



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/397,187	02/15/2012	Mark Barthold	16933(1)	8981
92231	7590	12/30/2019	EXAMINER	
Edell, Shapiro & Finnan LLC 9801 Washingtonian Blvd. Suite 750 Gaithersburg, MD 20878			KIM, EUGENE LEE	
			ART UNIT	PAPER NUMBER
			3711	
			NOTIFICATION DATE	DELIVERY MODE
			12/30/2019	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

epatent@usiplaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK BARTHOLD and WILLIAM MIEKINA

Appeal 2018-002469
Application 13/397,187
Technology Center 3700

Before SCOTT A. DANIELS, TARA L. HUTCHINGS, and
AMEE A. SHAH, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ seeks our review under 35 U.S.C. § 134(a) of the final rejection of claims 1–7, 9–14, and 17–20. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a new ground of rejection.

¹ We use the word “Appellant” to refer to “Applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies Mattel, Inc., as the real-party-in-interest. Appeal Br. 3.

THE INVENTION

Appellant's invention is a play set, i.e., a toy boxing or wrestling ring and stage including horizontal ring ropes that are attached to corner posts by an adjustable turnbuckle for tightening the ropes. Spec. 2. The play set further includes a removable turnbuckle pad for covering the turnbuckle and rope at the corner posts where the turnbuckle pad is held in place by "a removable coupler for mounting the turnbuckle pad to the rope." *Id.*

Claim 1 is reproduced below, with certain limitations of importance shown in italics, and is illustrative of the subject matter on appeal.

1. A toy ring, comprising:
 - a platform;
 - a plurality of posts attached to the platform;
 - a rope coupled to each of the posts; and
 - a turnbuckle pad removably mounted to the rope at the attachment point between the rope and one of the posts, the turnbuckle pad being formed to facilitate placement of the turnbuckle pad on the rope, the turnbuckle pad including a first end portion, a second end portion opposite the first end portion, and a removable coupler for mounting the turnbuckle pad to the rope, the coupler including a base and *at least two pegs integrally molded to the base* and extending substantially therefrom, one of the pegs including a shaft that engages the first end portion and the second end portion of the turnbuckle pad to couple them together.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Winterhoff	US 804,696	Nov. 14, 1905
Hayden	US 2,900,203	Aug. 18, 1969

Appeal 2018-002469
Application 13/397,187

Chang	US 4,710,049	Dec. 1, 1987
Baron	US 5,715,553	Feb. 10, 1998
Paolitto	US 6,254,532 B1	July 3, 2001
Kavanaugh	US 2008/0256760 A1	Oct. 23, 2008

Wikipedia² <http://en.wikipedia.org/wiki/Turnbuckle>, dated July 13, 2014 (“Wikipedia”).

The following rejections are before us for review:

1. Claims 1, 2, 7, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wikipedia and Chang.
2. Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wikipedia, Chang, and Hayden.
3. Claims 4 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wikipedia, Chang, and Baron.
4. Claims 6, 10, 13, and 17–20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wikipedia, Chang, Kavanaugh, and Paolitto.
5. Claims 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wikipedia, Chang, Kavanaugh, Paolitto, and Hayden.
6. Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wikipedia, Chang, Kavanaugh, Paolitto, and Winterhoff.

² The <http://en.wikipedia.org/wiki/Turnbuckle> webpage was apparently found using the “Wayback Machine,” <https://web.archive.org> (hereinafter “Wikipedia”). *See* Wikipedia, 1.

OPINION

*New ground of rejection for claims 1–7 and 9 under 35 U.S.C. 112(b)*²

Claim 1

Claim 1 is an independent claim. Appeal Br., Claims App'x.

In the Final Office Action, the Examiner concedes that Wikipedia lacks a removable coupler for mounting the turnbuckle pad to the rope and turnbuckle. Final Act. 2. The Examiner further concedes that Wikipedia fails to disclose “the coupler including a base and at least two pegs *integrally molded* to the base and extending substantially therefrom,” as recited in claim 1. *Id.* at 2–3. The Examiner relies on Chang as teaching the removable coupler including a base and two pegs, the two pegs having respective shafts that engage opposing first and second end portions of a protective hinge pad on an infant playpen. *Id.* at 3. The Examiner finds specifically that Chang’s planar member 36 is the claimed “base,” and that Chang’s connector pins 50 are commensurate with the claimed “pegs” and “shaft.” *Id.* The Examiner further finds that it would have been obvious as a matter of routine skill for one of ordinary skill in the art to form the base and pegs as an integral structure. *Id.* (citing *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893)).

The term “integrally molded” was added to claim 1 by an amendment submitted December 12, 2016, by Appellant during prosecution. Appellant argues that neither Wikipedia nor Chang teach or disclose the at least two pegs being integrally molded to the base. Appeal Br. 19. Appellant argues that Chang’s pins 50 are separate from planar base member 36 as they are

² Claim 8, as well as claims 15 and 16 stand as canceled. Appeal Br., Claims App'x.

described as being inserted through holes in planar base 36. *Id.* at 20 (citing Chang, col. 3, l. 67– col. 4, l. 4; Fig. 2).

What is not explained sufficiently by Appellant, however, is the meaning and scope of the term “integrally molded.” The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular invention with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

Although Appellant states that Chang’s pins 50 are different from the claimed invention because they “are threaded or fed through apertures 38 of the planar member 36,” beyond this, Appellant does not provide any explanation or advocate any certain meaning to the term “integrally molded.” Appeal Br. 20. Appellant also does not point to any evidence or explanation in the Specification explaining the meaning of the term “integrally molded.” *See id.* at 19–22. The Specification states mainly that “fastener 34 comprises a base 46 and at least two pegs 42 *fixed* substantially perpendicular to the base 46.” Spec. 11 (emphasis added). Therefore, the claim requirements, read in light of the Specification, do not specify to a reasonable degree a standard by which to discern if a particular fastener meets a particular requirement. The Specification’s brief disclosure does not provide a qualitative or quantitative metric, formula, or other guideline to allow one of ordinary skill to know when the claim limitation is satisfied.

See Halliburton Energy Serv., Inc., v. M-I LLC, 514 F.3d 1244, 1255 (Fed. Cir. 2008) (“the Court held indefinite claims that recited only ‘inaccurate suggestions of the functions of the product.’”) (*citing United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 234 (1942)). Instead, the word “fixed” in the Specification renders the meaning of “integrally molded” even more ambiguous as to any particular embodiment meeting the claimed requirements and does not offer sufficient guidance as to what constitutes the “integrally molded” requirement. *See Ex parte Miyazaki*, 89 USPQ2d 1207, 1211–12 (BPAI 2008) (precedential) (“The USPTO is justified in using a lower threshold showing of ambiguity . . . because the applicant has an opportunity and a duty to amend the claims during prosecution to more clearly and precisely define the metes and bounds of the claimed invention and to more clearly and precisely put the public on notice of the scope of the patent”).

Because the limitation is indefinite, the prior art rejections must fall because they are necessarily based on a speculative assumption as to the meaning of the claims. *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

Claims 2–7 and 9

Because claims 2–7 and 9 depend either directly or indirectly on claim 1, these claims are also rejected under 35 U.S.C. 112(b), and that the related prior art rejections also must fall. *Id.*

*Unpatentability of Claims 6, 10, 13, and 17–20
over Wikipedia, Chang, Kavanaugh, and Paolitto*

Independent Claims 10 and 19

Claims 10 and 19 are independent claims, and notably, do not include the “integrally molded” limitation as in claim 1. Appeal Br., Claims App’x. Different from claim 1, claim 10 recites that the turnbuckle pad includes “two side portions and two dimples where each of the side portions includes one of the dimples,” and “wherein the two dimples contour the turnbuckle pad to the rope at an attachment point between the rope and the turnbuckle.” *Id.* Claim 19 is similarly drawn to a “dimple” with “each of the turnbuckle pads having angled side portions with dimples formed therein that facilitate the mounting of the turnbuckle pad to the rope.” *Id.*

In the Final Office Action, the Examiner concedes that Wikipedia lacks a removable turnbuckle pad having two dimples on opposing sides of the turnbuckle pad to facilitate mounting the pad to the rope and turnbuckle. Final Act. 9. The Examiner relies on Chang as teaching that the turnbuckle pads are removable, adding that making the pads removable would have been known to those of ordinary skill in the art for “easily replacing or repairing the pad.” *Id.* at 9–10. The Examiner turns to Kavanaugh for disclosure of opposing side portions for securing and “contouring the fastening device to the rope,” and finally to Paolitto “to provide projections in the form of dimples.” *Id.* at 11–12.

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). The patent applicant may then attack the Examiner’s prima facie

determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). However, where the Examiner fails to set forth a prima facie case of obviousness, the burden to rebut the Examiner's findings and conclusion never shifts to Appellant. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Here, the Examiner did not make out a prima facie case of obviousness. First, Kavanaugh does not disclose structure or function that meets the limitations recited in independent claims 10 and 19 with respect to the claimed turnbuckle pad. Second, the Examiner has not provided sufficient reasoning supported by rational underpinnings as to why a person of ordinary skill in the art would have combined Paolitto with any of Kavanaugh, Wikipedia, and Chang. We address Kavanaugh and Paolitto in turn below.

The Examiner relies on Kavanaugh as disclosing "two side portions with projections formed therein that facilitate mounting of the turnbuckle pad to the rope." Final Act. 7. The Examiner reasons that "such a modification would permit quick attachment of an object to the rope." *Id.* We agree that Kavanaugh's device is intended to attach to a rope, line or cord. *See* Kavanaugh para. 2 ("[T]he attachment device of the present invention is attachable to and remains in a fixed position on a line without knotting the line."). Kavanaugh is, however, different structurally and functionally from the claimed invention because Kavanaugh's inner projections grip and affix the device to the line. *Id.*, Fig. 5. The claimed turnbuckle is not, nor intended to be, attached and affixed to the rope or line in the manner of Kavanaugh. The claimed turnbuckle pad is not attached to

the rope nor does it have projections that fixedly engage the rope. Claim 10 does not require attachment of the turnbuckle pad to rope. To the contrary, claim 10 defines the turnbuckle pad as having “an attachment point between the rope and post.” Appeal Br., Claims App’x.

It is also unexplained by the Examiner why one of ordinary skill in the art would have modified the turnbuckle pad to include rope attachment projections that maintain the turnbuckle pad in a fixed position on the rope as taught by Kavanaugh. Appellant argues, persuasively, that Kavanaugh’s structure and function are entirely different because, for a boxing or wrestling ring “the rope is required to slide through the eyelet of the turnbuckle, especially when ‘adjusting the tension or length of ropes’ or when a person or object is forced against the ropes.” Appeal Br. 24. Kavanaugh’s device is contrary to the disclosure in Wikipedia which explains that the turnbuckle eyelets permit the ropes and cable to slide in order for “adjusting the tension or length of ropes.” Wikipedia, first paragraph. The Examiner’s finding does not rely on factual findings or provide sufficient explanation as to why a person of ordinary skill in the art would have combined Kavanaugh and Wikipedia for expediency of attaching or detaching the claimed turnbuckle pad with a rope to meet the present claims. *See* Appeal Br. 7 (The Examiner alleges that modifying Wikipedia with Kavanaugh’s device “would permit quick attachment of an object to the rope.”). Further, the Examiner’s finding also fails to explain how the modified turnbuckle pad with Kavanaugh’s projections gripping the rope meets the limitation of, “an attachment point between the rope and the turnbuckle,” as called for in claim 10.

In addition, the Examiner makes no plausible findings supported by persuasive reasoning and rational underpinnings that support a conclusion that one of ordinary skill in the art would have combined Paolitto's dimple and hole retention arrangement with any of the above-discussed prior art references to achieve the claimed invention. The Examiner states that combining Paolitto "would entail substituting a known means in order to obtain a predictable result such as providing an alternate anchoring means (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007))." Paolitto teaches a surgical apparatus such as a sternum retractor or clamp for cardiac surgery. Paolitto, col. 1, ll. 4–6. Paolitto describes as part of the surgical apparatus "a pre-loaded, formed steel spring 182 [that] has a pair of ears 183, 184 having inwardly formed dimples for location in holes 162, 163 respectively." *Id.* at col. 9, ll. 42–44. A person of ordinary skill in the art would not have viewed the dimple and hole structure and function in Paolitto as a dimple for contouring and mounting a turnbuckle pad over a rope. To the extent a dimple and hole, i.e., a detent, retention mechanism is a known structure, it is not explained how, or why, a person of ordinary skill in the art would have viewed the dimple and hole retention structure in Paolitto as dimples that "contour the turnbuckle pad to the rope," as recited in claim 10 or how the dimples "facilitate the mounting of the turnbuckle pad to the rope," as called for in claim 19. The claimed "dimples," as they contour and permit mounting of the turnbuckle pad to the rope, do not fixedly attach the turnbuckle pad to the rope, as Paolitto's device is intended to directly attach two structures together. Since the Examiner's factual finding here is not adequately supported, the Examiner's conclusion of obviousness lacks rational underpinning. *See In re Kahn*, 441 F.3d 977, 988

(Fed. Cir. 2006), cited with approval in *KSR*, 550 U.S. at 418 (“[R]ejections on obvious grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”).

Inasmuch as the Examiner fails to make out a prima facie case of unpatentability, we need not address Appellant’s arguments and evidence in detail. We do not sustain the rejection of independent claims 10 and 19.

Claims 13, 17, 18, and 20 depend, either directly or indirectly, from claims 10 and 19 and add various dependent limitations. The Examiner’s rejection of these claims suffers from the same infirmities that we have discussed above with respect to independent claims 10 and 19. For the same reasons, we do not sustain the rejection of these dependent claims.

Claim 6

Claim 6 depends from claim 1, and includes limitations similar to independent claims 10 and 19, relating to “a dimple.” Appeal Br., Claims App’x. The Examiner’s rejection of claim 6 over Wikipedia, Chang, Kavanaugh, and Paolitto, suffers from the same deficiencies that we have discussed above with respect to independent claims 10 and 19. For the same reasons, we do not sustain the rejection of dependent claim 6.

Unpatentability of Claims 11, 12, and 14

Claims 11, 12, and 14 depend from claim 10 and are rejected over Wikipedia, Chang, Kavanaugh, and Paolitto in combination with various other references. We have reviewed the additional cited art and the Examiner’s findings, and we determine that these additional references do not cure the deficiencies we have noted above with respect to the rejection of

claims 6, 10, 13, and 17–20. For the same reasons, we do not sustain the rejection of claims 11, 12, and 14.

CONCLUSION

We enter new grounds of rejection under 35 U.S.C. § 112, second paragraph. We reverse, without reaching the merits of the prior-art rejections as to claims 1–7, and 9. We reverse the rejections of claims 10–14, and 17–20.

Overall outcome:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Ground
1–7, 9	112(b)	Indefinite			1–7, 9
1, 2, 7, 9	103	Wikipedia, Chang		1, 2, 7, 9	
3	103	Wikipedia, Chang, Hayden		3	
4, 5	103	Wikipedia, Chang, Baron		4, 5	
6, 10, 13, 17–20	103	Wikipedia, Chang, Kavanaugh, Paolitto		6, 10, 13, 17–20	
11, 12	103	Wikipedia, Chang, Kavanaugh, Paolitto, Hayden		11, 12	
14	103	Wikipedia, Chang, Kavanaugh, Paolitto, Winterhoff		14	
Overall outcome				6, 10–14, 17–20	1–7, 9

This decision contains new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant

to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, 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 the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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

REVERSED; 37C.F.R. § 41.50(b)