

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERT J. FLIS

Appeal No. 97-3551
Application No. 08/342,759¹

ON BRIEF

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

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-7, which constitute all of the claims of record in the application.

¹Application for patent filed November 21, 1994.

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

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OPINION

The Examiner's Rejection

In rejections under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

All of the claims before us require, *inter alia*, inner and outer telescoping tubes and a spring disposed around the inner tube, and all but claim 5 further include at least two stops engaged by the spring. In formulating the rejection, the examiner has combined the teachings of the two embodiments disclosed in Very. This reference was discussed in the appellant's specification. It is directed to the same problem as the appellant's invention, and the manner in which it solves the problem has much in common with the appellant's invention. In Very's first embodiment (Figures 1 and 2), an

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inner elongated cylinder (1) is slidably received in an outer elongated cylinder (2), which is of "slightly greater" diameter (column 3, lines 41 and 42). Both cylinders are closed at their lower ends by a bottom wall (5 & 10). A coil spring (3) is interposed between the two bottom walls, biasing them apart, with the strength of the spring being such that when a golf club is placed inside the inner tube, it telescopes downward within the outer one. When the golf club is removed, the inner tube is moved upwardly by the spring, with the extent of movement being limited by a cord (4).

Very's second embodiment (Figures 3 and 4) utilizes only one tube, which is slidable up and down with respect to the golf bag divider plates. The tube is provided with an annular stop ring (4), and a coil spring (3) is wrapped around the tube at a point between the lower divider plate (9) and the stop ring, biasing the tube upwardly into contact with the upper divider plate (8) when no club is present. When a club is placed in the tube, it moves downwardly.

The examiner's position is that these two teachings would have suggested to one of ordinary skill in the art that the spring and cord interposed between the two bottom walls in the

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first embodiment of the Very invention be replaced by a coil spring installed about the inner elongated tube, "motivated by the teaching of being able to shift the location of the spring without a change in function" (Answer, page 4). We do not agree. The mere fact that the prior art structure could be modified does not make such a modification obvious absent suggestion of the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Very discloses two different ways of solving the same problem. The fact that all of the elements needed to construct the appellant's claimed invention can be found in the two Very embodiments is not enough to establish a *prima facie* case of obviousness. There must be some reason why one of ordinary skill in the art would have selected certain elements from each embodiment and combined them in such a manner as to meet the terms of the claims on appeal. In our opinion, this is where the rejection fails. We cannot perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to combine the teachings in the manner proposed by the examiner, that is, to substitute a spring

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wrapped around the inner tube for the one beneath it and, in the case of claims 1-4, 6 and 7, to add stops on the cylinders, other than the hindsight accorded one who first viewed the appellant's disclosure. This, of course, is improper. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The rejection of claims 1-7 as being unpatentable over Very is not sustained.

New Rejection By The Board

Pursuant to our authority under 35 CFR § 1.196(b), we enter the following new rejection:

Claim 5 is rejected under 35 U.S.C. § 103 as being unpatentable over Very in view of Jacoby.²

This claim merely requires the presence of a first elongated cylinder, a second elongated cylinder received in the first, and a spring disposed about the second one. The embodiment of Very shown in Figures 3 and 4 discloses the second cylinder and the spring. What is lacking is the first cylinder within which the second one is "receivable."

²This patent was cited by the appellant on page 2 of the appellant's specification.

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Very teaches that his invention is adapted for installation in a golf bag (column 4, lines 33-35). We take official notice of the fact that golf club bags in the shape of elongated cylindrical tubes were well known in the art at the time of the appellant's invention. In this regard, we point out that Jacoby discloses in Figure 1 a golf club carrier having a cylindrical body "like a conventional golf bag" (column 1, lines 52 and 53). Interestingly, the Jacoby device contains spring-biased elongated cylindrical tubes for holding golf clubs, the purpose of which is the same as the inventions of both Very and the appellant.

In view of the foregoing, it is our opinion that it would have been obvious to one of ordinary skill in the art to install the golf club holder disclosed in Figures 3 and 4 of Very in a cylindrical golf bag. In such case, the "first elongated cylinder" recited in claim 5 reads on the golf bag, and the second elongated cylinder which is "receivable" in the first reads on the tubes of Very which are installed in the golf bag, and around which the springs are positioned. Thus, a *prima facie* case of obviousness is established with respect to the subject matter of claim 5.

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SUMMARY

The standing rejection of claims 1-7 is not sustained and the examiner's decision therefore is reversed.

A new rejection of claim 5 is entered by the Board.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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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).

REVERSED, 1.196(b)

NEAL E. ABRAMS)	
Administrative Patent Judge))	
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CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
))	INTERFERENCES
))	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge))	

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Fay, Sharpe, Beall, Fagan, Minnich and McKee
1100 Superior Avenue
Suite 700
Cleveland, OH 44114