

UNOBVIOUS: Substitution of Material.

Admitting that the principle of making articles that are apt to sink in water floatable is old, to do so by making the eyeglass frames and temple members of a material of sufficient strength, and of volume and specific gravity sufficiently less than 1.0, is unobvious over the prior art which teaches external attachment only of floatable materials; the propylene substance used having been known since the mid-1950's.

FINAL ACTION: Overruled.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated June 5, 1972 on application 084,892. This application was filed in the name of Mr. Carl H. Wilson and refers to "Spectacles". The Patent Appeal Board conducted a hearing on November 15, 1972, Mr. H.W. Rock and Mr. L. Selman represented the applicant.

In the prosecution terminated by the Final Action the examiner refused the claims as being obvious in view of the prior art and common general knowledge.

The prior art cited is as follows:

Canadian Patent
811,419 Apr. 29, 1969 Del Riccio

United States Patent
3,038,375 June 12, 1962 Gansz

British Patent
1,110,554 April 18, 1968

The examiner's action reads in part:

In the Office Action of October 26, 1971 it was contended that the only feature, for which the present application was directed for patent protection, was to provide eyeglasses with a frame composed of a material which would allow them to float if dropped into water. This contention was not denied or argued by the applicant and hence it is assumed the contention was correct.

The principle of concept, causing articles apt to sink to float by making them buoyant; by either (a) attachment of float means or (b) by making certain parts with a low enough specific gravity that the entire article will float, is old.

Proof that this is so is abundantly obvious in the world of commerce to-day. Examples of this related to (a) above are, floats attached to fish nets, floats attached to canoes, and the floats shown attached to the glasses in the Gansz patent. Examples of part (b) of the above principle are, canoes and the like made of foamed plastics, fishing knife handles, fishing rod handles and the substitution of materials in

binoculars, as shown in the patent to Del Riccio, which will allow binoculars to float.

Applicant has argued over the rejection by stating that (1) no prior art shows the construction of glasses that are made to float by using light plastic foams and that this substitution of material has had commercial success and; (2) that the use of the cork cladding of the Del Riccio binoculars will not allow them to float.

The applicant's response reads in part:

The major distinctions over the prior art are, of course, that applicant does not employ ancillary members or a cladding material in order to lower the specific gravity of the temple piece assemblies. Instead, applicant forms the temple pieces, and the frame, as unitary members of monolithic constructions, thus avoiding floats in their entirety. Further, and opposed to the teachings of the prior art, applicant's frame and side pieces are formed from a substantially inflexible material. In this respect, one can hardly visualize a spectacle frame made from foamed polystyrene, cork or sponge, etc. Such materials just would not have the necessary stiffness, unless, of course they were provided with metal reinforcements; but this again brings us back to the prior art method of adding something to make the spectacles buoyant.

While it is true on certain objects such as knives and fishing rods it may appear obvious to provide cork handles to make these devices floatable it is not seen that this is equivalent to the utilization by applicant of a material that has to be specially selected and formed to hold lenses and have hinge structure affixed permanently thereto as applicant has done in his invention. It is believed that if this invention as disclosed herein, specifically directed to spectacle frame and temple structure, was truly obvious both in conception and reduction to practice others would have followed applicant's superior approach before the invention thereof by him. Patents and structures such as illustrated in the Gansz patent appear to be an indication that others could not foresee how to reduce to practice applicant's invention and could not foresee all the advantages of applicant's inventive structure and this tends to demonstrate the unobviousness thereof.

This application relates to spectacles in which the frames and temple members are composed of material which will allow them to float in water. Claim 1 reads:

A pair of spectacles including lenses and frame, said frame being made of material having a specific gravity sufficiently less than about 1.0 and of a volume great enough to buoyantly support said spectacles in a body of water when said lenses have a specific gravity appreciably above 1.0.

Having studied the application the Board finds that as early as 1958 Gansz appreciated that it would be advantageous to have some means whereby eyeglasses will float if they are dropped into water. Gansz, however, discloses only externally applied floats to the temple members of the spectacles, as one would, for example, attach a float to fish net lines; the floats, however serve no other purpose. It is clear that the Gansz disclosure is silent regarding a buoyant spectacle article other than buoyancy provided by attachment of floats to the temple members. On this basis the Gansz reference fails to meet the applicant's claimed article in any specific characteristic. The Board, therefore, is satisfied that this reference tends to lead one away from what the applicant has done in making the frame and temple members of buoyant material.

The Del Riccio patent discloses external cork float attachments to field glasses to improve buoyancy properties. But, this reference, while disclosing external float attachments, does not teach field glasses manufactured from a material which in itself is inherently buoyant and capable of rendering the glasses floatable. It should also be noted that this reference discloses two relatively large, air filled eyepiece cavities, normally sealed and relied upon for floatation, and the cork cladding is an add-on float member rather than a structural member.

Regarding the position relating to the cited prior use of floatable material in "boats", "fishing floats", "fishing rod handles" and "fishing knife handles", such materials are known to have inherent buoyancy and the ability to render the complete article floatable. However, these articles may be dismissed as being analogous only in the sense of the general concept of making parts of articles, as add-on features, of sufficient volume of floatable material so that the article will float. Furthermore, the applicant is in agreement with this since in his request for review to the Commissioner under Rule 46(2) he states: "Applicant agrees that making articles that are apt to sink floatable is

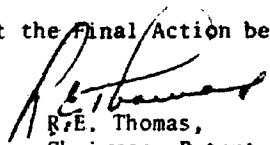
an established principle." Therefore, these citations add nothing further to the state of the prior art than that to which the applicant admits as being old.

There seems to be no doubt that the problem of persons losing their spectacles in deep water has existed for a long time without any satisfactory solution. Keeping in mind that spectacles have particular problems as to appearance and (special) material requirements as to strength to meet the problem of holding the lenses in proper position, it is obvious that the substances used in the cited art cannot be used in carrying out the objectives of the present invention as disclosed. Alternatively, as previously mentioned, the prior art has attempted to solve the problem of floatable spectacles by adding floatable devices to the temple members.

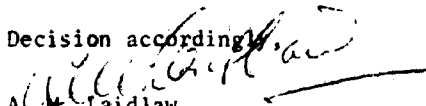
Furthermore, the substance polypropylene used by the applicant to carry out his invention, has been known since the mid 1950's. The Board, therefore, is satisfied that the prior art patents and common knowledge references do not meet the invention as set out in the present specification.

Notwithstanding, the Board has some doubt as to whether the claims are fairly based, in that they appear to go beyond the invention disclosed by failing to set out the required strength as well as buoyancy properties of materials needed to meet the normal function of spectacles as an article to be worn. The question of whether the claims satisfy Section 36(2) of the Patent Act in this respect will be the subject of further consideration and decision by the examiner.

The Board recommends that the ~~Final~~ Action be withdrawn.


R.E. Thomas,
Chairman, Patent Appeal Board.

I concur with the findings of the Patent Appeal Board and withdraw the ~~Final~~ Action and return the application to the examiner for resumption of prosecution.

Decision accordingly

A.W. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario,
this ^{24th} day of November, 1972.

Agent for Applicant
Messrs. Alex E. MacRae & Co.