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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW GOINS and ALLEN GOINS

Appeal 2017-002861
Application 12/061,068
Technology Center 2800

Before JOHN P. PINKERTON, JON M. JURGOVAN, and
NABEEL U. KHAN, *Administrative Patent Judges*.

KHAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Non-Final Rejection of claims 1–17. An oral hearing was held on November 7, 2018. A transcript of the hearing will be made of record in due course. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

¹ According to the Appeal Brief, the real parties in interest are the inventors, Matthew Goins and Allen Goins. Br. 3.

BACKGROUND

THE INVENTION

According to Appellants, the invention relates to “a pick for strumming, picking, and plucking a stringed instrument.” Spec. ¶ 3.

Exemplary independent claim 1 is reproduced below.

1. A pick for use with a stringed instrument, said pick being constructed of a material comprising:

a polyimide material characterized by a ring-shaped molecular structure containing nitrogen.

REFERENCES AND REJECTIONS

1. Claims 3, 13, and 17 stand rejected under 35 U.S.C. § 112, first paragraph (pre-AIA), as failing to comply with the written description requirement. Non-Final Act. 2.

2. Claims 1, 2, 4–12, and 14–16 stand rejected under 35 U.S.C. § 103(a) over Rios (US 2007/0148409 A1, June 28, 2007) and Kishimoto (JP 2000-104083 A; Apr. 11, 2000).² Non-Final Act. 2–5.

DISCUSSION

REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 3, 13, and 17 recite “poly-oxydiphenylene-pyromellitimide.” The Examiner finds “poly-oxydiphenylene-pyromellitimide” is not found in the original Specification and, thus, concludes the Appellants did not have

² The statement of rejection in the Non-Final Office Action indicates that claim 3 is rejected under 35 U.S.C. § 103(a). *See* Non-Final Act. 2. The Examiner, however, does not address claim 3 under 35 U.S.C. § 103(a). Therefore, we treat the inclusion of claim 3 in the rejection under 35 U.S.C. § 103(a) as error.

possession of the invention as claimed at the time of filing the application.
Non-Final Act. 2.

Appellants argue that the original Specification does support the recitation of “poly-oxydiphenylene-pyromellitimide” because the original Specification discloses “Vespel®, Meldin®, and Plavis®” which, according to Appellants, are trademarks referring to materials containing ring-shaped polyimides, including “poly-oxydiphenylene-pyromellitimide.” Br. 12. Appellants submit an affidavit³ supporting the contention that Vespel®, Meldin®, and Plavis® refer to materials fabricated from poly-oxydiphenylene-pyromellitimide. Matthew Goins Aff. ¶ 10.

The Examiner was “unable to locate any technical information that indicates that the trademarks recited in the originally recited claims are defined as poly-oxydiphenylene-pyromellitimide” and, therefore, maintains the rejection. Ans. 8.

We are persuaded by Appellants’ argument. The Examiner erroneously gives little to no weight to the affidavit submitted by Appellants, which provides support for the fact that the trademarks Vespel®, Meldin®, and Plavis® associated with materials that include poly-oxydiphenylene-pyromellitimide.

Accordingly, we do not sustain the Examiner’s rejection of claims 3, 13, and 17.

³ Affidavit of Matthew Goins, filed under 37 C.F.R. § 1.132 (dated Sept. 8, 2011) (“Matthew Goins Aff.”).

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1, 7–12, and 14–16

The Examiner finds Rios discloses a guitar pick constructed of a plastic material that can include a polyimide material. Non-Final Act. 3 (citing Rios ¶¶ 86, 119).

Appellants argue:

Rios does not disclose the use of a guitar pick which is constructed of a plastic material, as is stated in the Office Action. Rather, Rios is directed to a silicone grip pad consisting of a silicone film layer which, when combined with an adhesive backing layer, can be adhered to nearly any surface to increase the gripping characteristics of the surface.

Br. 16. According to Appellants, Rios’s discussion of polyimide film refers to the backing layer of the silicone grip and “has nothing to do with the manufacture or use of a guitar pick.” Br. 17; *see also* Br. 17–18 (“The disclosure of Rios is completely unrelated to the manufacture, composition, or use of guitar picks, and Rios only mentions ‘guitar picks’ as an example of an object on which a silicon grip pad may be attached.”).

We are unpersuaded by Appellants’ argument. Claim 1 recites a “pick being constructed of a material comprising: a polyimide material” Claims 12 and 16 similarly recite a “pick being constructed of a polyimide material.” These claims, however, do not require the picks to be made solely or integrally of a polyimide material. Rios discloses a silicon grip with a backing layer that comprises polyimides. *See* Rios ¶ 80. The backing layer is not simply an adhesive layer. Rios discloses that the backing layer can enhance the mechanical strength, toughness, moldability, tear resistance and other properties of the silicone layer. Rios ¶ 79. The backing layer

remains an integral part of the silicone grip.⁴ Thus, by disclosing a guitar pick with Rios's silicone grip, we agree with the Examiner that Rios discloses a guitar pick constructed of a material comprising a polyimide material.

Accordingly, we sustain the Examiner's rejection of claims 1, 12, and 16 under 35 U.S.C. § 103(a). Appellants do not argue claims 7–11, 14, and 15, separately; thus, we also sustain the Examiner's rejection of these claims under 35 U.S.C. § 103(a).

Claims 2 and 5

Although Appellants argue claims 2 and 5 separately, they rely on largely the same arguments presented for claims 1, 12, and 16 that we addressed above. *See* Br. 18–19. We do not find these arguments to be persuasive. Thus, we sustain the Examiner's rejection of claims 2 and 5.

Claim 4

Claim 4 depends from claim 1 and recites “wherein said pick is constructed of a material additionally comprising graphite.”

The Examiner does not present any findings regarding claim 4's requirement that the pick additionally comprises graphite. *See* Non-Final Act. 4–5. Thus, we do not sustain the Examiner's rejection of this claim.

⁴ At the hearing, Appellants argued that the backing layer of Rios's silicone grip is a layer that is peeled off when the grip is attached to the guitar pick. This argument was not made in the briefs and is, thus, waived. We note, however, that Appellants' argument is not consistent with Rios's disclosure. Rios does not indicate that the backing layer is peeled off. Instead it is the “release layer” that is removable. *See* Rios Fig. 4, ¶ 78.

Claim 6

Claim 6 depends from claim 1 and recites “wherein said pick is constructed of a material additionally comprising molybdenum disulfide.” The Examiner finds “the use of molybdenum disulfide (claim 6) is conventional and well known filler.” Non-Final Act. 4. Appellants argue the Examiner “has provided no substantial evidence to support the assertion that ‘the use of molybdenum disulfide (claim 6) is conventional and well known filler.’” Br. 20. We agree with Appellants that the Examiner has not supported the rejection with sufficient evidence or reasoning.

Accordingly, we do not sustain the Examiner’s rejection of claim 6.

DECISION

The Examiner’s rejection of claims 3, 13, and 17 under 35 U.S.C. § 112, first paragraph, is reversed.

The Examiner’s rejections of claims 1, 2, 5, 7–12, and 14–16 under 35 U.S.C. § 103(a) is affirmed.

The Examiner’s rejection of claims 4 and 6 under 35 U.S.C. § 103(a) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended. *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART