

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SHADDY Y. HANNA and MAMDOUH M. SALAMA

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Appeal 2007-2795  
Application 10/131,658  
Technology Center 3700

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Decided: July 21, 2008

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Before DONALD E. ADAMS, TONI R. SCHEINER, and DEMETRA J. MILLS, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing (reconsideration) of the decision entered January 17, 2008. That decision affirmed the Examiner's rejection of:

Claims 1, 2, 27-30, 42, 83, and 85 under 35 U.S.C. § 102(b) as anticipated by L'Espérance.

Claims 1, 2, 27-30, 42, 81, 82 and 85 under 35 U.S.C. § 102(b) as anticipated by McIntosh.

Claims 81 and 82 under 35 U.S.C § 103(a) as unpatentable over L'Espérance.

Claim 83 under 35 U.S.C. § 103(a) as unpatentable over McIntosh.

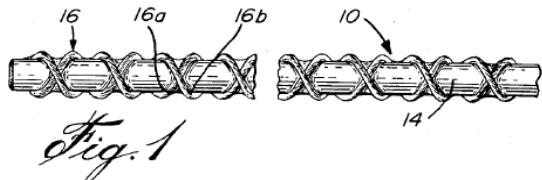
According to Appellants, because the Decision provides no citations to their Reply Brief, we must have overlooked the arguments in their Reply Brief, which Appellants believe serve to distinguish their claimed invention from the prior art (Request 1 and *passim*). In addition, Appellants assert that they grouped their claims differently in their Reply Brief than in their Appeal Brief, and we overlooked the claims they separately grouped in the Reply Brief (Request 6).

For complete clarity, we will grant Appellants' request to address these issues.

## DISCUSSION

### *Findings of Fact:*

1. L'Espérance teaches a structural rod "formed of a non-metallic non-electrically conductive cylindrical core composed of a plurality of fibers oriented in the longitudinal axis and bound to each other by a thermosetting resin" (L'Espérance, Abstract).
2. L'Espérance's figures 1 and 3 are reproduced below:



"FIG. 1 is an elevational view of a rod made in accordance with the present invention, the rod being broken to show indefinite length" (L'Espérance 3:

5-7). “FIG. 3 is a cross-sectional view of the rod” (L’Espérance, col. 3, l. 11).

3. L’Espérance teaches that the “structural rod **10** . . . compris[es] a core **14** and embossments **16** formed by helical windings on the core **14”** (L’Espérance, col. 3, l. 30).

4. L’Espérance teaches that “[t]he core **14** is cylindrical in shape and is composed of a plurality of elongated continuous fibers **18** substantially oriented in their longitudinal axis. These filaments are bound to each other by a thermosetting resin to prevent relative movements therebetween” (L’Espérance, col. 3, ll. 31-35).

5. L’Espérance teaches that “[t]he rod **10** is thus formed of only two basic materials: fibers and resin” (L’Espérance, col. 3, ll. 45-46).

6. L’Espérance teaches that “[t]he embossments **16** result from the provision of a double helix **16a** and **16b** wound on the cylindrical core **14”** (L’Espérance, col. 3, ll 38-40). In addition, “to form a unitary structure and to obtain an additional corrosion barrier to the final product” L’Espérance prefers “to envelop the core . . . and the embossments . . . formed thereon with a layer of thermosetting material” (L’Espérance, col. 4, ll. 63-67).

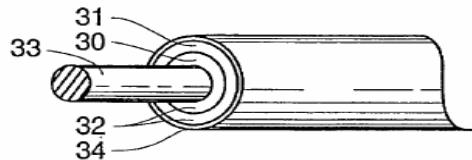
7. Appellants’ Specification discloses that a nontwisted tether “comprises one or more composite rods encased in a jacket” (Spec. 14, (emphasis added)). “[T]he rods may be placed in bundles or strands within the nontwisted tether, but the bundles or strands are not subjected to helical twisting to form twisted strands” (*id.*). “The rods may be solid or hollow. . . . Hollow rods are preferably open at either end and hollow across their entire length like a tube or pipe” (Spec. 17).

8. McIntosh teaches hollow rods are “formed with at least one inner ply of graphite fibers in a first thermoset resin matrix and at least one outer ply of nickel-coated graphite fibers in a second thermoset resin” (McIntosh, Abstract).

9. McIntosh teaches that the “nickel-coated graphite fibers impart increased impact strength to the final structure and serve to protect the inner graphite fiber layer(s)” (*id.*).

10. McIntosh’s figure 3 is reproduced below:

***FIG. 3***



“FIG. 3 illustrates the cross sectional structure of a multiply rod with an inner ply of graphite fiber and an outer ply of nickel-coated graphite fiber” (McIntosh, col. 2, ll. 31-33).

*Anticipation:*

1. Claims 1, 2, 27-30, 42, 83, and 85 stand rejected under 35 U.S.C. § 102(b) as being anticipated by L’Espérance.

Appellants separately argue claims 1, 42, and 85 in their Appeal Brief (App. Br. 7). In their Reply Brief, Appellants provide arguments for a different grouping of claims, specifically I. claims 1, 42, and 85; II. claim 2; and III. claims 27-30 and 83 (Reply Br. 6, 8, and 10). Accordingly, for complete clarity and to account for all permutations of Appellants’ claim groupings, we will limit our discussion to claims 1, 2, 27, 42, and 85.

*Claim 1:*

Claim 1 is drawn to a nontwisted composite tether (Decision 6). According to Appellants, “[c]laim [l]imitations [a]re [i]nterpreted [i]n [l]ight [o]f [t]he [s]pecification” (Request 6; Reply Br. 14). We agree. According to Appellants’ Specification, a nontwisted tether “comprises one or more composite rods encased in a jacket” (Spec. 14). “[T]he rods may be placed in bundles or strands within the nontwisted tether, but the bundles or strands are not subjected to helical twisting to form twisted strands” (*id.*)

L’Espérance teaches a nontwisted composite tether comprising a plurality of solid circular rods which are bundled into strands that are not twisted (FF 1-5). This configuration is illustrated in L’Espérance’s Fig. 3 (FF 2). Therefore, consistent with Appellants’ Specification, L’Espérance’s bundles or strands are not subjected to helical twisting to form twisted strands (*see Cf.* FF 1-5 and FF 7). The nontwisted bound rods are then empossessed with (encased in) “a double helix **16a** and **16b** wound on the cylindrical core **14**” (FF 6).

Accordingly, we disagree with Appellants’ assertion that L’Espérance teaches a twisted structure (Request 3; Reply Br. 6). The “twisted structure” to which Appellants refer is L’Espérance’s embossments **16** (FF 6), which are not excluded from the claimed nontwisted tether of claim 1 as interpreted in light of Appellants’ Specification (FF 7).

Therefore, for the reasons set forth above, and in the Decision, giving Appellants’ claim 1 its broadest reasonable interpretation in light of their Specification, L’Espérance’s tether reads directly on the tether of Appellants’ claim 1. Stated differently, “[t]he structural features of the

claimed ‘tether’, nontwisted and composite, are fully met by L’Espérance[‘s] rods” (Decision 6-7).

Accordingly, we disagree with Appellants’ assertion that “the instant Application’s claims to a ‘nontwisted’ tether must be considered at least a ‘slight’ difference from L’Esperance’s ‘twisted’ tether to defeat a finding of anticipation” (Reply Br. 8 (emphasis removed)). We also disagree with Appellants’ assertion that “had the Board not overlooked the above argument from the *Reply Brief*, the Board would not have opined, ‘[t]he structural features of the claimed ‘tether’, nontwisted and composite, are fully met by L’Esperance[‘s] rods” (Request 4 (emphasis and alteration original)).

Accordingly, we affirm the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by L’Espérance.

*Claim 2:*

Claim 2 depends from and further limits claim 1 to comprise one or more composite rods encased in a jacket. According to Appellants, L’Espérance’s embossments 16 do not “encase” the structural rod (Request 7; Reply Br. 9). In contrast, Appellants assert that according to their invention “a protective jacket . . . is extruded over the entire rod bundle . . . using a jacket machine” (*id.*)

We note, however, that claim 2 does not require a protective jacket to be extruded over the entire rod bundle. To the contrary, claim 2 simply requires that the nontwisted composite tether be encased in a jacket. While Appellants’ Specification discloses a jacket that is “extruded over the rod

bundle . . . using a jacket machine” (Spec. 20:1-2), we decline to read this limitation from Appellants’ Specification into claim 2.

Accordingly, absent evidence to the contrary, of which there is none, we agree with the Examiner that L’Experiance’s embossments encase the core and, therefore, L’Experiance’s tether falls within the scope of the tether set forth in Appellants’ claim 2 (*see Ans. 3*). Attorney argument cannot take the place of evidence lacking in the record. *Meitzner v. Mindick*, 549 F.2d 775, 782 (CCPA 1977).

