

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN F. MCJONES, JOSEPH U. TLEIMAT,
and J. WILLIAM JONES

Appeal No. 2000-1280
Application No. 09/110,785

ON BRIEF

Before CALVERT, McQUADE, and JENNIFER BAHR, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 20, all the claims in the application.

The claims on appeal are drawn to a reinforced tube joint (claims 1 to 9), and a method for fabricating such a joint

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(claims 10 to 20), and are reproduced in the appendix of appellants' brief.¹

The references applied in the final rejection are:

Boice 1959	2,917,822	Dec. 22,
Apblett, Jr. 1979	4,175,779	Nov. 27,

Claims 1 to 20 stand finally rejected as unpatentable over Apblett in view of Boice, under 35 U.S.C. § 103(a).

The basis of the rejection, as explained by the examiner on pages 4 and 5 of the answer, is:

Apblett, Jr. discloses the claimed device with first tube 44, stress collar 48 fitted about the first tube with the end of the first tube extending beyond the collar and into a second tube or weldolet 46 which is secured via weld 52 to both the tube and the collar.^[2] Apblett differs from the present invention in that inner diameter of collar 48 is just slightly larger than the outer diameter of the first tube 44 (see column 4, lines 45-50 and is therefor not in an interference fit therewith.

¹ In reviewing the claims, it appears that in claims 3 and 12 appellants intended "first tube" (first occurrence) to be --stress collar--. See page 6, lines 20 to 22 of the specification.

² The joint disclosed by Apblett appears to be essentially the same as that disclosed in appellants' Fig. 2, which is described as being in accordance with the prior art, and should be so labeled. MPEP § 608.02(g).

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Boice discloses that it is known in the art to provide a similar type coupling having the configuration of the first tube 2 extending beyond the collar 9 on body second tube 4 wherein the collar 9 is press fit onto the first tube 2. See column 3, lines 1-5. It would have been obvious to one having ordinary skill in the art at the time the invention was made to press fit collar 48 onto tube 44 of Apblett, Jr. such as taught by Boice, in order to provide a more secure coupling for the inserted tube and further to insure the two elements stay together during the welding process.

After fully considering the record in light of the arguments presented in appellants' brief and reply brief, and in the examiner's answer, we conclude that the examiner's position is not well taken. Boice discloses a different type of joint from that of Apblett, and although Boice discloses in a general way holding a collar 9 to be welded in position by means of a shrink (interface) fit, we do not consider that this would suggest to one of ordinary skill in the art that the collar 48 of Apblett be held in position in the same manner. Apblett discloses that the inner diameter of the collar is "just slightly larger" than the outer diameter of tube (pigtail) 44 (col. 4, lines 46 to 49), and attributes to this arrangement displacement of the point of maximum bending movement of tube 44 from weld 51 to the free end 48a of the

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collar (col. 6, lines 9 to 19). Absent any teaching or suggestion that providing an interference fit would favorably (or at least not adversely) affect the location and/or magnitude of the stress in the tube, i.e., would not increase the failure problem which Apblett's joint was intended to solve (col. 1, lines 31 to 39), one of ordinary skill would not have found it obvious to shrink fit collar 48 on to tube 44 simply for ease of assembly.

However, notwithstanding our disagreement with the examiner's position, we will sustain the examiner's position because independent claims 1 and 10 are both readable on Boice. The Boice patent discloses first and second tubes 2, 1, a collar 9 fitted with an interference fit about first tube 2 (col. 3, lines 3 to 6) with the end portion 12 of tube 2 extending beyond the end 11 of collar 9 (as shown in Fig. 2, the ends are tapered inwardly, see col, 2 lines 24 to 28), and second tube 1 having fitting 4 rigidly connected to the ends of collar 9 and first tube 2 by weld 14. While this is tantamount to a holding that claims 1 and 10 are anticipated by Boice under

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35 U.S.C. § 102(b), the § 103 rejection will be sustained since "The complete disclosure of an invention in the prior art is the ultimate or epitome of obviousness." In re Avery, 518 F.2d 1228, 1234, 186 USPQ 161, 166 (CCPA 1975). The rejection of dependent claims 2 to 9 and 11 to 20 will likewise be affirmed, inasmuch as appellants have grouped them with their respective parent claims (brief, page 4).

Although we will sustain the § 103 rejection, we will designate our action as a new ground of rejection pursuant to 37 CFR § 1.196(b), since the basis of our conclusion of unpatentability differs from that of the examiner. Cf. In re Meyer, 599 F.2d 1026, 1031, 202 USPQ 175, 179 (CCPA 1979).

Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claim 9 is additionally rejected for failure to comply with 35 U.S.C. § 112, second paragraph. Reading claim 9 on appellants' disclosure, it requires the end 12a of the second tube (furnace tube 12) to be welded to the stress collar 118 and the end portion of the first tube 16. While this is consistent with appellants' disclosure at page 4, lines 22 and 23, and page 8, lines 1 to 4, that in some instances a fitting may not be used, it is

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inconsistent with parent claim 1, which requires a fitting. This inconsistency between claim 9 and the specification renders the claim indefinite. See In re Cohen, 438 F.2d 989, 993, 169 USPQ 98, 98 (CCPA 1971).

Conclusion

The examiner's decision to reject claims 1 to 20 is affirmed, but the affirmance is designated a new ground of rejection under 37 CFR § 1.196(b). Claim 9 is also rejected pursuant to 37 CFR 1.196(b) on an additional ground.

In addition to affirming the examiner's rejection of one or more claims, this decision contains new grounds 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 "new grounds of rejection shall not be considered final for purposes of judicial review."

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

(b) Appellants 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 appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds 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.

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

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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)

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Administrative Patent Judge)
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