

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ERIC D. WEBER

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Appeal No. 2003-0384  
Application 09/557,718

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ON BRIEF

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Before COHEN, ABRAMS, and MCQUADE, Administrative Patent Judges.  
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Eric D. Weber appeals from the final rejection (Paper No. 13) of claims 7 through 11, all of the claims pending in the application.

THE INVENTION

The invention relates to "an apparatus for viewing fish during fishing" (specification, page 1). Representative claim 7 reads as follows:

7. A submersible camera for fishing comprising:  
an elongated fluid-tight housing having a housing body, a tapered front end and a transparent back end at opposite ends thereof; and  
a video tube received in the housing, the video tube having a lens assembly positioned adjacent the back end of the housing

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to receive light passing therethrough, wherein, when the camera is submerged in a stream of water, the housing body and front end coact to position the camera in the stream of water with the front end oriented upstream and with the back end oriented downstream.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

|                             |              |               |
|-----------------------------|--------------|---------------|
| Carrington                  | Des. 275,571 | Sep. 18, 1984 |
| Chapin, Jr. et al. (Chapin) | 4,485,398    | Nov. 27, 1984 |
| Rink                        | 5,778,259    | Jul. 7, 1998  |

THE REJECTIONS

Claims 7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chapin.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chapin in view of Carrington.

Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chapin in view of Rink.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 18 and 20) and to the examiner's answer (Paper No. 19) for the respective positions of the appellant and the examiner regarding the merits of these rejections.

DISCUSSION

Chapin, the examiner's primary reference, discloses an underwater camera 10 comprising a fluid-tight, elongated,

cylindrical housing composed of a lens section 20, a tube section 22 and an electronics section 24, a transparent lens 28 covering one end of the housing, a cover plate 42 having a tapered configuration (see Figure 3) covering the other end of the housing, a three-tube color camera disposed within the housing with its lens 58 positioned adjacent the transparent lens 28, a support cable 15 attached to the housing at an anchor flange 38, a triaxial cable 16 attached to the housing at a cable connector 44 in the cover plate 42, and a viewfinder housing 18.

As framed and argued by the appellant, the dispositive issue with respect to the rejection of independent claim 7 is whether Chapin teaches or would have suggested a camera meeting the limitations in the claim requiring the camera housing to have a tapered front end and a transparent back end wherein the housing body and front end coact to position the camera in a stream of water with the front end oriented upstream and the back end oriented downstream.

The depiction of Chapin's camera 10 in Figures 1 through 3 provides a reasonable basis for viewing the camera as having a tapered front end defined by the tapered cover plate 42 and a transparent back end defined by the transparent lens 28. The elongated cylindrical shape of the housing provides a reasonable

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basis for concluding that the housing body and tapered front end would coact to position the camera in a stream of water with the front end oriented upstream and the back end oriented downstream to the extent broadly recited in claim 1. The so-called technical arguments advanced in the briefs to refute this conclusion suffer from a number of fundamental flaws. To begin with, such attorney arguments do not constitute competent evidence of the proposition for which they are offered. See In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). In addition, the proposition itself, that Chapin's housing is such that it would position the camera in a stream of water with the front end oriented downstream and the back end oriented upstream rather than vice versa as claimed, rests on conjecture that fails to take into account a number of relevant factors such as speed of the stream of water, weight distribution of the camera, stiffness of the triaxial cable, etc. Moreover, the claim limitation itself, requiring that the housing body and tapered front end coact to position the camera in a stream of water with the front end oriented upstream and the back end oriented downstream, is quite broad in that it does not require such positioning under all circumstances. In this vein, even if the technical arguments advanced in the briefs are taken at face

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value, Chapin's housing body and tapered front end would coact to position the camera in a stream of water with the front end oriented upstream and the back end oriented downstream if the housing were initially so oriented and not subjected to yawing forces. This is all that is required to meet the broad claim limitations at issue.

Hence, the appellant's position that the subject matter recited in claim 7 is unobvious over Chapin is not persuasive. We shall therefore sustain the standing 35 U.S.C. § 103(a) rejection of claim 7, and dependent claim 9 which is grouped by the appellant as standing or falling therewith (see page 4 in the main brief), as being unpatentable over Chapin.

We shall not sustain, however, the standing 35 U.S.C. § 103(a) rejection of claim 8 as being unpatentable over Chapin in view of Carrington or the standing 35 U.S.C. § 103(a) rejection of claims 10 and 11 as being unpatentable over Chapin in view of Rink.

Claim 8 depends from claim 7 and further defines the housing as being torpedo shaped. Conceding that Chapin's housing is not so shaped, the examiner turns to Carrington for its disclosure of a submersible camera having a housing which is arguably torpedo shaped and concludes that it would have been obvious to impart

such a shape to the housing of Chapin as "[d]oing so would allow the camera system to easily move under the water at a high pressure" (answer, page 5). As pointed out by the appellant, however, Carrington's lens is positioned adjacent the front, rather than the back, of the housing so as to be oriented upstream relative to a stream of water. Given this difference with Chapin's camera, the only suggestion for selectively combining the two references so as to arrive at the subject matter recited in claim 8 stems from hindsight knowledge impermissibly derived from the appellant's disclosure.

Claim 10 depends from claim 7 and recites a fin attached to the housing adjacent the back end thereof, with the fin having a longitudinal axis which extends parallel to a longitudinal axis of the housing. Because Chapin's housing has no such fin, the examiner relies on Rink's disclosure of an underwater camera having a housing 10 with a longitudinally extending fin 50 at its back end and submits that it would have been obvious to attach Rink's fin to the anchor flange 38 of Chapin's housing since "[d]oing so would allow the camera system to maintain the camera position so that the camera easily captures an image of a particular object" (answer, page 4). As is the case with Carrington's camera, however, Rink's lens is positioned adjacent

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the front, rather than the back, of the housing so as to be oriented upstream relative to a stream of water. Here again, the only suggestion for selectively combining Chapin and Rink so as to arrive at the subject matter recited in claim 10, and dependent claim 11, stems from hindsight knowledge impermissibly derived from the appellant's disclosure.

SUMMARY

The decision of the examiner to reject claims 7 through 11 is affirmed with respect to claims 7 and 9, and reversed with respect to claims 8, 10 and 11.

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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

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| IRWIN CHARLES COHEN         | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) | BOARD OF PATENT |
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|                             | ) | APPEALS AND     |
| NEAL E. ABRAMS              | ) |                 |
| Administrative Patent Judge | ) | INTERFERENCES   |
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| JOHN P. MCQUADE             | ) |                 |
| Administrative Patent Judge | ) |                 |

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