

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(2) is not binding precedent of the Board.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. 66

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SPEED SHORE CORPORATION

Appeal No. 97-0813
Application 90/003,056¹

ON BRIEF²

Before COHEN, MEISTER and FRANKFORT, Administrative Patent Judges.

¹ Request filed May 12, 1993, Control No. 90/003,056, by Speed Shore Corporation for the Reexamination of Patent No. 5,096,334, issued March 17, 1992, based on application Serial No. 07/590,143, filed September 28, 1990.

² A request for an oral hearing (Paper No. 56) was subsequently waived (Paper No. 64).

Appeal No. 97-0813
Application 90/003,056

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

The present appeal in this reexamination proceeding for U.S. Patent No. 5,096,334 involves claims 9 and 10, under final rejection. In an earlier appeal during this reexamination proceeding, this panel of the board rendered a decision³ which affirmed rejections of claims 1 through 3 and 11, claims 5 and 6, claim 7, and claim 8, and reversed rejections of claims 4, 9, and 10.⁴ We also introduced a new ground of rejection for dependent claims 9 and 10 in accordance with 37 CFR § 1.196(b). In the current appeal exclusively involving amended claims 9 and 10, their content

³ Decision in Appeal No. 95-0623 (Paper No. 41). The content of the opinion in this earlier decision is incorporated herein.

⁴ As to the affirmed rejections, appellant did not request reconsideration within the one month period from the date of the earlier decision; 37 CFR § 1.197. The present decision is a final action on those affirmed rejections and establishes the effective date of the affirmance for purposes of appellant's right of judicial review under 35 U.S.C. §§ 141 or 145.

Appeal No. 97-0813
Application 90/003,056

differs from the earlier versions thereof previously before us for review.

The invention of claims 9 and 10 involves a device for shoring the walls of an excavation. A complete understanding of the invention can be derived from a reading of these claims, as they appear in the EXHIBIT "A" APPENDIX attached to the entered reply brief of November 7, 1996 (Paper No. 57).⁵

In rejections of claims 9 and 10 under 35 U.S.C. § 103, the examiner relies upon the following references:

Druml	2,987,890	June 13, 1961
Benning	3,922,866	Dec. 2, 1975
Griswold	4,058,983	Nov. 22, 1977
Krings	4,376,599	Mar. 15, 1983

"SPEED SHORE" Brochure, eight page color brochure (the U.S. Brochure).

"PILE BUCK STEEL SHEET PILING DESIGN MANUAL" (Pile Buck Manual), pages 1, 16, 27, 65, 85, and 127 (1987).

⁵ During any further prosecution before the examiner, the claims should be appropriately modified to conform to reexamination amendment requirements. See 37 CFR § 1.121(f) and MPEP § 2250.

Appeal No. 97-0813
Application 90/003,056

The rejections which follow are before us for review.

Claim 10 stands rejected under 35 U.S.C. § 112, first paragraph.

Claims 9 and 10 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over the U.S. Brochure in view of Krings and the Pile Buck Manual for the reasons set forth in the earlier decision of the Board mailed October 31, 1995 (Paper No. 41), further in view of Benning and Griswold.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over the U.S. Brochure in view of Krings and the Pile Buck Manual for the reasons set forth in the earlier decision of the Board mailed October 31, 1995 (Paper

Appeal No. 97-0813
Application 90/003,056

No. 41), further in view of Benning and Griswold, as applied to claim 9 above, and additionally in view of Druml.⁶

The full statement of the specified rejections and the response to the argument advanced by appellant can be found in the main and supplemental answers (Paper Nos. 51 and 62), while the text of appellant's argument appears in the main and reply briefs (Paper Nos. 50 and 57).

OPINION

This panel of the board has carefully assessed the specification, drawing, and claims⁷ of the patent undergoing

⁶ This rejection of claim 10 was denominated a new ground of rejection by the examiner on page 5 of the answer (Paper No. 51).

⁷ Claim 9, line 8, sets forth a "trench." Considering the recitation of an "excavation" in claim 9, as well as in parent claim 1, we understand the trench as denoting the excavation. Claim 10 refers to "said" solid corrugated aluminum narrow panels, based, of course, upon the earlier recited "solid panels of extruded corrugated aluminum" of claim 9. However,
(continued...)

reexamination, the applied prior art references,⁸ and the respective viewpoints presented by appellant and the examiner, as part of our consideration of the particular issues on appeal. As a consequence of our review, we make the following determinations.⁹

⁷(...continued)

the noted language of claim 10 lacks the "extruded" recitation and the specified language of claim 9 lacks the "narrow" recitation. These obviously inadvertent latter omissions should be rectified during any further prosecution before the examiner. Additionally, we understand claim 9 to set forth "panels," i.e., more than one panel for each one of the pair of shield members, since claim 10 recites that the "panels" further overlap each other along the length of each of said shield members.

⁸ In our evaluation of the applied teachings, we have considered all of the disclosure of each teaching 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, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

⁹ A number of amendments have been entered subsequent to the final rejection, i.e., the amendment dated May 21, 1996 (Paper No. 48) entered as acknowledged on pages 2, 3 of the main answer (Paper No. 51), and the amendment forming part (APPENDIX) of the reply brief dated November 7, 1996 (Paper No. 57), entered pursuant to the decision on petition dated October 29, 1996 (Paper No. 55). However, the examiner has
(continued...)

Appeal No. 97-0813
Application 90/003,056

The rejection under 35 U.S.C. § 112, first paragraph

We reverse this rejection of claim 10.

It appears to us that the examiner is relying upon the description requirement portion of 35 U.S.C. § 112, first paragraph, in this rejection. The description requirement is separate and distinct from the enablement requirement. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the

inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal

⁹(...continued)
not appropriately altered the rejections, as set forth in the main answer, in accordance with the language now present in the claims on appeal, as they appear in the APPENDIX of Paper No 57. Therefore, in the respective rejections on appeal under 35 U.S.C. § 112, first and second paragraphs, we will treat each of the points raised.

Appeal No. 97-0813
Application 90/003,056

support in the specification for the claim language. Further, the content of the drawings may also be considered in determining compliance with the written description requirement. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The examiner asserts that there is no antecedent basis in the specification for the terminology now used to define the "support means" and the "support members" set forth in paragraph (b), lines 1 and 2 of claim 10. However, claim 10 on appeal, as set forth in the APPENDIX to the reply brief (Paper No. 57), now includes the term "wales" in place of the recitation of "support members." The term "wales" has a descriptive basis in the original disclosure (columns 5 and 6) and clearly denotes rails for mounting or supporting the telescoping cross members, for example. Thus, based upon the current language of claim 10,

Appeal No. 97-0813
Application 90/003,056

the preceding point raised by the examiner is not well founded.

The examiner also indicates that the underlying specification lacks support for the limitation in claim 10 (paragraph (b), lines 2 and 3) of each of the narrow panels of the shield members being affixed "independently." We disagree. As pointed out by appellant (main brief, page 10), we readily perceive that the specification (column 6, line 67 to column 7, line 2) fairly supports the language of the aforementioned recitation.

The examiner also refers to the term "narrow" in paragraphs (a) and (b) of claim 10 as a word of degree, lacking a positive definition in the specification, and therefore rendering the scope of the claimed subject matter indeterminate. While the examiner raises this concern within a first paragraph rejection under 35 U.S.C. § 112, it appears

Appeal No. 97-0813
Application 90/003,056

to us that the second paragraph is also in point.
Nevertheless, we determine that a rejection under 35 U.S.C. §
112 based upon the first or second paragraphs is
inappropriate. Clearly the term "narrow" has descriptive
support in the specification (35 U.S.C. § 112, first
paragraph); for example, see column 6, lines 16, 56, and 66.
As to the meaning of the word narrow, in the context used by
appellant, we

understand it as representing the "narrower profile" or
"thinner profile" of the cross-section of the corrugated wall
(column 4, lines 17 through 27 and column 7, lines 3 through
12) which
provides additional room within an excavation, as compared to
previous combinations. The specification (column 6, lines 56,
57 and column 7, lines 3, 4) informs us that a basic narrow
segment utilizes the small dimension of a total section height
of 1.38 in. Thus, a narrower profile for the wall thickness
(column 11, lines 42 through 45), as disclosed, is 1.38 in.
Accordingly, the recitation of "narrow" in claim 10 must be

Appeal No. 97-0813
Application 90/003,056

read and understood in light of the aforementioned disclosure. As such, we consider the meaning of the term "narrow," at issue in claim 10, to be ascertainable and, therefore, definite.

The examiner also finds no support in the specification for the recitation that the manifold and valve means "maintains said shield means in fixed positions irrespective of the stability of the soil." This language does not appear in the current form of claim 10 on appeal. Thus, the rejection is not well founded on this latter basis.

Based upon our above assessment of the language of claim 10, the examiner's rejection under 35 U.S.C. § 112, first paragraph, must be reversed.

The rejection under 35 U.S.C. § 112, second paragraph

We reverse the rejection of claims 9 and 10 under 35 U.S.C. § 112, second paragraph.

Appeal No. 97-0813
Application 90/003,056

The examiner's concern for the recitation of "sheeting" is moot, since it does not appear in the current form of claim 9.

As to claim 10, the asserted double inclusion issue is likewise moot, since the current form of claim 10 lacks such a double inclusion.

For the above reasons, claims 9 and 10 are definite.

The rejections under 35 U.S.C. § 103

We reverse the examiner's rejection of claim 9.

This panel of the board fully comprehends the examiner's assessment of the applied prior art teachings, and the manner in which it is proposed that they be combined. However, for the reasons set forth below, we are not in accord with the examiner's conclusion of obviousness.

Appeal No. 97-0813
Application 90/003,056

Dependent claim 9 (APPENDIX of Paper No. 57) is drawn to a device for shoring the walls of an excavation comprising, inter alia, a shield means comprising a pair of opposing, rigid shield members containing solid panels of extruded corrugated aluminum with upper and lower edges and cap and skid elements affixed to the upper and lower edges of the shield members to provide a substantial increase in rigidity and positive protection for the shield means as well as to eliminate setting or digging of the panels into the trench, thereby allowing the shield members to move freely within the excavation.

Considering the applied teachings of the U.S. Brochure, Krings, the Pile Buck Manual, Benning, and Griswold together, as a whole, we do not perceive therefrom that one having ordinary skill in the art would have derived the suggestion to so modify the skeleton box arrangement of the U.S. Brochure to effect a device for shoring the walls of an excavation, as claimed. To reiterate, claim 9 requires each of a pair of opposed rigid

Appeal No. 97-0813
Application 90/003,056

shield members to contain solid panels of corrugated aluminum, with cap and skid elements affixed to the upper and lower edges of the shield members to provide a substantial increase in rigidity and to eliminate setting or digging of the panels into

the trench (excavation) thereby allowing the shield members to move freely within the excavation. This claim language corresponds to the expressly stated intended purpose of the cap and skid elements as set forth in the underlying specification (column 4, lines 27 through 34, and column 6, lines 20

through 31). The evidence simply fails to teach and would not have been suggestive of rigid shield members, wherein each member contains panels of corrugated aluminum, with cap and skid elements affixed to the shield members to provide a substantial increase in the rigidity thereof and to allow the shield members to move freely within an excavation, as claimed. Notwithstanding the teachings of Krings, Griswold and Benning, in particular, when it comes to a device for shoring the walls of an excavation relying upon panels of corrugated aluminum for each of a pair of shield members,

Appeal No. 97-0813
Application 90/003,056

only appellant teaches cap and skid elements therefor for the advantages, as disclosed and claimed. For these reasons, the rejection of claim 9 is reversed.

As to the rejection of claim 10 under 35 U.S.C. § 103, a claim dependent from claim 9, we find that the additional teaching of Drum1 does not overcome the deficiencies of the other applied prior art as discussed, supra. Therefore, we likewise reverse the rejection of claim 10.

Since we have determined that the evidence does not support a conclusion of obviousness relative to claims 9 and 10 on appeal, we need not evaluate the "Objective Indicia of Non-obviousness" relied upon by appellant in the main brief (pages 12 through 17).

In summary, this panel of the board has:

Appeal No. 97-0813
Application 90/003,056

reversed the rejection of claim 10 stands under
35 U.S.C. § 112, first paragraph;

reversed the rejection of claims 9 and 10 under
35 U.S.C. § 112, second paragraph, as being indefinite;

reversed the rejection of claim 9 under 35 U.S.C. §
103 as being unpatentable over the U.S. Brochure in view of
Krings, the Pile Buck Manual, Benning, and Griswold; and

reversed the rejection of claim 10 under 35 U.S.C.
§ 103 as being unpatentable over the U.S. Brochure in view
of Krings, the Pile Buck Manual, Benning, Griswold, and Druml.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)
Administrative Patent Judge)

Appeal No. 97-0813
Application 90/003,056

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