

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL STEWART

Appeal No. 98-2357
Application 08/772,336¹

ON BRIEF

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

MEISTER, ***Administrative Patent Judge.***

DECISION ON APPEAL

Michael Stewart (the appellant) appeals from the final

¹Application for patent filed December 23, 1996. According to appellant, this application is a continuation of Application 08/702,208, filed August 23, 1996, now abandoned, which is a continuation of Application 08/379,083, filed August 15, 1995, now abandoned, which is a division of Application 06/109,463, filed January 4, 1980, now U.S. Patent No. D264,060, granted April 27, 1982.

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rejection of claims 8, 9 and 11. Claim 10, the only other claim present in the application, as been indicated as being allowable subject to the requirement that it be rewritten to include all the subject matter of the claim from which it depends.

We REVERSE.

The appellant's invention pertains to a leash for a bodyboard the nature of which is readily apparent from a perusal of claim 8. Claim 8 reads as follows:

8. A leash for a bodyboard, comprising:

a first coil having a plurality of loops each adjacent to each other and forming a cylinder having an inner diameter; and

a flexible strap that is coupled to said first coil and which has a width and a flexibility such that said coil can be reversed by pulling said strap through said inner diameter of said coil while said coil is in a relaxed position.

The references relied on by the examiner are:

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| Cook 3, 1961 | 3,003,018 | Oct. |
| Staude et al. (Staude) 1977 | 4,037,442 | Jul. 26, |
| Tugwood et al. (Tugwood) 1984 | 4,479,785 | Oct. 30, |

Claims 8 and 11 stand rejected under 35 U.S.C. § 103(a)

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as being unpatentable over Tugwood in view of Cook.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tugwood in view of Cook and Staude.

Both of these rejections are bottomed on the examiner's position that:

Tugwood et al discloses a leash for a surfboard comprising a first coil having a plurality of loops adjacent to each other and forming a cylinder 3 having an inner diameter, and a flexible strap 1 having a width adapted to be secured to a user of the surfboard. No dimensions are given for the inner diameter nor for the width of the strap. **Cook** discloses a retractable coiled telephone cord and teaches forming the same with coils having an inner diameter of 1 3/4 inches. Conventional coiled telephone cord[s] have a coil with an inner diameter of about a 1/4 inch.² In view of these disclosures, it would have been an obvious matter of design choice to one having ordinary skill in the art to make the coils of the device of **Tugwood et al** with coils having an inner diameter larger than one inch [sic, 1 3/4 inches] generally [sic] as taught by **Cook**. The width of the strap relative to the size

² Apparently the examiner is also attempting to utilize a "conventional coiled telephone cord" as a reference. We must point out, however, if a reference (e.g., a "conventional coiled telephone cord" is relied upon in any capacity to support a rejection, the reference should be positively included in the statement of the rejection. See **Manual of Patent Examining Procedure** (MPEP) § 706.02 (j) (7th ed., Jul. 1998), **In re Hoch**, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) and **Ex parte Raske**, 28 USPQ2d 1304-05 (Bd. Pat. App. & Int. 1993).

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of the coil's inner diameter is deemed to have been an obvious matter of engineering design dependent on [the] particular application of the strap. If the inner diameter of the coil is larger than the width of the strap, the strap can obviously be pulled through the coils. [Answer, pages 3 and 4; footnote added.]

In support of this position, the answer states that:

The examiner contends that **Cook** teaches [sic, suggests] forming the coils in the cord of **Tugwood et al** with an inner diameter of 1 3/4 inches Even though **Tugwood et al** does not give dimensions for the strap, it is the examiner's position that the size of the strap is a matter of design choice to one of ordinary skill in the art and that a 1 3/4 inch wide strap for use in the surfboard environment would be an acceptable size. [Page 6.]

The examiner also contends that the reversibility of the coil "is inherent in the combination of **Tugwood** and **Cook**" (answer, page 6.)

