

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMOND H. JENSEN

Appeal No. 2002-0573
Application 09/150,422

ON BRIEF

Before COHEN, ABRAMS, and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 5. Claims 6 and 7, the only other claims pending in the application, have been allowed.¹

Appellant's invention relates to an integral combined pipe drop nipple and reducing coupling assembly (29) used in a fire

¹A minor amendment to claim 1 was made subsequent to the final rejection. See Paper No. 17, filed January 22, 2001.

Appeal No. 2002-0573
Application 09/150,422

sprinkler apparatus for use with a drop ceiling of suspended tile or sheetrock wherein a branch or run pipe (17) extending horizontally parallel to and positioned above the ceiling is connected to a sprinkler head (26) located below the drop ceiling. Claims 1 and 4 are representative of the subject matter on appeal and a copy of those claims may be found in Appendix B of appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Jackson et al. (Jackson)	4,007,877	Feb. 15, 1977
Ballard	4,834,186	May 30, 1989
MacDonald III (MacDonald)	5,743,337	Apr. 28, 1998

Claims 1 through 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ballard in view of Jackson and MacDonald.

Rather than reiterate the examiner's full statement of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the examiner's answer (Paper No. 23, mailed September 10, 2001) for the reasoning in support of the

Appeal No. 2002-0573
Application 09/150,422

rejection, and to appellant's brief (Paper No. 20, filed June 6, 2001) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination which follows.

Like appellant, we are of the opinion that the examiner has taken appellant's disclosure and claims as a blueprint and used them to seek out and assemble disparate elements from the prior art in an effort to arrive at appellant's claimed subject matter. Thus, the examiner's position in this appeal represents a clear case of impermissible hindsight reconstruction of the claimed invention based on appellant's own teachings. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated

Appeal No. 2002-0573
Application 09/150,422

disclosures and teachings of the prior art so that the claimed invention is rendered obvious. Moreover, and more to the point in the present appeal, we observe that the mere fact that some prior art references may be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir 1984). Here, the prior art relied upon by the examiner contains no such suggestion, particularly with regard to the examiner's asserted combination of Ballard and MacDonald.

In contrast to the examiner's position concerning the teachings of MacDonald (answer, page 5), we note that this reference does not teach or suggest a reducing coupling having an upper end mounted on the bottom end of a drop nipple "in abutting relationship" and with the outer surface of the reducing coupling and outer surface of the drop nipple in alignment with each other to form a smooth outer surface of the same circumference to thus form an integral drop nipple-coupling having the outside appearance of an integral pipe, as set forth in claim 1 on appeal. Nor does MacDonald teach or suggest the specific structure of the reducing coupling set forth in claim 4 on

appeal, or a weld connecting the top surface of the reducing coupling to the bottom surface of the drop nipple to form an integral drop nipple-reducing coupling assembly with a smooth, uniform outer surface, as required in the claims on appeal.

As correctly pointed out by appellant (brief, pages 13-14 and 18), MacDonald discloses a connection between a flexible conduit (18) made of stainless steel braid and a fitting or reducing coupling (14) wherein a section (118) of the outer surface (106) at the conduit end of the fitting (e.g., Fig. 5) is adapted to receive one end of the flexible conduit, with that end of the conduit being bonded to the fitting by any permanent method, for example, by welding (col. 5, lines 31-36). Thus, in MacDonald the flexible conduit (18) is apparently slid over the outer surface of the fitting (14) and then welded to the outer surface of the fitting by a circumferential weld, thereby forming an overlapping connection between the conduit and the fitting. Accordingly, even if one of ordinary skill in the art were led to modify Ballard in view of the teachings of MacDonald, the resulting structure of a flexible drop pipe and fitting in Ballard (connected as in MacDonald) would be entirely different than that claimed by appellant.

If the examiner intends to merely use the welding mentioned in MacDonald to affix the fitting (30) of Ballard to the vertical pipe (24), we find no factual basis in the applied prior art references for any such combination. Moreover, even if such a combination were attempted, we do not see that the structure claimed by appellant would be the result. As can be clearly seen in Figures 2 and 8 of Ballard, the fitting (30) and vertical pipe (24), even if welded together, would not have outer surfaces "in alignment with each other to form a smooth outer surface of the same circumference for the nipple and the coupling and to form an integral drop nipple-coupling having the outside appearance of an integral pipe," as required in claim 1 on appeal. Similarly, the welding of the fitting (30) to the vertical pipe (24) in Ballard would not result in an integral combination pipe drop nipple and reducing coupling assembly as defined in claim 4 on appeal, since appellant's assembly is required to have "a smooth outer surface of the same circumference for the drop nipple and the coupling," which clearly will not be present in Ballard as modified by MacDonald. Nor do we see any teaching or suggestion in Ballard, Jackson and MacDonald of having an abutting relationship between the upper end surface of the reducing coupling and the bottom end surface of the drop nipple, as required in appellant's claims on

Appeal No. 2002-0573
Application 09/150,422

appeal, or of an escutcheon fitting which slides over the combined integral drop nipple-reducing coupling assembly for a predetermined distance, as set forth in dependent claim 2.

Since we have determined that the teachings and suggestions found in Ballard, Jackson and MacDonald would not have made the subject matter as a whole of independent claims 1 and 4 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 2, 3 and 5 under that same ground will likewise not be sustained.

Appeal No. 2002-0573
Application 09/150,422

Accordingly, the decision of the examiner to reject claims 1 through 5 under 35 U.S.C. § 103(a) is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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Appeal No. 2002-0573
Application 09/150,422

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