

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CLIFF POSHADLO, JR.

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Appeal No. 1999-2035  
Application No. 07/772,698<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 32 through 37, which are all of the claims pending in this application.

We REVERSE.

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<sup>1</sup> Application for patent filed October 7, 1991.

BACKGROUND

The appellant's invention relates to an improved surface for a tennis court. An understanding of the invention can be derived from a reading of exemplary claim 32, 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:

Healy	1,897,801	Feb. 14, 1933
Grant et al. (Grant)	4,045,022	Aug. 30, 1977
Bourgin et al. (Bourgin)	2,553,001 <sup>2</sup> (France)	Apr. 12, 1985

Claims 32 through 37 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

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<sup>2</sup> In determining the teachings of Bourgin, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

Claims 32 through 35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Grant in view of Bourgin.

Claims 36 and 37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Grant in view of Bourgin as applied to claim 32 and further in view of Healy.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections<sup>3</sup>, we make reference to the answer (Paper No. 19, mailed November 3, 1994) and the response to the reply brief (Paper No. 21, mailed March 30, 1995) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 18, filed June 23, 1994) and reply brief (Paper No. 20, filed January 3, 1995) for the appellant's arguments thereagainst.

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<sup>3</sup> Since the other grounds of rejection set forth in the final rejection (Paper No. 16, mailed January 26, 1994) were not set forth in the examiner's answer we assume that these other grounds of rejection have been withdrawn by the examiner. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

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.

**The indefiniteness rejection**

We will not sustain the rejection of claims 32 through 37 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted

by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Thus, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is

not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146  
(Bd. Pat. App. & Inter. 1992).

With this as background, we analyze the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. The examiner determined (answer, p. 3) that (1) in claim 32, there is no antecedent basis for "the front of the net," and (2) in claim 37, it is not clear as to what is meant by "traditional court markings of which the identification means correspond."

We agree with the appellant's argument (reply brief, pp. 2-3) that the specific terms found objectionable by the examiner are not recited in claims 32 and 37. In that regard, claim 32 recites "the front by the net" not "the front of the net" and claim 37 recites "the identifying means further includes markings corresponding to traditional court marks" not "traditional court markings of which the identification means correspond."

We also agree with the appellant's argument (reply brief, pp. 2-3) that the specific terms recited in claims 32 and 37 (i.e., "the front by the net" recited in claim 32 and "the identifying means further includes markings corresponding to traditional court marks" recited in claim 37) would be clearly understood by those skilled in the art. Accordingly, we conclude that claims are definite under the second paragraph of 35 U.S.C. § 112.

For the reasons stated above, the decision of the examiner to reject claims 32 through 37 under 35 U.S.C. § 112, second paragraph, is reversed.

**The obviousness rejections**

Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness. Accordingly, we will not sustain the examiner's rejection of claims 32 through 37 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 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). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt

that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Grant discloses a no-line tennis court. As shown in Figure 1, the tennis court 10 includes a net 12, near serve-receiving zones 14 and 16 are pigmented or colored differently to define a single unidimensional boundary line 18 (similarly serve-receiving zones 20 and 22 are differently colored), end play zones 24 and 26 can be identically colored as well as the two doubles zones 28 and 30. Grant teaches that with a minimum of four different colors, each zone is distinguishable from every contiguous zone, and both halves of the court appear the same when viewed from the other side of the net. In Figure 2, the court surface can be seen to be defined by a

number of strips of matting 32, which can be manufactured in the desired colors and unrolled on the court. Grant further teaches that the use of matting eliminates the need to paint or otherwise color the court directly, and the mats could be transported to different courts.

Bourgin discloses an electrical grid board divided by a net over which a ball is served as in tennis. As shown in Figure 1, the playing area 1 is divided into two equal halves by a net 4. Each half is divided into a grid of rows 2 and columns 3. Bourgin teaches that the rows may be colored, the serving zones being red and the front zones being green. Using electronic circuitry connected to the rows 2 and columns 3 and a series of playing cards, the player follows a game of strategy in returning the ball to the opposite court.

With respect to claim 32 (the only independent claim on appeal), the examiner determined (answer, pp. 3-4) that

[t]o utilize the teachings of BOURGIN to divide the court of GRANT into a number of predetermined sectors would have been considered obvious in view of the teachings of BOURGIN, since the greater the number of sectors would require greater skill on the part of the practicing

player to hit a ball into a selected sector, thus better preparing the player for competitive play. The claimed nine (9) sectors is seen to be a mere design choice since such would merely depend on the level of skill desired to be obtained.

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require "means for physically identifying at least one sector on one of said playing areas" wherein a sector is defined as "one of nine areas for each playing area determined by dividing each playing area into three equal lanes parallel to the net and into three equal zones perpendicular to the net." It is our opinion that the "means for physically identifying at least one sector on one of said playing areas" limitation is not suggested by the prior art as applied by the examiner. In that regard, it is our view that the teachings of Bourgin would not have suggested to one of ordinary skill in the art at the time the invention was made any modification to the tennis court of Grant and thus would not have led an artisan to arrive at the claimed invention.

In our view, the only suggestion for modifying Grant in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 32 through 37.<sup>4</sup>

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 32 through 37 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 32 through 37 under 35 U.S.C. § 103 is reversed.

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<sup>4</sup> We have also reviewed the reference to Healy additionally applied in the rejection of claims 36 and 37 but find nothing therein which makes up for the deficiencies of Grant and Bourgin discussed above.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPEAL NO. 1999-2035 - JUDGE NASE  
APPLICATION NO. 07/772,698

APJ NASE

APJ FRANKFORT

APJ McQUADE

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 17 Aug 99

**FINAL TYPED:**

***Gloria:*** Translation of Bourgin is being obtained. **Do not mail decision without translation.**