

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(2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RODNEY J. ORR

Appeal No. 97-0519
Application 08/291,719¹

ON BRIEF

Before ABRAMS, FRANKFORT and NASE, Administrative Patent
Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed August 17, 1994.

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This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4, 6, 7, 9 through 28, 37, 41 and 42. Claims 8, 38 through 40 and 43 through 55, the only other claims remaining in the application, stand allowed. Claims 2, 5 and 29 through 36 have been canceled.

Appellant's invention relates to an emergency breathing apparatus which includes a decorative and/or functional front portion that "is sized so that the container 1, mouthpiece 2, and actuator 3 are substantially unobservable when the device is viewed along a front elevational view thereof" (specification, page 8). Appellant's intent here is that when the emergency breathing device is not in use, it may be decoratively situated in virtually any setting with the decorative front portion thereof exposed to view. Independent claims 1, 12 and 21 on appeal appear to be directed to this embodiment of appellant's invention. An additional embodiment of appellant's invention is set forth in independent claim 18 on appeal. This embodiment of the invention relates to an emergency breathing apparatus which includes "means for

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providing a location of said apparatus in darkness." As explained in appellant's specification (page 9), such a means may include a battery operated light (8) and/or a sound generating means (10). In addition, such a means may comprise an outer portion of the apparatus being constructed from luminescent material so as to substantially glow in the dark following exposure to a light source (specification, page 8). Claims 1, 18 and 21 are representative of the subject matter on appeal and a copy of those claims, as they appear in the Appendix to appellant's brief, is attached to this decision.

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

Benedict	2,550,954	May 1, 1951
Hall	4,637,387	Jan. 20, 1987
Heffer	4,905,684	Mar. 6, 1990
Dosch et al. (Dosch)	5,113,854	May 19, 1992

Claims 1, 3, 4, 6, 7, 9, 11 through 16, 18, 20 through 28, 37 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hall in view of Heffer and Benedict.

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Claims 10, 17, 19 and 42 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hall, Heffer and Benedict as applied to the above-noted claims, and further in view of Dosch.

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 examiner's answer (Paper No. 15, mailed November 12, 1996) for the examiner's reasoning in support

of the rejections, and to appellant's brief (Paper No. 14, filed August 19, 1996) and reply brief (Paper No. 16, filed January 16, 1997) 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

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respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of claims 1, 3, 4, 6, 7, 9, 11 through 16, 18, 20 through 28, 37 and 41 under 35 U.S.C. § 103, we note that independent claim 1 on appeal requires that "a front portion" of the storing means, the mouth- piece member, and the airflow permitting means of the emergency breathing apparatus include "a decorative and/or functional device," wherein said decorative and/or functional device comprises a means for retaining a pictorial image. Claim 12 on appeal is similar to claim 1 and requires that "a front portion" of the container for maintaining air under pressure, the air discharging means, and the air delivering means for orally

delivering air in said container to a user include "a decorative front surface," and that said decorative front

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surface comprises "a frame for slidably receiving a pictorial representation." Independent claim 21 is also directed to an embodiment of appellant's invention which has "a decorative front portion which serves as an aesthetically-pleasing home-like decoration so that said emergency breathing apparatus can be conveniently located in a variety of settings." By contrast, independent claim 18 on appeal makes no mention of a decorative front portion on the emergency breathing apparatus defined therein, but instead defines a breathing apparatus which includes "means for providing a location of said apparatus in darkness."

The examiner urges (answer, page 5) that Hall teaches the basic emergency breathing apparatus of appellant's claims on appeal, but does not teach "hiding the device behind an attached picture frame for cosmetic reasons." To address this difference the examiner looks to Heffer and Benedict, taking the position that

Heffer teach [sic] a similar emergency breathing device, and also teach hiding the emergency breathing device behind a decorative picture or the like for cosmetic

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reasons - see column 5 [sic, 3]. Heffer does not teach a completely portable unit with a

picture frame mounted thereon. Benedict teaches a cabinet for dispensing room deodor- izers or the like, where a picture frame is mounted on the front thereof for cosmetic purposes. In view of the art of record, it is shown that the emergency breathing appara- tus claimed is known in the art. Therefore the unobviousness question is based upon providing a known emergency breathing device with a cosmetic cover in the form of a pic- ture frame. The prior art teaches decora- tively disguising emergency breathing devices with picture frames as well as other func- tional devices. Therefore, the teachings of the prior art teach that it would have been obvious to one of ordinary skill in the art to have decoratively hid an emergency breath- ing device behind a picture frame for cos- metic purposes (answer, page 6).

In an apparent effort to address independent claim 18 on appeal, the examiner has additionally taken the position that

Heffer teach [sic] the need for visual and audible location indicating means to allow the devices to be located during a fire, so that the victims using the device may be rescued by firefighters. As such, it would

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have been obvious to one of ordinary skill in the art to have provided the Hall device with such location indication means for the same reasons (answer, page 7).

Like appellant (brief, page 6), we are of the opinion that the examiner's above positions are based on impermissible hindsight gleaned from appellant's own disclosure and not from any fair teaching or suggestion found in the applied prior art

references themselves. In this regard, we consider that the examiner has used appellant's own disclosure and the claimed invention itself as a blueprint for piecing together unrelated elements in the prior art so as to defeat patentability of the apparatus defined in appellant's independent claims 1, 12, 18 and 21 on appeal.

