

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. WELKER

Appeal No. 96-4197
Application No. 08/425,261¹

ON BRIEF

Before URYNOWICZ, JERRY SMITH, and FLEMING, ***Administrative Patent Judges.***

FLEMING, ***Administrative Patent Judge.***

DECISION ON APPEAL

¹ Application for patent filed April 18, 1995. According to appellant this application is a continuation of Application No. 08/136,374, filed October 15, 1993, now abandoned.

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This is a decision on appeal from the final rejection of claims 19 through 29,² all of the claims pending in the application. Claims 1 through 18 have been canceled.

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The invention relates to an insertion device used to insert a measuring instrument or sensor into a pipeline. More particularly, the invention relates to an insertion device that is able to power the insertion rod without extending the height of the structure. Appellant discloses on page 2 of the specification that the invention provides a folded structure. The folded structure assures the positioning of the power cylinders parallel and adjacent to the insertion rod rather than the prior art which positions the power cylinder axially aligned with the insertion rod. On pages 4 and 5 of the specification, Appellant discloses that Figure 1 shows the invention in sectional view. In particular, Figure 1 shows

² In a July 14, 1995 amendment, applicant cancels claims 12-18 and adds 11 additional claims numbered 17 through 27. The Examiner has renumbered claims 17 through 27 to claims 19 through 29 respectively. We note that Appellant has provided in the appendix claims 17 through 27. We have renumbered these claims as claims 19 through 29 respectively to accurately reflect the claims in the record.

the insertion apparatus 10 having the hydraulic cylinders 25 parallel and adjacent to the insertion rod 21 such that the insertion apparatus is able to power the insertion rod without extending the height of the structure.

The independent claims 19 and 22 are reproduced as follows:

19. A method of inserting a measuring instrument into the central portions of a pipeline to thereby measure aspects of fluid flow through the pipeline, and including the steps of:

(a) positioning a measuring instrument on an end of an insertion rod;

(b) positioning the insertion rod through a stuffing assembly so that the end thereof is moveable into or away from the interior of the pipeline;

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(c) applying a force to a second end of said rod wherein the second end is on the exterior of the pipeline so that the second end is forced toward the pipeline to achieve insertion into the pipeline;

(d) utilizing line pressure to form a pressurized fluid applied to a motive means to thereby force movement of said rod; and

(e) wherein the step of applying a force to the second end of said rod is accomplished laterally of said rod which precludes extending beyond said rod.

22. A pipeline insertion apparatus for making measurements of conditions in a pipeline by inserting a measuring mechanism through a stuffing assembly and blocking valve extending outwardly from and in communication with the pipeline and positioning the measuring mechanism at a desired location within the cross sectional area of the pipeline, the apparatus comprising:

(a) a laterally extending mounting member fixedly attached to the stuffing assembly and blocking valve, the mounting member having two opposing ends;

(b) an elongate insertion rod in sliding engagement relative to said laterally extending mounting member having

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a measuring end and a distal end, the insertion rod being axially aligned for insertion of the measuring end into the pipeline through said extending mounting member, the stuffing assembly, and the blocking valve, wherein the measuring end is capable of supporting a measuring mechanism;

(c) a laterally extending yoke connected with the distal end of the insertion rod having two opposing ends aligned with the opposing ends of said mounting member;

(d) a pair of parallel hydraulic cylinders, each hydraulic cylinder having an elongate cylinder body extending toward the pipeline adjacent to and aligned at the side of the stuffing assembly and blocking valve, a piston movably located in each of said cylinders, and a piston rod extending from said piston for connection to relatively move said yoke with respect to said mounting member wherein the pipeline insertion apparatus extends from the pipeline parallel to the insertion rod, and wherein the application of pressurized fluid to the piston moves the piston rod to move said yoke towards or away from the pipeline to insert or retract the measuring end of the insertion rod into the pipeline wherein the pair of hydraulic cylinders operate jointly in response to a common pressurized fluid system to provide movement of the rod without bending from said pair of cylinders to the side of the stuffing assembly.

The Examiner relies on the following references:

Welker 1983	4,387,592	Jun. 14,
Kamrat 1991	5,009,113	Apr. 23,

Claims 19 through 29 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Kamrat in view of Welker.

Rather than reiterate the arguments of Appellant and the

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Examiner, reference is made to the brief and answer³ for the respective details thereof.

OPINION

We will not sustain the rejection of claims 19 through 29 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. 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 implications contained in such teachings or

³ The Examiner mailed a corrected Examiner's answer on June 26, 1996, which we will refer to simply as the answer.

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suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 117 S.Ct. 80 (1996) ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

Appellant argues on pages 10 through 17 of the brief that Kamrat and Welker, together or individually, fail to teach or suggest applying a force lateral to the end of the insertion rod which precludes extending beyond the insertion rod as recited in claims 19 through 21 or a pair of parallel hydraulic cylinders, each hydraulic cylinder extending toward the pipe adjacent to and aligned at the side of the stuffing assembly and blocking valve as recited in claims 22 through 29.

The Examiner argues on page 4 of the answer that it would have been obvious to those skilled in the art to replace the Kamrat threaded bars with two of the hydraulic cylinders of

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Welker such that the hydraulic cylinders are fully lateral to
the

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insertion rods to obtain Appellant's invention as recited in the claims. The Examiner further states that the other details of the hydraulic system recited in the dependent claims are all obvious for these kinds of systems. The Examiner offer no showing of evidence to support the Examiner's conclusions.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." ***Para-Ordnance Mfg.***, 73 F.3d at 1087, 37 USPQ2d at 1239, ***citing W. L. Gore***, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

On page 4 of the answer, the Examiner reasons that it would have been obvious to those skilled in the art to make the Examiner's proposed modification because hydraulic motive means are the state of the art for force/pressure applications

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and provide automatic controlled operations without human muscular force. Even if we agree with the Examiner's rationale, we are then only left with reasons to substitute the Welker probe insertion apparatus for the Kamrat device. The Examiner has not offered any reason to modify the Kamrat device in which the threaded bars 7 shown in figure 1 are replaced with two hydraulic cylinders. Furthermore, the Examiner has not offered any reason to modify the Kamrat device further by redesigning the fastening means such that the hydraulic cylinders are positioned adjacent to and offset to the side of the stuffing and blocking valve so that force is precluded to extend beyond the insertion rod.

Upon a careful review of Kamrat and Welker, we fail to find that either one of these references recognizes the problem of providing the insertion power to the insertion rod without extending the height of the structure. Furthermore, we fail to find any suggestion or desirability disclosed other than what is provided by Appellant's specification. Therefore, we find that the Examiner has failed to establish that the prior art suggested the desirability of the modification as proposed in the rejection.

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We have not sustained the rejection of claims 19 through 29 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

STANLEY M. URYNOWICZ, Jr.)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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REVERSED

Prepared: September 24, 1999