

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* VINCENT J. CUSHING

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Appeal No. 96-2476  
Application 07/890,785<sup>1</sup>

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ON BRIEF

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

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed June 1, 1992.

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At the outset, it is necessary to review the final stages of the prosecution of this application prior to its arrival at the

Board of Patent Appeals and Interferences, for it bears upon the status of some of the claims alleged to be on appeal.

At the time the final rejection was rendered in this case, claims 14 through 35 were pending. However, as a result of a requirement for election of species, claims 18 through 21 and 25 through 35 had been withdrawn from consideration, and therefore the final rejection made by the examiner applied to claims 14 through 17 and 22 through 24 (Paper No. 21), and these were the claims recited in the appellant's Notice of Appeal (Paper No. 27). However, in the Brief on Appeal the appellant added to the appeal the propriety of the examiner's refusal to include claims 25 through 28 and 33 through 35 among those claims readable on the elected species (Paper No. 31).

The Examiner's Answer (Paper No. 32) dealt with the standing final rejection of claims 14 through 17 and 22 through 24 under 35 U.S.C. § 103. In addition, the examiner

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now added a new rejection under 35 U.S.C. § 112, second paragraph, which was directed to claims 25 through 28 and 33 through 35, apparently responding to the suggestion set forth in Section 821 of the Manual of Patent Examining Procedure. There then followed from the appellant an amendment under Rule 193(b) (Paper No. 33), a reply brief (Paper No. 34), and a reply brief accompanied by a supplemental amendment (Papers No. 35), all of which were refused entry by the examiner (Paper No. 36). A petition for entry of the latter two documents (Paper No. 37) was denied (Paper No. 38).

The result of the above sequence of events is that the record now before this panel of the Board is devoid of arguments by the appellant in rebuttal to the rejection of claims 25 through 28 and 33 through 35 under 35 U.S.C. § 112, second paragraph, which the examiner made for the first time in the Examiner's Answer. Since the Examiner's Answer sets forth the requirement that a response to the new ground of rejection be filed within two months (page 9), and because such a response has not been made of record, the appeal as to claims 25 through 28 and 33 through 35 is dismissed.

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Therefore, only claims 14 through 17 and 22 through 24 are before us on appeal.

The appellant's invention is directed to an in-line roller skate having a plurality of operating surfaces on each wheel. The subject matter before us on appeal is illustrated by reference to claim 14, which reads as follows:

14. An inline roller skate for skating along a skating surface, said skate comprising:

wheel means comprising at least one wheel attached to said skate and constrained for rotation about only a first axis, said wheel means comprising at least a rolling first surface rotatable about said first axis, a second surface disposed to one side of said first surface along said first axis and a third surface disposed on an opposite side of said first surface along said first axis; and

a first sliding surface disposed between said first and second surfaces and a second sliding surface disposed between said first and third surfaces, said first sliding surface contacting said skating surface only when said skate is tilted in a first direction and said second sliding surface contacting said skating surface only when said skate is tilted in a second direction, each of said sliding surfaces having a lower friction coefficient than said rolling first surface.

*THE REFERENCES*

The references relied upon by the examiner to support the final rejection are:

Stein	1,988,055	Jan. 15, 1935
Liberkowski	4,618,158	Oct. 21, 1986

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*THE REJECTIONS*

Claims 14 through 17 and 22 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Liberkowski.

Claims 23 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Liberkowski in view of Stein.

The rejections are explained in the Examiner's Answer and Supplemental Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

*OPINION*

Independent claim 14 stands rejected as being unpatentable over Liberkowski. The test for obviousness is what the combined teachings of the prior art would have suggested to one of

ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). The appellant has argued this reference would not have suggested the claimed subject matter to one of ordinary skill in the art because the wheel

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in the reference rotates about two axes whereas the claim requires that it be "constrained for rotation about only a first axis" (emphasis added). The examiner's reply to this assertion is that the Liberkowski wheel pivots, but does not rotate, about the second axis. We agree with the appellant and therefore will not sustain the rejection of this claim or of those that depend from it.

While one might dwell upon intricacies of the definitions of the verbs "rotate" and "pivot" in order to make a case for them being different, a reasonable view is that there is an overlap. That is, to rotate an object is to turn it around an axis, which is defined as a line about which a rotating body turns, and to pivot an object is to turn it about a pivot, which is defined as a point around which an object rotates or oscillates.<sup>2</sup> From our perspective, therefore, the wheel of the Liberkowski skate is rotatable about a first axis Z1-Z1 and a second axis X-X

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<sup>2</sup> See The Random House College Dictionary, Revised Edition, 1980, pages 95, 1013, and 1148.

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(Figure 1). The teachings of this reference thus do not establish a *prima facie* case of obviousness with regard to the subject matter of independent claim 14 or, it follows, of any of the claims dependent therefrom. Nor is this deficiency alleviated by considering Stein, which was cited by the examiner for its teaching of utilizing a nose wheel mounted at the forward end of the skate.

The rejections are not sustained, and the decision of the examiner is reversed.

REVERSED

	)	
JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	)
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	

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