

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(2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TRACE L. BOYD and ERIC A. TERBEEK

Appeal No. 2000-0484
Application 08/677,401

ON BRIEF

Before CALVERT, STAAB, and CRAWFORD, Administrative Patent
Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3
to 17, 21 and 23 to 34, all the claims remaining in the
application.

The claims on appeal are drawn to a method of making a

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transport chamber (claims 1, 3 to 17 and 25 to 30) and for making a chamber (claims 21, 23, 24 and 31 to 34). They are reproduced in Appendix A of appellants' brief.¹

The references applied in the final rejection are:

Cross 1929	1,699,688	Jan. 22,
Koch et al. (Koch) 1984	4,433,951	Feb. 28,

Claims 1, 3 to 17, 21 and 23 to 34 stand finally rejected as

unpatentable over Koch in view of Cross, under 35 U.S.C.

§ 103(a).

The examiner takes the position that, as to claim 1, Koch discloses all the claimed limitations, except "generating a chamber housing from a rolled forging that is a solid aluminum ring" and "machining a plurality of facets around the chamber

¹ In reviewing the drawings of the application, we note the following, which should be corrected: (1) Figs. 1, 2A and 2B should be labeled "Prior Art," Manual of Patent Examining Procedure § 608.02(g). (2) Reference numerals 500 (p. 13, line 12), 700 (p. 15, line 24) and 706 (p. 16, line 17) are not in the drawings. (3) In Figs. 5B and 7, ports 316 are not properly illustrated. Since the interior of housing 302 is cylindrical and the outside has facets 305, the walls would be of varying thickness, but ports 316 are shown as though the inner and outer wall surfaces are parallel. Also, the upper two ports are not parallel to the upper surface of the chamber.

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housing." He asserts, in essence, that one of ordinary skill would have found it obvious to form the Koch chamber housing 24, which has facets (sides) 32, 34, 36, by machining a forged piece of metal into the configuration of the housing in view of Cross' disclosure that a forged chamber is capable of withstanding greater temperatures and pressures than a welded chamber (page 2, lines 15 to 23). The examiner states that Koch's chamber presumably is formed by welding aluminum sheets, noting appellants' disclosure that such chamber construction (shown in Fig. 2a) is conventional, and also notes appellants' disclosure at page 13, lines 19 to 21, that rolled aluminum forgings were known in the art.

We do not agree with appellants' argument to the effect that Cross is nonanalogous art (brief, page 13), since it satisfies at least the second criterion of the test for analogous art enunciated in In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992), i.e., it is reasonably pertinent to the problem with which appellants were involved, namely, the fabrication of a chamber. Also, appellants' arguments concerning the length of time since issuance of the Cross reference (in 1929) are unpersuasive absent any showing

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that the passage of time is significant. In re Deters, 515 F.2d 1152, 1155, 185 USPQ 644, 647 (CCPA 1975).

Thus, we are basically in agreement with the examiner that, as a general proposition, it would have been obvious to make the chamber 24 of Koch from a forging, in view of the recognition in the art, as evidenced by Cross, that forged chambers are stronger than welded ones. However, the appealed claims call for the chamber housing to be generated from a rolled forging that is a solid aluminum ring (claim 1) or that has a cylindrically shaped wall (claims 21, 25, 31 and 34), and to machine at least one or a plurality of facets thereon, and it is not evident to us why it would have been obvious to one of ordinary skill to make the rectangular chamber 24 of Koch in this fashion. The examiner states that (answer, page 4):

the exact configuration of the forged piece of metal, prior to machining, would have been an obvious matter of engineering design choice, since such configuration per se solves no stated problem nor serves any apparent purpose with regard to forming a chamber housing that is stronger than a welded chamber housing.

Nevertheless, there is no evidence as to why one of ordinary skill would have selected a cylindrical forging as the basis

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for making a rectangular chamber, particularly since it appears that, unlike appellants' chamber, the interior of Koch's chamber must be rectangular to accommodate the apparatus therein. Claims 31 and 34 additionally call for a top plate which has a stepped lip. At page 5 of the answer, the examiner cites Hauer et al. (Patent No. 3,274,671) as evidence of the obviousness of this feature, but this reference will not be considered by us since it was not positively included in the statement of the rejection. Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993).

Accordingly, the rejection of claims 1, 3 to 17, 21 and 23 to 34 will not be sustained.

Rejection Pursuant to 37 CFR § 1.196(b)

(1) Claims 1 and 3 to 17 are rejected for failure to comply with 35 U.S.C. § 112, second paragraph. In lines 18 and 19 of claim 1 it is recited that a second o-ring seal is applied "around a parameter of the chamber housing top surface." It is not apparent what is meant by the term "a parameter" in this context, rendering the scope of claim 1 indefinite.

(2) Claims 21, 23, 24 and 26 to 34 are rejected for failing to comply with the written description requirement of the first

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paragraph of 35 U.S.C. § 112. All of these claims call for machining the top plate and for machining the bottom plate, while claim 34 also recites machining at least one view port hole. We find no disclosure in the application as filed of "machining" the top plate 304, bottom plate 306 or the view port holes 308. Moreover, we do not consider that the disclosure as filed would have made it clear to those skilled in the art that appellants were in possession of this claimed feature, particularly since it does not appear inherent that the top plate, bottom plate and view port holes would have to be made by "machining," but apparently could be made by other methods, such as investment casting. Claim 34 further recites that the top plate has a "grooved stepped lip," but we find no description in the application as filed of lip 402 as being "grooved."

Conclusion

The examiner's decision to reject claims 1, 3 to 17, 21 and 23 to 34 is reversed. Claims 1, 3 to 17, 21, 23, 24 and 26 to 34 are rejected 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

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rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. and 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 appellants, 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 (37 CFR § 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. . . .

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)

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