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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/242,489	09/23/2011	James Montgomery	JMG-0001	3125
23599	7590	11/15/2016	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			VENNE, DANIEL V	
			ART UNIT	PAPER NUMBER
			3617	
			NOTIFICATION DATE	DELIVERY MODE
			11/15/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES MONTGOMERY

Appeal 2014-008332
Application 13/242,489
Technology Center 3600

Before JENNIFER D. BAHR, EDWARD A. BROWN, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

James Montgomery (Appellant) appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1, 2, 5–12, 14, 16, and 18–26. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A suction stabilized float suitable for supporting objects on water comprising:

at least one flotation device comprising a buoyant material of a size sufficient to float at least a ten pounds [sic] above a waterline wherein said flotation device is unitary with or secured to a chamber wherein the chamber has a first portion that is gas and liquid tight and a second portion adapted to be open into water below a waterline, said first and second portions being unitary or integral and wherein said chamber is adapted to be at least partially filled with a volume of water thereby creating suction in the chamber which is sufficient to raise the water within the chamber above the waterline, and wherein the water within the chamber remains in connection with the water at the waterline, and

wherein the suction stabilized float has only one chamber.

REJECTIONS

- I. Claims 1, 2, 5–12, 14, 16, and 18–26 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
- II. Claims 1, 2, 5–12, 14, 16, and 18–26 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.¹
- III. Claims 1, 2, 5–12, 14, 16, and 18–26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cho (US 2006/0225634 A1, pub. Oct. 12, 2006).

¹ The Examiner includes only claims 7 and 23 in the statement of the rejection (Final Act. 4), but discusses claims 1, 2, 5–12, 14, 16, and 18–26 in the detailed explanation of the rejection (*id.* at 5).

DISCUSSION

Rejection I—Written Description

The Examiner finds that the present application fails to provide written description support for the limitation in claims 1 and 2 that “the suction stabilized float has only one chamber [or inner chamber]” because Appellant’s “disclosure as originally filed does not explicitly limit the device to only one chamber or only one inner chamber as now added to the claims by [Appellant].” Final Act. 3. Similarly, the Examiner finds that “the claimed limitation ‘wherein said float has only one flotation device’” in claim 24 lacks written description support because “the original disclosure did not explicitly limit the float to only one flotation device.” *Id.* According to the Examiner, “[t]he original disclosure specifies at least one flotation device unitary with or secured to a chamber which is not the same as only one chamber or only one inner chamber or only one flotation device.” *Id.* at 3–4.

Appellant points to the drawings (Figures 1–8) as showing “a device having only one chamber/inner chamber.” Appeal Br. 5. Appellant also contends that the Examiner’s insistence “that the disclosure of the current application must, ‘explicitly limit the device to only one chamber’” is improper because “the law contains no requirement that the disclosure be explicitly limited to the embodiment in the claims.” Reply Br. 1. We agree with Appellant.

The purpose of the written description requirement in 35 U.S.C. § 112, first paragraph, is to “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)

(quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1355, 1563 (Fed. Cir. 1991)). “[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad*, 598 F.3d at 1351 (citing *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989)). This test “requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Id.*

“Compliance with the written description requirement is essentially a fact-based inquiry that will ‘necessarily vary depending on the nature of the invention claimed.’” *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002) (quoting *Vas-Cath* at 1563). The “written description requirement is satisfied by the patentee’s disclosure of ‘such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.’” *Id.* at 969 (quoting *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)). “The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described.” *Id.* at 968 (citation omitted).

Merely by way of example, the embodiment of Appellant’s invention illustrated in Figure 8 has only one chamber (inner chamber 19c), and only one flotation device (dock 1c). *See* Spec. 5, l. 25–6, l. 10 (describing the embodiment of Fig. 8); Fig. 8. This disclosure is sufficient to convey to persons skilled in the art that, at the time the present application was filed, Appellant had possession of a float having only one chamber/inner chamber and only one flotation device. The fact that Appellant’s Specification does not explicitly exclude other embodiments having more than one

chamber/inner chamber or more than one flotation device does not negate the disclosure of at least one embodiment satisfying the claim limitations. Likewise, the fact that the Specification discloses that multiple docks as illustrated in Figure 8 and described in the accompanying disclosure bridging pages 5 and 6 of the Specification may be joined together to form a larger dock structure, as illustrated in Figure 7, does not nullify the disclosure of a float having only one dock and only one chamber/inner chamber.

For the above reasons, we do not sustain the rejection of claims 1, 2, 5–12, 14, 16, and 18–26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Examiner also objects to the Specification as failing to provide proper antecedent basis for the claimed subject matter—namely, the limitation “wherein the suction stabilized float has only one chamber.” Final Act. 2. Appellant expresses amenability “to adding the above language to the disclosure once the rejections under 35 [U.S.C.] § 112 have been resolved,” but “request[s] that the objection to the specification be overruled.” Appeal Br. 3–4. To the extent that this objection turns on the same issues as the written description rejection of the claims, our decision with respect to the written description rejection likewise is dispositive as to the corresponding objection.

