

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 PETER JAX

Appeal No. 2006-1436
Application No. 10/461,817

HEARD ON JUNE 7, 2006

Before HAIRSTON, JERRY SMITH, and SAADAT, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 3.

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and we will reverse the anticipation rejection of claims 1 through 3.

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claims invention. Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Recla discloses a sensor tube 16 with an inner perforated PVC conduit 12, a semipermeable membrane 14 wrapped around the inner conduit 12, and an outer woven mesh sheath 15. Recla states that the outer mesh sheath is used to "inhibit physical damage to the tube" (column 3, lines 33 and 34), and that the outer mesh sheath functions as "a protective woven mesh sheath whose sole purpose is to protect the thin outer membrane" (column 4, lines 5 through 7).

According to the examiner (final rejection, page 3), the outer woven mesh sheath 15 "while generally flexible, may be considered at least locally hard and pressure resistant as in the instant invention outer tube."

The appellant's response (brief, pages 9 and 10) is as follows:

Appellant disagrees with the Examiner and in addition to the declaration submitted on August 18, 2004, enclosed herewith, is a signed declaration under 37 C.F.R. § 1.132

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executed by Dr. Wolfgang Issel, which was also submitted with the response dated December 3, 2004, specifically traversing the Examiner's position that the mesh sheath (15) of Recla is substantively hard and the Examiner's position that "the outer layer, while generally flexible, may be considered at least locally hard and pressure resistant as in the instant invention outer tube" (page 3 of the Office action dated September 3, 2004).

The tube of Recla is definitely based upon Issel (U.S. Patent No. 4,735,095) ("patented design construction" column 3, line 30 of Recla).

Accordingly, Dr. Issel is a competent expert in providing conclusions about the tube. Dr. Issel clearly stated that the mesh sheath of Recla is neither pressure-resistant nor is it hard as recited in the claims of the instant application (see both declarations signed by Dr. Issel).

In conclusion, appellant argues (brief, page 10), "the declarations are of more relevance than the Examiner's conclusions and are more than sufficient to overcome the rejections over Recla."

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In response, the examiner maintains the position that the outer woven mesh sheath 15 in Recla is "hard" because it inhibits physical damage to the underground tube, and "must inherently resist pressure and penetration at least to some degree over some area" (answer, page 6).

In view of the evidence presented by appellant that the outer woven mesh sheath 15 in Recla is not "hard," and the lack of evidence in the record to support the examiner's position¹ that the "generally flexible" sheath is also "hard" because it "inhibits physical damage to the tube," we find that appellant has successfully traversed the use of Recla as an anticipating teaching of the claimed invention. Thus, the anticipation rejection of claims 1 through 3 is reversed.

¹ Nothing in the record supports the examiner's position that only a "hard" outer tube will inhibit physical damage to the tube.

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DECISION

The decision of the examiner rejecting claims 1 through 3 under 35 U.S.C. § 102(b) is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

KWH/ce

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