

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTINE A. RICH

Appeal No. 1999-0113
Application No. 08/472,321

ON BRIEF

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5-16 and 49-51. Claims 1-4, the only other claims pending in this application, stand withdrawn from further consideration under 37 CFR § 1.142(b) as being directed to a non-elected invention. We note that the appellant requested cancellation of claims 17-48, at the top of the "Request Form for Continuation or Divisional Application Under 37 CFR § 1.60" filed June 7, 1995 (Paper No. 1), but a review of the application file reveals that this amendment has not been physically

entered.¹ In any case, it is clear from the record that both the appellant and the examiner have treated claims 17-48 as having been canceled.

BACKGROUND

The appellant's invention relates to an exerciser (exercise device) comprising a resilient stretchable element and a flexible stretchable loop for exercising a number of different muscles or muscle groups in the human body. Independent claim 5, which is reproduced in the appendix to the appellant's brief, is exemplary of the invention.

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

Dubach	3,966,204	Jun. 29, 1976
Swann	4,403,773	Sep. 13, 1983
Suarez et al. (Suarez)	4,815,731	Mar. 28, 1989
Orford et al. (Orford) (British Patent)	451,516	Aug. 7, 1936

The following rejections are before us for review.

1. Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dubach.
2. Claims 5-10 and 49-51 stand rejected under 35 U.S.C. § 103 as being unpatentable over Orford in view of Dubach.

¹ We leave it to the examiner to take appropriate action to have this amendment entered.

3. Claims 11-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Orford in view of Dubach, as applied to claim 10 above, and further in view of Suarez.

4. Claims 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Swann in view of Dubach.

Reference is made to the brief (Paper No. 11) and reply brief (Paper No. 14) and the answer (Paper No. 12) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

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.

According to the appellant's brief (page 4), claims 5-10, 12-16, 50 and 51 stand or fall together and claims 11 and 49 are each separately patentable. Therefore, we have selected independent claim 5 as the representative claim from the appellant's grouping of claims 5-10, 12-16, 50 and 51 to decide the appeal of these rejections under 35 U.S.C. § 103. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

Rejection 1

Dubach discloses an exercise device comprising a tensile element (2) consisting of an endless rubber cord or rubber-elastic cable (column 2, lines 15-16) and rings or hand grips (1) consisting of "elastic plastic material or rubber" (column 2, lines 11-14), with the rings being connected to the tensile element at a detachable connection (3), which may be achieved by tying or looping the tensile element about the ring. The examiner (answer, page 3) appears to concede that Dubach differs from the claimed "exerciser" in that Dubach does not disclose that the tensile element has a spring force which permits it to be stretched by the muscle force of a person "to a length which exceeds at least 100% of its length at rest" but concludes that manufacturing the tensile element of Dubach to have such a spring force would have been an obvious matter of design choice within the skill of the art.

It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Having reviewed the language of claim 5 and the entirety of the appellant's disclosure, we cannot agree with the interpretation (i.e., as requiring an extended length at least double its length at rest) accorded claim 5 in our colleague's concurring opinion. Turning first to the language of claim 5, we observe that the spring force limitation therein merely requires that the resilient stretchable element be stretchable by the muscle force of a person "so as to extend to a length which exceeds at least 100% of its length at rest." As we see it, any degree of extension or stretch of the tensile element, no matter how small, from its length at rest constitutes a stretching "to a length which exceeds at least 100% of its length at rest" as this language would ordinarily be understood by one of ordinary skill in the art. In describing the spring force of the resilient element, the appellant's specification (page 6, lines 21-26, and page 31, lines 1-4) uses the same language found in claim 5, with a preferable range of extension as recited in dependent claim 6. While we have carefully considered, for example, the language in the appellant's specification on page 31, in lines 5-20, regarding fluidity of motion, elimination of jarring and reference to "tighter springs with heavier spring forces and lesser degrees of elongation" and the drawings (Figures 4M and 5E) referenced in the concurring opinion, we find nothing therein which convinces us that the appellant has limited the scope of her invention to exercisers having resilient elements which are capable of stretching, at a minimum, to double their length at rest, as opposed to, for example, merely pointing out the advantages of using

resilient elements having relatively higher degrees of elongation within the broader scope of her invention.

It is apparent from Dubach's characterization of the elements (2) as "tensile"² elements and the arrows shown in Figures 6-14 of Dubach that the tensile elements are intended to be stretched to some degree by the muscle force of a person when the hand or foot is received in the ring. Accordingly, we are of the opinion that one of ordinary skill in the exercising art would have understood the tensile element (2) of Dubach to be stretchable by the muscle force of a person so as to extend to an extended length which exceeds the length of the element at rest, thereby meeting the broad spring force limitation of claim 5.

Moreover, we hasten to add that we agree with the examiner that the degree of resiliency and range of stretch ability would have been an obvious matter of design choice within the skill of the art to be determined depending on the particular types of exercises to be performed and the desired level of difficulty. For example, one of ordinary skill in the exercising art would have understood that a tensile element having a high degree of resiliency and a wide range of extensibility would be required to permit "dynamic uses for improving the circulation and endurance" as contemplated by Dubach (column 3, line 47, to column 4, line 2). Therefore, even if the appellant's claim were interpreted as requiring the stretchable resilient element to have a spring force which permits it to be stretched by the muscle force

² The term "tensile" is ordinarily defined as "capable of being stretched" (Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)).

of a person to a length which exceeds its length at rest by at least 100% (i.e., at least a doubling of the length) as urged in our colleague's concurring opinion, we agree with the examiner's conclusion that to manufacture the Dubach tensile element to have such resiliency and range of stretch ability would have been obvious to one of ordinary skill in the art.

The appellant (brief, pages 7-8) argues that Dubach fails to disclose that the ring (1) is "stretchable" and "configured to receive either a hand or foot in the alternative of the person exercising . . . closely conforming to and gripping either the hand or foot of the person." The disclosure by Dubach that the rings are "elastic plastic material or rubber" belies the appellant's argument with regard to stretch ability of the rings. Further, from our perspective, these rings are capable of receiving either a hand or foot of a person exercising and of closely conforming to and gripping an appropriately sized hand or foot.

For the reasons discussed above, we shall sustain the examiner's rejection of claim 5, and claim 6 which stands or falls therewith, under 35 U.S.C. § 103 as being unpatentable over Dubach.

Rejection 2

Orford discloses an exercising apparatus which "allows a wide range of healthful exercises to be performed" (page 1, lines 42-44) comprising a chest harness having resilient cords (13), which "may consist of multi-strand rubber, or of helical steel springs (page 2, lines 28-30) and hand grips (14) made of leather bent over to form a rolled gripping portion (15) and

a flat knuckle shield (16). According to the examiner, Orford fails to disclose that the loop members (hand grips) are made of resilient stretchable material. However, it is the examiner's position that, in view of the teachings of Dubach, it would have been obvious to one of ordinary skill in the art to manufacture the folded and joined loops (14) of Orford of a flexible and stretchable material and in an I-shaped configuration as disclosed by Dubach as a means to enhance the grip of the device of Orford and as a means to strengthen the muscles of the hand of a user (answer, page 4). The examiner further points out that it is well known in the art to manufacture resilient exercising cords of various resiliencies to vary exercising difficulties and apparently concludes that it would have been an obvious matter of design choice to manufacture the resilient cord of Orford so as to have a spring force permitting the cord to be stretched by a person's muscle force to a length exceeding at least 100% of its length at rest.

Initially, as discussed above, any extension of the resilient cord, no matter how small, constitutes a stretching "to a length which exceeds at least 100% of its length at rest" as required by the claim. Thus, the disclosure by Orford (page 1, lines 63-66) that "[the strength of the cord is such that the user needs to make a fair effort in order to stretch the cords, but not so great that strain is imposed]" clearly meets the spring force limitation of claim 5.

Moreover, Orford discloses that the exercise apparatus "allows a wide range of healthful exercises to be performed; in particular it is useful for 'shadow boxing' and the like exercises" (page 1, lines 41-45). One of ordinary skill in the art would have appreciated that shadow boxing involves movement of the arms from a bent position wherein the fists are close to the chest or face to a fully extended position to simulate an undercut, jab or other hitting motion. In order to accommodate this wide range of motions and positions, it would have been obvious to one skilled in the art to manufacture the Orford cords (13) so as to permit significant stretching, with the precise resilience and range of stretch ability being a matter of design choice within the skill of the art, depending on the particular exercises to be performed and the desired degree of difficulty. Therefore, even if claim 5 were interpreted as requiring that the resilient element have a spring force which permits stretching by the muscle force of a person to a length which exceeds its length at rest by at least 100% (i.e. at least a doubling of the length) as urged in our colleague's concurring opinion, we are of the opinion that such a feature would have been obvious to one of ordinary skill in the art.

The appellant does not contest the examiner's assertion that it would have been obvious to manufacture the Orford hand grips of a stretchable material as taught by Dubach, but urges that the material of the rings of Dubach is not disclosed as being "stretchable." This argument is not well taken, in view of Dubach's disclosure that the rings be made of "elastic plastic material or rubber." The appellant further argues that the I-section configuration (Figure 18 and column 3, lines 27-38) alluded to by the examiner "is not likely stretchable in use as

claimed, due to its configuration with the webs" (brief, page 8), but has not provided any evidence to support this assertion.³

We are also not persuaded by the appellant's argument that Orford discloses "nothing more than loops which are engageable by the hand only and not likely engageable by the foot" (brief, page 8). As we see it, the hand grips of Orford are capable of receiving either a hand or a foot of the user and of closely conforming to and gripping an appropriately sized hand or foot so as to meet the claim limitations.

Accordingly, we shall also sustain the examiner's rejection of claim 5, and of claims 6-10, 50 and 51 which stand or fall therewith.