Rejection II—Indefiniteness

The Examiner rejects independent claims 1 and 2, as well as the claims depending therefrom, as indefinite because, according to the Examiner, the limitation “wherein the suction stabilized float has only one chamber [or inner chamber]” following the open-ended “comprising”

language in these claims renders the scope of these claims unclear. Final Act. 5. Similarly, the Examiner determines that the recitation in claim 23 that “the float consists essentially of: said at least one flotation device and said chamber” and the recitation in claim 24 that “said float has only one flotation device” following the open-ended “comprising” language and “‘at least one flotation device’ and ‘a chamber’” language in claim 1, from which claims 23 and 24 depend, render these claims indefinite. *Id.* According to the Examiner, “[i]t is not clear if the added limitations to claims 1 and 2 and 23 and 24 negate that which is first recited as included under ‘comprising’ in independent claims 1 and 2.” *Id.*

Along similar lines, the Examiner determines that the recitation “wherein the float consists essentially of: said at least one flotation device and said inner chamber” in claim 7 following the open-ended “comprising” language of claim 2, from which claim 7 depends, is improper. *Id.* at 4. According to the Examiner, “[s]imilar applies to claim 23 which recites the limitation ‘the float consists essentially of: said at least one flotation device and said chamber’ since the limitation ‘comprising’ is first recited in the independent claim.” *Id.* The Examiner states that “[i]t is not clear if claims 7 and 23 negate that which is first recited as included under ‘comprising’ in independent claims 1 and 2.” *Id.*

For the reasons set forth by Appellant on pages 6–9 of the Appeal Brief and pages 2–3 of the Reply Brief, the Examiner fails to establish that claims 1, 2, 5–12, 14, 16, and 18–26 are indefinite.

The use of the open-ended term “comprising” in the preambles of claims 1 and 2 provides that these claims may include elements in addition to the elements explicitly recited after the term “comprising.” Similarly, the

use of the term “comprising” following the recitation of “at least one flotation device” connotes that the at least one flotation device may comprise elements in addition to the elements explicitly recited in that paragraph. The recitation of “at least one flotation device” connotes that a float covered by claim 1 or claim 2 must have one flotation device, but may include more than one flotation device. The further limitation in claims 1 and 2 “wherein the suction stabilized float has only one chamber [or inner chamber]” is in no way inconsistent with the aforementioned open-ended language in these claims. Rather, this further limitation restricts claims 1 and 2 to floats having only one chamber/inner chamber; a float covered by claim 1 or claim 2 may still include other elements, but must include only one chamber/inner chamber.

The further limitation in claim 7, which depends from claim 2, restricts the scope of the claim to a float consisting essentially of the at least one flotation device and inner chamber recited in claim 2. In other words, claim 7 is narrower than claim 2 and, in this respect, is a proper dependent claim. Likewise, the “consists essentially of” limitation of claim 23, which depends from claim 1, restricts the scope of the claim to a float consisting essentially of the at least one flotation device and chamber recited in claim 1. As such, claim 23 is narrower than claim 1 and, in this respect, is a proper dependent claim.

For the above reasons, we do not sustain the Examiner’s rejections of claims 1, 2, 5–12, 14, 16, and 18–26 under 35 U.S.C. § 112, second paragraph, as indefinite.

Rejection III—Obviousness

Appellant argues for patentability of claims 1, 2, 5–12, 14, 16, and 18–26 subject to this ground of rejection as a group. Appeal Br. 9–11. We select claim 1 as representative of this group, and claims 2, 5–12, 14, 16, and 18–26 stand or fall with claim 1.

The Examiner finds that Cho discloses a suction stabilized float substantially as called for in claim 1, but acknowledges that Cho “does not explicitly disclose only one chamber.” Final Act. 7–8.² The Examiner notes, however, that Cho “discloses that the number of compartments is not limiting; therefore, the particular number of compartments would have been a matter of preference to one of ordinary skill in the art depending on volume, sizing, weight, buoyancy, stability and other engineering design considerations.” Final Act. at 8–9; *see* Cho, para. 26 (“the depicted number of compartments is not limiting”). According to the Examiner, “having only one chamber would simplify construction to one of ordinary skill in the art.” Final Act. 9. The Examiner adds that “[t]he rejection presents known features to achieve expected results; no unknown features or unexpected results are achieved by . . . the claimed subject matter.” *Id.*

Appellant argues that Cho “teaches only embodiments with a plurality of compartments” and asserts that “[t]he proposed modification of Cho . . . to a single chambered design is in direct opposition to” Cho’s teaching “to

² The Examiner also finds that Cho does not explicitly disclose a buoyant material sufficient to float at least ten pounds above the waterline, but determines that “[t]he sufficiency for supporting any amount of weight would have been an obvious engineering design expedient . . . to suit sizing, performance and desired loads.” *Id.* at 7. Appellant does not contest this determination. *See* Appeal Br. 9–11.

provide, ‘a negative pressure source to . . . at least one of the compartments; **and** one or more arrangements by which at least one or more other of the compartments can be made to exhibit a positive buoyancy.’” Appeal Br. 9 (quoting Cho, para. 6). Appellant contends that “[a]ll embodiments of Cho . . . require . . . at least one compartment for negative pressure and at least one compartment for positive pressure.” *Id.*

Appellant adds that the modification of Cho to provide “a single chambered design would destroy the ability of the float to ‘raise the water within the chamber above the waterline,’ which is also required by the claims.” *Id.* at 9–10. According to Appellant, “[t]he positive chamber provides upward force via buoyancy which lifts the negative chamber thereby creating suction which lifts water above the outside water level.” Thus, Appellant contends that at least both a positive chamber and a negative chamber are required by Cho. *Id.* at 10.

