

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

---

Ex parte SHANNON HERRING

---

Appeal No. 2002-1288  
Application No. 09/570,759

---

ON BRIEF

---

Before ABRAMS, FRANKFORT, 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 1 to 10, 12, 14 and 16 to 19, which are all of the claims pending in this application.<sup>1</sup>

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

---

<sup>1</sup> While the examiner has approved entry of the amendment after final rejection canceling claim 13 (Paper No. 10, filed September 28, 2001), we note that this amendment has not been clerically entered even after this application had been remanded to the examiner for entry of that amendment (see Paper No. 18, mailed December 16, 2002).

BACKGROUND

The appellant's invention relates to guitar accessories (specification, p. 1). A copy of the claims under appeal is set forth 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:

|                          |           |               |
|--------------------------|-----------|---------------|
| White                    | 5,219,075 | June 15, 1993 |
| Pirchio et al. (Pirchio) | 5,375,497 | Dec. 27, 1994 |
| Hoshino                  | 5,497,689 | Mar. 12, 1996 |
| Garrison                 | 5,986,193 | Nov. 16, 1999 |

Claims 1, 2, 4 to 7, 10, 12, 14, 16 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Garrison in view of Hoshino.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Garrison in view of Hoshino and White.

Claims 8, 9, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Garrison in view of Hoshino, White and Pirchio.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 19, mailed January 31, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 11, filed January 10, 2002) for the appellant's arguments thereagainst.

#### 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. 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 with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 10, 12, 14 and 16 to 19 under 35 U.S.C. § 103. Our reasoning for this determination follows.

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 would have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 1, 5 and 10, the independent claims on appeal, read as follows:

1. Apparatus including a protective device for musical instruments comprising:
  - a soft bottom rest having an angled cavity for receiving a guitar-like instrument and allowing the guitar-like instrument to rest against a wall or other substantially vertical structure
5. Apparatus comprising:
  - a guitar-like instrument in combination with a soft bottom rest shaped to fit the guitar-like instrument.
10. Apparatus including a protective device for musical instruments comprising:
  - a soft bottom rest having an angled cavity for receiving a guitar-like instrument and allowing the guitar-like instrument to stand upright without resting against a wall or other substantially vertical structure.

In rejecting claims 1, 5 and 10 under 35 U.S.C. § 103<sup>2</sup>, the examiner

(1) determined that Garrison teaches the use of a protective device for musical instruments comprising a soft bottom rest for receiving a guitar and allowing the guitar to rest against a vertical structure or to stand upright; (2) determined that Hoshino

---

<sup>2</sup> See page 3 of the answer.

teaches the use of a guitar stand with an angled cavity 28 covered with a buffer layer 60 as shown in plan view in figure 1 and in cross section in figure 4; (3) ascertained<sup>3</sup> that Garrison does not disclose the use of an angled cavity that is shaped closely for receiving the guitar; and (4) concluded that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the guitar holder as taught by Garrison with the cavity as taught by Hoshino for providing retentive and cushioning capabilities for a guitar while being used or viewed.

The appellants argue (brief, pp. 3-5) that Hoshino does not teach the use of a guitar stand with an angled cavity and therefore it would not have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Garrison's guitar holder to arrive at the claimed invention. We agree.

Hoshino teaches (column 2, lines 23-26) that guitar stand 10 includes a concave region 28 for holding the guitar on the upper surface of the main guitar stand body 20 and that a buffer 60 of rubber or sponge is provided on the upper surface of the concave region for protecting the guitar. Hoshino further teaches (column 2, lines 12-21) that the main guitar stand body 20 comprises a frame which is approximately in the shape of U, with an opening at its front and is sized to hold the lower part of the

---

<sup>3</sup> After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

ordinary acoustic guitar, particularly when it is held leaning. In our view, Hoshino's U-shaped main guitar stand body 20 with a concave region 28 for holding the guitar on each of the projecting legs does not define an angled cavity.<sup>4</sup> Since the rejection before us in this appeal is based on the examiner's conclusion that it would have been obvious to modify the guitar holder as taught by Garrison with the cavity as taught by Hoshino, the rejection is improper and cannot be sustained.

For the reasons set forth above, the decision of the examiner to reject independent claims 1, 5 and 10, and claims 2 to 4, 6 to 9, 12, 14 and 16 to 19 dependent thereon, under 35 U.S.C. § 103 is reversed.<sup>5</sup>

---

<sup>4</sup> Cavity is defined as a hollow; a hole; a hollow area within the body. Hole is defined as a cavity in a solid. Hollow is defined as a cavity, gap, or space: a hollow behind a wall; an indented or concave surface or area. See The American Heritage Dictionary, Second College Edition, (1982). From these definitions, it is our view that the broadest reasonable meaning of cavity as it would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellant's specification (see In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)) is an opening in or a perforation through a solid body, an unfilled area in a solid body or a dent or depression on a surface, or a hollow or hollow area within a solid body or object. Clearly, a U-shaped body does not define such a cavity.

<sup>5</sup> We have also reviewed the White and Pirchio patents additionally applied in the rejection of claims 3, 8, 9, 18 and 19 but find nothing therein which makes up for the deficiencies of Garrison and Hoshino discussed above.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claim 5 is rejected under 35 U.S.C. § 102(b) as being anticipated by Hoshino.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 5 is readable on Hoshino as follows: Apparatus comprising: a guitar-like instrument (Hoshino's guitar G shown in Figures 6-8) in combination with a soft bottom rest shaped to fit the guitar-like instrument (Hoshino's U-shaped main guitar stand body

20 with concave region 28 provided with buffer 60 of rubber or sponge for protecting and holding the guitar).

### CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 10, 12, 14 and 16 to 19 under 35 U.S.C. § 103 is reversed and a new rejection of claim 5 under 35 U.S.C. § 102(b) has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

|                             |   |                 |
|-----------------------------|---|-----------------|
| NEAL E. ABRAMS              | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) | BOARD OF PATENT |
| CHARLES E. FRANKFORT        | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| JEFFREY V. NASE             | ) |                 |
| Administrative Patent Judge | ) |                 |

Appeal No. 2002-1288  
Application No. 09/570,759

Page 10

GARVEY SMITH NEHRBASS & DOODY, LLC  
THREE LAKEWAY CENTER  
3838 NORTH CAUSEWAY BLVD., SUITE 3290  
METAIRIE, LA 70002

JVN/jg