

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSE F. DOMINGUEZ

Appeal No. 95-4860
Application No. 08/044,923¹

ON BRIEF

Before McCANDLISH Senior Administrative Patent Judge and
MEISTER and NASE, Administrative Patent Judges.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

Jose F. Dominguez (the appellant) appeals from the final rejection of claims 12-22, the only claims remaining in the application. We reverse and, pursuant to our authority under

¹ Application for patent filed April 8, 1993. According to the appellant, the application is a continuation of Application 07/770,565, filed October 3, 1991.

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the provisions of 37 CFR § 1.196(b), we will enter new rejections of claim 18.

The appellant's invention pertains to a temporary pipeline plug. Independent claim 12 is further illustrative of the appealed subject matter and reads as follows:

12. For use in forming a temporary closure and seal of a pipeline end defining an inner diameter, a major axis and an inner surface, a pipeline plug comprising:

an elongated support shaft having first and second ends;

an expandable seal supported at said first end;

an anchor larger than said inner diameter removably supported at said second end;

means for expanding said expandable seal from said second end;

an intermediate support coupled to said support shaft between said first and second ends having a portion contacting said pipeline at said inner surface to form a support for said elongated support shaft to maintain alignment of said support shaft and said major axis of said pipeline during and following removal of said anchor.

The references relied on by the examiner are:

O'Connor	551,598	Dec. 17, 1895
Leroy	2,475,748	July 12, 1949
Grunsky	2,824,577	Feb. 25, 1958
Streich	4,178,967	Dec. 18, 1979

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Claims 12-22 stand rejected under 35 U.S.C. § 112, first paragraph.

Claims 12 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Grunsky.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Grunsky.

Claims 15-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over O'Connor in view of Streich.

Claims 20-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over O'Connor in view of Streich and Leroy.

The examiner's rejections are explained on pages 3-7 of the answer.

OPINION

As a preliminary matter we base our understanding of the appealed subject matter upon the following interpretation of the terminology appearing in independent claim 12. In lines 9 and 10² we interpret "means for expanding said expandable seal from said second end" to be -- means for expanding said

² Reference in this opinion to specific lines in claims is with respect to the claims as they appear in the appendix to the appellant's brief.

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expandable seal operable from said second end --. In line 15
we interpret "and" to be -- with respect to --.

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Considering first the rejection of claims 12-22 under 35 U.S.C. § 112, first paragraph, the examiner is of the opinion that there is no descriptive support for the recitation of the anchor being "removably supported" on the end of the support shaft (independent claim 12) or "removably coupled" to the first shaft (independent claim 15) because the specification does not expressly state that the anchor can be removed. We must point out, however, that drawings alone may be sufficient to satisfy the description requirement of § 112. **See, e.g., Vas-Cath Inc. v. Mahurkar**, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Moreover, adequate descriptive support is provided for a recited function if the disclosed device inherently performs that function, even if the specification makes no mention of the function being performed. **See In re Reynolds**, 443 F.2d 384, 389, 170 USPQ 94, 98 (CCPA 1971). Here, the specification in the sentence bridging pages 7 and 8 states that the outer shaft 11 is provided with threaded ends 16 and 17, and Fig. 2 of the drawings clearly depicts the threads 16 extending completely to the right-hand end of the outer shaft 11. Accordingly, the

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threaded hub 24 of the anchor 13 has the capability of being threaded on and off the outer shaft 11 as desired and, thus, the anchor 13 is inherently "removably supported" (independent claim 12) or "removably coupled" (independent claim 15) on the outer shaft 11. This being the case, there is adequate descriptive support for these limitations and we will not sustain the rejection of claims 12-22 under 35 U.S.C. § 112, first paragraph.

Turning now to the rejection of claim 12 under 35 U.S.C. § 102(b) and the rejection of claims 13 and 14 under 35 U.S.C. § 103 as being unpatentable over Grunsky, each of these rejections is based on the examiner's view that the anchor 29 of Grunsky can be considered to be "removably supported" as set forth in independent claim 12 because the "anchor 29 is removable when the end 15, the seal 19 and collar 25 are removed" (see answer, page 4). We must point out, however, that independent claim 12 expressly requires that the intermediate support

form a support for said elongated support shaft to maintain alignment of said support shaft and [sic, with respect to] said major axis of said pipeline

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during and following removal of said anchor.³

[Emphasis ours; footnote added.]

While the examiner is correct in noting that the anchor 29 of Grunsky can be removed from the support shaft 11, we observe that, in order to do so, Grunsky's entire plug must be removed from the pipeline 31, thus making it impossible for the intermediate support 35 to maintain alignment of the support shaft with respect to the pipeline by forming a support for the support shaft 11 "during and following removal of said anchor" as claimed. Therefore, we will not sustain the rejections of claim 12 under 35 U.S.C. § 102(b) and claims 13 and 14 under 35 U.S.C. § 103.

Considering now the rejections under 35 U.S.C. § 103 of 15-19 based on the combined disclosures of O'Connor and Streich and claims 20-22 based on the combined disclosures of O'Connor, Streich and Leroy, both of the rejections are bottomed on the examiner's belief that it would have been

³ This limitation sets forth a function which the claimed apparatus must be structurally capable of performing (**see, e.g., *In re Venezia***, 530 F.2d 956, 959, 189 USPQ 149, 151-52 (CCPA 1976)) and such a functional statement must be given full weight and may not be disregarded in evaluating the patentability of the claims (**see, e.g., *Ex parte Bylund***, 217 USPQ 492, 498 (Bd. App. 1981)).

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obvious to provide the device of O'Connor with an intermediate support as taught by Streich at 78. We do not agree. While the member 78 of O'Connor may broadly be considered a support, this member 78 is attached to a removable plug which is initially positioned in the conductor pipe of an offshore production platform and serves to keep the removable plug in the center of the pipe (and thus reduce the possibility of the removable plug sticking in the conductor pipe) as it is drawn through the conductor pipe when the removable plug is to be removed from the conductor pipe (see column 5, lines 41-51). On the other hand, O'Connor is directed to a plunger apparatus for removing obstructions in sewer and water-closet pipes. To this end, an expandable seal (C) is coupled to a first shaft (f) and an expandable plunger head (B), which may be expanded to fit various sizes of pipe, is attached to a second shaft (A) which is reciprocally mounted within the first shaft. In use the, the expandable plunger head (B) of O'Connor is (1) adjusted to fit the size of the pipe in which it is employed, (2) the expandable plunger head (B) and expandable seal (C) are inserted into the pipe, (3) the expandable seal (C) is expanded into sealing relationship

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the pipe, (4) the plunger head is moved up and down by reciprocating the (A) so as to forcibly remove the obstruction, (5) the expandable seal (C) is disengaged from sealing relationship with the pipe and (6) the plunger apparatus is removed from the pipe (see page 2, line 89, through page 3, line 5). In our view, it would not have been obvious to provide the plunger apparatus of O'Connor with a "supporting" or centering device as taught by Streich at 78 inasmuch as there is neither reason nor need to provide the plunger apparatus of O'Connor with such a centering device. In the first place, the plunger apparatus of O'Connor only extends into the pipe in which it is to be used a relatively short distance and, in the second place, the seal (C) and the plunger (B) of O'Connor would already inherently function to center or "support" that portion of the plunger apparatus that is inserted within the pipe.

We have carefully reviewed the teachings of Leroy but find nothing therein which would overcome the deficiencies already noted with respect to O'Connor and Streich.

In view of the foregoing we will reverse the rejections under 35 U.S.C. § 103 of 15-19 based on the combined

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disclosures of O'Connor and Streich and claims 20-22 based on the combined disclosures of O'Connor, Streich and Leroy.

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

Claims 18-22 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon a nonenabling disclosure since the appellant's disclosure provides no teaching of how to "make and use" an embodiment wherein the second pressure plate is **threadably coupled** to the third end of the second shaft as claim 18 sets forth. Viewing Fig. 2 of the appellant's disclosed embodiment, a resilient sealing material 61 is positioned between a fixed or first pressure plate 40 and a second or movable pressure plate 41 and movement of the movable or second pressure plate towards the fixed or first pressure plate causes the resilient material to expand against the inner surface 72 of the pipeline. If, as this claim sets forth, the second or movable pressure plate was **threadably coupled** to the second shaft, then no movement of the second pressure plate toward the first pressure plate could occur unless somehow (1) the second shaft 12 was reciprocated

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relative to the first shift 11 or (2) the second pressure plate 41 was rotated so that it would advance along the threads 19 on the end of the second shaft 12. There is, however, no enabling disclosure of a mechanism which would accomplish either of these alternatives. To the contrary, the specification sets forth it is the **hexagonal nut 48** (which is received in a hexagonal recess 47 in the second pressure plate 41) which is threadably engaged with the threads 19 (see page 9, lines 13-21) and, in describing the interaction between these elements, states that:

The rotation of inner shaft 12 causes threads 19 on the interior end thereof to be advanced within nut 48. The **advancement of nut 48** and threads 19 decreases the distance between front pressure plate 41 and rear pressure plate 40. [Page 11, lines 3-6; emphasis ours.]

The above description clearly describes the nut 48 as being threadably coupled to the shaft 12 and further suggests that the pressure plate 41 is simply loosely mounted on shaft 12 so that advancement of the nut 48 along threads 19 will cause the pressure plate 41 to be moved toward pressure plate 42.

Claims 18-22 are rejected under 35 U.S.C. § 112, second paragraph. In order to satisfy the requirements of the second

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paragraph of § 112, a claim must accurately define the invention in the technical sense. *See In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). Here, parent claim 18 does not accurately define the invention in the technical sense inasmuch as the second pressure plate cannot be considered to be threadably coupled to the third end of the second shaft for the reasons stated above with respect to the rejection of this claim under the first paragraph of § 112.

In summary:

The examiner's rejections of (1) claims 12-22 under 35 U.S.C. § 112, first paragraph, (2) claim 12 under 35 U.S.C. § 102(b) and (3) claims 13-22 under 35 U.S.C. § 103 are all reversed.

New rejections of claims 18-22 under 35 U.S.C. § 112, first and second paragraphs, have been 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 of the decision (37 CFR § 1.197). Should appellant

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elect to have further prosecution before the examiner in response to the new rejections under 37 CFR § 1.196(b) 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.

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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).

REVERSED
37 CFR § 1.196(b)

HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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ROY A. EKSTRAND
3158 REDHILL AVE., STE. 150
COSTA MESA, CA 92626

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JMM/jrg

MEISTER

APPEAL NO. 95-4860 - JUDGE

APPLICATION NO. 08/044,923

APJ MEISTER

Senior APJ McCANDLISH

APJ NASE

DECISION: **REVERSED 37 CFR § 1.196(b)**

Typed By: Jenine Gillis

DRAFT TYPED: 07 Apr 00

Revision: 14 Aug 97

FINAL TYPED: