

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT L. SUTHERLAND

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Appeal No. 97-2807  
Application 08/233,216<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, STAAB and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 26 through 29 and 32 through 35, all of the claims remaining in the application. Claim 1 through 25, 30 and 31 have been canceled.

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<sup>1</sup> Application for patent filed April 26, 1994. According to appellant, this application is a continuation of application 07/844,588, filed March 27, 1992.

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Appellant's invention relates to a ski which is designed "to remain closer [to] the surface of soft snow when skiing downhill such that it will float, and plane, to allow foot steering" (specification, page 1). Claim 26 is representative of the subject matter on appeal and a copy of that claim may be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Guild	3,926,451	Dec. 16, 1975
Sarver	4,007,946	Feb. 15, 1977
Bortoli	4,264,087	Apr. 28, 1981
Johnston et al. (Johnston)	4,343,485	Aug. 10, 1982

Claim 26 stands rejected under 35 U.S.C. § 103 as being unpatentable over Johnston in view of Sarver.

Claim 27 stands rejected under 35 U.S.C. § 103 as being unpatentable over Johnston in view of Sarver as applied to claim 26 above, and further in view of Guild.

Claims 28, 29 and 32 through 35 stand rejected under § 103 as being unpatentable over Johnston, Sarver and Guild as applied above to claim 27, and further in view of Bortoli.

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Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 30, mailed March 3, 1997) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 29, filed December 9, 1996) for appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of independent claim 26 under 35 U.S.C. § 103, we note that while Johnston does disclose a long instructional ski which has a length within appellant's claimed range, the width (c) of such ski at its widest point is significantly less than that required in appellant's claim 26. As for the "short" ski of Sarver, while it may have a width within appellant's claimed range, the length of this ski is significantly less than that required in appellant's claim 26. Moreover, and perhaps more importantly, the entire

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thrust of the disclosure in Sarver is to a "new skiing technique" (col. 3, line 19, *et seq.*) and to a specially designed ski, having a flexible forward shovel section and a less flexible after section, specifically configured for use in practicing that new skiing technique.

Given the wide disparity in the types of skis disclosed in Johnston and Sarver, and the clear differences in the manner in which such skis are intended to be used, we share appellant's view that Johnston and Sarver are not properly combinable in the manner urged by the examiner. In our opinion, the only possible reason that one of ordinary skill in the art would have considered the combination as proposed by the examiner is based on hindsight derived from appellant's own disclosure and not from any teachings or suggestions found in the applied references themselves. Like appellant, we consider that, absent the disclosure of the present application, one of ordinary skill in the art would not have been motivated to modify the long instructional ski of Johnston in view of the teachings associated with the short specialized ski of Sarver. For this reason, the examiner's rejection of appellant's claim 26 under 35 U.S.C. § 103 will not be sustained.

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We have also reviewed the patents to Guild and Bortoli applied by the examiner in the § 103 rejections of claims 27 through 29 and 32 through 35. However, we find nothing in either of these references which would supply that which we have noted above to be lacking in the patents to Johnston and Sarver. Accordingly, the examiner's rejections of dependent claims 27 through 29 and 32 through 35 on appeal under 35 U.S.C. § 103 will likewise not be sustained.

As should be apparent from the foregoing, the decision of the examiner rejecting claims 26 through 29 and 32 through 35 of the present application is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
LAWRENCE J. STAAB	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

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