Further, Appellant argues that modifying Cho to provide only one compartment “would not ‘simplify’ the design,” as stated by the Examiner, but, instead, would cause Cho’s float either to sink (where the only one compartment is a negative pressure compartment) or to lose its ability to stabilize (where the only one compartment is a positive pressure compartment). *Id.* Consequently, Appellant argues, “if either chamber is eliminated to form a single chambered design, the float of Cho . . . will cease to function for its intended purpose.” *Id.*

Appellant’s arguments that Cho’s float requires at least both a positively pressurized compartment and a negatively pressurized compartment in order to function for its intended purpose overlook Cho’s disclosure that other arrangements for introducing positive buoyancy, such

as foam-filled compartments, “could be used instead of, or in addition to” the positively pressurized compartments. Cho, para. 25. A foam-filled compartment, which would function much like Appellant’s buoyant material 7a, 7b, or 7c to provide positive buoyancy, does *not* constitute, comprise, or define a chamber. Thus, even assuming that the number and proportions of negatively pressurized compartments, and the magnitude of negative pressure applied thereto, are such that arrangements for introducing positive buoyancy are required to counterbalance the negative buoyancy introduced by such number of negatively pressurized compartments (*see id.*), Cho teaches that such positive buoyancy may be introduced without the need for any positively pressurized compartments. *Id.*

Appellant argues additionally that Cho provides no teaching of how to balance the positive and negative buoyancy forces with only one negative pressure compartment and one positive pressure compartment. Reply Br. 4. In particular, Appellant asserts that Cho “teaches only embodiments where the positive and negative compartments are the same shape and arranged adjacent to each other” and that “[t]wo chambers, one positive and one negative arranged adjacent to each other will immediately flip over due to unbalanced positive and negative forces.” *Id.* Thus, according to Appellant, Cho’s float requires more compartments than one negative pressure compartment and one positive pressure compartment. *Id.*

Appellant points to paragraph 30 of Cho in support of the contention that Cho’s float requires more than two compartments to prevent flipping. *Id.* at 3–4. However, we discern nothing in paragraph 30 of Cho that supports this contention. Cho’s description of distributing negatively pressurized compartments more toward one side of the matrix opposite

where loading from a crane is expected (Cho, para. 30) in no way suggests that multiple negatively pressurized compartments are required to prevent flipping. Contrary to Appellant's suggestion, Cho gives no hint that the float must comprise compartments that are of similar shape and arranged adjacent one another, rather than, for example, a single negatively pressurized compartment of either regular or irregular shape to achieve the requisite distribution of negative buoyancy on the float for the intended application of the float. In fact, Cho emphasizes that the specifically illustrated "conformations of the compartments are not limiting, but rather are merely examples." Cho, para. 26.

Appellant alleges the Examiner has engaged in improper hindsight reasoning, arguing, "it is improper to dismiss the specific requirements of the claims as an 'obvious matter of preference' when one skilled in the art would have no reason to construct the claimed float from the teachings of Cho . . . except in view of [Appellant's] own disclosure." Reply Br. 4–5.

We do not agree with Appellant's characterization of the Examiner's reasoning in support of the proposed modification of Cho to provide only one chamber. The Examiner's reasoning (i.e., that "the particular number of compartments would have been a matter of preference to one of ordinary skill in the art depending on volume, sizing, weight, buoyancy, stability and other engineering design considerations") is gleaned, not from Appellant's disclosure, but from the teachings of Cho (para. 26) and knowledge of those skilled in the art. Final Act. 8–9. Further, the Examiner's reasoning that having only one chamber, rather than multiple chambers, would simplify construction (*id.* at 9) has rational underpinnings, especially for applications in which complex distributions of negative buoyancy are not required.

For the above reasons, Appellant fails to apprise us of error in the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Cho. Accordingly, we sustain the rejection of claim 1 and claims 2, 5–12, 14, 16, and 18–26, which fall with claim 1, under 35 U.S.C. § 103(a) as unpatentable over Cho.

DECISION

The Examiner's decision rejecting claims 1, 2, 5–12, 14, 16, and 18–26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, is REVERSED.

The Examiner's decision rejecting claims 1, 2, 5–12, 14, 16, and 18–26 under 35 U.S.C. § 112, second paragraph, as being indefinite, is REVERSED.

The Examiner's decision rejecting claims 1, 2, 5–12, 14, 16, and 18–26 under 35 U.S.C. § 103(a) as unpatentable over Cho is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED