

Ex parte Yamamoto et al.

File

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte HIDEO YAMAMOTO and
MITSUO YAMAMOTO

JAN 30 1997

Appeal No. 95-0160
Application 07/927,953¹

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before COHEN, LYDDANE and FRANKFORT, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1, 2 and 4 through 9, which are all of the claims remaining in the application.

The subject matter on appeal is directed to an apparatus for discharging a surface liquid. Claims 1 and 6 are exemplary of

¹ Application for patent filed August 11, 1992.

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the invention and a copy thereof, as they appear in the appendix to the appellants' brief, has been appended to this decision.

The references of record relied upon by the examiner in rejections of the claims under 35 USC 103 are:

Sumimoto et al. (Sumimoto)	3,395,803	Aug. 6, 1968
Panosh	3,633,749	Jan. 11, 1972
Baffert et al. (Baffert)	4,301,008	Nov. 17, 1981
Galletti	5,059,312	Oct. 22, 1991
Christie	5,104,528	Apr. 14, 1992

Claims 1, 2 and 5 stand rejected under 35 USC 103 as being unpatentable over either of Galletti or Baffert in view of Panosh.

Claims 6, 8 and 9 stand rejected under 35 USC 103 as being unpatentable over either of Galletti or Baffert in view of Panosh and Christie.

Claims 4 and 7 stand rejected under 35 USC 103 as being unpatentable over either of Galletti or Baffert in view of Panosh, Christie and Sumimoto.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellants, we refer to pages 2 through 6 of the examiner's answer and to pages 4 through 11 of the appellants' brief for the full exposition thereof.

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OPINION

At the outset, we note that appellants have chosen not to argue the patentability of dependent claims 2, 5, 8 and 9 with any reasonable specificity. Accordingly, these claims stand or fall with the claims from which they depend. See In re Nielson, 816 F.2d 1567, 1570, 2 USPQ2d 1525, 1526 (Fed. Cir. 1987). We note that 37 CFR 1.192(c)(6) requires that the argument specify the errors in the rejection including any specific limitations in the rejected claims which are not described in the prior art relied on. Merely including a list of dependent claims along with the arguments directed to a claim or claims from which they depend is not sufficient.

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellants' specification and claims, the applied prior art, and the respective positions advanced by the appellants and the examiner. With respect to the applied references, we have considered all of the disclosure of each reference for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, we have taken into account not only the specific teachings of each

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reference, but also the inferences which one skilled in the art would have reasonably been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). On the basis of the knowledge and level of skill in the art at the time of appellants' invention, as reflected by the applied references, it is our conclusion that the examiner's rejections of claims 1, 2, 4, 5 and 9 under 35 USC 103 are well founded, but that those of claims 6 through 8 under 35 USC 103 are not. Our reasoning for this determination follows.

With respect to the rejection of appealed claims 1, 2 and 5 under § 103 based on the teachings of Galletti or Baffert in view of the teachings of Panosh, the examiner has taken the position that both Galletti and Baffert

disclose devices for discharging surface liquid with a float and damming plate, substantially as claimed, but disclose a sliding relationship between the float and the reservoir instead of flexible walls laterally exposed to the liquid [answer, paragraph spanning pages 2 and 3].

The appellants do not dispute this finding by the examiner, and we find no error in this finding ourselves.

The examiner then takes the position that the patent to Panosh discloses a float type surface liquid collecting device similar to that of Galletti and Baffert but which utilizes

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flexible walls laterally exposed to the liquid to form the seal for the reservoir within which the float is buoyantly supported.

The examiner concludes that it would have been obvious to one having ordinary skill in the art to modify the devices of Galletti and Baffert to include the use of laterally exposed flexible walls as suggested by Panosh "to prevent the heavier component from entering the reservoir without the friction and potential leakage of the seals required by a sliding wall configuration" (answer, page 3). We agree.

The appellants have argued on pages 4 through 7 of the brief that

Galletti and Baffert cannot be combined with Panosh, since Galletti and Baffert rely on the rigidity of their nested members to get the results that Galletti and Baffert consider to be important [brief, page 5, emphasis in original],

that "Panosh has rigid nested members similar to what is found in Galletti and Baffert" (page 5, emphasis in original), and that

the Examiner has ignored not only what both Galletti and Baffert consider to be essential features of their inventions, but what they consider to be great advantages of their inventions [brief, page 5, emphasis in original].

Notwithstanding the appellants' arguments, it is our opinion that the use of a flexible member to sealingly connect the base portion to the float portion of a liquid collection and discharge

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device whereby the flexible member is exposed laterally to the liquid environment is an art recognized alternative to the telescoping members disclosed by Galletti and Baffert, as taught by Panosh and by the admitted prior art discussed in column 1, lines 17 through 25 of Baffert. As noted by appellants, Baffert does state in column 1, lines 26 through 31 that the prior art bellows, or flexible membrane has the disadvantage that "its size needs to be specially adapted to the sizes of the spillway and the vat" and that "the material from which the seal is made is not necessarily compatible with the chemical aggressiveness of the medium in which it is immersed" (emphasis added).

Nevertheless, one of ordinary skill in the art would certainly have considered the self-evident advantages of such a flexible sealing member pointed out by the examiner, i.e., (1) to prevent the heavier liquid component from entering the reservoir without substantial friction and (2) to eliminate potential leakage of the seals required by the sliding wall configurations of Galletti and Baffert, and would have found such a flexible wall seal an obvious modification to the devices of Galletti and Baffert where size was not an issue and/or where the material of the flexible seal and the particular liquid were not incompatible.

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Furthermore, it is our opinion that any such incompatibility of the liquid and the flexible seal material or of the sizing of the float, reservoir and sealing member would be readily overcome by proper selection of the material and size of the seal. We note that the law presumes skill on the part of the artisan rather than the converse. See In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985).

We make the additional observation that the device of Panosh includes every element recited in appealed claim 1 except that the second end of the flexible member 24 (Figure 1) is connected to the inner portion of the float 32 rather than to the outer peripheral portion of the float as recited in claim 1 and that the float is thus not buoyantly supported by the liquid in the reservoir defined by the space delimited by the base 22, the flexible member 24, and the float 32. However, it is clear that both Galletti (Figure 2) and Baffert (The Figure) teach that it is well known in the art of collecting and discharging a surface liquid, via a floating, expandable reservoir, to provide the float members within the upper portion of the reservoir so that the float members are buoyantly supported by the liquid therein. Thus, we further conclude that one having ordinary skill in the art would have found it obvious to modify the device of Panosh by

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attaching the flexible member 24 thereof to the outer peripheral portion of the float 32 so that the float is buoyantly supported by the liquid within the reservoir as taught by Galletti and Baffert. Where a rejection is predicated on a combination of references, each containing pertinent disclosure which has been pointed out to the appellants, it is merely a matter of exposition that the rejection is stated to be on A or B in view of C instead of on C in view of A or B; such differing forms of expression do not constitute different grounds of rejection. See In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 267 (CCPA 1961).

In the final analysis, the test for obviousness, which is set forth in In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981), is what the combined teachings of the references would have suggested to those of ordinary skill in the art. Considering the collective teachings of Galletti, Baffert and Panosh in the manner set forth above, it is our conclusion that appellants' claimed invention as a whole, as set forth in appealed claim 1, would have been obvious to one having ordinary skill in the art at the time of the appellants' invention. Thus, we shall sustain the examiner's rejection of appealed claim 1 under 35 USC 103, as well as the rejections of claims 2, 5 and 9 under § 103 which stand or fall therewith.

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Turning next to the rejection of claims 6 and 8 under 35 USC 103 as being unpatentable over either of Galletti or Baffert in view of Panosh and Christie, we note that independent claim 6 is similar to appealed claim 1 but also includes the recitations of

a damming plate, provided on and surrounding the outer peripheral portion of said float...said damming plate being fixed to the second end of said flexible member

and

a liquid inlet between said float and said damming plate for entry into said reservoir of liquid flowing over the top of said damming plate.

The examiner takes the position that an inlet between a float and a damming plate is taught by the patent to Christie. We cannot agree. As the appellants have correctly argued on pages 7 and 8 of the brief, in the embodiment of Figures 1 through 3 of Christie the liquid flows under the dam formed by float 32 and into discharge opening 40 and in the embodiment of Figures 4 and 5 of Christie the liquid flows under the dam formed by baffle 110 and into the discharge opening 40. There is simply no teaching or suggestion in Christie, or in any of the other applied prior art, of appellants' claimed damming plate and liquid inlet between the float and damming plate.

We observe that rejections based on §103 must rest on a factual basis with these facts being interpreted without

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hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Our reviewing court has also repeatedly cautioned against employing hindsight by using the applicants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). Absent a factual basis, as here, we cannot sustain the examiner's rejection of claim 6, or of claims 7 and 8 dependent thereon, under 35 USC 103.

Lastly, considering the rejection of appealed claim 4 under 35 USC 103 based on the combined teachings of Galletti, Baffert, Panosh and Sumimoto, which claim is directed to the flexible member of claim 1 formed as a "bellows cylinder," we note that the patent to Baffert clearly discloses that flexible membranes connecting movable portions of prior art liquid collecting and discharging devices have been formed "by a bellows" (column 1,

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line 22). It is our opinion that one having ordinary skill in the art would have found it obvious to configure a device for collecting and discharging liquid formed in accordance with the collective teachings of Galletti, Baffert and Panosh as set forth above by forming the flexible member thereof as a bellows in view of such knowledge clearly present in the prior art, and we shall therefore sustain the examiner's rejection of appealed claim 4 under 35 USC 103. We regard the examiner's application of the teachings of Sumimoto in this rejection as mere surplusage.

Accordingly, the decision of the examiner rejecting claims 1, 2, 4, 5 and 9 under 35 USC 103 affirmed, but the decision rejecting claims 6 through 8 under 35 USC 103 is reversed.

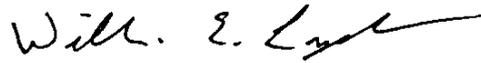
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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART



IRWIN CHARLES COHEN)
Administrative Patent Judge)

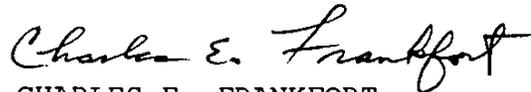


WILLIAM E. LYDDANE)
Administrative Patent Judge)

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APPENDIX

1. An apparatus for discharging a surface liquid, comprising:
a base arranged in a liquid and having an outer peripheral portion;

a flexible member having a first end, which is fixed to said base at the outer peripheral portion thereof, and a second end, said flexible member being exposed laterally to the liquid environment external to said apparatus;

a float disposed above said base and having an outer peripheral portion, which is fixed to the second end of said flexible member, and a liquid inlet;

a liquid reservoir formed in a space delimited by said base, said flexible member and said float, for receiving the surface liquid which flows in from the liquid inlet of said float, said float buoyantly supported by the liquid in said reservoir, the upper outer peripheral portion of said float functioning as a damming plate and being moved above and below the level of the liquid by ascent and descent of said float; and

a liquid discharge pipe open to the interior of said liquid reservoir for discharging the surface liquid received in said liquid reservoir to the exterior of the liquid.

6. An apparatus for discharging a surface liquid, comprising:
a base arranged in a liquid and having an outer peripheral portion;

a flexible member having a first end, which is fixed to said base at the outer peripheral portion thereof, and a second end, said flexible member being exposed laterally to the liquid environment external to said apparatus;

a float disposed above said base and having an outer peripheral portion;

a damming plate, provided on and surrounding the outer peripheral portion of said float, for being moved above and below the level of liquid by ascent and descent of said float, said damming plate being fixed to the second end of said flexible member;

a liquid reservoir formed in a space limited by said base, said flexible member and said damming plate, for receiving surface liquid, said float buoyantly supported by the liquid in said reservoir;

a liquid inlet between said float and said damming plate for entry into said reservoir of liquid flowing over the top of said damming plate; and

a liquid discharge pipe open to the interior of said liquid reservoir for discharging the surface liquid received in said liquid reservoir to the exterior of the liquid.