

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMOND GIANNELLI

Appeal 2008-0433
Application 10/293,042
Technology Center 3700

Decided: March 7, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Raymond Gianelli (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-2 and 7-13. Claims 3-6 and 14-20 have been cancelled (App. Br. 2). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The invention relates to a torso exercise machine. Claim 1, the sole independent claim, reproduced below, is illustrative of the subject matter on appeal.

1. A lower torso exercise machine comprising:
 - a frame;
 - a user support structure mounted to the frame, wherein the user support structure includes a seat and a pelvic stabilizing pad, the seat being mounted to the frame below and at an angle oblique to the pelvic stabilizing pad; and
 - a footrest attached to the frame in front of the user support structure wherein the pelvic stabilizing pad is substantially half-cylindrical in shape.

THE REJECTION

The Examiner relies upon the following as evidence² of unpatentability:

Eriksson	US 2002/0022556 A1	Feb. 21, 2002
Simonson	US 5,597,375	Jan. 28, 1997

The following rejection is before us for review:

¹ Our decision will make reference to Appellants' Appeal Brief ("App. Br.," filed Oct. 31, 2006), the Examiner's Answer ("Answer," mailed Apr. 5, 2006), and the Reply Brief ("Reply Br.," filed May 3, 2007).

² The Answer also lists Ellis (US 6,6719,672 B1) as evidence of unpatentability. Ellis was only relied upon to reject claim 15 (see Final Rejection 2). Since claim 15 has been cancelled, Ellis is no longer applicable.

- Claims 1-2 and 7-13 are rejected under 35 U.S.C. § 103(a) over Eriksson and Simonson.

ISSUE

The issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 1-2 and 7-13 as unpatentable over Eriksson and Simonson. These issues turn on whether one of ordinary skill in the art would have been led to substitute Eriksson's rectangular pelvic stabilizing pad for Simonson's half-cylindrically-shaped knee stabilizing pad and thus arrive at the claimed apparatus.

The element of the claimed apparatus that is at issue is the rectangular pelvic stabilizing pad 18 shown in Fig. 1 of the Specification.

Fig. 1 of the Specification is reproduced below:

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FIG. 1

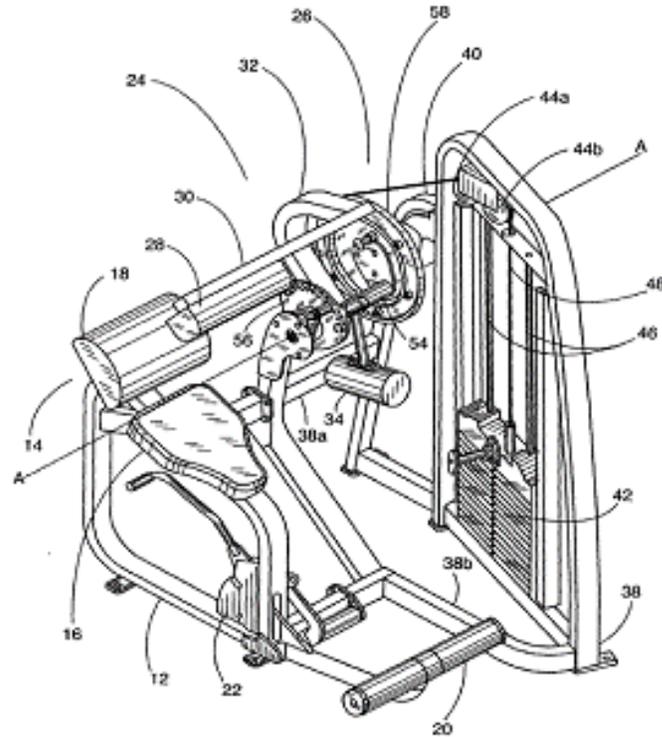


Fig. 1 of the Specification of 10/293,042 is said to depict a lower torso exercise machine comprising a half-cylindrically-shaped pelvic stabilizing pad (18), a seat (16) attached to frame (12) (which is itself mounted on user support structure (14)) oriented at an oblique angle to the pad and sloping downward to the footrest (20).

