

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM L. COURTNEY and ROBERT MANUEL CARMICHAEL

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Appeal No. 2001-2543  
Application No. 09/225,892

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ON BRIEF

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Before COHEN, FRANKFORT, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1 through 7 and 21 through 25 as amended in a paper (Paper No. 9) filed subsequent to the final rejection. Claims 8 through 14, the only other claims pending in the application, have been withdrawn from consideration as being directed to non-elected inventions. Claims 15 through 20 have been canceled.

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Appellants' invention relates to a counterweight assembly, best seen in Figures 28 through 31 and 37 through 41, comprising one or more weight members (460 or 780) and means for attaching the one or more weight members to a breathing gas cylinder (301) worn by a diver. The counterweight assembly is specifically used to provide an enhanced heads up surface positioning of the diver in emergency situations and is attached to the cylinder (301) at a position where the diver/user cannot remove the one or more weight members while the cylinder is attached to the diver/user and where the weight member or members can rotate the diver to ensure heads up surface positioning if the diver becomes incapacitated. The heads up surface positioning, shown generally in Figures 12 and 43 of the application drawings, provides a way of keeping the diver/user's airway out of the water when the diver is unable to. In the embodiment of Figures 28 through 31 the means for attaching includes a pouch member (430) having pockets (432) for receiving the weight member or members therein and a tank strap (420) to which the pouch member is either removably or permanently attached. The pouch member (430) includes a flap member (440) for covering the pockets and preventing inadvertent loss of the weight member or members stored therein. In Figures 37 through 39 the means for attaching

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includes a pocket member (710) either permanently or removably attached to a tank belt (320) and a pouch member (740) for receiving the one or more weight members. The pouch member is to be carried in the pocket member and includes a quick release handle (754) to allow a person, other than the diver, to remove the pouch member and weights carried therein when the diver is finished with his or her underwater travels. It is repeatedly emphasized in appellants' specification that the weight member or members must be positioned on the cylinder exactly opposite the diver so that the diver is unable to gain access to the one or more weight members and remove or release them during his or her underwater travels. See particularly page 64, lines 6-21, for an indication of the critical nature of the positioning of the weight members so that they cannot be dropped in an emergency situation. Independent claims 1 and 21 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellants' brief (Paper No. 15).

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

Finnern	4,455,718	Jun. 26, 1984
Eylander	5,076,575	Dec. 31, 1991

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Claims 1 through 7 and 21 through 25 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim that which appellants regard as their invention. In the examiner's view, the language in independent claims 1 and 21 regarding the attachment of the weight member "at a position on said cylinder where the person cannot remove said weight member while the cylinder is attached to the person" renders the claims indefinite because the physical abilities and limitations from one person to another may greatly vary.

In addition to the foregoing rejection, the appealed claims stand rejected under 35 U.S.C. § 103(a) as follows:

- a) claims 1 and 21 as being obvious over Finnern; and
- b) claims 2 through 6 and 22 through 24 as being obvious over Finnern in view of Eylander.<sup>1</sup>

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<sup>1</sup> The rejection of claims 1 through 7 and 21 through 25 in the final rejection based on double patenting has been withdrawn by the examiner in light of the amendments made by appellants to claims 1 and 21 in Paper No. 9 and the terminal disclaimer filed July 31, 2000 (Paper No. 12). See the advisory action mailed August 18, 2000 (Paper No. 13).

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Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 16, mailed January 17, 2001) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 15, filed November 1, 2000) and reply brief (Paper No. 18, filed April 23, 2001) for the arguments thereagainst.

#### OPINION

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

We turn first to the examiner's rejection of the claims on appeal under 35 U.S.C. § 112, second paragraph. After reviewing appellants' specification and the language focused on by the examiner in claims 1 and 21 in light thereof, and also in light of appellants' arguments in their brief and reply brief, it is

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our opinion that the scope and content of the subject matter embraced by the claims on appeal is reasonably clear and definite, and fulfills the requirements of 35 U.S.C. § 112, second paragraph. In determining whether a claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977). When that standard of evaluation is applied to the language employed in claims 1 and 21 on appeal, we are of the opinion that those claims set out and circumscribe a particular area with a reasonable degree of precision and particularity, and that one of ordinary skill in the art would clearly understand what is claimed.

More particularly, one skilled in the art would perceive that the weight member of the present invention must be positioned on the cylinder at a location directly opposite the diver and secured such that the diver cannot remove or release

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the weight member during his or her underwater travels, thereby guaranteeing that the weight member will provide reliable and consistent heads up positioning of the diver at the water's surface in the event of an emergency where the diver is incapacitated. While one might speculate, as the examiner has, that a person having a high degree of manual dexterity might be able to remove or release the weight assembly seen in Figures 28 through 31 or 37 through 39 of the present application, we nonetheless remain of the view that the claims on appeal set out and circumscribe a particular area with a reasonable degree of precision and particularity by requiring the weight member to be positioned and secured to the cylinder directly opposite the diver and so that a typical diver wearing the cylinder cannot remove or release the weight member while underwater. Accordingly, we will not sustain the examiner's rejection of appellants' claims 1 through 7 and 21 through 25 under 35 U.S.C. § 112, second paragraph.

We next look to the examiner's prior art rejections of the appealed claims, turning first to the rejection of claims 1 and 21 under § 103(a) as being unpatentable over Finnern. While this rejection is said to be under 35 U.S.C. § 103 we note that the

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examiner has not identified any difference between the claimed subject matter and the applied prior art and has made no obviousness statement with regard to any modification of the scuba tank weight strap seen in the Finnern patent. After a careful assessment of appellants' independent claims 1 and 21 and of the Finnern reference, we must agree with appellants' position as set forth in the brief (pages 7-12) and in the reply brief, that the scuba tank weight strap of Finnern is expressly positioned and secured to the cylinder or tank (12) therein so as to be easily and rapidly jettisoned by the diver in the event of an emergency situation and is thus the exact opposite of appellants' claimed subject matter. Moreover, we share appellants' view that, contrary to the assertions of the examiner, the weights (50) of Finnern are not positioned on the cylinder (12) so as to allow the weight members to rotate the diver to ensure heads up surface positioning if the diver becomes incapacitated. In that regard, we observe that appellants specifically mentioned the Finnern patent on page 7 of their specification, noting that the weights shown therein are positioned off center and would thus most likely reenforce the side righting moments acting on the diver and dispose the diver so that the diver's airways are under water. On page 7 of their

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specification, appellants again emphasize that the "critical location" for the weight member is on the exact opposite side of the tank from the diver, a relationship clearly not taught or suggested by Finnern.

In light of the foregoing, we must conclude that the examiner has failed to establish a *prima facie* case of obviousness and therefore we refuse to sustain the examiner's rejection of claims 1 and 21 under § 103(a) as being unpatentable over Finnern.

As for the examiner's rejection of claims 2 through 6 and 22 through 24 under § 103(a) as being unpatentable over Finnern in view of Eylander, we have reviewed the Eylander patent, but find nothing therein that provides for the deficiencies noted above in the basic patent to Finnern. Appellants' claimed subject matter requires that the means for attaching and the weight member be "attached at a position on said cylinder where the person cannot remove said weight member while the cylinder is attached to the person" and wherein the attachment position of the weight member on the cylinder "allows the weight member to rotate the person to ensure heads up surface positioning if the person becomes

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incapacitated." Neither Finnern nor Eylander teach or suggest these aspects of appellants' claimed subject matter.

Accordingly, we will not sustain the examiner's rejection of dependent claims 2 through 6 and 22 through 24 under 35 U.S.C. § 103(a).

To summarize our decision, we note that 1) the examiner's rejection of claims 1 through 7 and 21 through 25 under 35 U.S.C. § 112, second paragraph, has not been sustained, 2) the examiner's rejection of claims 1 and 21 under § 103(a) as being obvious over Finnern has not been sustained, and 3) the examiner's rejection of claims 2 through 6 and 22 through 24 under 35 U.S.C. § 103(a) based on Finnern and Eylander has not been sustained.

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As should be apparent from the foregoing, the decision of the examiner rejecting claims 1 through 7 and 21 through 25 of the present application is reversed.

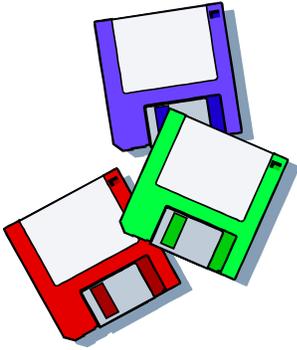
REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

CEF/LBG

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DECISION: REVERSED

Prepared: August 1, 2003

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PALM / ACTS 2 / BOOK

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