

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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE E. MORRIS

Appeal No. 2002-0027
Application No. 08/963,812

HEARD: AUGUST 14, 2002

Before FRANKFORT, STAAB and NASE, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 7 through 21. Claims 1 through 6 have been allowed. Claims 22 and 23, the only other claims in the application, have been objected to as being dependent from a rejected base claim, but have also been indicated by the examiner to be allowable if rewritten in independent form.

As noted on page 2 of the specification, appellant's invention relates to a tapping connector or tapping flange for connecting branch pipes to carrier pipes, such as subsea carrier

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pipes for carrying oil and/or gas. A copy of independent claims 7 and 18 on appeal can be found in Appendix A of appellant's brief. Representative claim 18 is reproduced below:

18. A tapping connector, comprising:

a connector body having a first end and a second end, said first and second ends defining a bore therebetween; and

an arcuate membrane disposed within said bore between said first and second ends, and

said membrane isolating said first end from said second end.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Vallourec (French Patent)	1,224,818	Feb. 5, 1962
Wood et al. (Wood) (German Patent)	2,708,505	Aug. 31, 1978

Illustration C1, cited on PTO Form-1449, submitted May 18, 1998.¹

¹ A copy of a translation of each of the above-noted foreign documents prepared by or for the U.S. patent and Trademark Office is attached to this decision.

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Claims 7 through 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Prior Art Illustration C1 or Vallourec in view of Wood.

Rather than reiterate the examiner's statement of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the final rejection (Paper No. 10, mailed May 22, 2000) and the examiner's answer (Paper No. 13, mailed January 17, 2001) for the reasoning in support of the rejection, and to appellant's brief (Paper No. 12, filed October 23, 2000) and reply brief (Paper No. 14, filed March 20, 2001) for the arguments thereagainst.

OPINION

As a preliminary matter, we note that appellant has indicated (brief, page 5) that claims 7 through 21 "stand or fall together." Accordingly, we have selected claim 18 as being representative of this grouping and will decide the appeal on the basis of that claim alone. Claims 7 through 17 and 19 through 21 will stand or fall with claim 18.

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In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's above-noted rejection will be sustained. Our reasons follow.

According to the examiner, both Prior Art Illustration C1 and Vallourec disclose a tapping connection like that claimed by appellant, with the exception that each of those references shows the membrane blocking the bore of the connector as a planar or flat membrane rather than an "arcuate membrane" as required in appellant's claim 18. To address this deficiency in the prior art, the examiner turns to Wood, urging that Wood "clearly teaches a tapping structure with a concave/convex tapping membrane disposed within a bore of a containment structure" (final rejection, page 2). Based on the combined teachings of the applied references, the examiner concludes that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to substitute the membrane of Wood for the flat membrane of either Prior Art Illustration C1 or Vallourec.

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Appellant argues that even if the combination proposed by the examiner were made, the rejection would still be improper because the membrane taught by Wood is not the claimed membrane, i.e., an "arcuate" membrane. Appellant characterizes the membrane of Wood as being a dome-shaped membrane and urges that the claim recitation of an "arcuate membrane" does not encompass dome-shaped membranes. We do not agree.

Before the USPTO, when evaluating claim language during examination of the application, the examiner is required to give the terminology of a claim its broadest reasonable interpretation consistent with the specification, and to remember that the claim language cannot be read in a vacuum, but instead must be read in light of the specification as it would have been interpreted by one of ordinary skill in the pertinent art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In applying those precepts to the present case, the examiner has determined that the broadest reasonable interpretation consistent with the specification that may be applied to the terminology "arcuate membrane" is that such

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membrane is bent or curved in the form of a bow (answer, page 4). With this understanding, the examiner has concluded that one of ordinary skill in the art would thus have viewed Wood's curved, dome-shaped membrane as being an "arcuate membrane."

Appellant contends in the brief and reply brief that he has, in his specification, clearly defined the "arcuate membrane" of his invention so as to preclude it from covering dome-shaped membranes. However, we find no such "clear" definition in appellant's specification of exactly what constitutes an "arcuate membrane." Rather, we find examples of what are apparently appellant's preferred embodiments of the invention, i.e., wherein the arcuate membrane is "typically an elongated arched membrane" (page 4, lines 7-8), or "may be configured to resemble a longitudinal segment of a conduit" (page 4, lines 19-20).

Particularly telling in interpreting appellant's "arcuate membrane" language of claim 18 is the paragraph at the top of page 5 of the specification wherein appellant indicates that

"[i]n one embodiment of the tapping connector, a membrane may be defined by opposing surfaces comprising an outer convex surface and an inner concave surface, wherein these outer and inner surfaces are each characterized by a radius of curvature. The

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membrane may further be defined by a generally linear longitudinal axis or centerline and a generally curved or arched latitudinal axis or centerline" (emphasis added).

The permissive language of this paragraph is quite broad and, in our view, the "one embodiment" first set forth would clearly encompass a curved or dome-shaped membrane like that seen in Wood, i.e., a membrane with an outer convex surface and an inner concave surface, wherein the outer and inner surfaces are each characterized by a radius of curvature. Although a further embodiment of appellant's invention may also be defined by a generally linear longitudinal axis or centerline and a generally curved or arched latitudinal axis or centerline, it does not appear to us that such a configuration is required, or is the only configuration envisioned by appellant. This position is further bolstered by disclosure on page 16 of the specification, wherein appellant describes one of the preferred embodiments of the invention and then follows that disclosure by the statement that "[h]owever, it will be understood with benefit of this disclosure that the shape and/or orientation of a membrane may vary substantially as described elsewhere herein" (page 16, emphasis added). Also, on page 17, after describing a preferred embodiment, appellant again indicates that "[h]owever, it will be

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understood with benefit of this disclosure that the shape of a membrane 16 may vary substantially" (emphasis added).

Having failed to find a definition in appellant's specification of exactly what constitutes an "arcuate membrane" and likewise failed to find a definition which precludes a curved or dome-shaped membrane like that in Wood, and given the broad, permissive language noted-above on pages 5, 16 and 17 of appellant's specification, we have given the claim language its plain, ordinary and accustomed meaning as such would have been understood by one of ordinary skill in the art. See, for example, Johnson Worldwide Associates Inc. v. Zebco Corp., 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999); Bell Atlantic Network Services Inc. v. Covad Communications Group Inc., 262 F.3d 1258, 1267, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001); and Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1341-1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001).

Having found that the "arcuate membrane" set forth in claim 18 on appeal is broadly readable as a bowed or curved membrane, we must agree with the examiner that the "arcuate membrane" in

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claim 18 can be construed to encompass a curved membrane like that seen in Wood.

Since we have disagreed with the only argument presented by appellant as to why the examiner's rejection might have been improper, it follows that we will sustain the examiner's rejection of claim 18 under 35 U.S.C. § 103(a). Given appellant's grouping of the claims on page 5 of the brief, we consider that claims 7 through 17 and 19 through 21 will fall with claim 18.

In accordance with the foregoing, the decision of the examiner rejecting claims 7 through 21 under 35 U.S.C. § 103(a) is affirmed.

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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).

AFFIRMED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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