The appellant has argued separately the patentability of claim 49 (brief, pages 10-11). This claim depends from claim 10 and adds the further limitation that the loop is rectangular in cross section so that it is wider than it is thick. The Orford hand grips are disclosed as being "made of leather bent over to form a rolled gripping portion 15 and a flat knuckle shield 16" (page 2, lines 37-41). We share the appellant's opinion that it is not clear what a "rolled" gripping portion is and that, based on this description and the illustration thereof, the gripping portion is more likely to be round than rectangular as claimed. While the flat knuckle shield may be rectangular in cross section, we are unable to determine with any certainty that this is the case and the examiner has not addressed this issue. Further, we agree with the appellant

³ Attorney's arguments in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

that the rings of Dubach appear in most of the drawings to be circular or round in cross section, with the exception of the I-section illustrated in Figure 18, and thus would not have suggested a rectangular cross section. Therefore, we are constrained to reverse the examiner's rejection of claim 49.

Rejection 3

With regard to the examiner's rejection of claims 12-14 as being unpatentable over Orford in view of Dubach and Suarez, the appellant has chosen not to argue the patentability of these claims separately from claim 5. Therefore, claims 12-14 shall stand or fall with representative claim 5.⁴ As we have sustained the examiner's rejection of claim 5 as being unpatentable over Orford in view of Dubach, it follows that we shall also sustain the examiner's rejection of claims 12-14 as being unpatentable over Orford in view of Dubach and Suarez.

The examiner's position with regard to claim 11, as expressed on page 5 of the answer, is that it would have been obvious to one of ordinary skill in the art to provide a stretchable textile covering on a portion of the Orford loop (hand grip) "for the purpose of enhancing the comfort of the loop when worn by a user" in view of the nylon cover (7) which covers the resilient pad (8) of Suarez. The appellant argues (brief, page 10), and we agree, that, even if the covering material (7) of Suarez is a "textile" as claimed, there is no teaching or suggestion

⁴ See Young, 927 F.2d at 590, 18 USPQ2d at 1091; Wood, 582 F.2d at 642, 199 USPQ at 140.

that such a covering, if placed on the hand grip of Orford, would be "stretchable with the stretchable member" of the hand grip as required by the claim. Therefore, we shall not sustain the examiner's rejection of claim 11.

Rejection 4

The examiner has rejected claims 15 and 16, which require a rigid flat platform for accommodating the body of the person exercising and a stationary anchor to which the resilient stretchable element recited in claim 5 or 9 is fastened, as unpatentable over Swann in view of Dubach. Swann discloses an exercising apparatus comprising a flat rectangular support having a pair of spaced end bars (13, 14) at each end with eye bolts (15, 16) attached thereto for fastening tension means (26) with hand grips (25). The examiner takes the position that it would have been obvious to one of ordinary skill in the art to fasten the tensile elements (2) with hand grips (1) taught by Dubach onto the Swann apparatus, "thereby enhancing the versatility of the device by adding stretchable handle elements which allow a user to also exercise their hands" (answer, page 7).

The appellant has chosen not to argue the patentability of claims 15 and 16 separately from independent claim 5. Rather, the appellant has elected to have claims 15 and 16 stand or fall with claim 5, apparently relying on the perceived deficiencies of Dubach in teaching a resilient stretchable element and flexible stretchable loop as required in claim 5. As we have sustained the examiner's rejection of claim 5 as being unpatentable over Dubach, it follows that

we shall also sustain the examiner's rejection of claims 15 and 16 as being unpatentable over Swann in view of Dubach.

CONCLUSION

To summarize, the decision of the examiner to reject claims 5 and 6 as unpatentable over Dubach, claims 5-10, 50 and 51 as unpatentable over Orford in view of Dubach, claims 12-14 as unpatentable over Orford in view of Dubach and Suarez and claims 15 and 16 as unpatentable over Swann in view of Dubach is affirmed; however, the examiner's decision to reject claim 49 as unpatentable over Orford in view of Dubach and claim 11 as unpatentable over Orford in view of Dubach and Suarez is reversed.

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

AFFIRMED-IN-PART

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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) APPEALS
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) INTERFERENCES
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COHEN, Administrative Patent Judge, concurring:

I concur in the entirety of the majority's opinion, but for the view (page 5) that "any degree of extension" corresponds to the limitation of claim 5 wherein the resilient stretchable element has a spring force so as to "extend to a length which exceeds at least 100% of its length at rest." Read in light of the underlying specification (page 31; distinguishing present invention from tighter springs) and accompanying drawings (Figs. 4M and 5E; the solid and dot and dash spring positions reflect a significant extension in length), it is my understanding that the claim 5 language at issue, supra, clearly denotes that appellant's exerciser requires an extended length at least double its length at rest.

PATENT	IRWIN CHARLES COHEN)	BOARD OF
	Administrative Patent Judge)	APPEAL AND
)	INTERFERENCES

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Daniel M. Riess
Lockwood, Alex, Fitzgibbon &
Cummings
Three First National Plaza, Suite 1700
Chicago, IL 60602