Appellant argues that “McKee surely does not disclose such a stationary body actually received on a tee” (Br. 20). That argument is not persuasive because McKee’s base (210) and tee (220) can be considered to correspond, respectively, to the Appellant’s tee and body received on the tee (fig. 13C).

Claim 8

Claim 8 requires that the body portion comprises a recess shaped partially in conformance with a shape of a tip of an American football.

The Appellant argues that “[n]o such recess having such configuration is anywhere taught or suggested by McKee” (Br. 20). Such a recess is McKee’s indentation 230 (fig. 13C).

Claim 10

Claim 10 requires that the body portion comprises a rearward facing projection located slightly left of a centerline of the football when looking forward from a rear of the football.

The Appellant argues that McKee does not disclose such a portion that gets struck after a football is kicked as required by claim 1 from which claim 10 depends (Br. 21). That argument is not convincing because the rearward portion of McKee’s first surface extends both to the right and left of the centerline and, as indicated by figure 13C, is struck by a kicked football.

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Claim 15

Claim 15 requires a tee having a first recess shaped generally in conformance with a shape of a tip of an American football, a second recess connected to and forward of the first recess, and a stationary body removably received within the second recess.

The Appellant argues that McKee does not disclose a second recess connected to and forward of the first recess (Br. 20-21). McKee's first and second recesses are, respectively, indentation 230 in tee 220, and cavity 211 which receives the tee and extends forward of the tee (figs. 12A and 13C). The recesses are connected by way of the tee removably received within the cavity (fig. 13C).

Claim 16

Claim 16 requires that the body comprises a further recess shaped partially in conformance with a shape of a tip of an American football, the further recess and the first recess combining to substantially circumferentially enclose the football tip.

The Appellant argues that there is no teaching or suggestion that McKee's recess 230 is shaped generally in conformance with the shape of a tip of an American football (Br. 20-21). McKee's disclosure and illustration that a tip of a football is placed in indentation 230 (col. 11, ll. 50-51; fig. 13C) indicates that the indentation is shaped generally in conformance with the shape of a football's tip. Thus, each portion of recess 230 is a recess that is shaped partially in conformance with the shape of a football's tip.

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Conclusion regarding claims 1-3, 8, 10, 11, and 14-20

For the above reasons we are not convinced of reversible error in the Examiner's rejection under 35 U.S.C. § 102(b) of claims 1, 3, 8, 10, 15, 16 and claims 2, 11, 14 and 17-20 that fall with them.

Claims 4-7, 9, 12, and 13

Claim 4 requires a tee having a recess shaped generally in conformance with a shape of a tip of an American football, the football having a tip releasably received within the recess.

The Examiner argues that "McKee et al shows the tee (210) has a recess shaped generally in conformance with a shape of a tip of an American football, said football having a tip releasably received within said recess (indentation 230, please see figures 11A and 13C)" (Answer 4). Claim 3, however, from which claim 4 depends, requires that the body recited in claim 1 is received on a tee. The Examiner relies upon McKee's tee 220 as corresponding to the Appellant's body, and McKee's base 210, which receives the tee (fig. 13C) as corresponding to the Appellant's tee (Answer 3). Those components meet the requirements of the Appellant's claim 3. However, McKee's football tip-shaped recess 230 is in tee 220 (fig. 13C). There is no generally football tip-shaped recess in McKee's base 210 that receives the tee (figs. 12A and 13C). Thus, McKee does not disclose both a base received on a tee, as required by the Appellant's claim 3, and a generally football tip-shaped recess in the tee as required by claim 3's dependent claim 4.

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The Examiner, therefore, has not established a prima facie case of anticipation of the invention claimed in the Appellant's claim 4 or claims 5-7, 9, 12, and 13 that depend directly or indirectly therefrom.

DECISION

The rejection of claims 1-20 under 35 U.S.C. § 112, first paragraph, written description requirement, is reversed. The rejection of under 35 U.S.C. § 102(b) over McKee is affirmed as to claims 1-3, 8, 10, 11, and 14-20, and reversed as to claims 4-7, 9, 12, and 13.

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

AFFIRMED-IN-PART

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