Absent the disclosure of the present application, it is our opinion that one of ordinary skill in the art would not have been motivated to modify the portable breathing apparatus of Hall in light of the decorative cabinet door (13) of Heffer

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or the wall mounted picture frame and deodorizing cabinet of Benedict, so as to arrive at the subject matter set forth in appellant's claims 1, 12 and 21 on appeal. As to independent claim 18, we share appellant's view that one of ordinary skill in the art would not have found any suggestion in the applied references to merely take the warning lights and buzzers from the wall mounted fume protection cabinet in Heffer and somehow apply those same features to the portable breathing apparatus of Hall. Thus, the examiner's rejection of appellant's claims 1, 3, 4, 6, 7, 9, 11 through 16, 18, 20 through 28, 37 and 41 under 35 U.S.C. § 103 based on Hall, Heffer and Benedict will not be sustained.

We have also reviewed the patent to Dosch applied by the examiner in the § 103 rejection of dependent claims 10, 17, 19 and 42. However, we find nothing in this reference which would supply that which we have noted above to be lacking in the basic combination of Hall, Heffer and Benedict. Accordingly, the examiner's rejection of claims 10, 17, 19 and

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42 on appeal under 35 U.S.C. § 103 will likewise not be sustained.

As should be apparent from the foregoing, the decision of the examiner rejecting claims 1, 3, 4, 6, 7, 9 through 28, 37, 41 and 42 of the present application is reversed.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against claims 18 and 19 on appeal.

Claims 18 and 19 are rejected under 35 U.S.C. § 103 as being unpatentable over Hall in view of Dosch. Hall discloses a portable breathing apparatus generally like that set forth in appellant's claims 18 and 19 on appeal, except that the breathing apparatus of Hall does not include "means for providing a location of said apparatus in darkness" as in claim 18 on appeal, and

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also does not teach or suggest an arrangement wherein an apparatus location providing means like that of claim 18 would include "a visual indicating means," which latter means includes "an outer surface of said device comprising luminescent material," as in dependent claim 19 on appeal. However, we note that Dosch discloses a portable emergency breathing apparatus wherein the apparatus includes one or more chemiluminescent elements (64) connected thereto to assist in donning of the breathing apparatus particularly in the dark, and which chemiluminescent elements are later used for assisting in finding the wearer by rescue personnel. Based on the collective teachings of Hall and Dosch, it is our opinion that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to provide the emergency breathing apparatus of Hall with chemiluminescent or luminescent elements as generally suggested in Dosch so as to provide the user of Hall's breathing apparatus with assistance in donning the apparatus in the dark and also with a visual indicating means that

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allows the user to be more easily located in the dark by rescue personnel.

In addition to the foregoing, we also REMAND this case to the examiner for a consideration of the appropriate scope of

the "second means" set forth in independent claim 21 on appeal under 35 U.S.C. § 112, sixth paragraph, and for a consideration of whether such a means (1) is distinguishable from the printed indicia, advertisements or the like (col. 8, lines 31-39) on the breathing apparatus of Hall, or (2) serves to distinguish the claimed subject matter from a breathing apparatus like that resulting from the combination of Hall and Dosch in our new rejection of claims 18 and 19 above.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997)), 1203 Off. Gaz. Pat. & Trademark Office 63, 122

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(Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that 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 proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both,

and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

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REVERSED, 37 CFR § 1.196(b) AND REMANDED

	NEAL E. ABRAMS)	
	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
	CHARLES E. FRANKFORT)	APPEALS AND
	Administrative Patent Judge)	
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)	
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APPENDIX

1. An emergency breathing apparatus, comprising:

means for storing air under pressure;

a mouthpiece member;

means, connected to said storing means and said mouthpiece member, for selectively permitting airflow from said storing means to said mouthpiece member;

a front portion of said storing means, said mouthpiece member, and said airflow permitting means includes a decorative and/or functional device;

said air storing means, mouthpiece member and said airflow permitting means are substantially portable for suspension from a user's mouth when in use; and

wherein said decorative and/or functional device comprises a means for retaining a pictorial image.

18. An emergency breathing apparatus, comprising:

means for storing pressurized gas for breathing;

a mouthpiece operatively connected to said storing means;

means, connected to said storing means, for selectively discharging air from said storing means to said mouthpiece in response to initiation of said discharging means by a user of said apparatus;

means for providing a location of said apparatus in darkness; and

wherein said gas storing means, said mouthpiece and said air discharging means are substantially portable and sub-

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stantially sized so as to suspend from a user's mouth when in use.

21. An emergency breathing apparatus, comprising:

first means for providing air to a user in an emergency situation;

second means for a decorative and/or functional purpose;

said first and said second means are substantially portable;

a predetermined portion of said first means includes said second means; and

said predetermined portion of said first means which includes said second means comprises a decorative front portion which serves as an aesthetically-pleasing home-like decoration so that said emergency breathing apparatus can be conveniently located in a variety of settings.