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

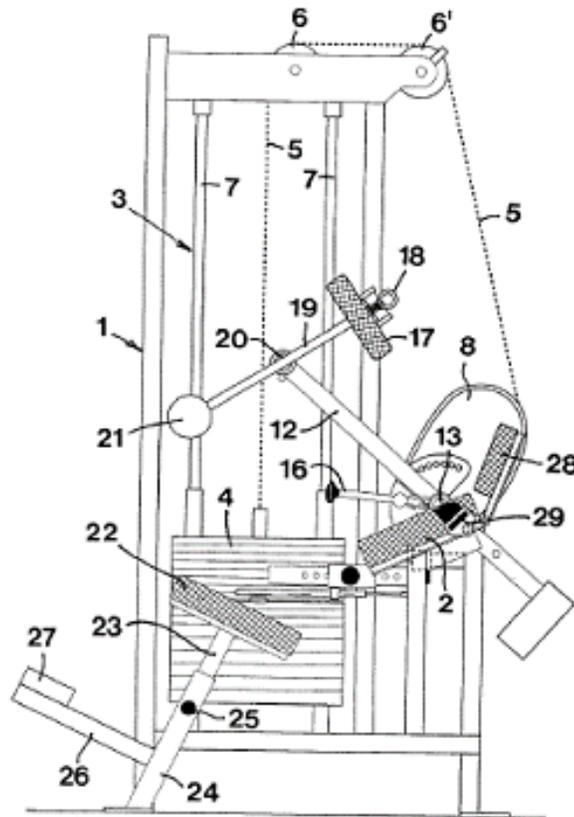
Claim construction

1. Claim 1 calls for a “pelvic stabilizing pad.”
2. The Specification does not provide a definition for the “pelvic” region to which the “pelvic stabilizing pad” refers.
3. The ordinary and customary meaning of “pelvic” is a region of the body “of or near the pelvis.” (*See Webster’s New World Dictionary* 997 (3rd Ed. 1988.)(Entry for “pelvic.”)
4. Claim 1 does not indicate which part of the “pelvic” area the “pelvic stabilizing pad” contacts.
5. The Specification does not provide a definition for “stabilizing.”
6. The ordinary and customary meaning of the term “stabilizing” is “to make stable, or firm.” (*Webster’s New World Dictionary* 1302 (3rd Ed. 1988.) (Entry 1. for “stabilize.”)

The scope and content of the prior art

7. Eriksson is directed to a machine for training back muscles.
8. Eriksson discloses a “support 28 [for] the lumbar or bottom of the user.” (Eriksson [0020].)(See element 28 in Fig. 1.)

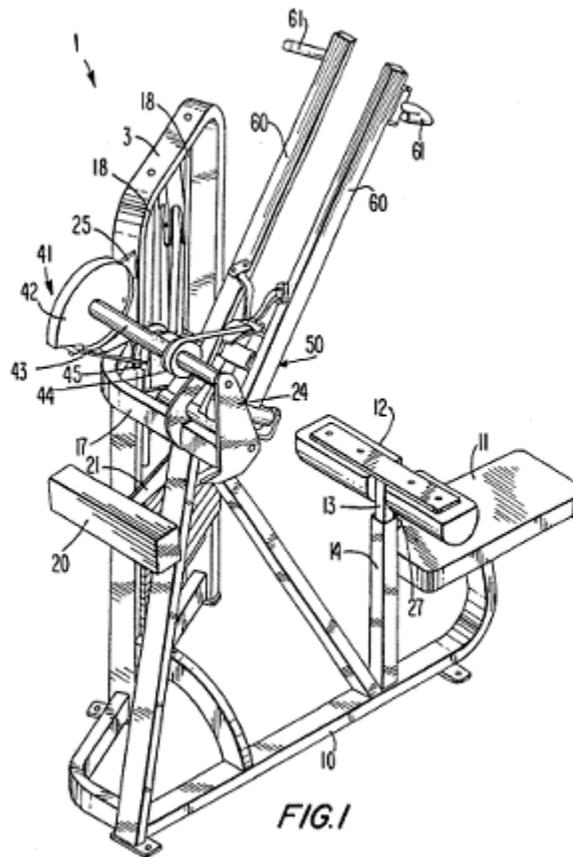
Eriksson Fig. 1 is reproduced below:



Eriksson's Fig. 1 is said to depict a machine for back muscular training with support 28.

9. Eriksson's support 28 is situated near a user's pelvis and thus acts as a support for the pelvic area.
10. On Fig. 1 (see *supra*), Eriksson's support 28 is shown to be rectangular in shape.
11. Simonson is directed to a lat-pull down exercise machine.
12. Simonson discloses that its machine includes a "knee pad" (Specification 5:13), as shown by element 12 in Simonson Fig. 1.

Simonson's Fig. 1 is reproduced below:



Simonson's Fig. 1 is said to depict a lat pulldown exercise machine.

13. Simonson's kneepad 12 stabilizes the knees as one pulls down on handles 61.
14. The kneepad 12 in Simonson Fig. 1 is substantially half-cylindrical in shape.

Any differences between the claimed subject matter and the prior art

15. The claimed apparatus is the result of substituting Eriksson's pelvic pad with one shaped like Simonson's kneepad.

The level of skill in the art

16. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art of exercise machines. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

17. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*]

factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18.

ANALYSIS

The Appellant argued claims 1-2 and 7-13 as a group (App. Br. 3-7 and Reply Br. 2-3). We select claim 1 (see *supra*) as the representative claim for this group, and the remaining claims 2 and 7-13 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner argued that “Eriksson et al discloses all of the limitations of the instant invention except for the half cylindrical shaped pad.” (Answer 4.) The Examiner relied on the teaching in Simonson of “pad 12 in the shape of a half cylindrical” (*id.*) and determined that it would have been obvious to “modify Eriksson et al in view of [Simonson] such that changing the shape of the pad allows a user to be more comfortable” (*id.*).

In the Appeal Brief, which was filed before *KSR* issued, the Appellant argued that Eriksson and Simonson are non-analogous, do not pertain to the same problem as to each other or to the claimed invention, and that the Examiner has used hindsight to reach the claimed invention from a combination of the prior art teachings. (App. Br. 4-7.) After *KSR* issued, in the Reply Brief, the Appellant argued that it would not have been obvious to try the Simonson pad in the Eriksson machine, that the use of a half-cylindrical shaped pad in the claimed invention is not a matter of mere design choice, and, in an argument similar to the non-analogous argument

made in the Appeal Brief, that Simonson is not in the same field of art as the claimed invention. (Reply Br. 2-3.)

We have reviewed the record and do not find that the Appellant has shown error in the rejection.

That Eriksson discloses a pelvic stabilizing pad is not in dispute. The dispute is only over the significance of giving Eriksson's pelvic stabilizing pad a half-cylindrical shape instead of the rectangular one shown in Fig. 1 of Eriksson. The Appellant submits that the change in shape is significant, i.e., that it is one that is more than a mere design choice. We can find no evidence in the record to support the Appellant's assertion that changing the Eriksson pad shape to one that is half-cylinder has any significance. Appellant's attorney's arguments in a brief cannot take the place of evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974). *See also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). The Specification does describe a stabilization effect but it is described in relation to the assembly as a whole, and specifically the one shown in Fig. 5 of the Specification. In that Figure, the pelvic stabilizing pad is oriented in a manner that claim 1 is not limited to. (See FF 1-6.)

The Appellant also makes a number of arguments whose common thread is the view that Eriksson and Simonson are non-analogous to each other or to the invention. We are not persuaded by this line of argument. Both Eriksson and Simonson are related to exercise machines, as is the claimed invention. To one of ordinary skill in the exercise machine art, these references and the claimed apparatus are clearly within the same field. Prior art is "analogous" when a person of ordinary skill in the art would

consider it relevant or related to the invention sought to be patented. *Dann v. Johnston*, 425 U.S. 219, 229 (1976). Here, one of ordinary skill in the art would consider support pads used in exercise machines such as the ones described in Eriksson and Simonson relevant and related to the exercise machine claimed.

With respect to the arguments directed to the differences in problems that the references are concerned with, those, too, are unpersuasive as to error in the rejection. “In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR, id.* at 1741-42.

Finally, we are not persuaded by the argument that one of ordinary skill would not have tried to use the half-cylindrical shape of Simonson’s knee pad as the shape for the back pelvic pad in Eriksson’s back training machine. One of ordinary skill in the art with these references in hand would have been led to consider forming Eriksson’s pelvic pad in any shape, not just rectangular. Nothing in Eriksson suggests limiting the pelvic pad to a rectangular shape. The pad need only function to stabilize the back pelvic region. One such shape, as suggested by Simonson, is half-cylindrical. Nothing unpredictable has been shown for changing the shape of a pelvis stabilizing pad to the half-cylindrical shape of Simonson. One would predict the same level of stabilization. In light of Simonson’s use of a half-cylindrical shape for a supporting pad, there is ample reason for one of ordinary skill to form Eriksson’s pelvic pad in that shape. Accordingly, we

are not persuaded that the Examiner used hindsight in reaching the claimed invention from the Eriksson and Simonson disclosures.

We are satisfied the Examiner has established a prima facie case of obviousness. Given the absence of evidence of secondary considerations, the prima facie case has not been overcome.

CONCLUSIONS OF LAW

We conclude the Appellant has failed to show that the Examiner erred in rejecting claims 1-2 and 7-13 as unpatentable over Eriksson and Simonson.

DECISION

The decision of the Examiner to reject claims 1-2 and 7-13 is affirmed.

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

See 37 C.F.R. § 1.136(a)(1)(iv) (2007).

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AFFIRMED

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