In addition, L’Espérance further prefers to place a layer, or jacket, of thermosetting material over the core and embossments to provide for a unitary structure and to obtain an additional corrosion barrier (FF 6). There is no evidence on this record to suggest that a person of ordinary skill in this art would not consider this layer of thermosetting material to represent a jacket that encases the one or more composite rods.

For the foregoing reasons, we affirm the rejection of claim 2 under 35 U.S.C. § 102(b) as being anticipated by L’Espérance.

*Claim 27:*

Claim 27 depends from and further limits claim 2 to require that a portion of the rods is bundled into one or more strands. Accordingly, claim 27 is drawn to a nontwisted composite tether further comprising one or more composite rods that are bundled into one or more strands and encased in a jacket.

According to Appellants, L’Espérance does not teach that “one or more rods are bundled into one or more strands” (Reply Br. 10). We disagree (*see FF 1-5*). Appellants appear to be of the impression that their

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“rods” are the completed structural rod taught by L’Espérance (*see, e.g.*, Reply Br. 11). We are not persuaded. Interpreting the claim in light of Appellants’ Specification (*see FF 7*), Appellants’ rods in the context of claims 1, 2, and 27 are the equivalent of L’Espérance’s fibers (FF 1-5).

As discussed above, L’Espérance teaches a nontwisted composite tether comprising a plurality of solid circular rods which are bundled into strands that are not twisted (FF 1-5). L’Espérance then embosses this bundle of solid circular rods (e.g., fibers) and preferentially coats them with a layer of thermosetting material (FF 6).

Accordingly, notwithstanding Appellants’ assertions to the contrary, L’Espérance teaches a tether within the scope of Appellants’ claim 27. Therefore, we affirm the rejection of claim 27 under 35 U.S.C. § 102(b) as being anticipated by L’Espérance. Claims 28-30 and 83 fall together with claim 27.

*Claim 42:*

Appellants assert that L’Espérance teaches a twisted structure which does not anticipate the tether of claim 42 (Request 4-5). For the reasons set forth above, and in the Decision, we disagree.

Accordingly, we affirm the rejection of claim 42 under 35 U.S.C. § 102(b) as being anticipated by L’Espérance.

*Claim 85:*

Appellants assert that L’Espérance teaches a twisted structure which does not anticipate the tether of claim 85 (Request 5). For the reasons set forth above, and in the Decision, we disagree. Accordingly, we affirm the

rejection of claim 85 under 35 U.S.C. § 102(b) as being anticipated by L'Espérance.

3. Claims 1, 2, 27-30, 42, 81, 82 and 85 stand rejected under 35 U.S.C. § 102(b) as being anticipated by McIntosh.

Appellants assert that we did not consider their arguments regarding McIntosh as presented in their Reply Brief (Request 6). According to Appellants “had the Board not overlooked the Reply Brief’s arguments, the Board would not have affirmed the rejections of claims 1, 2, 27-30, 42, 81, 82, and 85 under 35 U.S.C. § 102(b) as being anticipated by McIntosh” (*id.* (emphasis removed)).

With regard to McIntosh, notwithstanding Appellants’ assertion to the contrary, the only claims separately argued in the Reply Brief are claims 27-30, 81, and 82<sup>1</sup> (Reply Br. 10; Request 6). Therefore, as Appellants have not identified a point of law or fact that we have misapprehended or overlooked regarding claims 1, 2, 42, and 85, we find that Appellants have not contested and, therefore, concede that McIntosh anticipates claims 1, 2, 42, and 85.

As Appellants argue claims 27-30, 81, and 82 together, we limit our discussion to claim 27.

*Claim 27:*

As discussed above, claim 27, which depends from claims 1 and 2, is drawn to a nontwisted composite tether further comprising one or more

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<sup>1</sup> While Appellants have included claim 83 in this grouping, claim 83 is not included in this ground of rejection.

composite rods that are bundled into one or more strands and encased in a jacket.

According to Appellants, McIntosh does not teach that “one or more rods are bundled into one or more strands” (Reply Br. 10). We disagree (*see* FF 8-10). Appellants appear to be under the impression that their “rods” are the completed hollow rod taught by McIntosh (*see, e.g.*, Reply Br. 12). We are not persuaded.

Interpreting the claim in light of Appellants’ Specification (*see* FF 7), Appellants’ rods in the context of claims 1, 2, and 27 are the equivalent of each of McIntosh’s hollow fiber plies (FF 8-10). As illustrated in McIntosh’s FIG. 3, each ply is layered onto another resulting in consecutive layers, or bundles, of ply rods that are nontwisted. Appellants provide no persuasive argument or evidence to distinguish their claim from the final rod taught by McIntosh. Accordingly, we disagree with Appellants’ assertion that bundling McIntosh’s rods, *e.g.*, ply fibers, “would ridiculously result in the production of multiple-shafted golf clubs, multiple-shafted fishing rods, and/or multiple-shafted arrows” (Reply Br. 12). To the contrary, bundling the hollow ply fibers, as taught by McIntosh, results in a multiply composite nontwisted rod or tether that is encased in a nickel-coated graphite fiber jacket (FF 8-10).

Accordingly, notwithstanding Appellants’ assertions to the contrary, McIntosh teaches a tether within the scope of Appellants’ claim 27. Therefore, we affirm the rejection of claim 27 under 35 U.S.C. § 102(b) as being anticipated by McIntosh. Claims 28-30, 81, and 82 fall together with claim 27.

*Obviousness:*

Claims 81 and 82 stand rejected under 35 U.S.C § 103(a) as unpatentable over L’Espérance.

According to Appellants, L’Espérance does not “teach, suggest or even hint at the possibility of bundling their respective products to form any structure” (Request 8). For the reasons set forth above, and in the Decision, we are not persuaded by this assertion. Appellants also assert that “L’Esperance does not teach a non-twisted structure” (Request 4, n. 2 (emphasis removed)). For the reasons set forth above, and in the Decision, we are not persuaded by this assertion. We also recognize Appellants’ assertion that L’Espérance “does not teach or suggest all the elements of claims 81 or 82” (*id.*). Appellants do not, however, identify with any particularity which elements of claims 81 or 82 are not taught by L’Espérance. Accordingly, we turn to Appellants’ Reply Brief wherein Appellants argue “had the Board not overlooked the Reply Brief’s arguments, the Board would not have affirmed the rejections of claims 81 and 82 as being unpatentable under 35 U.S.C § 103(a) over L’Espérance” (Request 8 (emphasis removed)).

Appellants assert that “if a person of ordinary skill in the art was seeking to construct a ‘nontwisted’ composite offshore platform tether, that person would not follow the path set out in L’Esperance” (Reply Br. 8 (emphasis removed)). For the reasons set forth above, and in the Decision, we are not persuaded by this assertion.

Appellants assert that “because L’Esperance does not teach or suggest a jacket that ‘encases’ the composite rods of an offshore platform tether, L’Esperance cannot serve as § 103 obviousness art for the claims of the

instant Application” (Reply Br. 10 (emphasis removed)). For the reasons set forth above, and in the Decision, we are not persuaded by this assertion.

“Ambiguity would explain the Examiner’s reliance on kayaks and plastic plates as offshore platforms in the arguments supporting his determination that L’Esperance . . . [is a] credible §§ 102 and 103 reference[ ] to support rejections of the subject claims” (Reply Br. 17 (emphasis removed)). For the reasons set forth above, and in the Decision, we are not persuaded by this assertion.

For the foregoing reasons, we affirm the rejection of claims 81 and 82 under 35 U.S.C § 103(a) as unpatentable over L’Espérance.

Claim 83 stands rejected under 35 U.S.C. § 103(a) as unpatentable over McIntosh.

According to Appellants, McIntosh does not “teach, suggest or even hint at the possibility of bundling their respective products to form any structure” (Request 8). For the reasons set forth above, and in the Decision, we are not persuaded by this assertion. Nevertheless, Appellants assert that “had the Board not overlooked the Reply Brief’s arguments, the Board would not have affirmed the rejections of claim 83 as being unpatentable under 35 U.S.C § 103(a) over McIntosh” (*id.*). Accordingly, we turn to the arguments Appellants presented in their Reply Brief.

“Ambiguity would explain the Examiner’s reliance on kayaks and plastic plates as offshore platforms in the arguments supporting his determination that . . . McIntosh . . . [is a] credible §§ 102 and 103 reference[ ] to support rejections of the subject claims” (Reply Br. 17 (emphasis removed)). For the reasons set forth above, and in the Decision, we are not persuaded by this assertion.

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For the foregoing reasons, we affirm the rejection of claim 83 under 35 U.S.C. § 103(a) as unpatentable over McIntosh.

#### SUMMARY

We grant Appellants' request for rehearing to the extent that we have addressed the claims they have separately grouped in their Reply Brief, and have cited to their Reply Brief. We do not, however, find a point of law or fact that we have misapprehended or overlooked in our prior opinion. Accordingly, we reaffirm our prior holding.

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

#### GRANTED-IN-PART

clj

Patrica Meier Conoco Philips Company  
P.O. Box 2443 IP Legal  
Bartsville, OK 74005