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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

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PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GINO COCCHI

Appeal No. 95-1344
Application 07/888,843[1]

ON BRIEF

Before COHEN, STONER AND STAAB, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 and 2, as amended subsequent to the final rejection. Claim 4, the only other claim remaining in the application,

[1] Application for patent filed May 27, 1992.

stands withdrawn from consideration by the examiner pursuant to 37 CFR 1.142(b).

As an initial matter, we address the "REQUEST FOR CONSIDERATION OF ORDER DENYING REQUEST TO RESET HEARING DATE" (hereafter, request). The referenced order of April 5, 1995 denied a request filed April 4, 1995 for rescheduling the oral hearing set for April 4, 1995. A chronology of events follows.

Counsel for appellant was scheduled to appear before this panel of the board at 9:00 AM on April 4, 1995 for an oral hearing (Paper No. 26). At approximately 8:30 AM on the day of the hearing, this panel was advised by a member of the staff of the Board of Patent Appeals and Interferences (BPAI) that counsel's office was requesting rescheduling because of a mistake regarding the date of the hearing. This panel was aware that counsel was with a local firm. Under the circumstances known to us at that time, we decided to accommodate the situation and permit counsel to appear by 11:00 AM to present oral argument. Counsel was so notified, but did not appear before this panel for oral argument.

The BPAI received a FAX transmission (Paper No. 28) from counsel's firm at 3:30 PM on the afternoon of the hearing date of April 4, 1995 requesting that the hearing be rescheduled, however briefly, even one day, for reasons specified.

On April 5, 1995, Mr. Dale M. Shaw, Program and Resources Administrator for the BPAI, responded to the request for rescheduling the hearing by sending counsel an "ORDER DENYING REQUEST TO RESET HEARING DATE" (Paper No. 29). In that order, Mr. Shaw pointed out, inter alia, that no reason has been given as to why the attorney assigned to argue the case or another attorney associated with the firm could not have adequately presented oral argument on the scheduled hearing day.

On April 10, 1995, counsel filed the present request, including respective declarations of Marvin Petry and Kevin J. Dunleavy.

In the request, the error that occurred regarding the hearing date has been characterized as "unavoidable human error". The documentation available to us clearly indicates that the database relied upon by the administrative personnel at counsel's firm accurately indicated the hearing date as April 4, 1995. What is not mentioned, however, is any practice of administrative personnel notifying counsel of a particular hearing date days in advance of the hearing date. In particular, it appears that administrative personnel did not inform or remind Mr. Dunleavy of the hearing date of April 4, 1995 days before the hearing. If a practice of informing or reminding counsel were in place, it would have, of course, remedied the apparent oral misunderstanding between Mr. Petry and Mr. Dunleavy, as reflected

in the respective declarations. Accordingly, the error that occurred cannot be simply dismissed as "unavoidable human error".

The application file specifies Mrs. Linda R. Poteate as an Associate Attorney in the present application (Paper No. 27). The declarants both identify Mrs. Poteate as the former Linda Ring, whose name appears on papers submitted in the application. As understood from declarant Petry's statements, Mrs. Poteate is acknowledged to have actually handled most of the prosecution in the present case, especially during the latter stages thereof, <u>including the briefs before the Board of Patent Appeals and Interferences</u>. Thus, it is readily apparent to us that Mrs. Poteate was already very familiar with the present case on the day of the scheduled hearing. There is no indication given that she was other than available on April 4, 1994 to deliver an oral argument before this panel of the board. It is clear from declarant Petry that Mrs. Poteate was not viewed as having the "considerable experience" in making oral argument, as did Mr. Dunleavy. However, nothing presented in the request or declarations reveals to us any convincing reason as to why, under the circumstance where Mr. Dunleavy was clearly unable to present appellant's case, Mrs. Poteate could not have ably presented oral argument on April 4, 1995.

In the request, the point is made that our decision to reschedule the hearing to 11:00 AM to accommodate counsel was essentially equivalent to not rescheduling the hearing at all. Of particular importance, is the clear indication given in the request that "it probably would have been adequate to reschedule the hearing for the end of the day". We are unaware as to why this panel of the board was not informed by counsel on April 4, 1995 that an argument could be presented later in the day.

Having considered each of the views articulated in the request in conjunction with the respective statements of declarants Petry and Dunleavy, we conclude that counsel for appellant was clearly capable of presenting oral argument to this panel of the board on the scheduled date of April 4, 1995. Therefore, the "REQUEST FOR CONSIDERATION OF ORDER DENYING REQUEST TO RESET HEARING DATE" is granted to the extent of considering the order, but is <u>denied</u> with respect to making any change therein.

We turn now to the merits of appellant's appeal.

Appellant's disclosed invention pertains to a method of manufacturing a tubular heat exchanger for use in a refrigerating unit. A basic understanding of the invention can be derived from

a reading of exemplary claim 1, a copy of which is appended to this opinion.[2]

As evidence of obviousness, the examiner has relied upon the references listed below:[3]

Carter	4,960,170	Oct. 2, 1990
Jordon et al (Published European Patent Application) (Goodrich)	395,080	Oct. 31, 1990

Additional references of record which we rely upon in a new ground of rejection, infra, are:

Dewald	2,004,387	Jun. 11, 1935
Geppelt et al (Geppelt)	5,092,038	Mar. 3, 1992 (filed Nov. 21, 1990)

The following rejections are before us for review.

Claims 1 and 2 stand rejected under 35 USC 103 as being unpatentable over Goodrich in view of Carter.

In the main answer, the examiner introduced the following new ground of rejection.

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[2] Claim 1, as it appears in the appendix to the brief, has been superseded by a further amended version of claim 1 as it appears in the "AMENDMENT AFTER EXAMINER'S ANSWER" (Paper No. 21). A copy of the further amended version is appended to this opinion. We note that this further amended version errs in indicating that claim 1 has been amended once when the record reveals that this further amended version is the third amended version of original claim 1.

[3] The examiner's answer failed to list the applied references in section (7) Prior Art of record, but the rejections specify by name the references applied.

Claims 1 and 2 stand rejected under 35 USC 103 as being unpatentable over appellant's admitted prior art (AAPA) in view of Carter.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the main and supplemental answers (Paper Nos. 19 and 22), while the complete statement of appellant's argument can be found in the main (pages 3 through 8), reply, and supplemental reply briefs (Paper Nos. 18, 21, and 23).

In the main brief (page 2), appellant points out that claim 2 is deemed to be separately patentable as argued and, therefore, does not stand or fall with claim 1.

OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, we have carefully considered appellant's specification and claims, the applied references, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection based upon Goodrich and Carter

We do not sustain this rejection of appellant's claims 1 and 2 under 35 USC 103 based upon Goodrich and Carter.

We certainly appreciate the examiner's understanding of the applied teachings, and the manner in which it is proposed that

they would have been combined by one having ordinary skill in the art. However, the difficulty that we have with the rejection is that based upon the particular teachings relied upon, we do not discern that these teachings would have by themselves motivated one to make the proposed combination.

The Goodrich disclosure evidences a heat exchanger configured as a composite of steel components held rigidly together. On the other hand, the finned tube product of Carter (Figure 1) is a composite of components intended to be fabricated from materials with differing coefficients of thermal expansion. More specifically, the prior art arrangement of Carter (column 1, lines 26 through 31 and column 2, lines 39 through 49), as assembled, includes an aluminum fin fitted within a helical groove in a steel tube which fin would be expected in use to expand outwardly in the groove, but still remain in contact with the tube.

Absent appellant's own teaching, we are of the view that one having ordinary skill in the art would not have been motivated to modify the method of manufacturing the heat exchanger of Goodrich, as proposed. We reach this conclusion for the reason that, unlike the heat exchanger of Goodrich, one of ordinary skill would have viewed the specific teaching of Carter as focused upon the fabrication of a composite product wherein materials utilized have significantly different thermal

coefficients and are expected to move relative to one another in use.

The rejection based upon AAPA and Carter

We do not sustain this rejection of appellant's claims 1 and 2 under 35 USC 103 founded upon AAPA and Carter.

We rely upon the same reasons articulated above relative to the examiner's first rejection under 35 USC 103 in concluding that, absent appellant's own disclosure, the teaching of Carter would not have been suggestive of modifying the AAPA, as proposed by the examiner.

New ground of rejection

Under the authority of 37 CFR 1.196(b), this panel of the board introduces the following new rejection.

Claims 1 and 2 are rejected under 35 USC 103 as being unpatentable over Goodrich in view of Geppelt and Dewald.

As claimed, it is readily apparent to us that appellant's method of manufacturing a tubular heat exchanger is one that, while intended for use with a refrigerating unit, may or may not be used with same.

The Goodrich document discloses a method of manufacturing a tubular heat exchanger from steel components, as claimed, except for the forming of the groove into a portion of the inner cylindrical sleeve and the winding of the spiral strip in screw-thread fashion in said groove.

We consider the fabricated heat exchanger configuration of Goodrich to certainly be capable of use in connection with a refrigeration unit. Further, it is our view that the inlets and outlets 25 and 26 of Goodrich would have been suggestive of the claimed tubular unions.

Geppelt instructs us (column 4, lines 54 through 66) that, at the time appellant's invention was made, those of ordinary skill in the heat exchanger art considered the known practices of welding a spiral fin onto the surface of a tube wall (Figure 3) and securing a spiral fin within a groove in a tube wall (Figure 4) to be alternate attachment arrangements. Dewald, an earlier patent, likewise teaches the well known securement procedure in the heat exchanger art of attaching a metal fin to a metal tube by anchoring the fin within a groove formed in the tube.

As is evident from the applied teachings, each was concerned with the problem in the heat exchanger art of attaching a spiral component to a tube.

In applying the test for obviousness,[4] we reach the conclusion that it would have been obvious to one having ordinary skill in the art, from a combined consideration of the applied

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[4] 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 588, 18 USPQ2d 1089 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

teachings, to replace the method step of forming a welded connection for the continuous strip or support 21 of Goodrich (Figure 2) with the method steps of forming a groove in the tube and winding the strip in the groove. In our opinion, the incentive on the part of one having ordinary skill in the heat exchanger art for making this modification would simply have been to gain the benefits of this well known alternate procedure, e.g., the self-evident advantage of avoiding the use of welding equipment and a welding procedure.

In summary, this panel of the board has

denied the "REQUEST FOR CONSIDERATION OF ORDER DENYING REQUEST TO RESET HEARING DATE",

reversed the rejection of claims 1 and 2 under 35 USC 103 as being unpatentable over Goodrich in view of Carter, and

reversed the rejection of claims 1 and 2 under 35 USC 103 as being unpatentable over the admitted prior art (AAPA) in view of Carter.

Additionally, we have introduced a new rejection of appellant's claims pursuant to 37 CFR 1.196(b).

The decision of the examiner is reversed.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR 1.197). Should appellant elect to

have further prosecution before the examiner in response to the new rejection under 37 CFR 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a). See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

REVERSED
37 CFR 1.196 (b)

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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BRUCE H. STONER JR.) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
LAWRENCE J. STAAB)
Administrative Patent Judge)

Appeal No. 95-1344
Application 07/888,843

Larson and Taylor
727 Twenty-Third St. South
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Appeal No. 94-1344
Application 07/888,843

APPENDIX

CLAIM 1

1. (Amended) A method of manufacturing a tubular heat exchanger for use in a refrigerating unit, comprising the steps of:

forming a helical groove [on the] extending from an outer wall surface and into a portion of an inner cylindrical steel sleeve to a depth less than a thickness of said inner cylindrical sleeve;

winding a flat strip of annealed mild steel in screw-thread fashion in said groove to form a screw-thread shaped member;

heating an outer cylindrical steel sleeve to allow insertion of the inner cylindrical steel sleeve with the screw-thread member therein;

shrink-fitting the previously heated outer cylindrical steel sleeve onto the crests of said member with the outer sleeve to thus form an interference fit and a fluid-tight annular space between said inner and outer cylindrical steel sleeves; and

forming, at opposed ends of said outer cylindrical steel sleeve, tubular unions for connection to a refrigerating unit.