

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH J. ESTWANIK

Appeal No. 98-1242
Application No. 08/498,884¹

ON BRIEF

Before ABRAMS, FRANKFORT, and PATE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-15, which constitute all of the

¹Application for patent filed July 6, 1995. According to appellant, this application is a continuation of Application No. 29/023,620 filed May 27, 1994, now U.S. Design Patent No. D367,731 issued March 5, 1996.

claims of record in the application. However, the examiner has indicated on page 2 of the Answer that claims 9 and 11-15 are allowable over the art of record. This being the case, only claims 1-8 and 10 remain on appeal.

The appellant's invention is directed to a hand and wrist stabilization device for use under a boxing glove. The claims on appeal have been reproduced in an appendix to the Brief (Paper No. 11).

The references relied upon by the examiner to support the rejections that remain are:

Travers 1929	1,706,503	Mar. 26,
Ballard 1994	5,295,269	Mar. 22,

The following rejections presently stand on appeal:

Claims 1-4 and 7 under 35 U.S.C. § 102(b) as being anticipated by Ballard.

Claims 5, 6 and 10 under 35 U.S.C. § 103 as being unpatentable over Ballard in view of Travers.

Claim 8 under 35 U.S.C. § 103 as being unpatentable over Ballard.

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the

examiner and the appellant as set forth in the Answer (Paper No. 12) and the Brief (Paper No. 11), considered in the light of the guidance provided by our reviewing court.

The Rejection Under 35 U.S.C. § 102(b)

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See *Verdegaal Brothers Inc. v. Union Oil Co. of California*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does anticipation require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S.

1026 (1984). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of the claim. See *In re Mott*, 557 F.2d 266, 269, 194 USPQ 305, 307 (CCPA 1977).

The appellant's invention is a hand and wrist stabilization device for use by a boxer to protect the hands while clenched into fists. It is the examiner's position that all of the subject matter recited in independent claim 1 and claims 2-4 and 7, which depend therefrom, is anticipated by Ballard. We agree.

Using the language of claim 1 as a guide, Ballard discloses a hand and wrist stabilization device (column 1, line 44 *et seq.*) comprising a body formed of flexible material for disposition over at least a portion of the hand and the wrist and including a hand portion and a wrist portion (Figure 1). A force dispersion pad (3) is mounted to the body portion and extends transversely across the metacarpophalangeal joints, functioning to disperse impact force to these joints (column 1, lines 46-50). A strap (5) extends laterally away from the pad

from a position adjacent the joints. We point out here that while this strap is not "adjacent" the joints in the sense of extending laterally from a position aligned with the joints, as is disclosed by the appellant, it nevertheless is "adjacent" the joints in that it lies near and is not distant from the joints,² which is all that is required by the claim. Finally, Ballard discloses means for fastening the strap (2) at the wrist portion when the hand is formed into a fist, which strap is capable of isolating wrist movement and maintaining the user's hand in a fist condition. Given that the Ballard strap is 85 inches long (column 1, line 53), it is capable of performing the claimed function if it were wrapped about the clenched fist and then anchored to the pad (unnumbered) on the wrist portion of the glove, even though such a use is not taught by the patentee.

The requirements for a second strap as recited in claim 2 are met by strap 10 of Ballard, which extends laterally away from the body portion oppositely of the first strap and is fastenable to the wrist portion oppositely of the first strap.

²See, for example, Merriam Webster's Collegiate Dictionary, Tenth Edition, 1996, page 14.

We point out here that it is not necessary, according to the claim language, that the second strap be fastened to the body portion at a point directly opposite to the first strap, but only that it "extend laterally away" from the body "oppositely from" the first strap, which we interpret to mean simply in the opposite direction.

Claims 3, 4 and 7 also depend from claim 1, but since their patentability was not separately argued, they fall with claim 1. See *In re Nielson*, 816 F.2d 1567, 1570, 2 USPQ2d 1525, 1526 (Fed. Cir. 1987).

The rejection of claims 1-4 and 7 is sustained.

The Rejections Under 35 U.S.C. § 103

In rejections under Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re*

Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom (see *In re Boe*,

355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

The first rejection under this section of the statute is that claims 5, 6 and 10 are unpatentable over the combined teachings of Ballard and Travers. Claim 5 adds to claim 1 the requirement that there be a stabilization member mounted on the hand portion of the glove "at a position oppositely disposed from said force dispersion pad with the user's hand disposed therebetween," that is, a second pad on the palm portion of the glove.

Ballard has been described above, and it does not disclose or teach such a structure. In fact, according to Ballard, the palm should be "free from padding and unrestricted" (column 2, line 8). Travers teaches providing a boxer's hand protector glove with a pad (17) around which the hand is closed. However, we agree with the appellant that it would not have been obvious to add such a pad to the Ballard glove, in view of Ballard's explicit teaching that the palm should be free from just such an element, which would have been a disincentive for one of ordinary skill in the art to have made such a

modification. The same comments apply to independent claim 10, which also contains this structure.

The teachings of Ballard and Travers therefore fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in claim 5, its dependent claim 6, and claim 10, and we will not sustain the rejection of them.

Claim 8 stands rejected as being unpatentable over Ballard, alone. This claim further defines the features of the second strap recited in claim 2, stating that it forms an ulnar wrist stabilization strap extending away from the dispersion pad for attachment to the wrist portion of the device. In our view, Ballard's strap 10 complies with these requirements, and thus this reference establishes a *prima facie* case of obviousness with regard to the subject matter of claim 8. We therefore will sustain this rejection.

Summary

The rejection of claims 1-4 and 7 as being anticipated by Ballard is sustained.

The rejection of claims 5, 6 and 10 as being unpatentable over Ballard in view of Travers is not sustained.

The rejection of claim 8 as being unpatentable over Ballard is sustained.

The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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WILLIAM F. PATE)	
Administrative Patent Judge)	

NEA/jlb

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