

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* OWEN WALMSLEY

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Appeal No. 97-4247  
Application No. 08/190,618<sup>1</sup>

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ON BRIEF

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Before CALVERT, ABRAMS and CRAWFORD, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

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<sup>1</sup>Application for patent filed January 3, 1994. According to appellant, this application is a continuation of Application 07/696,260 filed April 30, 1991, now abandoned; which is a continuation of Application 07/356,672 filed May 3, 1989, now abandoned; which is a continuation of Application 07/099,671 filed September 21, 1987, now abandoned; and which is a continuation of Application 06/710,063 filed March 11, 1985, now abandoned.

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**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 15-27, which constitute all of the claims remaining of record in the application.

The appellant's invention is directed to a clamp for gripping an elongate member such as a pipe. The subject matter before us on appeal is illustrated by reference to claim 15, which has been reproduced in an appendix to the Brief on Appeal (Paper No. 10).

**THE REFERENCES**

The references relied upon by the examiner to support the final rejection are:

Dillon 1939	2,182,797	Dec. 12,
British specification (Atlas) 4, 1951	651,556	Apr.
German patent (Price) 1956	952,307	Oct. 21,
British specification 1977 (Compagnie)	1,478,861	Jul. 6,

**THE REJECTIONS**

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Claims 15 and 17-27 stand rejected under 35 U.S.C. § 103  
as being unpatentable over Dillon in view of Price.

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Claims 15, 17, 19 and 23-27 stand rejected under 35  
U.S.C.

§ 103 as being unpatentable over Atlas in view of Price.

Claim 16 stands rejected under 35 U.S.C. § 103 as being  
unpatentable over Dillon in view of Price and Compagnie, or  
Atlas in view of Price and Compagnie.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in  
the Brief on Appeal.

#### **OPINION**

The test for obviousness is what the combined teachings  
of the prior art would have suggested to one of ordinary skill  
in the art. See, for example, *In re Keller*, 642 F.2d 413,  
425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima*  
*facie* case of obviousness under 35 U.S.C. § 103, it is  
incumbent upon the examiner to provide a reason why one of  
ordinary skill in the art would have been led to modify a  
prior art reference or to combine reference teachings to  
arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ

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972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). The appellant's invention is a clamp for gripping elongate members. It comprises a body having an axis and a surface inclined at an acute angle to the axis, a support having apertures, and movable elements which extend through the apertures for operative engagement with the inclined surface on the one hand and with the outer surface of the elongate member on the other hand. An objective of the appellant's invention is to accommodate differences in the ovality of a pipe-shaped element in a clamp (specification, page 2). This is manifested in independent claims 15 and 19 by the requirement of

the apertures being shaped to permit both axial and radial movement of the elements relative to the support for accommodating ovality of the elongate member when the movable elements move relatively

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along said inclined surface into gripping engagement with the surface of the elongate member, the movable elements being free to move axially within the support apertures and relative to each other a sufficient amount such that the respective movable elements may adopt differing radial and axial positions when gripping the elongate member to accommodate such ovality.

It is the examiner's position that both Dillon and Atlas disclose the basic structure required by claims 15 and 19, except for the elongated apertures, but that it would have been obvious to one of ordinary skill in the art to elongate the apertures in view of the teachings of Price. The appellant disagrees, on the basis that there would have been no suggestion to do so. We agree with the appellant, our reasoning being as follows.

From our perspective, both Dillon and Atlas disclose exactly the type of gripping device over which the appellant believes his invention to be an improvement. While the theory of operation and the structures themselves have much in common with the claimed invention, neither of these references recognizes the problem solved by the appellant, nor do they disclose structure which inherently would solve the problem. In both, the apertures through which the locking balls extend

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clearly are circular, and thus, while they permit radial movement of the balls with respect to the support in which they are mounted, they do not permit the axial movement required by the appellant's two independent claims. This is acknowledged by the examiner (Answer, page 3).

Price discloses a pipe coupling in which a male element (Figure 2) is locked onto a female element (Figure 1) into which it is received. The male element is provided with an annular groove (2) into which are received a plurality of locking balls (3) carried by the female element. The balls extend into the receiving cavity through a plurality of elongated apertures (15). However, the Price coupling is a different type than that of Dillon or Atlas, it operates in a different manner, and the purpose of the elongations in the apertures is far afield from that of the appellant's invention. Initially, it must be recognized that the Price coupling attaches two ends of a pipe, each of which is provided with a fixture. It does not and cannot receive an elongate member of the type with which the two primary references, and the appellant's invention, are intended to operate. The elongated apertures disclosed by Price are for

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the purpose of allowing the balls to be moved axially by the shoulder (24) of the advancing male member into a location where they can be radially displaced into a recess (13), to allow the shoulder to pass. Thereafter, the balls move radially inwardly to seat in the annular groove (2) in the male member, to lock it in place. When gripping the male members, the balls cannot adopt differing radial and axial positions with respect to one another; they all are seated in the groove in identical radial and axial positions.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to perceive any teaching, suggestion or incentive in the applied references which would have led one of ordinary skill in the art to modify the devices of Dillon or Atlas by replacing the round apertures with ones shaped to allow both radial and axial movement. In our opinion, the only suggestion for making such a modification is found in the luxury of first viewing the appellant's disclosure. This, of

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course, is not a permissible basis for a rejection. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

For the above reasons, it is our opinion that the combined teachings of Dillon and Price, and Atlas and Price, each fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in independent claims 15 and 19 and, it follows, with regard to that of the dependent claims. *Compagnie*, cited against claim 16 for its showing of another feature, fails to cure this deficiency.

None of the rejections are sustained.

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The decision of the examiner is reversed.

**REVERSED**

IAN A. CALVERT	)	
Administrative Patent Judge)	)	
)	)	
)	)	
NEAL E. ABRAMS	)	BOARD OF PATENT
Administrative Patent Judge)	)	APPEALS AND
)	)	INTERFERENCES
)	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge)	)	

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