

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLFGANG KASTNER et al.

Appeal No. 1998-1787
Application No. 08/151,257¹

ON BRIEF

Before STAAB, 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 8 and 11 through 22, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed November 12, 1993.

BACKGROUND

The appellants' invention relates to a pipe (claims 1 through 8 and 11 through 14), a steam generator (claims 15 through 20 and 22), and a heat exchanger (claim 21). An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

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

Koch et al. 1963 (Koch)	3,088,494	May 7,
Jabsen et al. 1978 (Jabsen)	4,124,064	Nov. 7,
Stevens 1980	4,191,133	Mar. 4,
Onishi et al. 1984	4,480,684	Nov. 6,

Claims 1 through 4, 6 through 8 and 12 through 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stevens in view of Onishi.

Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Stevens in view of Onishi as applied to claim 1 above, and further in view of Jabsen.

Claims 1 through 7 and 12 through 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koch in view of Onishi.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Koch in view of Onishi as applied to claim 1 above, and further in view of Stevens.

Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Koch in view of Onishi as applied to claim 1 above, and further in view of Jabsen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 18, mailed September 3, 1997) for the examiner's complete reasoning in support of the rejections, and to the brief

(Paper No. 17, filed July 21, 1997) for the appellants' arguments thereagainst.

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 insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 8 and 11 through 22 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 would

have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require a pipe having an inner wall surface, and ribs disposed on the inner wall surface forming a multiple thread wherein the ribs have a lead equal to between 0.8 and 0.9 times the square root of the mean inside pipe diameter. However, it is our view that these limitations are not suggested by the applied prior art.

In that regard, while Stevens and Koch do teach a pipe having an inner wall surface, and ribs disposed on the inner wall surface forming a multiple thread, Stevens and Koch do not teach or suggest the ribs having a lead equal to between 0.8 and 0.9 times the square root of the mean inside pipe

diameter. Accordingly, the examiner relied on the teachings of Onishi as providing the evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. However, the mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. See In re Fitch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We have reviewed the teachings of Onishi and fail to find any motivation therein that would have suggested modifying Stevens' or Koch's ribs to have a lead equal to between 0.8 and 0.9 times the square root of the mean inside pipe diameter. Thus, it is our view that the only suggestion for modifying Stevens or Koch in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates,

Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 through 8 and 11 through 22.²

² We have also reviewed the reference to Jabsen additionally applied in the rejection of claim 11 but find nothing therein which makes up for the deficiencies of the applied prior discussed above.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 8 and 11 through 22 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB)	
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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APPEAL NO. 1998-1787 - JUDGE NASE
APPLICATION NO. 08/151,257

APJ NASE

APJ McQUADE

APJ STAAB

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 09 Sep 99

FINAL TYPED: