

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TADAHIRO OHMI, MICHIO YAMAJI, NOBUKAZU IKEDA,  
TSUTOMU SHINOHARA, TETSUYA KOJIMA

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Appeal No. 1997-4077  
Application No. 08/441,989

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HEARD: January 12, 2000

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Before McCANDLISH, Senior Administrative Patent Judge and  
ABRAMS, and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 1 through 9, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.<sup>1</sup>

We AFFIRM-IN-PART.

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<sup>1</sup> While the examiner has approved entry of the amendment after final rejection (Paper No. 6, filed May 9, 1996), we note that this amendment has not been clerically entered.

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The subject matter on appeal is directed to a pipe joint comprising a pair of tubular joint members made of metal having opposed end faces, a threaded nut having a side wall with an inspection window therein and a metal gasket between the opposed end faces of the joint members. The pipe joint may also include a metal retainer for holding the gasket in place against an end face of one of the joint members. Either the gasket or the retainer for holding the gasket in place is distinctly colored so as to make the gasket or retainer discernible from the joint members when viewed through the inspection window. For example, the gasket or retainer may be formed of stainless steel and an oxide film may be formed on the stainless steel surface thereof or the stainless steel surface may be coated with a colored resin (specification, page 4). Claim 1 is illustrative of the subject matter on appeal and is reproduced below:<sup>2</sup>

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<sup>2</sup> We consider the recitation of "a pair of tubular joint members . . . each having an abutting end face" and the various recitations of "abutting end faces" in claims 1 and 4 to be misdescriptive because they suggest that the end faces of the joint members abut or touch one another. In fact, appellants' specification teaches that the end faces of the joint members are arranged opposite one another, but do not actually abut. Accordingly, we construe claims 1 and 4 as requiring simply that the gasket be interposed between and that the inspection window be positioned radially aligned with opposite or opposed end faces of the first and second joint members. We also

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1. A pipe joint comprising a pair of tubular joint members [1, 2] made of a metal and each having an abutting end face, a distinctly colored annular gasket [30] made of a metal and interposed between the abutting end faces of the respective joint members, and a nut [4] joining the joint members together and formed in said nut's side wall an inspection window [40] at a position radially aligned with the abutting end faces of the joint members, the inspection window extending through the nut side wall for viewing said gasket, and the pipe joint being characterized in that the gasket is distinctly colored making the gasket discernable from the joint members when observed through said inspection window. (Reference numerals added)

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

Babuder et al.	4,650,227	1987	Mar. 17,
(Babuder)			
Yamaji et al.	5,308,124		May 03,
1994			
(Yamaji)			
Shinohara et al.	5-332483		Dec. 14,
1993 <sup>3</sup>			
(Shinohara)	(Japanese published		

application)

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consider the recitations of a "distinctly colored" gasket in lines 3 and 12 of claim 1 (as reproduced in this decision) as repetitious. Correction of these informalities is in order upon return of this application to the jurisdiction of the examiner.

<sup>3</sup> In determining the teachings of Shinohara, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellants' convenience. Any reference in this decision to Shinohara by page is to this translation.

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The following rejections are before us for review:

(I) claims 1, 4 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Babuder in view of Shinohara;<sup>4</sup> and

(II) claims 2, 3, 5, 6, 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamaji.

The full text of the examiner's rejections and the responses to the arguments presented by appellants appear in the final rejection (Paper No. 5), the answer (Paper No. 12) and the supplemental answer (Paper No. 15), while the complete statement of appellants' arguments can be found in the main and reply briefs (Paper Nos. 11 and 14, respectively).<sup>5</sup>

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and

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<sup>4</sup> As a result of the amendment filed May 9, 1996 (Paper No. 6), the examiner has withdrawn the rejection of claims 1, 4 and 7 under 35 U.S.C. § 102 based on Babuder and added rejection (I)(answer, page 2). In addition, the examiner has designated rejection (I) as a new ground (answer, page 4).

<sup>5</sup> Appellants also filed a corrected brief on September 23, 1999 (Paper No. 19), which includes the name of the real party in interest and information regarding related appeals and interferences.

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claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Rejection (I)

We turn first to the examiner's rejection of claim 1 based on 35 U.S.C. § 103(a) as being unpatentable over Babuder in view

of Shinohara. After considering the collective teachings of Babuder and Shinohara, we agree with the examiner that the claimed invention would have been obvious to one of ordinary skill in the art at the time of appellants' invention.

Shinohara discloses a pipe coupling comprising first and second tubular coupling members 1 and 2, a ring-shaped gasket 3, a nut 4 for fixing the second coupling member to the first coupling member with the gasket enclosed between opposed end faces of the first and second coupling members (pages 5 and 6). The nut 4 is also disclosed as including liquid escape holes 22 (page 7). Shinohara also specifically teaches that the gasket 3 may be made of copper (page 6).

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Figures 1 and 2 of Shinohara show that when the first and second coupling members are fixed to one another by means of the nut 4 with the gasket 3 enclosed between opposed end faces of the first and second coupling members 1 and 2, the escape holes 22 are radially aligned with the gasket 3 and the opposed end faces of the first and second coupling members. Appellants do not argue that the escape holes 22 shown by Shinohara are not radially aligned with the "abutting" end faces of the joint members. Instead, appellants argue at page 2 of the reply brief that there is no teaching or suggestion in Shinohara that the holes or ports 22 should be used for viewing the gasket. We must point out, however, that the recitation in claim 1 of an inspection window "for viewing said gasket" merely sets forth a function which the ports or holes 22 in Shinohara must be capable of performing and it is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, the claim reads on the prior art device regardless of whether there was a recognition that it could be used to perform the claimed function. See, e.g., In re

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Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Here, in view of the fact that the ports or holes 22 in Shinohara are radially aligned with the tubular coupling members 1, 2 and gasket 3 when the nut 4 is properly tightened, there is a sound basis to conclude that Shinohara's ports or holes 22 are inherently capable of being used in the claimed manner, i.e., for viewing the gasket. Whether Shinohara's ports or holes 22 actually are or might be used in such a manner depends upon the performance or non-performance of a future act of use, rather than upon a structural distinction in the claims. Stated differently, the ports or holes 22 of Shinohara would not undergo a metamorphosis to a different structure simply because they were used in a pipe joint in the claimed manner. See In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) and Ex parte Masham, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

While Shinohara does not expressly disclose the material or materials suitable for manufacturing the first and second tubular coupling members 1 and 2, it is our opinion that the threaded connection between the nut and coupling member 1 and the annular protrusions 7 and 8 on the end faces of the

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coupling members 1 and 2 would have suggested the use of a metal with sufficient strength to withstand the shear and compressive stresses necessarily created when the nut 4 is "tightened with a wrench or other tool" (Shinohara, page 5). It is undisputed that stainless steel was well known in the art at the time of appellants' invention for its superior strength and resistance to corrosion and, specifically, for its use in the manufacture of tubular coupling members such as shown by Shinohara.<sup>6</sup> In light of Shinohara's teaching, one of ordinary skill in the art would have been motivated to select stainless steel for manufacturing the first and second coupling members in order to obtain the self-evident advantages of that particular material. In this regard, we observe that an artisan must be presumed to know something about the art apart from what the references disclose (see In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of

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<sup>6</sup> Appellants even acknowledge that it was well known in the art prior to their invention to manufacture tubular joint members in a pipe coupling of stainless steel (see, for example, appellants' specification, page 1, lines 5 and 6).

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ordinary skill in the art (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is presumed on the part of those practicing in the art. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

We are informed by appellants' specification that stainless steel is silver white in color. Copper is, of course, copper-colored. Thus, the gasket 3 shown in Shinohara, when made of copper as suggested by Shinohara, would inherently be "distinctly colored making the gasket discernable from" the stainless steel joint members 1 and 2.

In view of the above analysis, Shinohara, alone, teaches or suggests each and every limitation of claim 1. Assuming, for argument sake, that Shinohara does not suggest joint members made

of stainless steel, Babuder specifically teaches, inter alia, a fluid coupling or pipe joint having first and second coupling components 10 and 12 manufactured from stainless steel (col.

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6, lines 38-40). In view of Babuder's teaching, it is our opinion that it would have been obvious to a person of ordinary skill in the art at the time of appellants' invention to make the joint members 1 and 2 in Shinohara of stainless steel in order to achieve the self-evident advantages thereof.

Appellants' argument at pages 2 and 3 of the reply brief that the provision of a nut tightening quantity display device 5 in Shinohara "flies in the very face of using the ports 22" as windows for inspection purposes is unpersuasive. The nut tightening quantity display device 5 in Shinohara simply assists in preventing excessive or insufficient tightening of the nut (page 11). It does not indicate whether or not the gasket has been properly installed.

For the reasons set forth above, we will sustain the rejection of claim 1 under § 103(a) over Babuder and Shinohara.

Appellants have not challenged the rejection of claim 4 with any reasonable specificity, thereby allowing claim 4 to fall with

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claim 1 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)). Likewise, dependent claim 7 has not been separately argued by the appellants. Accordingly, claim 7 will be treated as falling with parent claim 1. Thus, it follows that the rejection of claims 4 and 7 under 35 U.S.C. § 103(a) will also be sustained.

Although our analysis of the prior art is considered from the standpoint of utilizing Shinohara as the primary reference, the question of which reference is relied upon as the primary reference is of no moment since the pertinent disclosures of both Shinohara and Babuder have been pointed out to appellants. See In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 267 (CCPA 1961). However, inasmuch as the basic thrust of our affirmance of the 35 U.S.C. § 103(a) rejection of claims 1, 4 and 7 differs from the rationale advanced by the examiner for the rejection, we hereby designate the affirmance of the rejection of claims 1, 4 and 7 to be a new ground of rejection pursuant to 37 CFR

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§ 1.196(b) to allow the appellants a fair opportunity to react thereto (see In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)).

### Rejection (II)

We next turn to the examiner's rejection of claims 2, 3, 5, 6, 8 and 9 based on 35 U.S.C. § 103(a) as being unpatentable over Yamaji.<sup>7</sup>

It is the examiner's position that Yamaji discloses all of the claimed subject matter, except for the particular material of the gasket or retainer (final rejection, page 3). The examiner concluded that

[i]t would have been obvious . . . to coat the gasket or retainer with an oxide film or resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. (Final rejection, pages 3 and 4)

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<sup>7</sup> In that claims 2, 3, 5, 6, 8 and 9 depend, directly or indirectly, from either independent claim 1 or 4, it is not clear why claims 1 and 4 were not included in this rejection.

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The examiner adds that "since the oxide film is naturally occurring the stainless steel seal/retainer will inherently tarnish with time thus providing a distinct color" (final rejection, page 4).

We cannot support the examiner's position. We are informed by appellants' specification (pages 1 and 2) that in prior art pipe joints it is difficult to discern whether or not the gasket is provided between the end faces of the two joint members because the joint members and gasket are similarly colored. Accordingly, the claimed pipe joint solves a known problem in the art. Compare In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975) wherein the court indicated that the rationale of "obvious matter of design choice" applies when a modification is made which "solves no stated problem." Therefore, we do not agree that the examiner has a valid basis for asserting that it would have been an obvious matter of "design choice" to coat the gasket or retainer with an oxide film or resin.

We note further that Yamaji is silent with respect to the material used to make the joint members 3, 4, the gasket 5 and

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the retainer 14. We also fail to find any teaching or suggestion in Yamaji that the material used to make the gasket and retainer

will tarnish or oxidize whereas the material used to make the joint members will not. When relying upon the theory of inherency, the examiner has the initial burden of establishing a

basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. See Ex parte Levy, 17 USPQ2d 1461 (Bd. Pat. App. & Int. 1990). Here, the examiner has failed to provide any explanation why the gasket

or retainer in Yamaji would inherently tarnish while the joint members would not such that the gasket or retainer of Yamaji will inherently assume a distinct color making the gasket (claim 1) or the retainer (claim 4) discernible from the joint members as required by claims 2, 3, 5, 6, 8 and 9.

Accordingly, the rejection of claims 2, 3, 5, 6, 8 and 9 under 35 U.S.C. § 103(a) will not be sustained.

SUMMARY

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The rejection of claims 1, 4 and 7 under 35 U.S.C. § 103(a) is affirmed, but we designate our affirmance as a new ground of rejection pursuant to 37 CFR § 1.196(b).

The rejection of claim 2, 3, 5, 6, 8 and 9 under 35 U.S.C. § 103(a) is reversed.

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

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(b) Appellant may file a single request for rehearing within two months from the date of the original decision. . . .

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), 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.

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If the appellants elect 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 the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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)

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HARRISON, E. McCANDLISH	)	
Senior Administrative Patent Judge	)	
)	)	
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	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JOHN F. GONZALES	)	
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