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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

MAY 29 1996

Ex parte JAMES H. LIGHT

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 95-2539
Application 07/918,003¹

HEARD: MAY 8, 1996

Before MEISTER, ABRAMS and STAAB, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-4 and 7-9, the only claims remaining in the application.

The appellant's invention pertains to a sports trainer which allows a student player to simultaneously observe (1) his own movements in a mirror and (2) the movements of the reflected image of a skilled player in a television monitor. Independent

¹ Application for patent filed July 24, 1992.

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claim 1 is further illustrative of the appealed subject matter and reads as follows.

1. A sports trainer to enable a student player to practice and become more proficient in performing various sports activities comprising a supporting stand including a generally upright frame, a reflective mirror supported in said frame, a mat supported front of the mirror, said mat including a delineated area on which a student player assumes a position for observing the reflected image of the student player in the mirror to enable the student player to review and analyze position, techniques and movements when performing a particular sports activity and means displaying optimum position, techniques and movements of a player performing the same sports activity and displaying the optimum position, techniques and movements as a reflected image thereby enabling the student player to observe the displayed optimum reflected image in the mirror and the reflected image for comparison purposes thereby enabling the student player to attain the same position, techniques and movements as displayed in the optimum reflected image.

The references relied on by the examiner are:

Sneed	3,353,282	Nov. 21, 1967
Michaels et al. (Michaels)	4,015,344	Apr. 5, 1977

Claims 1 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sneed.

Claims 2-4, 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sneed in view of Michaels. The examiner is of the opinion that it would have been obvious to one of ordinary skill in the art to replace the projector and screen of Sneed with a video cassette player and television monitor in view of the teachings of Michaels.

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Rather than reiterate the arguments of the appellant and examiner in support of their respective positions, reference is made to the brief and answer for the full exposition thereof.

OPINION

At the outset we note that the appellant on page 3 of the brief has grouped (1) claims 1 and 9 as a first group, (2) claims 2-4 as a second group and (3) claims 7 and 8 as a third group and the examiner has held that all claims within each group stand or fall together since the appellant has failed to state that the claims in each group do not stand or fall together. We note that 37 C.F.R. § 1.196(c)(7) requires an appellant to do two things in order to have the claims within each group separately considered for patentability purposes, namely, (1) provide a statement that the claims do not stand or fall together and (2) explain why the claims are separately patentable. While the appellant has failed to provide a statement that the claims do not stand or fall together, he has explained why the claims are separately patentable. Inasmuch as there is partial compliance with the rule we will, in this instance, treat the claims as being separately argued (note *Ex parte Schier*, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991)).

Considering first the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Sneed, the appellant does not dispute the examiner's position that Sneed teaches a means for

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displaying a "reflected image."² Instead, the appellant argues that Sneed does not show a "delineated area on which a student player assumes a position for observing ..." as set forth in independent claim 1.

We are unpersuaded by the appellant's argument. The terminology in a pending applications's claims is to be given its broadest reasonable interpretation (see *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (see *Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See *Verdegaal Brothers Inc. v. Union Oil Co. of California*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). A prior art reference anticipates the subject matter of a claim when that reference discloses, either expressly or under the principles of inherency, each and every element set forth in the claim (see *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655,

² Indeed, under questioning at oral hearing the appellant's attorney conceded that Sneed's projector projects a reflected image on his screen.

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1657 (Fed. Cir. 1990)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983)).

Here, Sneed in Figs. 1 and 2 clearly shows a mat in front of the mirror 2 and screen 12 which includes a mark 25 that "describes the proper path of the club head" (see column 3, lines 43-44). Viewing these figures, it is readily apparent to us that this mark, in conjunction with the sides and rear of the mat on which the student player is depicted as standing, can be considered to define or delineate the area on which the student player "assumes a position for observing" as broadly set forth in independent claim 1. This being the case, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b).

Considering next the rejection of claim 9 under 35 U.S.C. § 102(b), the examiner is of the opinion that the recitation of "displaying a reflected image of substantially smaller scale" is not entitled any patentable weight because the "reflected image of the student player is not, in and of itself, a structural element of the instant invention" (see answer, page 2). We must point out, however, that claim 9 sets forth "means ... for displaying a reflected image of substantially smaller scale" Thus, the functional recitation of displaying "a reflected image

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of substantially smaller scale" is part of a "means plus function clause" which, according to the sixth paragraph of § 112, is **structure** and, accordingly, must be treated as such. Since we find nothing, nor has the examiner even alleged there is anything, in Sneed which would suggest a means for displaying a reflected image of substantially smaller scale, we will not sustain the examiner's rejection of claim 9 under 35 U.S.C. § 102(b) as being anticipated by Sneed.

