

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GLEN DAVIS

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Appeal No. 2004-0184  
Application No. 09/837,824

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ON BRIEF

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

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Glen Davis appeals from the final rejection of claims 1 through 3 and 5 through 10, all of the claims pending in the application.

THE INVENTION

The invention relates to "water skipping and hydroplaning devices" (specification, page 1). Representative claim 1 reads as follows:

1. A water skipping article, comprising:  
a three-dimensional body having a substantially smooth edged and elliptical outer perimeter, said body further including a side profile defined by upper and lower elliptically extending faces which converge into said outer perimeter, and

Appeal No. 2004-0184  
Application No. 09/837,824

said body exhibiting a smooth and continuous exterior surface and further defining a hollowed and interior cavity suspended within said body, said body further including substantially elliptical and interiorly extending surfaces defining said interior cavity;

wherein, upon a user launching said article in a substantially horizontal trajectory and with a specified rotational spin, said interior cavity causing centrifugal forces to be applied to said outer perimeter of said article and said elliptically extending faces increasing individual incidences of said article contacting a water surface.

#### THE PRIOR ART

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

Hand	3,544,113	Dec. 1, 1970
Glovak et al. (Glovak)	4,151,997	May 1, 1979

#### THE REJECTIONS

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Hand.

Claims 3, 5 through 8 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hand.

Claims 2 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hand in view of Glovak.

Attention is directed to the main and reply briefs (Paper Nos. 7 and 10) and the answer (Paper No. 8) for the respective positions of the appellant and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claim 1

Hand discloses a variety of discs designed to be thrown and skipped across a liquid surface. For purposes of this appeal, the examiner focuses on the disc or disc assembly member illustrated in Figure 5. As described by Hand:

Referring to FIG. 5, we have disc assembly member 40 which has a body assembly made up of upper body member 41 and lower body member 42. Body member 41 and body member 42 are joined at contact area 44 and they form a rounded outer edge section 45. The body member 41 has a sealing surface 47, an outer convex surface 48 and an inner concave surface 49. The body member 42 has a sealing surface 52 which acts with sealing surface 47 of body member 41 to form the contact area 44. Body member 42 has an outer convex surface 54 and an inner concave surface 55. The body members 41 and 42 form an air pocket 57 defined by inner concave surfaces 49 and 55, respectively, and sealing edges 52 and 47, respectively, forming contact area 44. In a preferred embodiment, the air pocket 57 would be airtight. The size of the air pocket in proportion to the weight of the body members 41 and 42 determines if the disc assembly member 40 would float or sink. Generally, this type of structure includes a structural means to cause the body member to sink when stopped in water and therefore would be used to provide a floating disc assembly member but a controlled sink disc assembly member could also be provided using the principles illustrated and discussed above [column 2, line 74, through column 3, line 20].

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency,

Appeal No. 2004-0184  
Application No. 09/837,824

each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

In determining that the subject matter recited in claim 1 is anticipated by Hand (see page 3 in the answer), the examiner finds that the limitation in the claim requiring the body to have "a side profile defined by upper and lower elliptically extending faces" is met by Hand's depiction in Figure 5 of a body side profile defined by outer convex surfaces 48 and 54.<sup>1</sup> As persuasively argued by the appellant, however, Hand does not provide the evidentiary basis necessary to support this finding. The fact that Hand's surfaces 48 and 54 are broadly described and shown as being "convex" does not necessarily mean that they are "elliptically extending" as set forth in claim 1, even when this claim language is considered in light of the dictionary definitions of the terms "ellipse" and "elliptical" advanced by the examiner (see page 3 in the answer). Although the term "convex" encompasses elliptically extending surfaces, it also

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<sup>1</sup> In making this finding, the examiner mistakenly refers to reference numerals 41 and 42 which actually denote the body members having the surfaces 48 and 54.

Appeal No. 2004-0184  
Application No. 09/837,824

embraces any number of other regular (e.g., circular) and irregular surfaces which are not elliptically extending. Under these circumstances, the broad disclosure by Hand that surfaces 48 and 54 are convex is not sufficient to meet the limitation in claim 1 calling for the faces to be "elliptically extending."

Claim 1 also requires the body to have a "substantially . . . elliptical" outer perimeter into which the upper and lower elliptically extending faces converge. As clearly shown in exemplary Figure 1, Hand's disc assembly members, including the one shown in Figure 5, have outer perimeters which are circular, rather than substantially elliptical.

Hence, Hand does not disclose, expressly or under principles of inherency, each and every element of the water skipping article set forth in claim 1. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Hand.

II. The 35 U.S.C. § 103(a) rejections of claims 2, 3 and 5 through 10

Claims 2, 3 and 5 through 8 depend from claim 1 and thus include the parent claim's limitations relating to the elliptically extending faces and substantially elliptical outer perimeter. Independent claims 9 and 10 contain similar

Appeal No. 2004-0184  
Application No. 09/837,824

limitations. The examiner's conclusion that the subject matter set forth in these claims would have been obvious at the time the invention was made to a person having ordinary skill in the art rests in large part on an implicit finding that Hand meets these limitations. For the reasons explained above, this finding is unsound. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 3, 5 through 8 and 10 as being unpatentable over Hand, or the standing 35 U.S.C. § 103(a) rejection of claims 2 and 9 as being unpatentable over Hand in view of Glovak.

#### IV. New grounds of rejection

The following new grounds of rejection are entered pursuant to 37 CFR § 1.196(b).

Claims 1 through 3 and 5 through 10 are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with the written description requirement of this section of the statute.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of

Appeal No. 2004-0184  
Application No. 09/837,824

literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id.

In the present case, the disclosure of the application as originally filed would not reasonably convey to the artisan that the appellant had possession at that time of a water skipping article comprising a body having a substantially elliptical outer perimeter as is now recited in claims 1, 9 and 10, the three independent claims on appeal. As originally disclosed (see, for example, pages 4, 6 and 7 in the specification and Figure 4 in the drawings), the water skipping article instead comprises a body having a "circular" or "substantially circular" outer perimeter 12.

Claims 2, 5, 6 and 8 through 10 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d

1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims 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. Id.

To begin with, claim 2 recites a body constructed from a material "selected from the group including of an environmentally inert and biodegradable material." Similarly, claim 9 recites a body constructed of a material "selected from the group including biodegradable materials and environmentally inert materials." The underlying specification (see pages 4 and 6) indicates that the body is constructed of an environmentally inert material, a biodegradable material or other unspecified types of material. Against this background, the scope of the open-ended material groups set forth in claims 2 and 9 is unclear.<sup>2</sup> Furthermore, the recitation in claim 2 of a material which is both environmentally

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<sup>2</sup> To the extent that the appellant may have intended to define these groups in so-called Markush format, attention is directed to MPEP § 2173.05(h).

Appeal No. 2004-0184  
Application No. 09/837,824

inert and biodegradable is self-contradictory and inconsistent with the underlying specification.

In claims 5, 6 and 8, the term "said elliptical interior cavity" lacks a proper antecedent basis. This terminology also is inconsonant with the recitation in parent claim 1 that the interior cavity is defined by surfaces which are merely "substantially elliptical."

In the same vein, the recitation in claim 10 that the body includes a "second ellipse" is inconsonant with the subsequent recitation in the claim that this "ellipse" is created by surfaces which are merely "substantially elliptical."

#### SUMMARY

The decision of the examiner to reject claims 1 through 3 and 5 through 10 is reversed; and new rejections of these claims are entered pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

Appeal No. 2004-0184  
Application No. 09/837,824

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 grounds of rejection to avoid termination of proceedings (§ 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. . . .

Appeal No. 2004-0184  
Application No. 09/837,824

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

REVERSED; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	APPEALS AND
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	INTERFERENCES
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JOHN P. MCQUADE	)	
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Appeal No. 2004-0184  
Application No. 09/837,824

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