

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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHANIE R. VAUGHAN

Appeal No. 2000-1486
Application No. 08/968,871

HEARD: February 8, 2001

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

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21 to 25, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an exercise device for providing buoyancy for deep water exercise. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Homewood 1915	1,128,682	Feb. 16,
Lennon 1989	4,804,326	Feb. 14,
Alston 1990	4,905,991	March 6,

Claims 21 to 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lennon in view of Alston and Homewood.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 25, mailed March 10, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 24,

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filed November 22, 1999) and reply brief (Paper No. 26, filed
May 10, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 21 to 25 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983),, cert. denied, 469 U.S. 851 (1984)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the

whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Claim 21, the sole independent claim on appeal reads as follows:

An exercise device for providing buoyancy for deep water exercise, said device comprising a resilient tubular body member being open at one end thereof for receiving a user's appendage and the other end of said body member having a loop member for limiting movement of said body member upon the user's appendage, said tubular body member being formed of buoyant material comprised of foam material shaped for having thin marginal portions adjacent said one end and adjacent said loop member for minimizing interference with other appendages of the user and including a cover material of elasticized fabric, said tubular body member being in the form of a generally closed oval in cross-section when in repose and generally cylindrical in use for elastically conforming to a user's appendage for minimizing slippage thereon and for further minimizing interference with an adjacent appendage.

Lennon discloses a swimming instruction and training aid. As shown in Figure 1, the swimming instruction and training aid is worn about the ankle and leg of a swimmer. The swimming instruction and training aid comprises an approximately cylindrical sleeve of resilient cellular neoprene material surfaced on both sides with a nylon or similar fabric. The sleeve is provided with slits so that it can be easily fitted over the foot, placed on the ankle, and remain in position there without movement and consequent distraction. Lennon teaches that the swimming instruction and training aid provides only a relatively small buoyant force.

Alston discloses a swim weight sleeve system for use in aquatic exercises and training applications by swimmers. As shown in Figure 1, a sleeve 1 includes a rubberized sleeve material 2 containing an adjustable quantity of weights 3 and adapted to snugly fit around the forearms and/or calves of a swimmer. Sleeve 1 is adapted to stretch over the hand or foot of a swimmer and retract to substantially its original size to provide a snug fit conforming to the shape of the forearm or calf of the swimmer. Securing straps 5, provided at each end

of sleeve 1, ensure a secure fit of the sleeves. A wrap-around weighted sleeve 6 is shown in Figure 2. Alston teaches that a suitable material for the sleeves 1 and 6 is 1/8 inch, closed cell neoprene rubber incorporating stretchy, nylon fabric bonded to one or both sides.

A non-weighted sleeve 10 that absorbs water to serve as weight during swimming is shown in Figure 3 of Alston. Alston teaches that the sleeve 10 is non-weighted when dry, and contains water absorbent material 11 such as polyester quilting or a foamed rubber, such as urethane rubber. The outer covering 12 of sleeve 10 is formed of a suitable porous material to permit passage of water to the primary absorbing material 11 or the covering 12 may be formed of the same material as adsorbent material 11 if desired. An elasticized band 13 is featured at one end of the sleeve 10, and a securing strap 14 is featured at the opposite end to prevent the sleeve 10 from slipping during rigorous swimming actions.

Homewood discloses a swimming aid. The swimming aid comprises an elastic sleeve which can be an armlet 2 as shown

in Figures 1 and 2, or a legging 5 as shown in Figures 3 and 4. Homewood teaches that a loop 6 may be attached to one end of the legging 5 in order to retain the legging in place.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Lennon and claim 21, it is our opinion that the differences are: (1) a loop member for limiting movement of the body member upon the user's appendage, (2) the tubular body member being formed of buoyant material comprised of foam material shaped for having thin marginal portions adjacent the one end and adjacent the loop member, (3) a cover material of elasticized fabric, and (4) the tubular body member being in the form of a generally closed oval in cross-section when in repose.

With regard to the first three differences noted above, the examiner determined (answer, pp. 3-4) that each of these

differences would have been obvious based upon the combined teachings of Lennon, Alston and Homewood. With regard to the fourth difference noted above, the examiner determined (answer, p. 4) that it would have been obvious to make the device of Lennon to "have a closed oval cross section [when in repose] since it has been held a change of shape of a prior art device does not present a patentable difference. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)."

The appellant argues (brief, pp. 5-9; reply brief, pp. 1-2) that the applied prior art does not suggest the claimed subject matter. We agree. In our view, the combined teachings of the applied prior art would not have led an artisan to arrive at the claimed invention. In that regard, it is our opinion that differences (2) and (4) are not suggested by the applied prior art. Specifically, we see no motivation, suggestion or teaching in Alston of the desirability of making the tubular body member of Lennon to be formed of foam material shaped for having thin marginal portions adjacent each end. Additionally, we believe it was

inappropriate in this instance for the examiner to have determined that the limitation that the tubular body member is in the form of a generally closed oval in cross-section when in repose was obvious without any evidence providing some motivation, suggestion or teaching of the desirability of making that change to Lennon.

In our view, the only suggestion for modifying Lennon to arrive at the claimed invention in the manner proposed by the examiner stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, In re Dembiczak, supra; W.L. Gore & Assocs., Inc. v. Garlock, Inc., supra.

For the reasons set forth above, the decision of the examiner to reject claim 21, and claims 22 to 25 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 21 to 25 under 35 U.S.C. § 103 is reversed.

REVERSED

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