

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL J. OISTER, CHRISTOPHER S. WISENER,  
WILLIAM C. BOETTCHER, THOMAS M. DOHERTY

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Appeal No. 2004-1322  
Application No. 10/014,297

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ON BRIEF

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Before GARRIS, KRATZ, and JEFFREY T. SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-21 which are all of the claims in the application.

The subject matter on appeal relates to an apparatus comprising a ball, such as a basketball, having integrated therewith a timer for measuring a predetermined time period.

This appealed subject matter is adequately illustrated by independent claim 21 which reads as follows:

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21. An apparatus comprising:  
a ball having a surface and at least one internal cavity;  
at least one timer for measuring at least one predetermined  
time period; and  
the timer integrated with the ball.

The references set forth below are relied upon by the Examiner  
as evidence of obviousness:

Bennett	5,468,000	Nov. 21, 1995
Willner et al. (Willner)	5,810,685	Sep. 22, 1998
Maurer	5,912,864	June 15, 1999

Claims 1-10 and 16-21 stand rejected under 35 U.S.C. § 103(a)  
as being unpatentable over Maurer in view of Willner, and claims  
11-15 stand correspondingly rejected over these references and  
further in view of Bennett.

We refer to the brief and to the answer for a complete  
discussion of the contrary viewpoints expressed by the Appellants  
and by the Examiner concerning the above noted rejections.

#### OPINION

For the reasons which follow, these rejections cannot be  
sustained.

As correctly explained by the Appellants in their brief and  
contrary to the Examiner's viewpoint, the timing device associated

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with Maurer's ball performs the function of measuring the duration of flight when the ball is thrown (e.g., see the abstract and lines 6-11 in column 1) which is not a predetermined time period as required by each of the appealed claims. Stated otherwise, while patentee's desideratum for measuring flight duration may be predetermined, the time period of this flight duration is not and cannot be predetermined. Indeed, the fact that this flight duration time period cannot be predetermined is the very problem which necessitated development of Maurer's timing device.

According to the Examiner, "since applicant failed to recite any particular feature of the timer to support the desired function, it is submitted that the timer of Maurer is capable of performing the stated function" (answer, pages 4-5). This is incorrect. Each of the independent claims on appeal expressly requires a timer capable of performing the function "measuring at least one predetermined time period," and, contrary to the Examiner's apparent belief, this functional requirement is not somehow vitiated by the absence of claim recitation concerning structural features of the timer. See In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971). Moreover, as previously discussed, the timing device of Maurer unquestionably

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is not capable of performing this function. Thus, absent structure which is capable of performing this function, Maurer does not meet this aspect of the appealed claims. See In re Mott, 557 F.2d 266, 269, 194 USPQ 305, 307 (CCPA 1977).

In short, notwithstanding the Examiner's opposing viewpoint, it is clear that the timing device of Maurer is incapable of satisfying the functional requirement of the Appellants' claimed timer. This deficiency of Maurer is not supplied by the other applied references, and the Examiner does not contend otherwise. It follows that we cannot sustain either the § 103 rejection of claims 1-10 and 16-21 as being unpatentable over Maurer in view of Willner or the § 103 rejection of claims 11-15 as being unpatentable over these references and further in view of Bennett.

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The decision of the Examiner is reversed.

REVERSED

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
PETER F. KRATZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY T. SMITH	)	
Administrative Patent Judge	)	

BRG/jrg

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