

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HELMUT SCHIWEK

Appeal No. 1999-2845
Application No. 08/495,471

ON BRIEF

Before CALVERT, 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 17 to 61. Claims 62 to 66 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. Claims 1 to 16 have been canceled.

We AFFIRM-IN-PART.

Appeal No. 1999-2845
Application No. 08/495,471

Page 2

BACKGROUND

The appellant's invention relates to a safety container for storing and transporting environmentally hazardous, in particular explosive substances (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Held	2,305,923	Dec.
22, 1942		
Stewart	3,650,431	Mar. 21,
1972		

Claims 17, 18, 24 to 33, 37 to 44 and 47 to 60 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Held.

Claims 19 to 23, 34 to 36, 45, 46 and 61 stand rejected under 35 U.S.C. § 103 as being unpatentable over Held in view of Stewart.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 14, mailed September 29, 1998) and the answer (Paper No. 20,

mailed May 11, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 19, filed March 29, 1999) and reply brief (Paper No. 21, filed June 14, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We sustain the rejection of claims 17, 18, 24 to 33, 37 to 44 and 47 to 60 under 35 U.S.C. § 102(b).

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference.

See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Claim 49

Claim 49 reads as follows:

A safety apparatus for oil tankers and ships for storing and transporting hazardous material comprising a container and glass wool filling in the container.

Held's invention relates to receptacles such as tanks, cans or similar containers for combustible liquids, such as petrol, benzole, ethylether or the like, having a low boiling point and forming explosive vapors, and more particularly to tanks of vehicles, such as motor cars, airplanes and the like (column 1, lines 1-7). Held's object was to develop a tank which offers maximum safety against explosions (column 1, lines 8-11). As shown in Figure 1, Held teaches (column 2, lines 1-38) the use of a tank 1 having a charging and discharging opening 2, which may be closed by a lid 3. In the interior of the tank 1 there is arranged a number of vertical and horizontal partitions 4 which consist of wire cloth, perforated sheets, etc., which are well permeable to the liquid but which have the necessary strength in order to keep a glass wool filling in proper position and to prevent the glass wool filling from being upset and sticking together. The space between the partitions 4 is filled up with loose glass wool 8 in such a manner that preferably the whole interior of the tank, except for a small space 9 underneath the inlet 2 which is provided with a perforated cylindrical body 10, is filled with glass wool.

It is our determination that claim 49 reads on Held and accordingly claim 49 is anticipated by Held. In that regard, we read claim 49 on Held as follows: A safety apparatus for oil tankers and ships for storing and transporting hazardous material (the receptacle disclosed by Held's Figure 1 is a safety apparatus clearly capable of the recited intended use of being for oil tankers and ships for storing and transporting hazardous material) comprising a container (Held's tank 1) and glass wool filling in the container (Held's glass wool filling 8 in the tank 1).

The argument presented by the appellant in the brief (pp. 9-15) and the reply brief (pp. 1-2) does not convince us that the subject matter of claim 49 is novel. The appellant is correct that Held's tank 1 does include partitions 4 defining individual chambers or cells filled with glass wool 8. However, we fail to find any limitation in claim 49 (or for the matter claim 17) that would preclude the claimed container from having a supporting structure therein (e.g., the

appellant's supports 16, 17 (see Figure 2), Held's partitions 4, etc.). Thus, the claimed subject matter is not distinguishable from Held's tank 1 with partitions 4 defining individual chambers or cells filled with glass wool 8. As to the appellant's allegation (brief, p. 13) that "Held will inherently have areas with the liquid in the material and areas with free flowing liquid thereby leading away from the claimed invention in which the liquid is uniformly stored in the mat," we note first that arguments in a brief cannot take the place of evidence (In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974)) and second that the argument is not commensurate in scope with the claimed invention. Likewise, the appellant's argument that Held is silent on "**bonded** glass wool" is not commensurate in scope with the claimed invention since bonded glass wool is not claimed.

Since all the limitations of claim 49 are disclosed in Held for the reasons set forth above, the decision of the examiner to reject claim 49 under 35 U.S.C. § 102(b) is affirmed.

Claims 17, 18, 24 to 33, 37 to 44, 47, 48 and 50 to 60

The decision of the examiner to reject claims 17, 18, 24 to 33, 37 to 44, 47, 48 and 50 to 60 under 35 U.S.C. § 102(b) is also affirmed since the appellant has not argued separately the patentability of any particular claim apart from the others, thus allowing claims 17, 18, 24 to 33, 37 to 44, 47, 48 and 50 to 60 to fall with claim 49 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); and 37 CFR § 1.192(c)(7) and (8)(iv)).

The obviousness rejection

We will not sustain the rejection of claims 19 to 23, 34 to 36, 45, 46 and 61 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d at 591, 18 USPQ2d at 1091 and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The teachings of Held have been set forth above. Stewart discloses a safety container in which a bulked or textured filamentary plastic material is employed to reduce explosion hazard and/or as a anti-sloshing means.

The examiner found (final rejection, p. 3) that Stewart teaches "that it was known to provide a coating binder as set forth at column 1, lines 70+." The examiner then determined that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to "modify the 'glass wool' of Held to include a binder, as taught by Stewart."

The appellant argues (brief, pp. 15-19, and reply brief, pp. 2-3) that the examiner has not presented a prima facie case of obviousness with respect to claims 19 to 23, 34 to 36, 45, 46 and 61 since there is no suggestion to combined the applied prior art to arrive at the claimed invention. We agree. We have reviewed the teachings of Stewart (especially those set forth at column 1, lines 70+) and fail to find any teaching "that it was known to

provide a coating binder." In our view, the teachings of Stewart would not have suggested modifying the glass wool of Held to include a binder but instead would have suggested replacing the glass wool in Held's tank with a bulked or textured filamentary plastic material.

With regard to claim 19 and its dependent claims (i.e., claims 20 to 23, 45 and 46), it is clear to us that the subject matter of claim 19 (i.e., a coating on the glass wool comprising a binder, a resin, a hardener, methylpolysilane, a dust-collecting agent, and silicone) is not suggested by the applied prior art. The examiner has not even alleged that the subject matter of claim 19 would have been obvious at the time the invention was made to a person having ordinary skill in the art from the applied prior art. In this regard, we note that the examiner has not pointed to any teaching in the applied prior art of a coating including the recited hardener, methylpolysilane, dust-collecting agent and silicone.

With regard to claim 34 and its dependent claim (i.e., claim 35), it is clear to us that the subject matter of claim

34 (i.e., a compressed air source connected to the container)
is not suggested by the applied prior art. The examiner has
not alleged

that the subject matter of claim 34 would have been obvious at the time the invention was made to a person having ordinary skill in the art from the applied prior art.¹

With regard to claim 36, it is clear to us that the subject matter of claim 36 (i.e., an inert gas chamber in the container)² is not suggested by the applied prior art. The examiner has not even alleged that the subject matter of claim 36 would have been obvious at the time the invention was made

¹ While the examiner has stated (final rejection, p. 4) that "[t]he use of an 'inert gas' is deemed old and no teaching is deemed necessary," the examiner never determined that adding a compressed air source connected to Held's tank would have been obvious at the time the invention was made to a person having ordinary skill in the art.

² It is not clear to us where the original disclosure provides written description support (required by the first paragraph of 35 U.S.C. § 112) for the limitation of claim 36. While Figure 1 clearly discloses inert gas containers 19, the specification (p. 19) clearly states that inert gas from the containers 19 is introduced via connection 18 into the interior 10 of the container 7. Thus, the inert gas containers 19 are not an inert gas chamber within the container as set forth in claim 36. The examiner should determine whether or not claim 36 is in compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112.

to a person having ordinary skill in the art from the applied prior art.³

With regard to claim 61, it is clear to us that the subject matter of claim 61 (i.e., a latticework of glass fibers surrounding walls of the ships, wherein the latticework has a hydrophobic binder coating) is not suggested by the applied prior art. The examiner has not alleged that the subject matter of claim 61 would have been obvious at the time the invention was made to a person having ordinary skill in the art from the applied prior art. In this regard, we note that the examiner has not pointed to any teaching in the applied prior art of a latticework of glass fibers wherein the latticework has a hydrophobic binder coating.

³ While the examiner has stated (final rejection, p. 4) that "[t]he use of an 'inert gas' is deemed old and no teaching is deemed necessary," the examiner never determined that adding an inert gas chamber in Held's tank would have been obvious at the time the invention was made to a person having ordinary skill in the art.

For the reasons set forth above, the decision of the examiner to reject claims 19 to 23, 34 to 36, 45, 46 and 61 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 17, 18, 24 to 33, 37 to 44 and 47 to 60 under 35 U.S.C. § 102(b) is affirmed and the decision of the examiner to reject claims 19 to 23, 34 to 36, 45, 46 and 61 under 35 U.S.C. § 103 is reversed.

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

IAN A. CALVERT)
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)	
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Appeal No. 1999-2845
Application No. 08/495,471

Page 18

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