

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2005-1835
Application No. 10/106,538

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (mailed March 19, 2004) of claims 1 to 19 and 21, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to an apparatus and method for testing load bearing capacity on a pile or group of piles, utilizing a reaction anchor apparatus and method (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The rejections under appeal are as follows:¹

1. Claims 1, 2, 4, 14, 15 and 17 under 35 U.S.C. § 102(b) as being anticipated by the Appellant's Admitted Prior Art (AAPA).²
2. Claims 3, 5 to 13, 16, 18, 19 and 21 under 35 U.S.C. § 103 as being unpatentable over AAPA in view of U.S. Patent No. 4,974,997³ to Sero et al. (Sero).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer

¹Since the rejection of claims 1-19 and 21 under the judicially created doctrine of obviousness-type double patenting set forth in the final rejection was not set forth in the examiner's answer we assume that this ground of rejection has been withdrawn by the examiner in view of the terminal disclaimer filed subsequent to the final rejection. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

²The AAPA is described on pages 3-4 and 9-12 of the specification and depicted in Figures 1 and 2 and relates to conventional testing apparatus and method for testing vertical piles, as shown in ASTM D1143-81 (reapproved 1987).

³Issued December 4, 1990.

(mailed September 10, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed August 18, 2004) and reply brief (filed October 15, 2004) for the appellant's arguments thereagainst.

OPINION

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

The anticipation rejection

We sustain the rejection of claims 1, 2, 4, 14, 15 and 17 under 35 U.S.C. § 102(b).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v.

Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 1 on appeal reads as follows:

A method of testing piles for load bearing capacity, comprising:
a. applying a static compressive force on a pile to be tested for load bearing capacity;
b. applying an opposite reaction force on an I-beam;
c. providing two reaction anchor assemblies on opposite sides of said pile;
and
d. bracing said I-beam by said two reaction anchor assemblies to hold said I-beam stationary in counter-action against said opposite reaction force on said I-beam.

Figure 1 of the AAPA depicts the conventional testing apparatus and method for testing a single pile 1 which has been driven into soil 17. A pair of anchor piles 7 are also driven into soil at a distance at least seven feet away from or clear of pile 1. A bottom flange of an I-beam 6 is set on top of a bearing plate 5 of a piston ram 4 of hydraulic cylinder 2. The hydraulic cylinder 2 is set on a test plate 3, which is centered on top of the pile 1. The I-beam 6 is tied to the anchor piles by means of a series of connecting rods 8, a pair of plates 9 are placed on a top flange of the I-beam 6, and the

connecting rods are secured by a series of threaded nuts 10, threaded down against the plates 9.

By the conventional method of the AAPA, a powerful, upwardly driven push is provided by the piston ram 4 of the hydraulic cylinder 2, as represented by an arrow 15. This upwardly driven push is exerted upon the I-beam 6, by means of the bearing plate 5 which bears on the bottom flange of the I-beam. The beam 6 is fixedly connected to the anchor piles 7 by means of the threaded nuts 10, tightened on the connecting rods 8, against the plates 9. As a result, the I-beam 6 cannot move up. The forceful push of the piston ram 4 is effectively resisted by the anchor piles 7 because of the friction between the anchor piles 7 and the soil 17. An equivalent forceful push therefore is exerted downwardly on the test plate 3 and, as a result, on the individual pile 1.

In our view, claim 1 reads on the AAPA as follows:

A method of testing piles for load bearing capacity (the AAPA provides a method of testing piles for load bearing capacity), comprising:

a. applying a static compressive force on a pile to be tested for load bearing capacity (the AAPA applies a static compressive force on the pile 1 being tested for load bearing capacity);

- b. applying an opposite reaction force on an I-beam (the AAPA applies an opposite reaction force on the I-beam 6);
- c. providing two reaction anchor assemblies on opposite sides of said pile (the AAPA provides two anchor piles 7 with connecting rods 8 on opposite sides of the pile 1); and
- d. bracing said I-beam by said two reaction anchor assemblies to hold said I-beam stationary in counter-action against said opposite reaction force on said I-beam (the AAPA braces the I-beam 6 by the two anchor piles 7 with connecting rods 8, plates 9 and nuts 10 to hold the I-beam 6 stationary in counter-action against the opposite reaction force on the I-beam 6).

The appellant argues in the brief (pp. 11-12) that the invention as claimed is not anticipated by the AAPA because of the differences between the claims and the AAPA which differences are important in using an anchoring system that requires only a small hole to be drilled for an anchor that has expanding feet to obtain proper resistance to obtain the uplift required to perform the pile test. Using the claimed apparatus and method, the appellant asserts that the cost is reduced by 50% because the main factor in pile testing is the type of anchor used. The appellant points out that the pile test system of the claimed invention uses anchors that are retractable and reusable, whereas, on the other hand, the existing pile test of the AAPA uses rock anchors that require 6 to 12 holes drilled to a depth of 50 feet to 100 feet so that concrete then can

be grouted in and that such concrete must be cured for at least three days prior to the pile test being performed. Whereas, in the present application, the new anchor that replaces the concrete grouted anchor can be used immediately, and only 1 to 2 holes need to be drilled to a maximum depth of 15 feet. The appellant further points out that the anchors of the claimed invention are retrievable and can be used over and over, whereas, on the other hand, the concrete grouted anchors of the AAPA are left in place and burned off at ground level.

The arguments set forth in the brief do not convince us that claim 1 is novel. In that regard, we note that none of the argued limitations (e.g., a small hole drilled for each anchor; each anchor having expanding feet to obtain proper resistance to obtain the uplift required to perform the pile test; anchors that are retractable and reusable) is set forth in claim 1. It is well-settled that limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The appellant argues in the reply brief (p. 2) that claim 1 is not anticipated by the AAPA because the claimed two reaction anchor assemblies are nowhere to be found in the AAPA.

This argument set forth in the reply brief does not convince us that claim 1 is novel. In that regard, as set forth above, it is our determination that the claimed two reaction anchor assemblies are readable on the AAPA's two anchor piles 7 with connecting rods 8. As such, the claimed two reaction anchor assemblies are found in the AAPA. The appellant has offered no explanation as to why the claimed two reaction anchor assemblies are not readable on the AAPA's two anchor piles 7 with connecting rods 8.

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed.

The decision of the examiner to reject claims 2, 4, 14, 15 and 17 under 35 U.S.C. § 102(b) is also affirmed since the appellant has not argued separately the patentability of any particular claim apart from the others, thus allowing claims 2, 4, 14, 15 and 17 to fall with claim 1 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

The obviousness rejection

We sustain the rejection of claims 3, 5 to 13, 16, 18, 19 and 21 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

In the obviousness rejection under appeal, the examiner ascertained⁴ (answer, p. 3) that AAPA shows all features of the claimed invention except for provision of fins and swingable anchor plates. The examiner then set forth that Sero discloses a hydraulic setting tool which includes an anchoring device with fins (elements 208, see Figure 20) and swingable plates (elements 184, see Figures 17-19 and 23). Lastly, the examiner determined that it would have been obvious to an artisan of ordinary skill at the time of invention to incorporate these arrangements of Sero into the AAPA for ease of penetrating into the ground and facilitate the motion of the pile into the soil.

⁴After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The appellant argues (brief, pp. 13-14; reply brief, p. 2) that (1) Sero is directed to foundations and nowhere teaches or suggests pile testing; and (2) there is no motivation to combine Sero with the AAPA.

We find the appellant's argument unpersuasive since in applying the above-noted test for obviousness we conclude that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the AAPA by replacing the AAPA's two anchor piles 7 with an anchor device as suggested and taught by Sero. The motivation for this modification of AAPA comes from the teachings of Sero. Sero teaches that the setting of the anchor device requires augering a hole in the media followed by lowering of the device into the hole so that the device rests at the bottom of the hole. Once the device is installed, the hydraulically actuated motive means of his invention forces plates to swing outwardly in an arc to compact and consolidate the surrounding media. Sero teaches (column 2, lines 24-29) that "[t]he preferred anchor or foundation device of this invention minimizes costs, eliminates the need of in-ground concrete, eliminates the need for costly deep drilling and media analysis, and estimates approximating the holding strength by providing an actual measurement of the structure's strength." In our view, this teaching of Sero provides ample motivation to a person having ordinary skill in the art to have modified the AAPA by replacing the AAPA's two anchor piles 7 with an anchor device as taught by Sero.

For the reasons set forth above, the decision of the examiner to reject claims 3, 5 to 13, 16, 18, 19 and 21 under 35 U.S.C. § 103 is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 4, 14, 15 and 17 under 35 U.S.C. § 102(b) is affirmed and the decision of the examiner to reject claims 3, 5 to 13, 16, 18, 19 and 21 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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