

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAY R. AYERS and DONALD W. ALLEN

Appeal No. 96-2247
Application No. 08/218,488¹

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 3, which are all of the claims pending in this application.²

¹ Application for patent filed March 28, 1994.

² The appellants' reply brief (Paper No. 15, filed October 16, 1996) amended claim 1 to overcome the new ground of rejection set forth in the examiner's answer (Paper No. 10, mailed September 18, 1995). Based upon the amendment to claim 1, the supplemental examiner's answer (Paper No. 18, mailed March 21, 1997) withdrew the new ground of rejection.

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We REVERSE.

BACKGROUND

The appellants' invention relates to a marine spar platform. A copy of claims 1 through 3 appears in the appendix to the appellants' reply brief.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Tallman	3,696,325	Oct. 3, 1972
Wilde	3,717,113	Feb. 20, 1973

Every et al. (Every), Vortex-Excited Vibrations of Cylinders and Cables and Their Suppression, Ocean Engng., Vol. 9, No. 2, pp. 135-157 (1982)

Claims 1 through 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wilde in view of Tallman and Every.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the § 103 rejection, we make reference to the examiner's answer for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 9, filed June 30, 1995) for the appellants' arguments thereagainst.

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OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is not sufficient to establish a prima facie case of obviousness with respect to claims 1 through 3. Accordingly, we will not sustain the examiner's rejection of claims 1 through 3 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie

obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we turn to the examiner's rejection of claim 1.

Claim 1 recites a marine spar platform comprising an essentially vertical cylindrical buoyant vessel and a shroud surrounding the essentially vertical cylindrical buoyant vessel. Claim 1 further recites that the shroud comprises two essentially

perpendicular intersecting sets of fiberglass elements, wherein the open area between the fiberglass elements exceeds about 40% of the total shroud area.

The examiner, at pages 3-4 of the answer, determined that

Wilde discloses the basic claimed structure including a marine spar platform with an essentially cylindrical vessel 50, a shroud 52 surrounding the vessel and standoffs 73, 77, 78. Not disclosed by Wilde is the particular claimed shroud including intersecting sets of elements.

The examiner then determined that Tallman and Every teach shrouds of two essentially perpendicular intersecting sets of elements and concluded that

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the shroud of Wilde in the manner taught by Tallman and Vortex [Every] including two essentially perpendicular intersecting sets of element [sic, elements] in order to provide improved fluid flow past the cylindrical vessel. Additionally, it would have been an obvious choice of engineering design to a person of ordinary skill in the art at the time the invention was made to form the shroud of Wilde, as modified by Tallman and Vortex [Every] above, of the particular dimensions for improved flow and of fiberglass for high strength.

The appellants' argue (brief, pp. 3-4) that a prima facie basis for the rejection is not presented by the applied prior art. We agree. It is our opinion that Tallman and Every would not have suggested modifying Wilde's shroud 52 to be two

essentially perpendicular intersecting sets of elements since that would have resulted in the shroud 52 being porous. Wilde's shroud 52 is disclosed as being a buoyant member 52. Wilde discloses (column 6, lines 22-47) that

[t]he buoyant members 52 are generally hollow structures and their effective buoyancy may be varied by allowing water to flow into or forcing water out of the internal spaces within the foil members. In this way, the net buoyancy of entry tube 50 and the various structures connected thereto (not including central sphere 10) may be adjusted about a neutral buoyancy so as to be capable of providing a net positive or a net negative buoyancy of entry tube 50 and the attached structures. It should be noted that when the access apparatus (e.g., entry tube and attached structures), are in functional relationship to the sub-sea structure as shown in FIG. 4, the access apparatus may have either a negative or a positive net buoyancy and still achieve the desired righting action by means of buoyant foil members 52. This may be best illustrated by noting that increasing the weight at the lower end of entry tube 50 will decrease the buoyancy of the access means and still give the desired vertically floating characteristic as a result of buoyant foils 52. Therefore, the choice of positive, negative or neutral buoyancy for the access means when in functional disposition with respect to the sub-sea structure will depend on the structural details and the anchoring or mooring for the sub-sea structure.

Thus, it is our opinion that one skilled in the art would not have modified Wilde's member/shroud 52 to be porous since that would have negated the primary purpose of the member/shroud 52.

Additionally, the appellants argue that the applied prior art would not have suggested the limitations of claim 1 that the

shroud (1) include intersecting sets of fiberglass elements, or (2) have a "porosity" (i.e., open area) greater than 40%.

Our review of Tallman and Every reveals that the teachings therein would not have rendered the above-identified limitations obvious to one of ordinary skill in the relevant art at the time of the appellants' invention. In that regard, we see no teaching in Tallman and/or Every that would have suggested modifying Wilde to include a shroud having intersecting sets of fiberglass elements as set forth in claim 1. Contrary to the examiner's assertions, we find no teaching in the applied prior art that would have suggested a shroud having intersecting sets of fiberglass elements. While fiberglass may be known for its high strength, we see no motivation in the applied prior art, of why one skilled in the art would have modified the device of Wilde to include a shroud comprising two essentially perpendicular intersecting sets of fiberglass elements. Furthermore, the examiner has not set forth an effective line of reasoning of why a shroud having a "porosity" (i.e., open area) greater than 40% would have been an obvious choice of engineering design to a person of ordinary skill in the art at the time the invention was made.

In summary, we see no motivation in the applied prior art, of why one skilled in the art would have modified the device of Wilde to have a shroud comprising two essentially perpendicular intersecting sets of fiberglass elements, wherein the open area between the fiberglass elements exceeds about 40% of the total shroud area. Thus, it appears to us that the examiner has engaged in a hindsight reconstruction of the claimed invention. This, of course, is impermissible.³ Since the examiner's rejection was based upon an erroneous obviousness determination, the examiner has failed to meet the initial burden of presenting a prima facie case of obviousness.⁴ Thus, we cannot sustain the examiner's rejection of appealed independent claim 1, or claims 2 and 3 which depend therefrom, under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 3 under 35 U.S.C. § 103 is reversed.

REVERSED

³ In re Fine, supra; In re Warner, supra.

⁴ Note In re Rijckaert, supra; In re Lintner, supra; and In re Fine, supra.

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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SHELL OIL COMPANY
INTELLECTUAL PROPERTY
P.O. BOX 2463
HOUSTON, TX 77252-2463

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APJ NASE

APJ FRANKFORT

APJ McQUADE

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 22 Dec 97

FINAL TYPED: