

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte DENNIS RONCA and DAVID ALTOPIEDI

---

Appeal No. 99-0073  
Application No. 08/562,166<sup>1</sup>

---

ON BRIEF

---

Before FRANKFORT, McQUADE 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 18 through 20. Claims 10, 11, 14, 16, 21

---

<sup>1</sup> Application for patent filed November 22, 1995. According to the appellants, the application is a divisional of Application 08/206,638, filed March 7, 1994, now U.S. Pat. No. 5,514,056.

Appeal No. 99-0073  
Application No. 08/562,166

and 22, the only other claims pending in this application,  
have been indicated by the examiner to be allowable (Paper No.  
6).

We reverse and remand.

BACKGROUND

The appellants' invention relates to a method of attaching a weighted element to the shin region of the leg so as to increase the mass of the leg and assist in the development of the muscle groups that act to move the weighted leg in a manner without restricting the movement of any joint or muscle group. An understanding of the invention can be derived from a reading of exemplary claim 18, which reads as follows:

18. A method of attaching a weighted element to the shin region of the leg, comprising the steps of:

providing a single weighted element;

positioning said weighted element on the shin region in a predetermined area where the tibia is most discernable, wherein said weighted element is sized to substantially fit within the predetermined area on the shin region;

biasing said weighted element against the tibia in the predetermined area of the shin region with an elastic element, wherein said weighted element is retained in abutment with the predetermined area of the shin region.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Alston

4,905,991

Mar. 6, 1990

The following rejection is before us for review.

Claims 18 through 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Alston.

The complete text of the examiner's rejections and response to the argument presented by the appellants appears in the final rejection (Paper No. 6, mailed August 12, 1996) and in the answer (Paper No. 9, mailed December 11, 1996), while the complete statement of the appellants' argument can be found in the brief (Paper No. 8, filed November 13, 1996).

#### OPINION

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

Alston, the reference relied upon by the examiner, discloses swim weights comprising a sleeve (1 or 6) made of pliable water adaptable material such as a closed cell neoprene rubber incorporating a stretchy nylon fabric (column 3, lines 8 through 10 and 47 through 49) with one or more

units of weight (3 or 7) contained in thin pouches sewn or glued onto the sleeve (column 3, lines 17 through 25). When more than one unit of weight is used, the units are spaced for weight distribution (column 3, lines 31 through 34). Alston does not disclose details of the spacing, dimensions or particular distribution of the weight units. The swim weights may be worn about the forearms or calves of a swimmer (abstract). Alston illustrates two embodiments of swim weight sleeves worn about the forearm (Figures 1, 2 and 2a). A third embodiment of swim weight wherein the weight is provided by absorption of water through a porous outer covering (12) into an absorbent material (11) is shown in Figure 3 (column 3, line 66 through column 4, line 29). A swimmer wearing swim weights or "stroke weight sleeves 15" on the forearms and swim weights or "kick weight sleeves 16" on the lower legs is illustrated in Figure 4. As noted by the examiner (final rejection, page 2), Figure 4 does not illustrate where the weights are positioned when the device is placed on the lower leg.

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

inherency, 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 other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Turning first to the claim, we note that the step "providing a single weighted element" in claim 18 does not preclude the provision of more than one weighted element. However, claim 18 does require, *inter alia*, a step of positioning a single weighted element "on the shin region in a predetermined area where the tibia is most discernable, wherein said weighted element is sized to substantially fit

within the predetermined area on the shin region." Stated differently, the claimed method requires a step of providing a single weighted element which is sized to substantially fit within a predetermined area on the shin region where the tibia is most discernable and a step of placing that weighted element in that predetermined area.

We have carefully reviewed the disclosure of Alston and we cannot find therein any express disclosure of either providing a single weighted element sized to substantially fit within a predetermined area where the tibia is most discernable or placing that weighted element in the predetermined area. It does not appear to be in dispute that Alston does not expressly disclose where the at least one weight unit is to be positioned on the lower leg.

The examiner's position is that Alston illustrates (Figure 2) placement of one of the weight units (7) against the arm in a predetermined region where the ulna is most discernable and that placement of the device on the leg in a similar manner to placement of the device on the arm would result in positioning of the weight unit in a predetermined

area where the tibia is most discernable (final rejection, page 2, and answer, page 4).

The appellants challenge the examiner's contention that Alston discloses the method step of positioning a weight on the shank of a limb against the predominant bone at a position where the predominant bone is most discernable. Rather, according to the appellants, "[t]he only method implied by the Alston patent is the method of attaching two weights arbitrarily on either side of a limb" (brief, page 4).

We agree with the appellants. Initially, it is not apparent to us that Figure 2 shows an arrangement wherein either of the weight units (7) is positioned on the forearm in a predetermined area where the ulna is most discernable, as suggested by the examiner.<sup>2</sup> Even accepting the examiner's position that Figure 2 shows an arrangement wherein one of the

---

<sup>2</sup> In fact, we are not convinced that there is a particular area on the forearm where either the radius or the ulna is most discernable. In this regard, the forearm is not like the lower leg, which does have a clearly identifiable region, the shin, where the tibia is most discernable. Moreover, as the ulna is the bone on the little-finger side of the forearm and as neither of the weights (7) is shown in Figure 7 as being positioned on the little-finger side of the forearm, it is not clear which weight (7) the examiner regards as being positioned in an area where the ulna is most discernable.

weights is positioned on the forearm in a predetermined area where either the ulna or the radius is most discernable, this disclosure by itself is not sufficient to show that placement of the device on the lower leg will necessarily result in positioning of one of the weight units in a predetermined area where the tibia is most discernable. While we find that a weighted sleeve of the type shown in Figure 1 or 2 of Alston may be positioned on the lower leg in such a manner that one of the weight units thereon is placed against the area of the leg where the tibia is most discernable, we find nothing in the disclosure of the spacing, dimensions or distribution of the weight units to show that such an arrangement will necessarily result from placement of a weighted sleeve as disclosed on the lower leg.

Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so

recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems all to be well settled that the disclosure should be regarded as sufficient.

For the reasons discussed above, it is our opinion that Alston does not disclose, either expressly or under the principles of inherency, a step of positioning a single weighted element "on the shin region in a predetermined area where the tibia is most discernable, wherein said weighted element is sized to substantially fit within the predetermined area on the shin region" as required by claim 18. Accordingly, we are constrained to reverse the rejection of



JOHN P. McQUADE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

)  
)  
) BOARD OF PATENT  
) APPEALS  
) AND  
) INTERFERENCES  
)  
)  
)  
)  
)

BJ/pgg

Eric A Lamorte  
985 Reading Avenue  
Yardley PA, 19067