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BOARD OF PATENT APPEALS
AND INTERFERENCES

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

95-1787

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RALPH C. KENDRICK, JR.

Appeal No. 95-1787
Application 08/020,568¹

ON BRIEF

Before MEISTER, STAAB, and McQUADE, *Administrative Patent Judges*.
MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-16, the only claims present in the application.

¹ Application for patent filed February 22, 1993.

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The appellant's invention pertains to (1) a cable directing device, (2) the combination of a support pad and cable directing device and (3) a method of routing cable which includes using a cable directing device. Independent claims 1, 11 and 13 are further illustrative of the appealed subject matter and copies thereof, as they appear in the appendix to the appellant's brief, are appended to this opinion.

The prior art of record relied on by the examiner is:

| | | |
|-------------------------------------|-----------|---------------|
| Havens, Jr. (Havens) | 1,014,704 | Jan. 16, 1912 |
| Sargent | 1,986,121 | Jan. 01, 1935 |
| Papenheim (Germany) ² | 3,800,856 | Jul. 27, 1989 |

The prior art disclosed by the appellant in Fig. 1 and pages 6 and 7 of the specification. (the admitted prior art)

Claims 1, 2, 6 and 7 stand rejected under 35 U.S.C. 102(b) as being anticipated by Sargent.

Claims 3-5 and 8-10 stand rejected under 35 U.S.C. 103 as being unpatentable over Sargent in view of Havens or Papenheim.

According to the examiner

Sargent discloses the fishing funnel for wiring conduit systems as stated supra including a flange (see part 16 in Fig. 5) attached to the first cable passage opening except for a third cable passage opening. However, as shown by each of Havens and Papenheim, it is old and well known to use a plurality of cable openings for cable directing devices: and nothing unobvious is seen to have been involved in simply having applied this

² Translation attached.

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well known expedient for a cable directing device of the sort here involved. (see final rejection, page 3)

Claims 11-16 stand rejected under 35 U.S.C. 103 as being unpatentable over the admitted prior art in view of Sargent. In setting forth this ground of rejection the final rejection states

The prior art of Fig. 1 discloses all of the features claimed except for the claimed cable directing device. However, Sargent discloses a cable directing device, i.e[.,] fishing funnel, having a hollow housing 15 defining first and second cable passage openings, a cable directing passageway and a mating member 30. Thus, it would have been obvious to one of ordinary skill in the art to modify the disclosed prior art [of] Fig. 1 by adopting the teachings of Sargent to improve the guiding function of the basic claimed cable directing device and to protect the insulating material or jacket of the cable or wire from abrasive action. Further, the claimed method would have been inherent in view of the disclosed prior art Fig. 1 and Sargent. (see pages 3 and 4)

Rather than reiterate the arguments of the appellant and examiner in support of their respective positions, reference is made to the brief and answer for the full exposition thereof.

OPINION

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and by the examiner in the answer. As a consequence of this review, we will sustain the examiner's rejection of claims 1, 2, 6 and 7 under 35 U.S.C. 102(b). We

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will not, however, sustain either of the examiner's rejections under 35 U.S.C. 103. Additionally, pursuant to our authority under the provisions of 37 CFR 1.196(b) we will enter new rejections of (1) claims 6-9 under 35 U.S.C. 112, second paragraph, and (2) claims 14 and 16 under 35 U.S.C. 112, first paragraph. Our reasons for these determinations follow.

Considering first the rejection of claims 1, 2, 6 and 7 under 35 U.S.C. 102(b) as being anticipated by Sargent, it is the appellant's position that

[i]ndependent claim 1 expressly recites that the larger cable passage opening is directed upwardly and the second, smaller cable passage opening is directed generally horizontally. In addition, a mating member projects outwardly from the housing and is configured to mate with an underground shielding conduit. Further, the present invention includes a flange extending around the wide, horizontally oriented opening to support the housing on a pad. Such structure cannot be found in the Sargent reference. That which the Examiner identifies as a flange 16 is identified by Sargent as a "bell mouth" and nowhere in Sargent is [there] any indication that the bell mouth includes or even needs a flange. Since the bell mouth is shaped to conform to the inner portion of a beam, there is no need for a flange. Further, there is no mating member projecting horizontally outwardly from a housing and the item identified as such by the Examiner and indicated to be identified by reference numeral 30 is not to be found in the Sargent reference.

Further, there is no teaching or suggestion in Sargent to reorient the fishing funnel or to use the fishing funnel outdoors. (see brief, page 8)

We are unpersuaded by the appellant's arguments. The terminology in a pending application's claims is to be given its

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broadest reasonable interpretation (*see In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (*see Sjolund v. Musland*, 847 F.2d 1573, 6 USPQ2d 2020 (Fed. Cir. 1988)). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. *See Verdegaal Brothers Inc. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). A prior art reference anticipates the subject matter of a claim when that reference discloses, either expressly or under the principles of inherency, each and every element set forth in the claim (*see In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990)); however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (*see Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)).

With respect to the appellant's contention that there is no suggestion in Sargent "to use the fishing funnel outdoors," we observe that there is no requirement in claim 1 that the cable directing device be "outdoors." While the preamble of claim 1 does set forth that the cable directing device is "for enclosing

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and directing underground electrical cable between an underground shielding conduit for the cables and an above-ground electrical apparatus," we must point out that it does not follow that just because something is "underground" that it is necessarily "outdoors." For example, "underground" might simply refer to a location beneath a basement floor. Moreover, it is well settled that a preamble generally does not limit the scope of a claim if it merely states the invention's purpose or intended use. *See In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994). While no litmus test can be given with respect to when the introductory words of a claim constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim (*see Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989)), in a case such as this where the cable directing device of Sargent has the **capability** of being used in the manner set forth in the preamble, we are of the opinion that the recitation of "for enclosing and directing underground electrical cable between an underground shielding conduit for the cables and an above-ground electrical apparatus ..." appearing in the preamble of claim 1 is merely a statement of intended purpose or use which may not be relied on to distinguish structure from the prior art. *See In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974), *In re Yanush*, 477 F.2d 958, 177 USPQ 705 (CCPA 1973) and *In re Casey*, 370 F.2d 576, 152

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370 F.2d 576, 152 USPQ 235 (CCPA 1967). Note also *LaBounty Manufacturing v. International Trade Commission*, 958 F.2d 1066, 22 USPQ2d 1025 (Fed. Cir. 1992).

Similarly, the appellant's arguments concerning "upwardly" and "horizontally" merely go to the manner in which the cable directing device of Sargent is used (i.e., whether it is used with the second opening and mating member 17 oriented vertically and the first opening 16 oriented horizontally as shown by Sargent in Fig. 1, or whether it is used with the first opening oriented vertically and the second opening and mating member oriented horizontally as claimed). As our reviewing court set forth in *LaBounty Manufacturing* at 958 F.2d 1075, 22 USPQ2d 1032 (in quoting with approval from *Dwight & Lloyd Sintering Co. v. Greenawalt*, 27 F.2d 823, 828 (2d Cir. 1928)):

The use for which the [anticipatory] apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent; the statute authorizes the patenting of machines, not of their uses. So far as we can see, the disclosed apparatus could be used for "sintering" without any change whatever, except to reverse the fans, a matter of operation.

This principle applies here inasmuch as the cable directing device of Sargent can be used in either of the above-noted orientations, as well as in the manner set forth in the preamble, without any change in structure whatsoever.

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As to the appellant's contention that Sargent does not have a flange which supports the housing on a pad, this argument is not commensurate with the scope of independent claim 1 since no flange has been claimed. It is well settled that features not claimed may not be relied upon in support of patentability. *See In re Self*, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982).

The appellant has not separately argued the patentability of dependent claims 2, 6 and 7. Accordingly, these claims fall with independent claim 1. *See In re Schrader*, 22 F.3d 290, 30 USPQ2d 1455 (Fed. Cir. 1994) and *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987).

In view of the foregoing, we will sustain the examiner's rejection of claims 1, 2, 6 and 7 under 35 U.S.C. 102(b).

Considering next the rejection of claims 3-5 and 8-10 under 35 U.S.C. 103 as being unpatentable over Sargent in view of Havens or Papenheim, the examiner has taken the position that it would have been obvious to provide the fishing funnel of Sargent with a "third cable passage" in view of the teachings of either Havens or Papenheim.³ However, even if we were to agree with the examiner that, as a broad proposition, such a modification would have been obvious, the claimed invention would not result. Claim

³ We are at a loss to understand why the examiner has taken such a position with respect to claims 3, 4 and 10 inasmuch as these claims do not require a "third cable passage."

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3 (from which claims 4, 5, 8 and 9 depend) expressly sets forth a "means for mounting said device to the supporting pad." In an apparent reference to this limitation, the examiner has stated Sargent discloses "a flange (see part 16 in Fig. 5);" however, this position is based on speculation. As the appellant has correctly noted, the element 16 is identified by Sargent as a "bell mouth" with no reference whatsoever to a "flange." While Fig. 5 of Sargent does show two parallel lines at the "bell mouth" 16, there is absolutely nothing within the four corners of Sargent's disclosure which would fairly suggest that such lines do in fact represent a "flange." The examiner may not resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the references. *See In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

As to claim 1[^] (which depends from claim 2), we note this claim expressly requires "a bracing wall portion disposed adjacent and below said second cable passage opening." The examiner has offered no reason as to why such a limitation would have been obvious in light of the relied on prior art and we find none.

Since the examiner has not provided a factual basis upon which a conclusion of obviousness of the subject matter defined by claims 3-5 and 8-10 can be reached (*see In re Warner, supra*), we will not sustain the examiner's rejection of these claims

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under 35 U.S.C. 103 based upon the combined disclosures of Sargent and either Havens or Papenheim.

Turning now to the rejection of claims 11-16 under 35 U.S.C. 103 as being unpatentable over the admitted prior art in view of Sargent, the examiner has taken the position that it would have been obvious to modify the admitted prior art by "adopting the teachings of Sargent to improve the guiding function" We must point out, the mere fact that an improved guiding function would result does not serve as a proper motivation to combine the teachings of the admitted prior art and Sargent. It is the teachings of the prior art taken as a whole which must provide the motivation or suggestion to combine the references. *See Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985) and *In re Deminski*, 706 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). Here, the admitted prior art shows a plurality of conduit portions having 90° bends which are buried in a trench for the purpose of "directing" wires from a buried conduit to a switching device that is mounted on a concrete pad which rests on the ground. On the other hand, Sargent discloses a "fishing funnel" which allows a wire, that is being "fished" along the interior of a hollow beam, to be directed from the interior to the exterior of the beam through the wall of the beam. Particularly, in view of the fact that the

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admitted prior art is in no way concerned in performing a fishing operation wherein a wire is being directed through the wall of a hollow member, we can think of no cogent reason why one of ordinary skill in the art would have combined the disparate teachings of the admitted prior art and Sargent in the manner proposed by the examiner. As the court in *Uniroyal* stated at 5 USPQ2d 1438 "it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." This being the case, we will not sustain the examiner's rejection of claims 11-16 under 35 U.S.C. 103 based on the combined teachings of the admitted prior art and Sargent.

Under the provisions of 37 CFR 1.196(b) we make the following new rejections.

Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention. These claims are indefinite since independent claim 1 sets forth a "mating member" and dependent claims 6 and 8 set forth a "means for mating" as though they were two separate elements when in fact they are one and the same.

Claims 14 and 16 are rejected under 35 U.S.C. 112, first paragraph, as being based upon a disclosure which fails to

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provide descriptive support for the invention now being claimed.
See *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

We initially note that the description requirement found in the first paragraph of 35 U.S.C. 112 is separate from the enablement requirement of that provision. **See *Vas-Cath Inc. v. Mahurkar***, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991) and ***In re Barker***, 559 F.2d 588, 194 USPQ 470 (CCPA 1977). Moreover, as the court stated in ***In re Kaslow***, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983):

The test for determining 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 claimed language. The content of the drawings may also be considered in determining compliance with the written description requirement.
(citations omitted)

Although the claimed invention does not necessarily have to be expressed in *ipsis verbis* in order to satisfy the description requirement (**see *In re Wertheim***, 541 F.2d 257, 191 USPQ 90 (CCPA 1976)), it is nonetheless necessary that the disclosed apparatus inherently perform the functions now claimed. Note ***In re Smythe***, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973). The fact one skilled in the art might realize from reading a disclosure that something is possible is not a sufficient indication to that person that the something is a part of an appellant's disclosure. **See *In re***

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Barker, supra. Precisely how close the original description must come to comply with the description requirement must be determined on a case-by-case basis. The primary consideration is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure. *See Vas-Cath Inc. v. Mahurkar, supra.*

In the present case, we find no descriptive support in the original disclosure for "the step of compacting earth in abutment with" a portion of the wall which is disposed below the cable passage.

In summary:

The examiner's rejection of claims 1, 2, 6 and 7 under 35 U.S.C. 102(b) is affirmed.

The examiner's rejections of claims 3-5 and 8-16 under 35 U.S.C. 103 are reversed.

A new rejection of claims 6-9 under 35 U.S.C. 112, second paragraph, is made.

A new rejection of claims 14 and 16 under 35 U.S.C. 112, first paragraph, is made.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 CFR 1.197).

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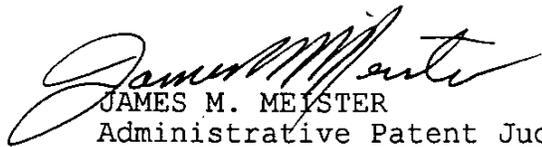
With respect to the new rejections under 37 CFR 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, in order to preserve the right to seek review under 35 U.S.C. 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

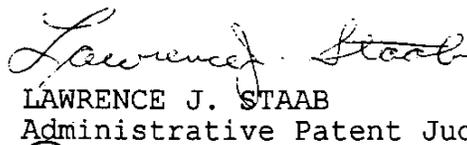
If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

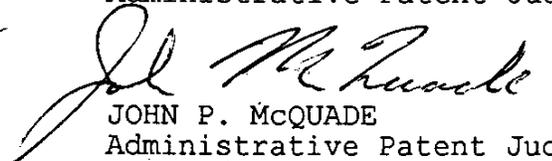
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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED-IN-PART
37 CFR 1.196(b)


JAMES M. MEISTER)
Administrative Patent Judge)


LAWRENCE J. STAAB)
Administrative Patent Judge)


JOHN P. McQUADE)
Administrative Patent Judge)

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APPENDIX

1. A cable directing device for enclosing and directing underground electrical cable between an underground shielding conduit for the cables and an above-ground electrical apparatus of the type disposed on a preformed supporting pad having formed therein an access opening substantially enlarged in relation to the underground conduit for passage of the cables through the access opening, said directing device comprising a hollow housing defining first and second cable passage openings and a cable directing passageway extending interiorly through the housing between said first and second cable passage openings, said first cable passage opening being directed upwardly and being substantially larger than said second cable passage opening, said first cable passage opening being configured to substantially conform to and be matable with the access opening in the supporting pad and said second cable passage opening being directed generally horizontally and configured to substantially conform to and be matable with the underground shielding conduit, including a mating member projecting outwardly from said housing and configured to mate with an underground shielding conduit, said first and second cable passage openings being oriented substantially perpendicularly to one another and said cable directing passageway being curved substantially ninety degrees (90°) between said first and second cable passage openings and being tapered narrowly from said

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first cable passage opening toward said second cable passage opening, whereby said cable directing device may be positioned to project downwardly from the access opening in the supporting pad for directing a plurality of underground cables between the access opening in the supporting pad and the underground conduit.

11. In combination, a ground level support pad for supporting electrical apparatus, the pad having at least one access opening formed therein for the routing therethrough of electrical cables for attachment to said electrical apparatus disposed on said support pad and a cable directing device for enclosing and directing underground electrical cable between an underground shielding conduit for the cables and the above-ground electrical apparatus disposed on said preformed supporting pad having said access opening substantially enlarged in relation to the underground conduit for passage of the cables through the access opening, said directing device comprising a hollow housing defining first and second cable passage openings and a cable directing passageway extending interiorly through said housing between said first and second cable passage openings, said first cable passage opening being directed upwardly into said support pad and being substantially larger than said second cable passage opening, said first cable passage opening being configured to substantially

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conform to and be matable with said access opening in said supporting pad and said second cable passage opening being directed generally horizontally and configured to substantially conform to and be matable with the underground shielding conduit, including a mating member projecting outwardly from said housing and configured to mate with an underground shielding conduit, said first and second cable passage openings being oriented substantially perpendicularly to one another and said cable directing passageway being curved substantially ninety degrees (90°) between said first and second cable passage openings and being tapered narrowingly from said first cable passage opening toward said second cable passage opening, whereby said cable directing device may be positioned to project downwardly from the access opening in the supporting pad for directing a plurality of underground cables between said access opening in said supporting pad and the underground conduit.

13. A method for routing electrical cable from an underground conduit to an above-ground electrical apparatus comprising the steps of:

providing a hole in the ground at a location for disposition thereabove of an above-ground electrical apparatus;

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providing a surface mounted support pad for the electrical apparatus having at least one opening formed therein for passage of electrical cable therethrough;

mounting said support pad above said hole;

providing a cable directing device having a hollow housing defining an upwardly directed first cable passage opening and a horizontally directed second cable passage opening, a cable directing passageway therebetween, and a flange projecting perpendicularly outwardly from said housing adjacent said first cable passage opening, said housing including a mating member for mating said housing with the underground conduit, said housing tapering from a relatively wide portion at said first cable passage opening to a relatively narrow portion at said second cable passage opening;

mounting said cable directing device on said support pad by placing said narrow portion through said access opening in said pad and lowering said cable directing device into said hole until said flange engages said support pad;

routing the electrical cable into said second cable passage opening, through said housing, and upwardly through said first cable passage opening; and

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mating said mating member with said underground
conduit.