

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 Robert E. Smith III

Appeal No. 2006-2450
Application No. 10/211,828
Technology Center 3700

HEARD October 18, 2006

Before GROSS, LEVY, and NAPPI, **Administrative Patent Judges**.

NAPPI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 3, 5 through 7, 9 through 11, 13, 14, 16, 17, 19 through 21 and 23. Claims 4, 8, 12, 15, 18 and 22 have been canceled. For the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 3, 5 through 7, 9 through 11, 13, 14, 16, 17, 19 through 21 and 23.

THE INVENTION

The invention relates to an undersea hydraulic coupling. Claim 1 is representative of the invention and is reproduced below:

1. An undersea hydraulic coupling member, comprising:
 - (a) a female member having an internal bore with a receiving chamber having an internal shoulder, and a valve for controlling fluid flow through the bore;
 - (b) a seal retainer insertable into the receiving chamber; the seal retainer having a first inner ring and a second outer ring concentric with the first inner ring; at least part of the first inner ring fitting radially inside the second outer ring in an engaged position; the first inner ring having a first end abutting the internal shoulder in the receiving chamber; at least part of the second outer ring having an externally threaded area to engage the female member; and
 - (c) a first ring-shaped seal positioned between the first inner ring and second outer ring; and a second ring-shaped seal positioned between the first inner ring and the internal shoulder.

THE REFERENCES

The references relied upon by the examiner are:

Smith, III	4,900,071	Feb. 13, 1990
Rogers	5,544,858	Aug. 13, 1996

THE REJECTION AT ISSUE

Claims 1 through 3, 5 through 7, 9 through 11, 13, 14, 16, 17, 19 through 21 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Smith in view of Rogers. Throughout the opinion we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. 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 rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellant and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of 1 through 3, 5 through 7, 9 through 11, 13, 14, 16, 17, 19 through 21 and 23 under 35 U.S.C. § 103.

Appellant states, on page 5 of the brief, that the invention involves a "design [that] permits a greater threaded area to hold the seal retainer without an increase in overall size of the coupling member." Appellant argues:

The Rogers reference describes a connector having no threaded members within the female coupling. Seal 36 is held in adapter 33 by body 34 which fits around the outside of one end of adapter 33. There is no seal retainer "insertable into the receiving chamber" as required by claim 1 or "insertable into the internal bore" as required by claim 17. Moreover, part of the second outer ring (34) does not have "external threads engaged to the receiving chamber" as required by claim 10.

Appellant also argues that Rogers discloses only one seal and does not contain a second seal as recited in independent claim 1. On page 6 of the brief, appellant argues that "both Rogers and Smith lack the claimed 'second outer ring having an externally threaded area to engage the female member.'" Finally, on pages 6 and 7 of the brief, appellant argues that the rejection lacks motivation to combine the references as asserted by the examiner.

The examiner, in reply, states that Smith, not Rogers, was relied upon to teach the threaded members in the female coupling and the second seal. See page 4 of the answer. Further, the examiner states one of "ordinary skill in the art would recognize overlapping

of the first and second rings shoulders with a seal between as disclosed by Rogers would more accurately hold the seal of Smith in place.”

We disagree with the examiner’s reasoning. Independent claim 1 recites “a seal retainer insertable into the receiving chamber; the seal retainer having a first inner ring and a second outer ring concentric with the first inner ring; at least part of the first inner ring fitting radially inside the second outer ring in an engaged position; the first inner ring having a first end abutting the internal shoulder in the receiving chamber; at least part of the second outer ring having an externally threaded area to engage the female member.” Independent claim 10 recites “at least part of the first inner ring held radially inside the second outer ring; part of the second ring having external threads to engage the receiving chamber.” Independent claim 17 recites “a first inner ring removably inserted through at least part of a concentric second outer ring ... the second outer ring having ... and a threaded area for engaging the female member.” Thus, each of the independent claims recites two rings within the female body, where one ring is insertable and concentric to the other ring.

Smith teaches a hydraulic coupling with a female body, item 60, which contains two rings (item 30 and item 50) with two ring seals (items 40 and 61). The outer of the two rings, item 30 has threads which thread into the female member. Smith does not teach that the rings are arranged such that a first inner ring fits radially inside the second outer ring as claimed in claim 1.

Rogers teaches a fluid coupling, with a female member (item 33) with a ring (item 34) around an outer shoulder of the female member which holds the seal (item 38). We do not find that Rogers teaches two rings and a female member, rather Rogers teaches that the female member has a shoulder which fits inside and is concentric to the one ring. This arrangement of female member and ring holds the seal.

It is the burden of the examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by the implication contained in such teachings or suggestions.

In re Sernaker 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). “The motivation,

suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.” *In re Huston* 308 F.3d 1267, 1278, 64 USPQ2d 1801, 1810 (Fed. Cir. 2002, citing *In re Kotzab* 217 F.3d 1365, 1370, 55 USPQ 1313, 1317 (Fed. Cir. 2000)). The examiner has not cited explicit statements from the art to support the combination of the references. Further, considering the teachings of the two references we do not find that the knowledge of one of skilled would lead to using Rogers’ teaching of the outer ring fitting over the female member to redesign the two ring seal retainer of Smith which fits inside the female member. Nor do we find that one would consider Rogers to more accurately hold the seal, as we note that the seal (item 40) of Smith fits inside a recess of the ring (item 50), which appears to be similar to Rogers’s method of holding the seal (item 38) in the recess of the female member (item 10). Thus, we do not find that one skilled in the art would have been motivated to combine the references to produce the claimed invention. Accordingly, we will not sustain the examiner’s rejection of claims 1 through 3, 5 through 7, 9 through 11, 13, 14, 16, 17, 19 through 21 and 23 under 35 U.S.C. § 103.

Accordingly, we will not sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 103. The decision of the examiner is reversed.

REVERSED

ANITA PELLMAN GROSS)
Administrative Patent Judge)
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STUART S. LEVY) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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ROBERT E. NAPPI)
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REN/vsh

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