

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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAIN PLASSIARD

Appeal No. 2004-0247
Application No. 09/899,664

ON BRIEF

Before ABRAMS, FRANKFORT, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 4. Claims 3 and 5-7 have been indicated as containing allowable subject matter.

We REVERSE.

BACKGROUND

The appellant's invention relates to a snowboard binding. An understanding of the invention can be derived from a reading of exemplary claim 1, 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:

Swanson	2,210,048	Aug. 6, 1940
Lehner <u>et al.</u> (Lehner) (German Patent Publication) ¹	19836554	Jan. 5, 2000

Claims 1, 2 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lehner in view of Swanson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 10) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 9) 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

¹Our understanding of this foreign language reference was obtained from a PTO translation, a copy of which is enclosed.

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention simplifies the nut-and-screw fittings that attach the highback (calf support) of a snowboard binding to the baseplate of the binding and increase the range of orientation adjustment of the highback about its vertical axis. With reference particularly to Figure 3 of the drawings, this is accomplished by making coaxial one of the screws (25) that secures the highback (8) to the bow (7) upon which it is mounted and one of the screws (24) that secures the bow (7) to the baseplate (6), and having these two screws (25 and 24) share a common nut (17).

It is the examiner's view that all of the subject matter recited in claim 1 is disclosed by Lehner except for the designated screws sharing a common nut. However, the examiner takes the position that it would have been obvious to so modify Lehner in view of the teachings of Swanson "for limiting the number of parts within the snowboard binding, for example" (Answer, page 5). The appellant argues that Swanson is not analogous art and that, in any event, the references fail to provide suggestion to one of ordinary skill in the art to modify the Lehner binding in the manner proposed by the examiner. We agree on both counts, and we will not sustain the rejection of claim 1 or of claims 2 and 4, which depend therefrom. Our reasoning follows.

The test for analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. See In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. See In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992).

The field of the inventor's endeavor is that of improvements in snowboard bindings. Swanson discloses means for securing keys to a key case which comprises a pair of opposed axially oriented screws that are received in opposite ends of a common nut. Clearly, Swanson is not in the same field as the appellant's endeavors. The problem to which the appellant has directed his inventive efforts is the attachment of a highback to a snowboard binding in such a manner as to simplify the structure and to increase the range of orientation of the highback with respect to the baseplate. The objective of the Swanson invention is to allow the length of the pivot upon which the keys are mounted in a key case to be adjustable so that more or less keys can be accommodated thereon. While it is true that Swanson utilizes a pair of axially aligned screws engaging a single nut, we agree with the appellant that Swanson is not reasonably pertinent to his invention because Swanson is concerned only with providing a shorter or longer pivot point, and not with mounting one component to another in such

a manner as to increase the range of orientation therebetween while simplifying the mounting of one to the other. Thus, it is our view that Swanson does not qualify as analogous art under either of the Wood tests.

Moreover, even if it were concluded, arguendo, that Swanson is analogous art, we further agree with the appellant that suggestion is lacking for combining the teachings of the references in such a manner as to meet the terms of claim 1. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Lehner discloses a snowboard binding comprising a heel loop (20) that is fixedly attached to the baseplate by means of two spaced rivets (21) (translation, page 12) and a calf support (2) attached to the baseplate by a single swivel axis (4) "for example . . .

a trunnion” (translation, page 11). The heel loop thus is not at all adjustable, and the calf support is not adjustable around a vertical axis but is limited to pivotal movement fore and aft. Notably, Lehner fails explicitly to disclose the use of screws in attaching these components together.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to discard the fixed mounting of the heel loop of Lehner in favor of an adjustable mounting and the single axis adjustability of the calf support in favor of a multiple axis system, much less that this be accomplished by the use of the screw and shared nut arrangement required by claim 1. From our perspective, the only suggestion for the modification proposed by the examiner is found in the luxury of the hindsight afforded one who first viewed the appellant’s disclosure. This, of course, is not the proper basis for a rejection under 35 U.S.C. § 103(a). In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

We therefore conclude that the combined teachings of Lehner and Swanson fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1 or, it follows, of dependent claims 2 and 4.

CONCLUSION

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

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