

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOSHUA OH

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Appeal No. 2001-2102  
Application No. 09/431,944

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ON BRIEF

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Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 21 to 30. The other claims remaining in the application, 1 to 4, 7 to 10, 13, 17 and 20, have been allowed.

The claims on appeal are drawn to a hockey-stop facilitating in-line skate (claims 21 to 28) and a method of in-line skating (claims 29 and 30), and are reproduced in the appendix of appellant's brief.



Appeal No. 2001-2102  
Application No. 09/431,944

at the side of the primary wheels with its bottom surface 41 spaced from the ground 24 by a distance  $H_1$  when the wheels 18 are positioned vertically. The Pratt apparatus differs from claim 21 in that distance  $H_1$  is disclosed as being "e.g., about 0.25 inch" (col. 4, line 18), whereas claim 21 recites that the auxiliary wheel is mounted "in a position raised at least one-half inch relative [to] a plurality of said primary wheels."<sup>1</sup>

As to this difference, the examiner takes the position that (answer, page 4):

It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the in-line skate of Pratt by raising the height of the auxiliary wheel relative to the primary wheels any desired amount including 0.5 inches and 1.0 inches by incorporating smaller diameter auxiliary wheels and/or by changing the size and relative dimensions of the auxiliary wheel mounting bracket as necessary and desirable to provide the user with more freedom to lean and

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<sup>1</sup> Although the claims are not rejected under 35 U.S.C. § 112, second paragraph, this language is less than precise as to exactly what dimension the "at least one-half inch" is intended to represent. In view of appellant's specification, we interpret this language (and similar language in claims 25 and 30) as meaning that the bottom of the auxiliary wheel is spaced the recited distance above a ground plane passing through the bottom of the primary wheels and perpendicular to the longitudinal plane in which the primary wheels lie.

Appeal No. 2001-2102  
Application No. 09/431,944

balance during turns and other maneuvers such as the hockey-style stopping maneuver.

Noting Pratt's disclosure at col. 4, lines 22 to 29, that auxiliary wheels of other diameters may be used, the examiner further states (answer, page 7):

one of ordinary skill in the art at the time the instant invention was made would have been able to conclude that Pratt's teaching to use different sized wheels would have led one of ordinary skill in the art to conclude that wheels of any size could be used, including wheels of smaller diameter and having higher height above the surface to provide a more stabilizing skating stance for, say, an experienced in-line skater who was nevertheless engaged in learning to skate tight turns and jumps that required more inclined skating angles, such as would occur in learning to skate in emulation of figure skating on ice, and other like sport skating.

Appellant argues that one of ordinary skill would not have found it obvious to increase the ground clearance of Pratt's auxiliary wheel 40 beyond the 0.25 inch amount disclosed, because the Pratt auxiliary wheel is used as a training wheel, to assist the skater to maintain balance without falling, and to increase the clearance to one-half inch or more would allow the skate to tip too far. Appellant argues that such a modification would not have been obvious

Appeal No. 2001-2102  
Application No. 09/431,944

because it would render the Pratt device inoperable for its intended purpose.<sup>2</sup>

Although Pratt discloses that the height (ground clearance) shown may be varied by mounting larger diameter wheels (thereby decreasing  $H_1$ ) (col. 4, lines 23 to 27), we do not consider that Pratt necessarily teaches away from substituting smaller diameter wheels (increasing  $H_1$ ), because Pratt states at col. 4, lines 28 to 30, that "the user may vary the height,  $H_1$ , as needed, and as balance acclimation improves." In light of this disclosure, one of ordinary skill would be led to increase  $H_1$  "as balance acclimation improves."

Nevertheless, we will not sustain the rejection. "Even when obviousness is based on a single reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). In the present case, the examiner has adduced no evidence to support the conclusion that it would have been obvious to increase the

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<sup>2</sup> Appellant cites In re Kramer, 18 USPQ2d 1415, 1416 (Fed. Cir. 1991) for this proposition, although Kramer was designated by the Court as "not citable as precedent."

Appeal No. 2001-2102  
Application No. 09/431,944

H<sub>1</sub> dimension of Pratt's apparatus to at least one-half inch, as claimed. While the examiner states, as quoted supra, that having a greater ground clearance for the auxiliary wheel would have obvious for an experienced in-line skater learning to skate tight turns and jumps, no evidence is cited in support of this statement, e.g., to show or suggest that such an experienced skater would use a skate with an auxiliary wheel or other device to assist in maintaining balance.

Accordingly, we will not sustain the rejection of claim 21, nor of claims 22 to 30, all of which include similar limitations concerning the position of the auxiliary wheel above the ground.<sup>3</sup>

#### Conclusion

The examiner's decision to reject claims 21 to 30 is reversed.

REVERSED

IAN A. CALVERT )

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<sup>3</sup> Claims 25 to 28 and 30 recite a greater clearance of at least one inch.

Appeal No. 2001-2102  
Application No. 09/431,944

Administrative Patent Judge	)	
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NEAL E. ABRAMS	)	APPEALS
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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