

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDITH WINSTON

Appeal No. 98-1201
Application No. 08/527,784¹

ON BRIEF

Before CALVERT, MEISTER, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 1, the only claim pending in this application.

We AFFIRM and enter a new rejection pursuant to 37 CFR § 1.196(b).

¹ Application for patent filed September 13, 1995.

BACKGROUND

The appellant's invention relates to an aquatic exercise device.

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

Winston 1989	4,838,546	June 13,
Alston 1990	4,905,991	March 6,

Velcro Product News, Velcro. Corp., ISDT tank bags, p. 3, 1976

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Winston in view of the ISDT tank bags and Alston.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 4, mailed April 25, 1996) and the examiner's answer (Paper No. 13, mailed August 4, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 12, filed April 25, 1997) and reply brief (Paper No. 14, filed September 8, 1997) 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. As a consequence of our review, we make the determinations which follow.

Claim 1 reads as follows:

Improvements for adapting for aquatic use an exercise device of a type worn encircling relation about

a selected limb of a user having plural compartments for receiving in inserted relation therein cooperating weights and in the use of which only some of said compartments may be filled with weights and others empty, said improvements comprising a rectangular flap attached along an upper edge to said exercise device so as to be folded in covering relation over said partially filled and unfilled weight-receiving compartments, "VELCRO" hook and loop fasteners disposed along opposite sides and a lower edge of said flap adapted to contact underlying areas of said exercise device in encircling relation about said compartments to contribute to providing a hermetic seal for said compartments, and means for positioning said exercise device in encircling relation about a limb of a user incident to exercising use of said positioned exercise device in a submerged condition in a swimming pool environment, whereby in said swimming pool environment there is nominal seepage of water into unfilled compartments as might add to the weight selected by the user for exercise routines.

The indefiniteness rejection

The appellant has not argued the rejection of claim 1 under 35 U.S.C. § 112, second paragraph. The appellant states in the brief (p. 4) that "[u]pon return of the Application to the Examining Group upon reversal of the Section 103 rejection, Applicant will provide an appropriate amendment to delete such material [VELCRO] from the claim." Since no amendment has yet been submitted to overcome this rejection,

we summarily sustain the rejection of claim 1 under 35 U.S.C. § 112, second paragraph.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

We are unable to determine the metes and bounds of the claimed invention with a reasonable degree of precision and particularity for the reasons set forth below. In addition to

the examiner's basis for the rejection of claim 1 under the second paragraph of 35 U.S.C. § 112 (see page 2 of the final rejection), we have determined that claim 1 fails to reasonably apprise those of skill in the art of its scope since it is unclear to us exactly what subject matter claim 1 is reciting. In that regard, it is unclear whether the appellant is claiming an exercise device for use in a swimming pool or just the recited improvements to an exercise device. It appears that the appellant may have intended claim 1 to be a claim of the type specified in 37 CFR 1.75(e), i.e., a "Jepson" claim, in which case the device being improved upon should be recited in the preamble as part of the combination. See 37 CFR § 1.75(e)(1). However, here the preamble of the claim recites "Improvements for adapting for aquatic use an exercise device of a type worn in encircling relation [etc.]..., said improvements comprising...". This departure from prescribed claim form makes it unclear whether the appellant is claiming the exercise device in combination with the improvements, or just the recited improvements per se. The scope of the claim is particularly unclear because although on the one hand the language in its preamble would

seem to limit it to the improvements, on the other hand some of the recited improvements seem to be claimed in combination with the exercise device, for example, the "rectangular flap" is recited as being "attached along an upper edge to said exercise device".

The obviousness issue

While we might speculate as to what is meant by the claim language, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art as we are obliged to do. Rejections under 35 U.S.C. § 103 should not be based upon "considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims." In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Accordingly, we are constrained to

reverse, pro forma, the examiner's rejections of claim 1 under 35 U.S.C. § 103.²

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 112, second paragraph is affirmed, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is reversed, and a new rejection of claim 1 under 35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

Since one rejection of claim 1 has been affirmed, the decision of the examiner is affirmed.

² However to avoid the inefficiency of piecemeal appellate review, we note that the appellant's argument (reply brief, pp. 2-3) to the effect that the ISDT tank bags are non-analogous art is well taken. The test for non-analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). In the present instance, the ISDT tank bags are not within the field of the inventor's endeavor or reasonably pertinent to the problem with which the inventor was involved. Thus, the ISDT tank bags are non-analogous art.

In addition to affirming the examiner's rejection of one or more claims, 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. 53131, 53197 (Oct. 10, 1997)), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

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. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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

AFFIRMED; 37 CFR § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPEAL NO. 98-1201 - JUDGE NASE
APPLICATION NO. 08/527,784

APJ NASE

APJ CALVERT

APJ MEISTER

DECISION: **AFFIRMED;**
37 CFR § 1.196(b)

Prepared By: Gloria Henderson

DRAFT TYPED: 18 Nov 98

FINAL TYPED: