

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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PAUL SMIT and ADRIANUS J.P.M. SCHUIT

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Appeal No. 2004-0942  
Application No. 08/718,573

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HEARD: July 13, 2004

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Before ABRAMS, STAAB, and NASE , Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 36-41, which are all of the claims pending in this application.

We REVERSE.

### BACKGROUND

The appellants' invention relates to a method for treating an underwater bed. An understanding of the invention can be derived from a reading of exemplary claim 36, which appears in the appendix to the Brief.

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

Cousineau	5,305,585	Apr. 26, 1994
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Claims 36-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cousineau.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 30) for the examiner's reasoning in support of the rejection, and to the Brief (Paper No. 29) and Reply Brief (Paper No. 32) for the appellants' arguments thereagainst.

### 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.

The appellants' invention is directed to a method for forming a trench in the surface of the bed of a body of water by means of a water jet suspended from a vessel floating on the water. The nozzle from which the water jet is emitted is maintained at a distance above the bed by means of cables, and the water jet strikes the bed in a concentrated manner to break the coherence of the soil that constitutes the bed in such a way as to create a trench. Specification, pages 1-3.

Independent claim 36 recites a method of forming a trench in the bed of a body of water which comprises suspending a pressure line that terminates in a nozzle from a vessel, positioning the nozzle a distance above the bed, pumping water on board the vessel and discharging the water through the nozzle downwardly against the bed at an overpressure "while maintaining said nozzle positioned at said distance above said bed." The examiner has rejected this claim as being obvious<sup>1</sup> in view of the teachings of Cousineau, in the course of which the finding is made that the reference discloses a downwardly directed nozzle 18, 18' that is located a distance "above the bed" when water is being discharged therefrom (Answer, page 3). The appellants argue that

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<sup>1</sup>The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Cousineau does not teach discharging water from the nozzle while it is spaced above the bed, much less maintaining the nozzle positioned a distance above the bed while it discharges water against the surface of the bed. In response, the examiner asserts that Cousineau states numerous times that the “discharge member” is “adjacent to” the bed which, applying the common definition of “adjacent,” constitutes a teaching that the nozzle is “above” the bed (Answer, page 5). In the course of the examiner’s presentation, reference is made to an earlier decision in this case<sup>2</sup> in which a panel of the Board of Patent Appeals and Interferences affirmed the rejection of the pending claims based upon the same reference, with the examiner drawing attention to statements made by the Board in that decision. However, it is important to note with regard to the earlier Board decision that the single independent claim now before us differs from that which was present in the previous appeal in that it contains the further limitation that the nozzle is maintained at a distance above the bed while the water is discharged toward the surface of the bed.

Cousineau discloses a system for uprooting aquatic plants. As shown in Figures 1 and 2 and explained in columns 4-6, pressurized water is pumped through a handle 12 and discharge member 14, whereupon it issues from a plurality of downwardly oriented nozzles 18 such that “the water jets churn the soil 20a of the lake bottom 20, undermining the roots by forming a pocket 36 of very loose soil and water,” the result

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<sup>2</sup>Appeal No. 1999-2034, mailed August 16, 1999.

being that the roots of the plants are freed from the soil (column 6, line 43 et seq.).

Figure 6 shows the device “in operation” (column 3, lines 47-51), and from our perspective one of ordinary skill in the art would have been taught by this showing that the nozzles are not positioned “above” the surface of the bed during operation, as is required by claim 36, but are in contact with or below the initial surface of the bed.

The foregoing interpretation is supported by several passages from the specification. In this regard, we initially point out that the examiner’s reliance upon the term “adjacent” to support the position of the nozzles in the rejection is not well taken, for Cousineau clearly states that it is discharge member 14 that is “adjacent” to the surface of the bed, and not nozzles 18, which are mounted in the underside of member 14 and extend below it. Thus, there is no teaching in Cousineau of locating the nozzles a distance above the surface of the bed while the jets of water are being discharged therefrom. Additional confirmation of the interpretation that the Cousineau nozzles are not positioned a distance above the bed during operation is provided by the explanation of the advantage of utilizing a discharge member having an elliptical cross-section rather than a circular one because it would “rest upon the soil rather than tending to burrow into it during operation, as might happen with narrow circularly cross-sectioned discharge members” (column 4, lines 45-50; emphasis added). Of course, if the discharge member rests upon the surface of the bed, the downwardly oriented nozzles clearly are not spaced a distance above the surface. Finally, we note Cousineau’s

instruction to add weight to discharge member 14 “for deeper penetration of the discharge member into the soil during operation” (column 5, lines 45-47) which, interestingly, is provided in the context of insuring that the discharge member (14) remain “adjacent” the soil during operation (column 5, lines 43-45).

We therefore find ourselves in agreement with the appellants arguments in the Briefs that the rejection is not well taken, for it is our view that the teachings of Cousineau do not establish a prima facie case of obviousness with regard to the subject matter recited in claim 36. This being the case, we will not sustain the rejection of independent claim 36 or, it follows, of claims 37-41, which depend therefrom.

CONCLUSION

The rejection is not sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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