

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW J. O'NEILL
and KENNETH R. DUMONT

Appeal No. 1998-0510
Application 08/742,519¹

ON BRIEF

Before BARRETT, FLEMING, and LALL, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

¹ Application for patent filed November 1, 1996, entitled "Forced Encapsulation Cable Splice Enclosure Including A Container For Exiting Encapsulant," which is a continuation of Application 08/373,356, filed January 17, 1995, now abandoned.

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DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1 and 3-8.

We reverse, but enter a new ground of rejection.

BACKGROUND

The invention relates to an electrical cable splice enclosure which receives an encapsulant through an inlet port and allows escape of the encapsulant through an output port. The output port has a light transmissive container to contain the encapsulant and to provide a visual indicator that the enclosure is filled.

Claim 1 is reproduced below.

1. An electrical cable splice enclosure comprising:

an enclosure shell for enclosing an electrical cable splice and for accommodating a curable encapsulant therein;

said shell including an inlet port for pressurized insertion of said encapsulant and an outlet port for permitting exiting of said encapsulant therefrom upon filling of said enclosure;

a pressure relief valve positioned over said outlet port; and

an outlet container positioned over said pressure relief valve for containing said exiting encapsulant, said container being formed of a light

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transmissive material enabling said exiting encapsulant to be observed.

The Examiner relies on the following prior art:

Wengen	3,138,657	June 23, 1964
Hickinbotham	4,708,938	November 24, 1987
Patel et al. (Patel)	5,171,813	December 15, 1992
DeCarlo et al. (DeCarlo)	5,251,373	October 12, 1993

Claims 1 and 3-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over DeCarlo in view of Wengen, Hickinbotham, and Patel.

We refer to the Final Rejection (Paper No. 12) (pages referred to as "FR__") and the Examiner's Answer (Paper No. 15) (pages referred to as "EA__") for a statement of the Examiner's position and to the Appeal Brief (Paper No. 14) (pages referred to as "Br__") for a statement of Appellants' arguments thereagainst.

OPINION

Claims 1 and 3-8 are grouped to stand or fall together (Br3). Claim 1 is analyzed as representative.

There is no dispute that DeCarlo discloses the subject matter of independent claims 1 and 7 except for the container positioned over the outlet port. The Examiner finds that

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figure 1 of Wengen discloses a splice insulating system including a flexible container 34 coupled to an inlet opening and that Hickinbotham discloses an apparatus having a chamber that can be pressurized to force liquid within the chamber to be expelled via a tube to a plastic bag 50. The Examiner concludes that it would have been obvious "to include the container of Wengen on the outlet port of DeCarlo et al. as taught by Hickinbotham since DeCarlo et al. would have been drawn to these references for the beneficial feature of preventing the exiting encapsulant from dripping on the enclosure" (FR4). The Examiner also concludes that it would have been obvious to make such a container on the outlet port from light transmissive material as taught by Patel "since this will enable observing the point at which liquid flows into the container, and when the container is full" (FR4).

Appellants argue that "the Wengen container is sized and shaped to deliver potting material to the inlet opening of the casing structure, **not** to receive exiting potting material from an outlet opening thereof" (Br5).

This is true. Figure 1 of Wengen relied on by the Examiner does not even have a separate outlet port.

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Nevertheless, figure 2a of Wengen discloses a second opening 37 that "will serve as a vent and observation opening whereby the user may be constantly aware of the depth of potting material which he is creating within the casing structure" (col. 3, lines 25-28). This second opening has a cylindrical wall that might broadly be considered a container that contains encapsulant exiting from the casing. However, claim 1 recites a "pressure relief valve" and such a valve would prevent direct visual observation. Therefore, some add-on structure is required. We find no motivation in Wengen to put a container like container 34 on the outlet port since the depth of the potting material can be directly observed through the opening. Assuming, arguendo, that it would have been obvious to put a container on the outlet port, it presumably would have been a wide container like container 34 which permitted viewing the level from the top and there would have been no necessity for the container to be light transmissive. Accordingly, the Examiner's obviousness rationale is incomplete.

Appellants note that in Hickinbotham the entire content of bag 20 is forced out of the structure into plastic bag 50.

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"Applicants submit that not only is the Hickinbotham reference non-analogous art, but that the structure and its intended function are so different from the structure set forth in pending Claim 1 that no person skilled in the art, in the absence of hindsight, would have found any teaching, suggestion or invention in the art to have used the Hickinbotham structure in the manner advanced by the Examiner." (Br5.)

The Examiner does not respond to the merits of the non-analogous art argument. The Examiner merely restates the test for analogous prior art and restates the rejection (EA6-7).

We find that Hickinbotham is not within the scope of the prior art. It is neither within Appellants' field of endeavor (making cable splices) nor reasonably related to the problem faced by Appellants (preventing the mess from exiting encapsulant while allowing observing of the encapsulant). However, assuming, arguendo, that Hickinbotham is within the scope of the prior art, we fail to see how it would have suggested the claimed subject matter. We agree with Appellants that the function of the bag in Hickinbotham is so

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different from that of the claimed container that the only reason for modifying DeCarlo is improper hindsight gleaned from Appellants' disclosure. The bag in Hickinbotham has nothing to do with capturing overflow of a fill material. Moreover, there is no conceivable reason why the bag in Hickinbotham should be made of light transmissive material since its function is not to permit observation of a fill material.

Appellants further argue that "no person skilled in the art would have utilized the disclosed structure [of Patel] in the manner suggested by the Examiner in the absence of hindsight reconstruction" (Br6).

We agree that there is no apparent motivation to use Patel in combination with the other references absent hindsight.

The Examiner has assembled the claimed subject matter from bits and pieces of the references where the only apparent motivation or suggestion comes from Appellants' disclosure and not from the references or the knowledge of one of ordinary skill in the art. We conclude that the Examiner has failed to

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establish a prima facie case of obviousness. The rejection of claims 1 and 3-8 is reversed.

NEW GROUND OF REJECTION UNDER 37 CFR § 1.196(b)

Although we are reluctant to enter a new ground of rejection at this late stage in the prosecution, we believe a question of patentability exists which needs to be explored.

Claims 1 and 3-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DeCarlo in view of Chilton's Import Car Manual 1991-1995 (Chilton Book Co. 1994), pp. 2-58, 6-74, 14-89, 18-51, and Remling, Brakes (2d ed., John Wiley & Sons 1983), pp. 184-86.

DeCarlo discloses the claimed subject matter of claims 1 and 7 except for a light transmissive container attached to a pressure relief valve. DeCarlo discloses that the escaping encapsulant may be allowed to drip onto the top of the closure upper surface (col. 4, lines 35-39).

Chilton's discloses that in bleeding fluid from a brake system to remove air and old brake fluid, a transparent hose is attached to the bleeder valve and the other end is submerged in a container with clean brake fluid. The

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transparent hose allows observation of when air and the dirty brake fluid has been replaced by clean brake fluid. This bleed arrangement (without a transparent hose) is shown in figure 11.4 of Brakes. Brakes is applied only to show the hose arrangement. Chilton's is within the scope of the prior art because it relates to Appellants' problem of bleeding air from a fluid system and preventing spillage while allowing observation of the exiting fluid. See Graham v. John Deere Co., 383 U.S. 1, 35, 148 USPQ 459, 473-74 (1966) (discussing the plastic finger sprayer patent in Calmar, Inc. v. Cook Chemical Co.: "The problems confronting Scoggins and the insecticide industry were not insecticide problems; they were mechanical closure problems.").

One of ordinary skill in the art of making cable splices would have looked to other pertinent arts for a solution to the problem of containing overflow of the encapsulant from the pressure relief valves 36 during encapsulation in DeCarlo. We also find that "a person having ordinary skill in the art to which said subject matter pertains" under 35 U.S.C. § 103(a) is a person having ordinary skill in the basic mechanical field of the problem facing Appellants, even though

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that person is not working in the field of cable splices. The use of a transparent hose to contain exiting fluid while allowing visual observation of the condition of the exiting fluid was a notoriously well known solution to the problem to mechanics of ordinary skill in the automotive art, which includes persons who do their own repair work, as evidenced by Chilton's. It would have been obvious to one of ordinary skill in the art to provide a transparent hose to the pressure relief valves 36 in DeCarlo to contain the exiting encapsulant in view of Chilton's.

The transparent hose of Chilton's meets the "light transmissive material" limitation of claims 1 and 8, the "elongate hollow tube" limitation of claim 2, the "translucent material" limitation of claim 5, the "transparent material" limitation of claim 6, and "means to observe the interior [of the container]" limitation of claim 7. The "means for attaching said tube to said outlet port" in claim 4 would have been obvious over Chilton's which teaches that the hose for bleeding brakes should have a smaller diameter than the bleeder valve so that it will not leak or slip off.

CONCLUSION

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The rejection of claims 1 and 3-8 is reversed.

A new ground of rejection is entered as to claims 1 and 3-8 pursuant to 37 CFR § 1.196(b).

This decision contains a new ground 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, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 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. . . .

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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).

REVERSED - 37 CFR § 1.196(b)

LEE E. BARRETT)	
Administrative	Patent Judge)
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
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