

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAWRENCE E. BERTOLUCCI and JOAN M. BERTOLUCCI

Appeal No. 98-1044
Application 08/126,336¹

ON BRIEF

Before COHEN ,STAAB and McQUADE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Lawrence E. Bertolucci and Joan M. Bertolucci appeal from the final rejection of claims 1 through 5 and 9 through 13.

¹ Application for patent filed September 23, 1993. According to appellants, the application is a continuation of Application 07/992,471, filed December 17, 1992, now abandoned.

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Claims 6 through 8, 14 and 15, the only other claims pending in the application, stand allowed. We affirm-in-part.

The invention relates to "an exercise apparatus to relieve or eliminate hip and back pain and a method for its use" (specification, page 2). A copy of the claims on appeal appears in the appendix to the appellants' main brief (Paper No. 15).

The references relied upon by the examiner as evidence of anticipation and obviousness are:

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| Silberman | 3,427,023 | Feb. 11, 1969 |
| Schuman | 4,045,033 | Aug. 30, 1977 |
| Bifulco | 4,088,326 | May 9, 1978 |
| Humphrey | 4,449,708 | May 22, 1984 |
| Ruden | 4,830,366 | May 16, 1989 |
| Noble | 4,943,047 | Jul. 24, 1990 |
| Hoff | 5,216,771 | Jun. 8, 1993 |

(filed Jul. 31, 1992)

Claims 1 through 5 and 9 through 13 stand rejected as follows:

a) claim 11 under 35 U.S.C. § 102(b) as being anticipated by Schuman;

b) claims 1, 9 and 10 under 35 U.S.C. § 103 as being unpatentable over Schuman in view of Bifulco;

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c) claim 2 under 35 U.S.C. § 103 as being unpatentable over Schuman in view of Bifulco and Humphrey;

d) claims 3 through 5 under 35 U.S.C. § 103 as being unpatentable over Ruden in view of Hoff, Silberman and Noble;
and

e) claims 12 and 13 under 35 U.S.C. § 103 as being unpatentable over Ruden in view of Hoff and Silberman.²

Reference is made to the appellants' main and reply briefs (Paper Nos. 15 and 17) and to the examiner's main and supplemental answers (Paper Nos. 16 and 19) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

Turning first to the standing 35 U.S.C. § 102(b) rejection of claim 11, Schuman pertains to "an aid for use in golf putting and, in particular, to an aid for maintaining the golfer's legs in a substantially fixed position to steady the golfer's stance and reduce body sway" (column 1, lines 6 through 9). As described in more detail by Schuman,

² The examiner entered the above rejections of claims 3 through 5, 12 and 13 for the first time in the main answer (Paper No. 16) to replace the rejections of these claims set forth in the final rejection (Paper No. 13).

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[t]he invention comprises a generally cylindrical [sic] shaped body 10 which is composed of a rigid lightweight material such as a plastic foam. The body 10 has a pair of opposed surfaces 12 concavely formed therein to engage the legs of the golfer. . . . The body 10 is shown as also having a second pair of opposed surfaces 14 formed therein but spaced a different distance apart than surfaces 12 so as to accommodate a wider stance of the golfer.

As shown in FIG. 2, the body 10 is placed between the legs 16 of the golfer at a position generally right above the knees and the golfer positions his legs 16 such that the surfaces 12 or 14 frictionally engage both of his legs [column 2, lines 5 through 22].

Anticipation is established when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The examiner's determination that the golf putting aid

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disclosed by Schuman meets all of the limitations in claim 11 is well founded. In this regard, Schuman's rigid body 10 constitutes a nondeformable block having side surfaces into which the inner thighs of a user may fit as recited in claim 11. Moreover, it is not apparent, nor have the appellants cogently explained, why rigid body 10 is not capable, under principles of inherency, of being used as an exercise apparatus for relieving a patient's hip and back pain as set forth in claim 11 whereby the patient can activate the adductor muscles by pressing against the

side surfaces with the inner thighs with the patient's lower legs beneath the knees being unconstrained.

The appellants' argument that the preamble of claim 11 ("An exercise apparatus for relieving a patient's hip and back pain") introduces bulk, size and rigidity limitations into the claim which are lacking in Schuman (see pages 5 through 10 in the main brief) is not persuasive. Simply put, this line of argument runs counter to the principle that during patent examination claims are to be given their broadest reasonable interpretation consistent with the underlying specification

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without reading limitations from the specification into the claims. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). As pointed out above, it is not apparent why Schuman's rigid block would not be inherently capable of the functional and/or use limitations actually set forth in the preamble and body of claim 11.

Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claim 11 as being anticipated by Schuman.

We shall not sustain, however, the standing 35 U.S.C. § 103 rejections of claims 1, 9 and 10 as being unpatentable over Schuman in view of Bifulco, or of claim 2 as being unpatentable over Schuman in view of Bifulco and Humphrey.

Claim 1 recites an exercise apparatus comprising, inter alia, a nondeformable block and a pair of leg straps to wrap around each respective thigh. Claim 9 recites an exercise apparatus comprising, inter alia, a nondeformable block and means to mount the block between the thighs. Claim 10 depends from claim 9 and further defines this means as including a pair of leg straps which wrap around each respective thigh.

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As conceded by the examiner (see page 4 in the main answer), Schuman's apparatus does not include such leg straps. The examiner's reliance on Bifulco to overcome this deficiency is unsound.

Bifulco discloses a practice device 10 for holding a person's knees in proper alignment during a golf swing. The device includes a pair of plate-like structures 14, 15 and 16, straps 19, 20 and 120 for securing the plate-like structures to the golfer's legs and a flexible member 13 connecting the plate-like structures to restrain movement of the knees during the swing. There is nothing in Bifulco's disclosure of this device which justifies the examiner's conclusion that it would have been obvious to one having ordinary skill in the art at the time the invention was made "to provide the block of Schuman with the pair of straps of Bifulco, in order to provide a means for securely and releasably fastening the device to the user's legs" (main answer, page 5). Although both Schuman and Bifulco pertain to golf practice devices, the nature of these devices differs substantially. The only suggestion for combining these references in the manner proposed by the examiner stems from hindsight knowledge

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impermissibly derived from the appellants' own teachings. Humphrey, applied against claim 2 for its disclosure of a golf practice device timer, does not cure the foregoing flaw in the Schuman-Bifulco combination.

Finally, we shall not sustain the standing 35 U.S.C. § 103 rejections of claims 3 through 5 as being unpatentable over Ruden in view of Hoff, Silberman and Noble, or of claims 12 and 13 as being unpatentable over Ruden in view of Hoff and Silberman.

Claims 3 through 5, 12 and 13 are drawn to an exercise therapy method having the step of placing a substantially nondeformable block between a seated patient's inner thighs just above the knees. Although Ruden discloses an exercise therapy method wherein a block 12 is placed between a seated patient's inner thighs just above the knees (see Figures 2 and 3), the block is a "deformable, resilient compression member" (Ruden, column 3, line 31). Thus, Ruden does not meet the claim limitations requiring the block to be substantially nondeformable.

Silberman discloses a "chest pull exerciser comprising a pair of hand grips with a plurality of elastic means extending

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therebetween" (column 1, lines 28 through 30). Silberman also teaches that the elastic means can be replaced by non-resilient, non-elastic bands for isometric exercises (see column 4, line 73, through column 5, line 2). This broad reference to isometric exercise in conjunction with a device which differs substantially from that disclosed by Ruden does not provide any reasonable basis for the examiner's conclusion that it would have been obvious to one having ordinary skill in the art at the time the invention was made "to make the [Ruden] block nondeformable in order to provide isometric resistance" (main answer, page 7). Here again, the examiner's conclusion of obviousness rests on an impermissible hindsight reconstruction of the claimed invention. Hoff's disclosure of a sculptured leg pillow and Noble's disclosure of a handgrip timer do not overcome the deficiencies in the examiner's evidence.

In summary and for the above reasons, the decision of the examiner to reject 1 through 5 and 9 through 13 is affirmed with respect to claim 11 and reversed with respect to claims 1 through 5, 9, 10, 12 and 13.

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

AFFIRMED-IN-PART

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| IRWIN CHARLES COHEN |) | |
| Administrative Patent Judge |) | |
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| LAWRENCE J. STAAB |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
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| JOHN P. McQUADE |) | |
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