Turning now to the rejection of claims 2, 3, 7 and 8 as being unpatentable over Sneed in view of Michaels, the appellant notes various alleged deficiencies of the references individually (such as that the orientation of the auxiliary mirror 25 in Michaels being "totally different" from the claimed arrangement and that Sneed uses a projector that is oriented in a remote relation to the screen on which is image is projected) and urges that

while a VCR is suggested in Michaels et al., it is associated with a mirror 12 with which the student player observing an auxiliary mirror 25 which is not the organization and arrangement claimed by Applicant. (see brief, page 7)

Such arguments do not persuade us of any error in the examiner's position. The test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and *In re Keller*,

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642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *See In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Sneed in Figs. 1 and 2 discloses a sports trainer having a supporting stand 4, a reflective mirror 2, a mat (the surface upon which the student player 1) is standing including a delineated area between the edges of the mat and the mark 25 and means 12, 17 for displaying the optimal movements of a player performing the same sports activity (golf) adjacent the mirror so that the student player may compare his image with that of the projected image on the screen. Michaels in Fig. 6 discloses a sports training arrangement including a mirror 25 and a TV set connected to a video tape deck for the purpose of displaying the reflected front image of an instructor performing a sports activity (golf - see column 1, line 8) simultaneously with the instructor's back view on the screen of the TV (see, e.g., column 3, lines 42-50) with the mirror and TV set being positioned in an adjacent side-by-side relationship to the mirror so that a student may compare his image with that of the instructor. A combined consideration of Sneed and Michaels would have fairly suggested to the artisan to utilize in Sneed in lieu of his

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screen and projector for projecting the image of the player performing "optimum" movements on the TV screen a video cassette player and TV as taught by Michaels in order to achieve Michaels' self-evident advantages of a more convenient and modern image-projecting device. With respect to the appellant's various criticisms of the references individually, nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See *In re Merck & Co. Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

As to claim 3, although the projected image in Sneed is above the mirror and in Michaels in side-by-side relationship to the mirror, we are of the opinion that the artisan would recognize that the projected image could equally as well be provided on a TV monitor or screen that was placed below the mirror and would have found such a modification to be obvious as a matter of common sense (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). As to claims 7 and 8, we observe that artisans must be presumed to know something about the art apart from what the references disclose. See *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). Accordingly, we perceive that the artisan would have been well aware of the fact that the utilization of different types of golf clubs require different positioning of the ball with respect to a player and, accordingly, have

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found it obvious to provide the sports trainer of Sneed, as modified by Michaels, with "different initial positions" as broadly set forth.

In view of the foregoing we will sustain the examiner's rejection of claims 2, 3, 7 and 8 based on the combined disclosures of Sneed and Michaels.

Turning to the rejection of claim 4 under 35 U.S.C. § 103 the examiner has taken the position that the provision of "portability" is not patentable. Even if we were to agree with the examiner that, as a broad proposition, it would have been obvious to make the device of Sneed as modified by Michaels portable, this would not serve as a sufficient factual basis to establish the obviousness of the particular structure set forth in this claim (*i.e.*, the TV monitor being mounted in an inclined portion of the frame, supporting wheels and supporting legs, and the mirror being mounted for pivotal movement). *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). This being the case, we will not sustain the examiner's rejection of claim 4 under 35 U.S.C. § 103.

Under the provisions of 37 C.F.R. § 1.196(b) we make the following new rejection.

Claim 9 is rejected under 35 U.S.C. § 103 as being unpatentable over Michaels. As we have noted above, Michaels in Fig. 6 discloses a sports training arrangement including a mirror 25 and

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a TV set connected to a video tape deck for the purpose of displaying the reflected front image of an instructor performing a sports activity (golf - see column 1, line 8) simultaneously with the instructor's back view on the screen of the TV (see, e.g., column 3, lines 42-50) with the mirror and TV set being positioned in an adjacent side-by-side relationship to the mirror so that a student may compare his image with that of the instructor. Particularly in view of the fact that Michaels is displaying two different images simultaneously on a single TV screen or monitor, we are of the opinion that the artisan would reasonably infer (*see In re Preda, supra*) that Michaels' reflected front image is substantially smaller than the reflected image of a student player in the mirror 25.

In summary:

The examiner's rejection of claim 1 under 35 U.S.C. § 102(b) is affirmed.

The examiner's rejection of claim 9 under 35 U.S.C. § 102(b) is reversed.

The examiner's rejection of claims 2, 3, 7 and 8 under 35 U.S.C. § 103 is affirmed.

The examiner's rejection of claim 4 under 35 U.S.C. § 103 is reversed.

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A new rejection of claim 9 is made under 35 U.S.C. § 103.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 CFR 1.197).

With respect to the new rejection under 37 CFR 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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