

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN SIGMUNDSTAD

Appeal No. 2000-0560
Application No. 08/578,636

HEARD: May 16, 2000

Before CALVERT, FRANKFORT and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 9, 10 and 12 through 15, which are all of the claims in the application.

We AFFIRM, but designate our affirmance as a new rejection pursuant to 37 CFR § 1.196(b).

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The subject matter on appeal is directed to a sealing arrangement for a swivel device used, for example, to allow the transfer of hydrocarbons between a marine riser connected to a buoy and a tube system on a tanker (specification, page 1). Specifically, the appellant's specification describes a swivel structure having an inner or male swivel member 3 and an outer or female swivel member 2, one of which is provided with a peripheral groove 16 or 48 receiving a radially displaceable ring element 17 or 47 which is provided with a sealing means 18 or 49 arranged for static sealing against the other swivel member, a dynamic sealing means 19 or 51 and a supply channel 20 for a barrier liquid, e.g., hydraulic oil (page 2 and Figures 3 and 4). In the embodiment illustrated in Figure 3, the barrier liquid in supply channel 20 communicates with static sealing means 18 through passages provided in swivel member 3, including ring groove 16 and ring element 17 (page 6) and with dynamic sealing means 19 through a small gap between the sealing surfaces of the ring element 17 and the ring groove 16 (page 7). In the embodiment illustrated in Figure 4, the barrier liquid in supply channel 50 communicates with static sealing means 49 through a

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buffer volume (unnumbered) at the bottom of the ring groove 48 provided in swivel member 46 and openings in ring element 47 and with dynamic sealing means 51 through passages in swivel member 46, including ring groove 48 (page 8).

A copy of the appealed claims is appended to the main brief (Paper No. 26).

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Harvey et al. (Harvey)	4,662,657	May
5, 1987		

Claims 9, 10 and 12 through 15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 9, 10 and 12 through 15 stand rejected under 35 U.S.C. § 102(b) as anticipated by Harvey.

The full text of the examiner's rejections and the response to the arguments presented by the appellant appear in the answer (Paper No. 27), while the complete statement of the appellant's arguments can be found in the main and reply

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briefs (Paper Nos. 26 and 28, respectively).

OPINION

In reaching our decision on the issues raised in this appeal, this panel of the Board has carefully considered the appellant's specification and claims, the applied patent and the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Turning first to the standing rejection under 35 U.S.C. § 112, second paragraph, it is our determination that claim 9 is indefinite, although for reasons that differ somewhat from those set forth by the examiner.

The examiner considers claims 9, 10 and 12 through 15 to be indefinite because "[s]ufficient structural relationships of the various elements have not been provided. The numerous 'adapted to . . .' recitations do not provide positive structure" (answer, page 3). The appellant, on the other hand, argues that "[t]he fact that some of the structural relationships between these features are defined by how the

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parts are to be interconnected in a final assembly, if assembled, does not render the claims indefinite." (main brief, page 5).

The second paragraph of § 112 requires that the claims particularly point out and distinctly claim the subject matter which an appellant regards as his invention. This is essentially a requirement for precision and definiteness of claim language so that the claims make clear what subject matter they encompass and thus what a patent, if granted, precludes others from doing. See In re Conley, 490 F.2d 972, 975, 180 USPQ 454, 456 (CCPA 1974). We agree with the appellant (reply brief, page 2) that there is nothing intrinsically wrong with employing "functional" limitations to define something by what it does rather than by what it is. In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971). However, for the following reasons, we believe that the claims fail to make clear what group of parts form the claimed sealing arrangement and thus lack the precision

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and definiteness required by § 112, second paragraph.

The body of claim 9 is drafted in such a way that it appears to be directed to the combination of a static seal, a dynamic seal, a barrier liquid supply, at least one swivel member and a ring element. For example, claim 9 calls for "a barrier

liquid supply communicating with said static and dynamic seals." As explained above, the underlying specification identifies the barrier liquid supply as the channels 20 and 50 and the means by which the barrier liquid supply communicates with the static and dynamic seals as various openings or passages formed in one of the swivel members 2 or 3, including grooves 16 and 48, and passages formed in the ring elements 17 and 47. Thus, according to the underlying specification, in order to have a barrier liquid supply communicating with static and dynamic seals, there must be certain structure, i.e., a swivel member provided with a supply channel and passages, including a groove, interconnecting the supply channel with the static and dynamic seals and a ring element

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provided with passages.

In contrast to the scope of the body of claim 9, the preamble is directed to the seal arrangement per se.¹ This is confirmed by the file record wherein appellant states that:

Applicant's claim language has been further clarified so as to recite a sealing arrangement per se comprising a combination of features including "static and dynamic seals being hydraulically activated by a barrier liquid" (claim 9). The "inner and outer, mutually rotatable swivel members", the "ring element" and the "fluid" being

transferred by the swivel members are part of the environment in which Applicant's sealing arrangement may be used. As such, these elements provide a frame of reference for describing the relationships between, and the functions performed by, the features of Applicant's invention, and do not themselves form part of Applicant's invention. (Emphasis added)²

The scope of the body of claim 9 is therefore inconsistent with the preamble, thus rendering the claim indefinite.

Because of this inconsistency between the body and preamble, it is unclear what elements of the swivel and sealing arrangement are being claimed.

¹ Claim 9 recites "[a] sealing arrangement for a swivel . . ."

² Appellant's remarks filed March 23, 1998 (Paper No. 17, pages 4-5).

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For the reasons set forth above, it is our determination that claim 9 fails to make clear what subject matter it encompasses. Thus, we will sustain the rejection of claim 9 under § 112, second paragraph.

Claims 10 and 12 through 15 are also indefinite because each claim is dependent, directly or indirectly, on claim 9 and, thus, includes the same indefinite language referred to above. Thus, it follows that the rejection of claims 10 and 12 through 15 under 35 U.S.C. § 112, second paragraph, will also be sustained.

However, inasmuch as the basic thrust of our affirmance of

the 35 U.S.C. § 112, second paragraph, rejection of claims 9, 10 and 12 through 15 differs from the rationale advanced by the examiner for the rejection, we hereby designate the affirmance of the rejection of claims 9, 10 and 12 through 15 to be a new ground of rejection pursuant to 37 CFR § 1.196(b) to allow the appellant a fair opportunity to react thereto (see In re

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Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)).

While we might speculate as to what group of parts form the claimed sealing arrangement, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art as we are obliged to do. Rejections under 35 U.S.C. § 102 should not be based upon "considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims." In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Accordingly, we are constrained to reverse, pro forma, the examiner's rejection of claims 9, 10 and 12 through 15 under 35 U.S.C. § 102(b). We hasten to add that this is a procedural reversal rather than one based upon the merits of the § 102(b) rejection.

CONCLUSION

To summarize, the decision of the examiner to reject claims 9, 10 and 12 through 15 under 35 U.S.C. § 112, second

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paragraph, is affirmed, but we have designated our affirmance as a new ground of rejection pursuant to 37 CFR § 1.196(b); the decision of the examiner to reject claims 9, 10 and 12 through 15 under 35 U.S.C. § 102(b) is reversed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

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:

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

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37 CFR § 1.196(b) also provides that the appellant, 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 appellant 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.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application,

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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
37 CFR 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

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