

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MISSION ITECH HOCKEY, INC.

Appeal 2008-3809
Application 11/052,531
Technology Center 3600

Decided: November 26, 2008

Before JAMESON LEE, SALLY C. MEDLEY, and MICHAEL P.
TIERNEY, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON APPEAL

A. STATEMENT OF THE CASE

This is a decision on appeal by the real party in interest, Mission Itech Hockey, Inc. (MIH), under 35 U.S.C. § 134(a) from a rejection of claims 16, 19-21, 23, 24, and 28. MIH requests reversal of the Examiner's rejection of those claims. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

References Relied on by the Examiner

Humphreys

4,139,209

Feb. 13, 1979

The Rejections on Appeal

The Examiner rejected claims 16, 19-21, 23, 24, and 28 under 35 U.S.C. § 102(b) as anticipated by Humphreys.

The Invention

The invention relates to an ice skate chassis having a skate blade with an adjustable pitch. (Spec. 1:¶1.) Claim 16 is the independent claim and is reproduced below (App. Br. 15, Claims App'x.)

16. An ice skate chassis adjustable between a plurality of discrete pitch positions, comprising:

an elongate skate blade;

a bladeholder configured to receive the elongate skate blade;

and

a mounting mechanism for securing the blade to the bladeholder, the mounting mechanism configured to selectively secure the blade only at a plurality of discrete, pre-set positions relative to the bladeholder.

B. ISSUE

Does “discrete, pre-set positions” include a continuous spectrum of potential locations?

C. FINDINGS OF FACT

1. Humphreys discloses an ice skate having a blade holder that allows for pivotally adjusting a skate blade. (Humphreys 1:31-39)
2. The adjustment mechanism includes a bolt 50 that contacts a rise portion 54 of a skate blade 22. (Humphreys 3:13-17.)
3. The act of rotating the threaded bolt causes continuous adjustment of skate blade 22 relative to a skate blade carrier 10. (Humphreys 3:35-41.)
4. Skate blade 22 has a continuous spectrum of securable locations one after the other. (Humphreys 3:35-41.)
5. A scale 56 is adjacent bolt 50 and includes reference markings 1-5. (Humphrey's Figure 1.)
6. The reference markings of scale 56 are not disclosed as limiting the possible positions that bolt 50 takes when it is rotated.
7. As bolt 50 is rotated, it moves through all the positions in-between the markings. (Humphreys Figure 1.)
8. The reference markings are simply visual indicators that allow the skate wearer to judge the angle of skate blade 22. (Humphreys 1:61-62; 3:18-22.)

D. PRINCIPLES OF LAW

To establish anticipation under 35 U.S.C. § 102, each and every element in a claim, arranged as is recited in the claim, must be found in a single prior art reference. *Karsten Manufacturing Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001).

E. ANALYSIS

The Examiner rejected claims 16, 19-21, 23, 24, and 28 as anticipated by Humphreys. To establish anticipation under 35 U.S.C. § 102, each and every element in a claim, arranged as is recited in the claim, must be found in a single prior art reference. *Karsten Manufacturing Corp.* 242 F.3d at 1383. We focus on the disputed limitations.

MIH disputes that Humphreys satisfies the requirement in claim 16 of a “mounting mechanism configured to selectively secure the blade only at a plurality of discrete, pre-set positions relative to the bladeholder.” (App. Br. 10:8-12.)¹

The Examiner found that the limitation is satisfied by the operation of Humphreys’ bolt 50. (Final Rejection 2:14-16, July 21, 2005.) In Humphreys, bolt 50 is part of an adjustment mechanism and contacts a rise portion 54 of a skate blade 22. (Humphreys 3:13-17.) The bolt is adjustably threaded vertically such that the act of rotating the bolt causes continuous pivoting of skate blade 22 relative to a skate blade carrier 10. (Humphreys 3:35-41.) For skate blade 22, there is a continuous spectrum of securable locations one after the other. (Humphreys 3:35-41.)

MIH argues that rotation of threaded bolt 50 enables the skate blade 22 to be adjusted to an infinite number of positions relative to the skate blade carrier. According to MIH, a mounting mechanism capable of infinite adjustment does not satisfy the requirement of a mounting mechanism that is configured to secure a skate blade “only at a plurality of discrete, pre-set positions.” (App. Br. 10:8 to 11:14.)

¹ “App. Br” refers to the Supplemental Corrected Appeal Brief filed August 18, 2006.

Whether an infinite number of adjustable securing positions are provided by the rotatable bolt is not determinative. If all of them are discrete and preset then the claim limitation would be met. The key here lies in the claim limitations “discrete” and “pre-set” insofar as they restrict the securing positions.

The term “discrete” means “consisting of distinct or unconnected elements: NONCONTINUOUS.” *Merriam Webster’s Collegiate Dictionary* 332 (10th ed. 1996). As noted above, the act of rotating Humphreys’ threaded bolt 50 causes continuous adjustment of skate blade 22 within a continuous spectrum of securable locations that follow one after the other. Nothing separates one position from the next. No one position is distinctly configured. Humphreys’ skate blade positions are neither “discrete” nor “pre-set.” They are not “discrete” because motion of the adjustable bolt is continuous. They are not “pre-set” because no position is structurally pre-configured for distinction from any other position.

Humphreys does disclose a scale 56 that is adjacent bolt 50 and includes reference markings 1-5. (Humphrey’s Figure 1.) However, those reference markings do not define structural limits or form structural configurations. As bolt 50 is rotated, it moves through all the positions in-between the markings. (Humphreys Figure 1.) The markings are simply visual indicators that allow a user to judge the angle of skate blade 22 when bolt 50 is rotated. (Humphreys 1:61-62; 3:18-22.) They do not cause any position to be structurally pre-set.

For all the foregoing reasons, we do not sustain the rejection of claim 16, under 35 U.S.C. § 102(b) as anticipated by Humphreys.

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Claims 19-21, 23, 24, and 28 are dependent, either directly or indirectly, on claim 16. We also do not sustain the rejection of those claims under 35 U.S.C. § 102(b) as anticipated by Humphreys.

F. CONCLUSION

“Discrete, pre-set positions” does not include a continuous spectrum of potential locations.

G. ORDER

The rejection of claims 16, 19-21, 23, 24, and 28 under 35 U.S.C. § 102(b) as anticipated by Humphreys is **reversed**.

REVERSED

rvb

Enclosure

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Notice of References Cited	Application/Control No. 10/898,364	Applicant(s)/Patent Under Reexamination of a Patent Appeal No. 2007-3229	
	Examiner Tuan Lam	Art Unit 2800	Page 1 of 1

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D	US-			
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*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
U	Merriam-Webster's Collegiate Dictionary, (10 th ed., 1993) at 332.
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*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
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