

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte H. CLAYTON MCDONALD

Appeal No. 2003-1144
Application 09/212,343

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 9 through 11, 13 and 14 as amended subsequent to the final rejection in a paper filed August 30, 2001 (Paper No. 14). Claims 1 through 8 and 12 have been canceled.

Appeal No. 2003-1144
Application 09/212,343

Appellant's invention is directed to a flotation device for use in the water and, more particularly, to a flotation device for use in exercise programs conducted in the water. Independent claim 9 is representative of the subject matter on appeal and reads as follows:

9. An exercise device for use in water by a user, the device comprising a unitary piece of material adapted for floating and having:

a buoyancy for supporting a user positioned in a body of water;

two opposed end portions having opposed sides, the end portions having sufficient length to envelop a trunk of the user; and

a narrowed central portion in connecting relation to the two end portions and dimensioned to fit between the upper leg portions of the user, wherein in use the user places the central portion between the legs, causing the end portions to be buoyed upward and over the chest and back of the user, the end portions freely extending and unjoined along the sides, enveloping the trunk of the user and thereby supporting the user in an upright position suitable for supporting [sic, performing] an exercise.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Marchello et al. (Marchello)	4,276,670	July 7, 1981
Helt et al. (Helt)	4,986,786	Jan. 22, 1991

Appeal No. 2003-1144
Application 09/212,343

Claims 9 through 11 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Helt.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Helt in view of Marchello.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the Office action mailed June 7, 2000 (Paper No. 7) and the examiner's answer (Paper No. 19, mailed May 21, 2002) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 18, filed January 3, 2002) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

In maintaining the rejection of claims 9 through 11 and 13 under 35 U.S.C. § 102(b) as being anticipated by Helt, the examiner has urged that the flotation device (10) therein for use in water recreation comprises a unitary piece of material adapted for floating and has a buoyance for supporting a user in a generally upright or seated position in a body of water; the device including two opposed end portions (12, 14) having opposed sides, with the end portions having sufficient length to envelope a trunk of a user, and a narrowed central portion (20) connecting the two end portions and dimensioned to fit between the upper leg portions of a user, wherein in use the user places the narrow central portion between the legs, causing the end portions to be buoyed upward and over the chest and back of the user, the end portions freely extending and unjoined along the sides (Fig. 2), enveloping the trunk of the user and thereby supporting the user in an upright position suitable for performing an exercise (answer, page 4).

We have reviewed the applied Helt patent and, like appellant, find that Helt does not disclose, teach or suggest a flotation device wherein the two opposed end portions are of a length sufficient to "envelope a trunk of a user," and which in

Appeal No. 2003-1144
Application 09/212,343

use in the water would be buoyed upwards "over the chest and back of the user ... enveloping the trunk of the user," as set forth in claim 9 on appeal.

Before the USPTO, when evaluating claim language during examination of an application, the examiner is required to give the terminology of the claims its broadest reasonable interpretation consistent with the specification, and to remember that the claim language cannot be read in a vacuum, but instead must be read in light of the specification as it would be interpreted by one of ordinary skill in the pertinent art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). This the examiner has clearly not done. The "trunk" of a user in the context of appellant's invention refers to that portion of the body of a human being not including the head and limbs, while "envelop" means to surround or cover completely. Thus, while appellant's flotation and exercise device has opposed end portions which are sized "to be buoyed upward and over the chest and back of the user" so as to envelop the trunk of the user, the flotation device of Helt includes opposed end

portions (i.e., front and back portions 16, 18) that are specifically described as being sized quite differently.

In describing the flotation device (10), Helt notes that it includes a front portion (16), a back portion (18) and an intermediate, narrow, connecting crotch portion (20), with "the back portion being of substantially greater area and volume than the front portion" (col. 2, lines 24-26). As further pointed out in column 2, line 52, *et seq.*, in use, the flotation device therein is worn with the crotch portion (20) between the legs of the user, and with the inner surface (22) of the front portion (16) "in engagement with the user's abdomen," and with the inner surface (22) of the back portion (18) "in engagement with the user's buttocks and lower back." The Helt patent makes clear that with this particular sizing of the front and back portions of the flotation garment

[t]he increased volume of back portion 18 compared with the front portion 16 helps float the wearer in a generally upright position as shown in FIG. 1. Further, the portion of back portion 18 which engages the user's buttocks helps maintain the user in a generally seated upright position also as shown in FIG. 1.

Appeal No. 2003-1144
Application 09/212,343

In light of the foregoing, it is clear to us that the examiner's assertions on page 6 of the answer that the device of Helt is inherently capable of performing the function described in the functional limitation of claim 9, and that "the garment of Helt on a five foot user would envelope [sic] the chest and back of the user, whereas the garment of Helt on a six foot nine user would envelope [sic] the trunk of a that [sic] user," are entirely without foundation and contrary to the clear teachings of the Helt patent. Accordingly, we will not sustain the examiner's rejection of claims 9 through 11 and 13 under 35 U.S.C. § 102(b) as being anticipated by Helt.

Given our above-noted determination regarding the shortcomings of Helt, and the lack of any further teaching or suggestion in Marchello supplying such deficiencies, it follows that the examiner's rejection of dependent claim 14 under 35 U.S.C. § 103(a) based on Helt and Marchello also will not be sustained.

Since we have refused to sustain either of the rejections posited by the examiner, the decision of the examiner rejecting

Appeal No. 2003-1144
Application 09/212,343

claims 9 through 11, 13 and 14 of the present application is
reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

CEF:pgg

Appeal No. 2003-1144
Application 09/212,343

JACQUELINE E HARTT
ALLEN DYER DOPPEL MILBRATH & GILCHRIST
255 S ORANGE AVENUE
SUITE 1401
P.O. BOX 3791
ORLANDO, FL 32802