

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICE JUNG and GUY LE BAIL

Appeal No. 95-4344
Application 08/087,030¹

HEARD: December 11, 1998

Before FRANKFORT, PATE and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Patrice Jung et al. appeal from the final rejection of claims 18 through 31, all of the claims

¹ Application for patent filed July 6, 1993. According to the appellants, the application is a continuation of Application 07/870,101, filed April 16, 1992, abandoned, which is a continuation of Application 07/615,498, filed November 19, 1990, abandoned.

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pending in the application.²

The invention relates to a flexible crush-resistant conduit for deep undersea applications. A copy of the claims on appeal appears in the appendix to the appellants' brief (Paper No. 30).

The references relied upon by the examiner as evidence of obviousness are:

Fulton	1,476,704	Dec. 11, 1923
Collom	2,056,840	Oct. 6, 1936

Chicago Metal Hose Corporation Catalog, pages 25, 31, 34 and 38 (1940)

Claims 18, 19 and 21 through 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Collom in view of the Chicago Metal Hose Corporation Catalog, and claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Collom in view of the Chicago Metal Hose Corporation Catalog and Fulton.³

Reference is made to the appellants' brief (Paper No. 30) and to the examiner's answer (Paper No. 31) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

Collom, the examiner's primary reference, discloses an exhaust pipe for an internal combustion

² Claim 18 has been amended subsequent to final rejection.

³ The examiner has withdrawn the 35 U.S.C. § 112, second paragraph, rejection of claims 18 through 31 which was set forth in the final rejection (see the advisory action dated October 18, 1994, Paper No. 29)).

engine. The pipe consists of inner and outer flexible conduits 1 and 2. As described by Collom,

[t]he flexible conduits 1 and 2 are each formed of a continuous helical winding of ~~metal~~ ribbon or the like 3 having a substantially S-shaped cross section form so that the successive convolutions thereof may be slidably interlocked with adjacent convolutions ~~to~~ permit a substantial range of flexibility in the exhaust assembly, and asbestos or like packing 3a is disposed intermediate certain of said interlocking portions to tightly seal the joint between successive convolutions of the strips 3 [page 1, column 1, lines 36 through 47].

The examiner acknowledges (see page 3 in the answer) that Collom does not disclose, and would not have suggested, a flexible tubular conduit having a discrete end section bearing in face-to-face contact at its end surfaces on the first main portion of an immediately adjacent turn as recited in claim 18.⁴ The examiner's reliance on the Chicago Metal Hose Corporation Catalog to overcome this deficiency (see page 3 in the answer) is not well founded.

The Chicago Metal Hose Corporation Catalog discloses a number of exhaust conduits formed from helically wound, S-shaped metal strips having interlocking convolutions. The RT-15 embodiment relied upon by the examiner appears from the illustrations thereof to have a discrete end section corresponding generally to the discrete end section set forth in claim 18. It is not at all clear, however,

⁴ Based on the underlying specification and the comments of counsel at the oral hearing, we understand the recitation in claim 18 that the discrete end section bears in face-to-face contact at its end surfaces on the first main portion of the immediately adjacent turn to mean that the discrete end portion is in surface-to-surface contact along its length, as opposed to edge or point contact, with the first main portion of the immediately adjacent turn.

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that this prior art end section bears in face-to-face contact at its end surfaces on the first main portion of the immediately adjacent turn. Given the ambiguity of the reference in this regard, the examiner's conclusion that the combined teachings of Collom and the Chicago Metal Hose Corporation Catalog would have suggested the subject matter recited in claim 18 is unsound, in essence because it is necessarily based on speculation, unfounded assumptions and/or hindsight reconstruction. Furthermore, this fundamental flaw in the basic prior art combination finds no cure in Fulton's disclosure of a helically wound exhaust conduit having a tapered discrete end section which does not even contact the first main portion of the immediately adjacent turn.

This being the case, we shall not sustain the standing 35 U.S.C. § 103 rejections of independent claim 18 or of claims 19 through 31 which depend therefrom.

The following rejections are entered pursuant to 37 CFR § 1.196(b).

Claims 18 through 20, 22 and 24 through 31 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in

light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The preamble of independent claim 18 sets forth “A crush resistant flexible tubular conduit capable of withstanding high external hydrostatic pressures.” The underlying specification indicates that such a conduit requires “a precise interlocking, without radial free play between the confronting portions of the adjacent spirals” (page 3). As clearly shown in Figures 3 through 7, and as conceded by counsel at the oral hearing, contact between the intermediate section 13 of the profiled band of the conduit and the first secondary portion of the adjacent turn is necessary to prevent radial free play between the confronting portions of the adjacent spirals. Such contact, however, is not recited in the bodies of claims 18 through 20, 22 and 24 through 31. This inconsistency renders the scope of these claims unclear.

Claim 20 is additionally indefinite in that the recitation therein that the discrete end section is slightly tapered and bears at its end on the first main portion of the adjacent turn is, as conceded by counsel at the oral hearing, inconsistent with the recitation in parent claim 18 that the discrete end section bears in face-to-face contact at its end surfaces on the first main portion of the immediately adjacent turn.

Claim 20 is also rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with the written description requirement of this section of the statute.

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The test for compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Here, the disclosure of the appellants' application as originally filed would not reasonably convey to the artisan that the appellants had possession at that time of a conduit having a discrete end section which is both slightly tapered and in face-to-face contact with the first main portion of the immediately adjacent turn as is now recited in claim 20.

In summary and for the above reasons:

a) the decision of the examiner to reject claims 18 through 31 under 35 U.S.C. § 103 is reversed; and

b) new rejections of claims 18 through 20, 22 and 24 through 31 are entered pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A

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new ground of rejection shall not be considered final for purposes of judicial review.”

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

CHARLES E. FRANKFORT)
Administrative Patent Judge)
)
) BOARD OF PATENT

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