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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW VITO DILORENZO

Appeal 2020-001693
Application 15/835,285
Technology Center 3600

Before DANIEL S. SONG, CHARLES N. GREENHUT,
and BRETT C. MARTIN, *Administrative Patent Judges*.

SONG, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1, 3–10, 12–19, and 23. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). The Appellant identifies the real party in interest as TYR Sport, Inc. Appeal Br. 4.

CLAIMED SUBJECT MATTER

The claims are directed to a swim paddle. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A swim paddle system comprising:
 - a paddle that is substantially planar and rigid having a first side for receiving a hand of a swimmer and a second side opposing the first side with a plurality of through holes extending through the paddle from the first side to the second side, the first side having a palm region for receiving a palm of the hand and a peripheral region for receiving a thumb, an index finger, a middle finger, a ring finger, a little finger, and a wrist of the hand, the peripheral region being a region with an edge that defines the outermost extent of the paddle;
 - wherein at least a portion of the paddle is transparent to allow at least a portion of the hand to cast a shadow as light shines through the paddle; and
 - wherein *at least a portion of the edge of the peripheral region has greater opacity than the at least a portion of the paddle that is transparent, the at least a portion of the edge of the peripheral region being provided along the edge such that the shadow of the hand is framed by a shadow outline of the paddle as the light shines through the paddle.*

Appeal Br. 19, Claims App. (emphasis added).

Independent claims 10 and 19 are substantively similar, but recite that at least a portion of the paddle is translucent (claim 10), or transparent or translucent (claim 19). Appeal Br. 19, 22, Claims App.

OPINION

The Examiner rejects claims 1, 3–10, 12–19, and 23 under 35 U.S.C. § 103 as unpatentable over Rives et al. (US 5,651,710, issued July 29, 1997 (“Rives”)). Final Act. 2. The Examiner finds that Rives discloses a swim paddle substantially as claimed, including at least a portion of the

paddle that “can be made of a clear fiber glass composite material but can also be of any color or combination of colors.” Final Act. 2 (italics removed); *see also* Rives, col. 4, ll. 26–37. The Examiner concedes that Rives fails to disclose, *inter alia*, “the recited opacity regions,” i.e., the recited portion of the edge having greater opacity than the transparent/translucent paddle. Final Act. 3.

However, the Examiner finds that:

any shadow of a user’s hand and ... a portion of a paddle edge that would be cast would be dependent on the particular color or combination of colors or any pattern of such colors or combination of such colors which would intrinsically affect transparency, translucency, and/or opacity for any portion or edge portion of such paddle, as well as the amount of light shining through the paddle.

Final Act. 3–4 (italics removed).

Based thereon, the Examiner concludes that the contrasting shadow feature of the claimed invention would have been obvious because providing specific opacity at the edge “would have been considered a matter of preference based on selected clarity and color combination,” and that provision of patterns or designs along the edge “would have been an obvious matter of preference to suit aesthetics,” and not an essential feature. Final Act. 3; *see also* Ans. 5.

The Appellant argues the independent claims as a group, challenging the sufficiency of the articulated rejection. *See generally*, Appeal Br. We agree with the Appellant. None of the Rives’s disclosure of a transparent paddle, providing team or supplier logos thereon, or its disclosure of a paddle of “any color or any combination of colors,” is sufficient to establish obviousness of Rives’s paddle having a portion of the edge with greater

opacity “such that the shadow of the hand is framed by a shadow outline of the paddle as the light shines through the paddle” as claimed. Rives, col. 4, ll. 26–37. As the Appellant argues, “Rives does not provide any suggestion whatsoever of the opacity differing depending on the particular location on the paddle, let alone the specific arrangement” recited in the claims. Appeal Br. 13.

As noted, the Examiner addresses this deficiency stating that the recited greater opacity and the particular location thereof are merely “an obvious matter of preference to suit aesthetics.” Final Act. 3; *see also* Ans. 5. The Examiner further explains that:

a color or logo pattern which would cause any portion of an edge of a peripheral region provided along an edge of the paddle to affect any shadow of a hand being produced or framed by the shadow outline of the paddle as light shines through the paddle such that the opacity of such portion of the edge of the paddle peripheral region is more opaque when compared to any other portion of the paddle that is more transparent and/or translucent, would have been recognized by one of ordinary skill in the art.

Ans. 4–5.

We are not persuaded by the Examiner’s explanation and agree with the Appellant that the rejection is improperly based on a conclusory assertion that “a person would, on the basis of their personal *preferences or selections*,” arrive at the swim paddle as claimed. Appeal Br. 14. As the Appellant points out, “the Examiner provides no articulated rationale for why the *particular* arrangement of differing opacity and resulting shadows recited in the claims would have been obvious” based on the broad and general teachings in Rives. Appeal Br. 15. Although it may have been obvious in view of Rives for a person of ordinary skill to provide a transparent paddle with a team or supplier logos, and that a portion of the

logo may wind up being adjacent, or contacting an edge of the paddle based on the Examiner's asserted preference to suit aesthetics, it does not follow, and is highly speculative to conclude, that the shadow of such a logo would frame the shadow of the hand as required by the claims. *See also* Reply Br. 5 (“An arbitrarily placed supplier logo, even one touching the edge of the paddle, would not cast a ‘shadow outline of the paddle’ as further required by the independent claims.”). As the Specification teaches and the Appellant argues, the claimed invention allows the swimmer to gauge positioning of his/her hand by the cast shadow. Appeal Br. 15–16 (citing Spec. ¶¶ 8, 29, 44; Fig. 5). It is entirely speculative that such a result would be attained based on the general disclosure of Rives, and the reasoning set forth by the Examiner is insufficient to demonstrate obviousness.

Therefore, the rejection of independent claims 1, 10, and 19, as well as dependent claims 3–9, 12–18, and 23, is reversed. The Appellant's separate arguments directed to claims 3, 12, and 23 are moot. Appeal Br. 17–18.

CONCLUSION

The Examiner's rejection is reversed.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 3–10, 12–19, 23	103	Rives		1, 3–10, 12–19, 23

REVERSED