

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRITTA DAUME

Appeal No. 2005-0289
Application No. 09/491,841

HEARD: June 7, 2005

Before RUGGIERO, LEVY, and SAADAT, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22-26, 29, 30 and 39.

BACKGROUND

Appellants' invention relates to a pipe clamp. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A device for providing electrical contact to an outer conductor of a coaxial cable, the outer conductor having bare segments, said device comprising:

a) a base structure adapted to be tensioned around a coaxial cable, said base structure provided with an interior surface and an exterior surface;

b) sealing lips operatively associated with said base structure and extending from said interior surface thereof, said sealing lips for providing a seal between said base structure and a coaxial cable when said base structure is tensioned therearound;

c) a band shaped, electrically conducting contact element attached to said base structure, said band shaped, electrically conducting contact element including at least one resilient, electrically conducting contact protrusion formed integrally therewith and biased to extend beyond said sealing lips so that when said base structure is tensioned around a coaxial cable said resilient, electrically conducting contact protrusion will rest against the bare segments of the coaxial cable and provide electrical contact therewith.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ellinwood	2,279,866	Apr. 14, 1942
Tinnerman	2,423,627	Jul. 8, 1947

Claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22-26, 29, 30 and 39 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22, 24, 25, 29 and 39 stand rejected under 102(e) as being anticipated by Ellinwood.

Claims 23 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellinwood.

Claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellinwood in view of Tinnerman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (mailed January 28, 2004) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (filed August 28, 2003) and reply brief (filed March 29, 2004) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of indefiniteness, anticipation and obviousness relied upon by the examiner as support for the

rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse. We begin with the rejection of claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22-26, 29, 30 and 39 under 35 U.S.C. § 112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). The examiner's position (answer, page 3) is that the band shaped coupling element is not attached to the base, but rather is part of the base. Specifically, the examiner relies upon the language of pages 17 and 18 of the specification that the base 4 comprises the band shaped contact element 10 and the elastic part 22. The examiner concludes, (id.) that the band is part of the base, not attached to it.

Appellant asserts (brief, pages 11 and 12) that in the elected embodiment of figures 5 and 6, "the contact element is imbedded into the base structure for purposes of attachment."

The examiner responds (answer, page 4) that appellant refers to the figures of the elected species and other embodiments, but does not address the description of the device in the specification. The examiner asks (answer, page 5) "[h]ow can a part of device also be attached to the same device."

Appellant responds (reply brief, page 2) that the examiner fails to consider the written description as a whole because as shown in figures 1 and 2 and as described on page 18 of the specification, the contact element is embedded into the base structure.

From our review of the elected species of figures 5 and 6 and the accompanying portions of the specification (which differs from the first embodiment by the substitution of a blade shaped contact protrusion) we find that base structure 4 comprises band-shaped metal contact element 10 and comprises part 22 made from an elastic material. As is clear from figure 2, contact element 10 is attached to and in some areas, embedded into, elastic part 22. With this interpretation of the specification in mind, we turn to the language of claim 1 that is argued by the examiner to

be indefinite. Claim 1 recites, inter alia, "a base structure . . . sealing lips operatively associated with said base structure . . . said sealing lips for providing a seal between said base structure and a coaxial cable . . . a band shaped, electrically conducting contact element attached to said base structure . . . said . . . contact element including at least one . . . protrusion . . . biased to extend beyond said sealing lips . . ."

We find from the language of the claim, that the claim does not recite the elastic part 22, but rather the sealing lips 30, 32, 34 and 36 of the elastic part 22. Thus, as set forth, the base as claimed is broad enough to include the portions of the elastic part 22 that are not part of the sealing lips. As a result, the claim language regarding the contact element being "attached to" the base structure is correct because the base structure, as claimed, includes the portions of the elastic part 22 that are not part of the sealing lips. The language of the specification of comprising, and the language of the claim of "attached to" are not mutually exclusive due to the breadth of the claim. This is so because of the claim language of the protrusion of the contact element extending beyond the sealing lips associated with the base structure, which includes the portions of the elastic element 22 other than the sealing lips. Accordingly, we find the

language of independent claims 1 and 13 to be definite. With respect to dependent claim 8, argued by appellant, we reverse the rejection of claim 8 based on our findings, supra, with respect to independent claims 1 and 13. The rejection of claims 1, 3, 7, 8, 13, 14, 16-18, 20, 22-26, 29, 30 and 39 under 35 U.S.C. § 112, second paragraph, is reversed.

We turn next to the rejection of claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22, 24, 25, 29 and 39 under 35 U.S.C. § 102(b) as being anticipated by Ellinwood. Appellant asserts (brief, page 14) that the sealing lips of subparagraph (b) are not found in Ellinwood. Appellant asserts (brief, page 15) that the sealing lips of the claimed invention seal against penetration of air and moisture. Appellant notes (id.) that in Ellinwood, cushion 13 prevents displacement and dampening vibration of an air or fuel conduit line. It is argued that in Ellinwood, there is no disclosure of a seal against a conduit, and that the mere fact that the edges are shown to project does not inherently suggest a seal, since the cushion does not extend around the circumference of the pipe (conduit) against which it is asserted to provide a seal. It is further argued (brief, page 16) that "[f]urthermore, the examiner has provided no reasonable basis in fact or

technical reasoning to support a conclusion sealing lips *necessarily* flow from the disclosure of Ellinwood."

The examiner's position (answer, page 3) is that in the embodiment of figures 5-8 of Ellinwood, base structure 10, 13 is adapted to be tensioned around a coaxial cable, and that the edges 13 of cushion 13 are sealing lips that project, in the area of 13 in figure 7 "for providing a seal." The examiner additionally relies upon element 10 of Ellinwood for the claimed electrically conducting contact element, which includes metallic contact protrusion 14.

A prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991). Schering Corp. v. Geneva Pharms., Inc., 339 F.3d 1373, 1377 (Fed. Cir. 2003). 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 to be well settled that the disclosure should be regarded as sufficient.

From our review of Ellinwood, we make the following findings of fact:

"[t]his invention relates to conduit supporting clips"
(col. 1, lines 1 and 2);

"the clips are especially made to provide for a cushioned supporting and an electrical grounding of metallic conduit lines, such as the air, oil, fuel and other conduit or similar lines in airplanes and the like." (col. 1, lines 6-10);

"[m]oreover, inasmuch as the lines are subjected to considerable vibration the clip must be rugged and have the cushioning medium and the grounding strip or element securely incorporated therewith or carried thereby so that the vibration will not cause the cushion and grounding element to slip or work out of place and fall in their respective functions, or cause a loose or insecure connection of the clip and line. The primary object of the present invention is to provide a line supporting clip for the purposes hereinbefore noted, which will afford a reliable and full cushioned and thoroughly electrically grounded support and connection of the line with respect to the structure on which the clip is mounted, and maintain these desirable qualities over long periods of time and regardless of vibration" (col. 1, lines 25-42);

"[y]et another purpose is to provide in a clip of the character described a novel and efficacious form of tensioned grounding strip or element which will resiliently or yieldingly engage the metallic conduit line embraced by the clip" (col. 2, lines 1-5);

"the clip comprises a bendable resilient metal strap 1 which is adapted to embrace a metallic conduit, line A" (col. 2, lines 44-48);

"[t]his cushion is made of resilient rubber or other similar resilient and compressible material and preferably is tubular and surrounds the loop portion to prevent displacement thereof from the strap as might occur if the cushion were otherwise formed or secured on the strap. The cushion may be preformed as a tube

and tightly fitted over the strap or the strap may be dipped in molten rubber or the like in such manner as to form the desired coating and cushion on the strap" (col. 3, lines 7-17);

As shown in figures 1 and 2, "[t]he reduced thickness of the grounding strip 6 permits the rubber cushion 5 to overlap the edges of the strip and therefore support substantially the entire circumference of the line A" (col. 3, lines 31-35);

"[t]hus the strip or member 6 will partly encircle the line in tensioned or yielding contact therewith when the ends 2 are secured tightly together and to the member B as shown in Fig. 1" (col. 3, lines 43-47);

"[w]hen the fastening 4 is inserted in place it will maintain the strip or tongue 6 carried by the portion 7 in the desired position overlying the cushion 5 and in contact with the conduit line embraced by the cushion and strap, so that the conduit line will be securely anchored and also electrically bonded or grounded to the metallic structure of the airplane on which the strip is mounted even if the integral joint of the strip with the strap breaks or falls in its purpose" (col. 4, lines 2-12);

"said cushion and strip will be securely held against displacement and reliably perform their respective functions regardless of vibratory and other movements of the line which would tend to dislodge such parts" (col. 4, lines 23-27),

"tongue-like strips 14 are resilient or tensioned and of considerably less width than the strap and lie in inwardly spaced relation to the inner periphery of the cushion so as to yieldingly engage or have a tensioned engagement with the line and the cushion" (col. 4, lines 38-44).

From the disclosure of Ellinwood, we note at the outset that there is no disclosure of a coaxial cable. In Ellinwood, the conduit lines contain items such as air, oil and fuel. Ellinwood also discloses "other conduits or similar lines" but does not state that these conduits contain wires. Even if the conduits did contain wires, there is no disclosure that the wires would be coaxial with the conduit. Thus, we would have to resort to speculation to find that the conduit lines are coaxial cables, much less coaxial cables with bare segments. Although claim 1 initially refers to the coaxial cable and bare segments in the preamble, the claim additionally refers to the coaxial cable and bare segments in the body of the claim, such that the preamble is given patentable weight.

In addition, we find that in Ellinwood, although there is disclosure of the supporting clips providing cushioning support, there is no disclosure that the cushioning support provides a seal. We do not agree with the examiner's assertion (answer, page 5) that "a seal is merely something that closes or fastens tightly or securely." We find that the examiner has provided only a portion of the Definition of a seal, and has taken the

definition out of context with the language of the Dictionary definition. Webster's New World Dictionary¹, Second Edition, © 1972, recites: "4. a) something that seals, closes or fastens tightly or securely; specif., a piece of metal, paper, etc., so placed over a lid, cap, etc. that it must be broken before the container can be opened b) a tight closure, as against the passage of air or water."

From our review of the Dictionary definition of a seal, we find that "fastening tightly or securely" is not enough to provide a seal, but rather that a seal requires that the tight enclosure prevents intrusion. As such, the tight cushioned support of Ellinwood is not a seal, and accordingly, the edges 13 of the tubular cushioning material are not sealing lips as recited in the claim. Moreover, we agree with appellant (brief, page 15) that in Ellinwood, the cushion does not provide a seal because it does not surround the conduit. In any event, even if, assuming arguendo, we considered the edges of cushion 13 to be sealing lips, and considered the conduit of Ellinwood to be a coaxial cable with bare elements, Ellinwood would still not anticipate independent claims 1 or 13 because the claims recite

¹ A copy of the pertinent pages of the Dictionary is attached to our Decision.

that the protrusion extends beyond the sealing lips. In Ellinwood, the cushioning element 13 could only act as a seal when compressed around the conduit line. However, as seen in figure 7, relied upon by the examiner, resilient tongue-like strips 14 do not extend beyond the cushion 13 when the conduit supporting clip is in place. Thus, for this additional reason, Ellinwood cannot be said to anticipate claims 1 and 13.

From all of the above, we find that the examiner has failed to establish a prima facie case of anticipation of independent claims 1 and 13. Accordingly, the rejection of claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22, 24, 25, 29 and 39 under 35 U.S.C. § 102(b) as being anticipated by Ellinwood is reversed.

We turn next to the rejection of claims 23 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Ellinwood. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or

to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). We reverse the rejection of claims 23 and 26 as there is no evidence of record that would have suggested to an artisan the obviousness of the limitations missing from independent claims 1

and 13 as noted, supra. Accordingly, the rejection of claims 23 and 26 under 35 U.S.C. § 103(a) is reversed.

We turn next to the rejection of claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Ellinwood in view of Tinnerman. We cannot sustain the rejection of claim 30 because the examiner has not shown that Tinnerman makes up for the basic deficiencies of Ellinwood. Accordingly, the rejection of claim 30 under 35 U.S.C. § 103(a) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22-26, 29, 20 and 39 under 35 U.S.C. § 112, second paragraph, is reversed. The decision of the examiner to reject claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22, 24, 25, 29 and 39 under 35 U.S.C. § 102(e) is reversed. The decision of the examiner to reject claims 23, 26 and 30 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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