We will not support the examiner's position. Independent claim 8 requires that (1) the flexible strap have a width and a flexibility which will allow it to be pulled through the coil's inner diameter when coil is in a relaxed position and (2) the coil has the capability of being reversed when the

flexible strap is pulled through the coil's inner diameter.³ Recognizing that the flexible strap 1 of Tugwood (which has a rather large rectangular ring 11 sewn into one end thereof) does not appear to have a width and flexibility such that it can be pulled through the inner diameter of the coil 3, the examiner has relied on the teachings of Cook. While the examiner has correctly noted that Cook teaches a coil having an inner diameter of 1 3/4 inches, Cook does so in a completely disparate context. That is, Cook teaches the storage of a coiled length of telephone cord within the housing of a telephone (see Fig. 1) or a coiled length of electrical cord within the base of a lamp (see Fig. 7). Absent impermissibly relying upon the appellant's own teachings, we are at a total loss to understand why one of ordinary skill in this art would have been motivated to

³ The appellant does not appear to dispute the examiner's position that, if the teachings of Tugwood and Cook were combined in the manner proposed, the coil 3 of Tugwood (as modified by Cook) would be inherently capable of being reversed in the claimed manner. Instead, the appellant has focused on the contention that there is no suggestion in Cook which would lead one of ordinary skill in the art to enlarge the inner diameter of Tugwood's coil such that the flexible strap could be pulled through it in the claimed manner.

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enlarge the inner diameter of the Tugwood's coil 3 relative to the strap 1 in view of the disparate teachings of Cook.

Although the examiner's position is not a model of clarity, it appears that the examiner may be suggesting the mere fact that it is known in the art of telephone cords to provide coils with varying inner diameters, as evidenced by Cook (1 3/4 inches) and a "conventional" telephone cord (1/4 of an inch), would have provided the motivation to make the inner diameter of the coil of Tugwood's surfboard leash 1 3/4 inches in diameter. We must point out, however, that obviousness under § 103 is a legal conclusion based on **factual evidence** (*In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)), and the mere fact that, generally speaking, it is known in disparate arts (such as telephone cords) to vary the inner diameter of a coil does not provide a sufficient factual basis for establishing the obviousness of enlarging the size of the inner diameter of the coil on Tugwood's leash relative to the width and flexibility of the strap. **See In re GPAC Inc**, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995) and *In re Warner*, 379 F.2d 1011,

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1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S.
1057 (1968)).

The examiner also seeks to dismiss the width and flexibility of the strap relative to the size of the coil's inner diameter as an obvious matter of engineering design dependent on the particular application of the strap. We must point out, however, that the appellant's specification states:

After extended use the coil 22 will sometimes obtain a semi-permanent stretched position. It has been found that by pulling the strap 56 through the coil 22, the coil 22 will return to the fully retracted flattened position. [Pages 8 and 9.]

It is the claimed width and flexibility of the strap relative to the size of the coil's inner diameter that allows reversal of the coil and, hence, the problem of semi-permanent stretch to be solved. This being the case, we do not believe that the claimed width and flexibility of the strap relative to the size of the coil's inner diameter can simply be dismissed as a matter of engineering design as the examiner proposes to do.

Cf. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 8-9 (CCPA 1975).

As to the examiner's conclusion that "if" the inner

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diameter of Tugwood's coil is larger than the width of the strap, the strap can obviously be pulled through the coil, it is well settled that in order to establish a *prima facie* case of obviousness the prior art teachings must be sufficient to suggest to one of ordinary skill in the art making the modification needed to arrive at the claimed invention. *See, e.g., In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984). Here, there is no such suggestion to make the inner diameter of Tugwood's coil larger than the width of the strap.

With respect to claim 9, we have carefully reviewed the teachings of Staude but find nothing therein which would overcome the deficiencies of Tugwood and Cook that we have noted above.

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The decision of the examiner to reject claims 8, 9 and 11
under 35 U.S.C. § 103(a) is reversed.

REVERSED

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| IRWIN CHARLES COHEN |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| |) | APPEALS AND |
| JAMES M. MEISTER |) | INTERFERENCES |
| Administrative Patent Judge |) | |
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| |) | |
| LAWRENCE J. STAAB |) | |
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