

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD McKIERNAN, JAMES A. SIGLER
and WILLIAM J. FRIEDMAN

Appeal No. 2000-1230
Application No. 08/717,904

ON BRIEF

Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 3, 12 to 15 and 21. Of the other claims remaining in the application, claim 11 stands withdrawn from consideration as being directed to a nonelected species, and claims 4 to 10 and 16 to 20 are indicated as being allowable if rewritten in independent form.

Appeal No. 2000-1230
Application No. 08/717,904

The claims on appeal are drawn to a boat assembly (claims 1 to 3, 12 and 13) and a sewage holding tank (claims 14, 15 and 21), and are reproduced in the appendix of appellants' brief.

Appellants disclose that in a conventional sewage assembly for a boat, as illustrated in Fig. 1, it has been recognized that pumping out the sewage holding tank 17, which is typically made of plastic, for a period of time after the tank has emptied can result in damage to the tank, or implosion (page 1, lines 5 to 17). Appellants' invention solves this problem by providing a vacuum relief means 40 on the tank, preferably in the form of a vent check valve. Two embodiments of such a valve are disclosed, of which appellants elected the embodiment of Figs. 4 to 7 for prosecution in response to the examiner's requirement for an election of species (Paper No. 4).

The prior art applied in the final rejection is:

Kinsey	1,164,098	Dec. 14,
1915		

Appeal No. 2000-1230
Application No. 08/717,904

The admitted prior art disclosed on pages 1 to 6 of appellants' specification.

Claims 1 to 3, 12 to 15 and 21 stand finally rejected under 35 U.S.C. § 103 as unpatentable over the admitted prior art in view of Kinsey.

Appeal No. 2000-1230
Application No. 08/717,904

First considering claim 1, all the elements recited therein except the last, i.e., "means for providing vacuum relief ... ," are disclosed by appellants as being conventional. The examiner takes the position that it would have been obvious to provide the disclosed conventional holding tank 17 with a vacuum relief means, as claimed, in view of Kinsey's disclosure of a vacuum valve. In particular, the examiner points to Kinsey's disclosure at page 1, lines 14 to 19, that the disclosed valve is

adapted to operate automatically for permitting return of air to a vessel being placed under vacuum to prevent it from collapsing, if for any reason the process of removing the air is carried too far.

Appellants argue that Kinsey does not suggest the structure of claim 1, because it does not provide vacuum relief for a holding tank. The question involved here, however, is whether claim 1 is unpatentable over the combination of the admitted prior art and Kinsey, rather than over Kinsey alone; the test is what the combined teachings of the references would have suggested to those of ordinary skill

Appeal No. 2000-1230
Application No. 08/717,904

in the art. Cable Electric Products, Inc. v. Genmark, Inc.,
770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985).

It is evident from the Kinsey patent that the disclosed valve would be applicable to any enclosure which is in danger of collapsing due to loss of internal pressure, including a "vessel" (page 1, line 16) and a "tank" (page 1, line 106).¹

Thus, since there is a known problem of damage or implosion of the conventional sewage holding tank when being pumped out, and Kinsey teaches the desirability of providing a check valve on a vessel or tank to admit air and prevent collapse of the vessel or tank if too much air is removed therefrom, it would have been obvious to one of ordinary skill in the art to have followed the teaching of Kinsey by providing such a valve on the holding tank in the conventional system disclosed by appellants in order to overcome the damage or implosion problem. Such a conclusion of obviousness is based not on impermissible hindsight gleaned from appellants' disclosure,

¹ The statement on page 1 of the reply brief that "there is absolutely no disclosure in Kinsey, Jr. of a 'tank'" is incorrect.

Appeal No. 2000-1230
Application No. 08/717,904

but upon what the prior art would have suggested to one of ordinary skill in the art.

Appellants argue that there is no prima facie case of obviousness² because even though the Kinsey valve has been available in the art for eight decades prior to appellants' invention, "no one heretofore provided the invention despite the

² A prima facie case of obviousness exists when the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification. In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

Appeal No. 2000-1230
Application No. 08/717,904

fact that a very real problem of implosion exist [sic: existed] within the prior art" (brief, page 7). This argument is not persuasive, absent any showing that the art tried and failed to solve the problem, notwithstanding its presumed knowledge of the references. In re Neal, 481 F.2d 1346, 1347, 179 USPQ 56, 57 (CCPA 1972). Also, as stated in Savoy Leather Mfg. Corp. v. Standard Brief Case Co., Inc., 261 F.2d 136, 138, 119 USPQ 336, 337 (2d. Cir. 1958):

It is as plausible to attribute the six year lapse [between the date of the reference and applicant's invention] to the belief on the part of mechanics in the art that in light of the highly developed state of the art an advance so small as that of [applicant] was not patentable.

Accordingly, the rejection of claim 1, and of claim 2 which appellants have grouped therewith, will be sustained.

Claim 3 recites, inter alia, that the vent check valve comprises "a movable valve element mounted interiorly of . . . said holding tank." Appellants argue that the valve element N of Kinsey is not mounted "interiorly" of the vessel or tank C, as claimed (brief, page 8). The examiner responds that Kinsey's valve element is mounted interiorly of the tank to the same extent that appellants' valve element 153 is, but

Appeal No. 2000-1230
Application No. 08/717,904

appellants disagree, noting that their valve opens inside the tank (as shown in Fig. 6), whereas Kinsey's valve "opens and closes completely exteriorly of the machine part C" (reply brief, page 3). We agree with this argument of appellants, and will not sustain the rejection of claim 3 inasmuch there is no teaching in the applied prior art of mounting the valve element interiorly of the holding tank.

Claim 12 recites that the vacuum relief means is capable of providing a particular sufficient airflow into the tank to prevent damage to the tank. The examiner notes that Kinsey discloses at page 2, lines 56 to 63, that the valve device is adjustable, and we agree with his implicit conclusion that it would have been obvious to adjust the Kinsey valve, when mounted on the conventional holding tank, to allow sufficient air flow to prevent collapse of the tank under the particular operating parameters of the system with which the tank was being used, keeping in mind that preventing collapse of the tank would have been the reason that the valve would have been provided in the first place.

Appeal No. 2000-1230
Application No. 08/717,904

Appellants' argument at page 10 of the brief that the rejection of claim 13 is improper is not understood, in view of the fact that the limitations which claim 13 adds to parent claim 1 are those which appellants have disclosed as being conventional. The argument that one of ordinary skill would not have found it obvious to apply the valve of Kinsey to a plastic tank is not convincing. While the vessel or tank C to which

Appeal No. 2000-1230
Application No. 08/717,904

Kinsey's valve is attached appears to be illustrated as made of metal, the valve itself would obviously be equally applicable to use on a plastic tank.

In view of the foregoing, the rejection of claims 12 and 13 will be sustained.

The rejection of claims 14 and 21 will be sustained for the reasons discussed above in connection with claims 13 and 12, respectively. The rejection of claim 15 will not be sustained for the same reason that the rejection of claim 3 will not be.

Claim 11

In the second Office action (Paper No.6, Feb. 25, 1999), the examiner stated that claim 11 was withdrawn from consideration as being drawn to a non-elected species. Appellants assert on page 11 of the brief that claim 11 should be examined and is patentable because it depends from an allowable generic claim.

We have held above that the rejection of claim 3, from which claim 11 depends, will not be sustained. However, unlike appellants (Response filed Nov. 23, 1998) and the examiner (Paper No.4, Nov. 12, 1998), we do not view claim 3

Appeal No. 2000-1230
Application No. 08/717,904

as being generic to the species of Figs. 3 and 5 to 7. As discussed previously, the recitation of claim 3 that the valve element is mounted "interiorly" of the holding tank is readable on the species of Figs. 5 to 7 because the valve element 153 of that species opens into the tank 17. However, as shown in Fig. 3, the valve element 44 of the species of Fig. 3 does not open into the tank, but rather, like Kinsey's valve element N, "opens and closes completely exteriorly" of the tank (reply brief, page 3). Thus, since the valve element of the species of Fig. 3 is not "mounted interiorly of . . . said holding tank," as recited in claim 3, claim 3 is not generic to both species.

Conclusion

The examiner's decision to reject claims 1 to 3, 12 to 15 and 21 is affirmed as to claims 1, 2, 12 to 14 and 21, and is reversed as to claims 3 and 15.

Appeal No. 2000-1230
Application No. 08/717,904

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

SLD

Appeal No. 2000-1230
Application No. 08/717,904

NIXON & VANDERHYE
1100 NORTH GLEBE RD
8TH FLOOR
ARLINGTON, VA 22201-4714

Shereece

Appeal No. 2000-1230
Application No. 08/717,904

APJ CALVERT

APJ ABRAMS

APJ NASE

AFFIRMED-IN-PART

Prepared: June 27, 2001