

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROWLAND W. KANNER

Appeal No. 1998-0832
Application 08/496,760

ON BRIEF

Before CALVERT, GONZALES and JENNIFER D. BAHR, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 8 to 12, all the claims remaining in the application.

The appealed claims are drawn to a process for forming a tube construction, and are reproduced in the appendix of appellant's brief.

The prior art applied in the final rejection is:

Uba et al. (Uba)	4,259,419	Mar. 31,
1981		

Stolzman

5,160,061

Nov. 3,

1992

The admitted prior art on page 1, line 7, to page 3, line 5 of appellant's specification (APA).

Claims 8 to 12 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over the APA in view of either Uba or Stolzman.

Considering first claim 8, the only independent claim on appeal, the examiner's position in a nutshell is that it would have been obvious, in view of Uba or Stolzman, to provide the mounting portion of the shoulder member of the APA with a raised, plastic rib, and that melting of the rib when the sleeve member and shoulder member of the APA are joined would necessarily fill the void between the sleeve member and shoulder member (answer, pages 4 and 5).

Appellant argues that the APA could be combined with Uba or Stolzman only with hindsight because the combination would not solve the problem with which appellant was concerned. This argument is not well taken, because "[a]s long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the

references be combined for the reasons contemplated by the inventor." In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). Here, the motivation for providing a rib on the mounting portion of the APA is found in the suggestion by Uba or Stolzman of the desirability of providing an energy director or concentrator.

Also we find no support in the record for the assertion at page 5 of the brief that it was appellant who discovered that it was the void between the seam and shoulder member which resulted in improper sealing. The APA does not attribute the discovery of the cause of this problem to appellant, but merely states that "With this prior art design, there is a problem of leakage at [the void]" (page 2, lines 18 to 24).

With the neck member shoulder of the APA modified in light of Uba or Stolzman to include a rib as an energy director or concentrator, the question still remains as to whether joining the thus-modified neck member to the sleeve of the APA would result in a method meeting all the steps of claim 8, and in particular, the final step, recited in lines 7 to 9 of the claim, of "melting said plastic rib to cause said rib ... to fill said void and seal said sleeve member and said shoulder member together." The examiner's position is, in effect, that such step

would inherently occur when the modified neck member of the APA was joined to the sleeve.

Unpatentability based on inherency of a claim limitation in the prior art is only established if the limitation would necessarily be present in the prior art, and would be so recognized by persons of ordinary skill. The mere fact that a certain thing may result from a given set of circumstances is insufficient. Electro Medical Sys., S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1020 (Fed. Cir. 1997); In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).¹ In the present case, we do not consider that the final step of claim 8 would inherently be met by the combination of the APA and Uba or Stolzman, for even if the excess material of the melted rib would necessarily go into the void, as the examiner maintains, it would not necessarily fill the void and seal the sleeve member and shoulder member together, as claim 8 requires. As appellant argues on page 6 of the brief, "there is no teaching in [Uba or Stolzman] to size the

¹ Although these cases concern anticipation under § 102(b) rather than obviousness, the question of inherency arises both in the context of anticipation and obviousness. In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995).

energy director to assure sufficient material to fill a void.”
Moreover, neither the APA, Uba nor Stolzman discloses any
dimensions or other information from which one of ordinary skill
in the art would recognize that the void would necessarily be
filled when the sleeve member and shoulder member of the modified
APA apparatus were joined. The fact that the void of the modified
APA apparatus might be filled when the sleeve member and shoulder
member were joined is not sufficient to establish that such
filling would be inherent.

Accordingly, a prima facie case of obviousness has not been
presented. See In re Rijckaert, 9 F.3d 1531, 1532-33, 28 USPQ2d
1955, 1956-57 (Fed. Cir. 1993).

The rejection of claim 8, and of claims 9 to 12 dependent
thereon, accordingly will not be sustained.

Conclusion

The examiner's decision to reject claims 8 to 12 is
reversed.

REVERSED

Appeal No. 1998-0832
Application 08/496,760

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