

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte CHRISTOPHE CHATILLION, CHRISTIAN LUCAS  
and MICHEL THEVENET

---

Appeal No. 2001-0036  
Application 08/971,611

---

HEARD: March 22, 2001

---

Before FRANKFORT, BAHR, and LAZARUS, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 19. Subsequent to the final rejection appellants filed amendments on January 24, 2000 (Paper No. 13) and on April 21, 2000 (Paper No. 18). These amendments direct cancellation of claims 1 and 3, and make substantial changes in the remaining claims on appeal. In

Appeal No. 2001-0036  
Application 08/971,611

advisory actions mailed, respectively, on February 4, 2000 (Paper No. 14) and May 4, 2000 (Paper No. 19), the examiner has approved entry of both of the above-noted amendments. Accordingly, we make note that claims 2 and 4 through 19 remain for our consideration in this appeal, while the appeal as to canceled claims 1 and 3 is dismissed.<sup>1</sup>

Appellants' invention relates to a support device for supporting a ski boot on a ski, and more particularly to a support device including a movable support element (e.g., 10 in Figs. 2, 3, 4 and 6) which is movable, at least in a transverse direction, relative to a stationary support (e.g., 9 of Figs. 2, 3, 4 and 6) and an anti-friction element (e.g., 20 of Fig. 4) or elements (e.g., 200, 201a, 201r of Fig. 11 or 201a, 201r of Figs. 15 or 16) located between the movable

---

<sup>1</sup>In reviewing the file history of this application, it has come to our attention that claim 12 as amended in Paper No. 18 (April 21, 2000) has been mistakenly lined through as being replaced, when in fact the version of claim 12 as it appears in Paper No. 13 (January 24, 2000) is the one that should be lined through and replaced by the version of claim 12 in Paper No. 18. This mistake should be corrected during any further prosecution of the application before the examiner.

Appeal No. 2001-0036  
Application 08/971,611

support element and the stationary support element along a bottom and at least one of a front and back of the movable support element. As an alternative, the anti-friction element may be in the form of a friction reducing layer disposed between the moveable element and at least the bottom and front walls of a groove on the stationary element (claim 16). Independent claims 4, 11, 12 and 16 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims under 35 U.S.C. § 103 are:

Bernard et al. (Bernard) 16, 1983	4,398,747	Aug.
Bogner 1992	5,114,174	May 19,
Challande et al. (Challande) <sup>2</sup>	0 729 771 A1	Sept. 4, 1996

Claims 2, 4, 6, 7 through 10, 16, 18 and 19 stand

---

<sup>2</sup> Our understanding of this foreign language document is based on a translation prepared for the U.S. Patent and Trademark Office. A copy of that translation is appended to this decision.

Appeal No. 2001-0036  
Application 08/971,611

rejected under 35 U.S.C. § 103(a) as being unpatentable over Challande.<sup>3</sup>

Claims 5, 13 through 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Challande in view of Bernard.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bogner.

Reference is made to the examiner's answer (Paper No. 20, mailed July 3, 2000) for the examiner's reasoning in support of the above-noted rejections. Appellants' arguments thereagainst are found in the brief (Paper No. 17, filed April 21, 2000) and reply brief (Paper No. 22, filed September 8, 2000).

---

<sup>3</sup> In contrast to the examiner's indication in the answer (page 2) that appellants' statement of the issues on appeal in the brief "is correct," we note that the examiner has (without comment) apparently withdrawn the rejection of claims 2, 8, 9 and 10 under 35 U.S.C. § 102(b) based on Challande as set forth on page 2 of the final rejection (Paper No. 11) and now substituted a rejection of those same claims under 35 U.S.C. § 103(a) as being unpatentable over Challande.

OPINION

In reaching our conclusion on the obviousness issues involved in this appeal, we have carefully considered appellants' specification and claims, the applied prior art references, and the respective viewpoints advanced by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of appealed claims 2, 4, 6, 7 through 10, 16, 18 and 19 under 35 U.S.C. § 103 based on Challande, we note that after pointing to Figure 2 of Challande and the anti-friction layer or element (20) seen therein, the examiner has concluded (answer, pages 4-5) that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to modify the prop plate (75) of Challande Figure 5 "to include the low friction coefficient film (20) on any contact surface (bottom, sides, or top) in order to allow the movable support element [80] to be able to have a smoother slide." In further support

Appeal No. 2001-0036  
Application 08/971,611

of this rejection, the examiner has relied on In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), urging that this case sets forth that as a general proposition "it has generally been recognized that the rearrangement of location of parts involves only routine skill in the art" (answer, page 5).

After reviewing the translation of the Challande reference and the views expressed by the examiner and appellants regarding this rejection, we find that we are in agreement with appellants' position as set forth in the brief (Paper No. 17) and reply brief (Paper No. 22). Like appellants, we note that neither the description of the invention in Challande nor the drawings therein provide any basis whatsoever for the modifications of the embodiment of Figure 5 of Challande as urged by the examiner. Nothing in Challande in any way relates to the problem confronted by appellants or to the results achieved by appellants' claimed structure. While it may be true as a general proposition that one of ordinary skill in the art would have recognized that including an anti-friction or bearing member between two

components will help one member slide relative to the other one more easily, it is our view that this knowledge alone would not have led the artisan to modify the structure seen in Figure 5 of Challande in the manner urged by the examiner. At best, it appears that Figure 2 of the Challande reference would have provided suggestion and motivation for one of ordinary skill in the art to provide the embodiment of Figure 5 therein with a low coefficient of friction film (like 20) located on the upper face (81) of the prop plate (75) so as to allow the sliding support plate (80) to more freely slide therethrough.

There is no evidence relied upon by the examiner that one of ordinary skill in the art would have recognized the particular problem of high forces toward the front (or rear) of the binding in Challande which can cause the sliding support plate (80) to bind or hang up against the front or rear surface of the prop plate therein and cause torque on the ankle and lower leg of the skier that may result in

Appeal No. 2001-0036  
Application 08/971,611

substantial physical injury to the skier, as in appellants' application. Moreover, there is nothing in Challande to suggest solving such a problem in the particular manner claimed by appellants. In our opinion, the examiner has inappropriately employed appellants' discussion of their discovery of the source of the problem as a teaching for the proposed modification of Challande. That is, in searching for an incentive for modifying Figure 5 of Challande, the examiner has impermissibly drawn from appellants' own teachings regarding the deficiencies of the prior art. In this regard, it is clear that the examiner has fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). As for the examiner's position (answer, page 8) that the exact location of the low friction material in appellants' claimed subject matter "is given little patentable weight," because appellants have not demonstrated unexpected results or criticality to having this material on

Appeal No. 2001-0036  
Application 08/971,611

the sides and top surfaces, we agree with appellants' comments on pages 3-4 of the reply brief, and observe that the examiner has inappropriately imposed an improper standard of patentability on appellants that is not provided for in 35 U.S.C. § 103(a).

Since it is our determination that the teachings and suggestions found in Challande would not have made the subject matter as a whole of independent claims 4 and 16 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 2, 6, 7 through 10, 18 and 19 under 35 U.S.C. § 103(a) based on Challande alone will also not be sustained.

Regarding the examiner's rejection of dependent claims 5, 13 through 15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Challande in view of Bernard, we note that even if it would have been obvious to one of ordinary skill in

Appeal No. 2001-0036  
Application 08/971,611

the art to modify Challande by using PTFE as the anti-friction material (at 20 of Challande) as suggested in Bernard (col. 1, lines 29-31) and by using a curved sliding groove as shown in Bernard (Fig. 2) in Challande, such modifications still would not provide response for the teachings and suggestions we have indicated above to be lacking in the basic reference to Challande. Accordingly, the examiner's rejection of dependent claims 5, 13 through 15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Challande in view of Bernard will likewise not be sustained.

As for the examiner's rejection of claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Bogner (answer, page 7), we agree with appellants' arguments as set forth on pages 8 and 9 of the brief and in the reply brief. Again, the examiner has relied upon appellants' own teachings and resorted to impermissible hindsight to modify the laterally movable support arrangement seen in Figure 5 of the Bogner reference in ways that are not suggested or motivated by the reference, and in a manner which modifies the operation of the

Appeal No. 2001-0036  
Application 08/971,611

Bogner reference in ways not suggested by the reference itself. For that reason, we will not sustain the examiner's rejection of appealed claims 11 and 12 under 35 U.S.C. § 103(a) based on Bogner alone.

With regard to the examiner's use of a *per se* rule such as that derived from In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), we direct the examiner's attention to In re Ochiai, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996) wherein the Court of Appeals for the Federal Circuit has held that the claimed invention as a whole must be evaluated under the standards set down in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), and its progeny, and that the use of *per se* rules is improper in applying the test for obviousness under 35 U.S.C. § 103 since such rules are inconsistent with the fact-specific analysis of claims and prior art mandated by section 103. Moreover, we also find that we are in agreement with appellants' treatment in the reply brief of the examiner's reliance on the Japikse case.

Appeal No. 2001-0036  
Application 08/971,611

In light of the foregoing, the decision of the examiner to reject claims 2 and 4 through 19 under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES

