Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NILS E. JOHANSSON

Appeal No. 97-2713
Application 08/373,069[1]

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and NASE and CRAWFORD, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 5, 7 through 26, 29 and 32 through 34. The only other claims still pending in the application, namely dependent claims 6, 30 and 31, are

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[1] Application for patent filed January 13, 1995.

considered to be allowable subject to being rewritten in independent form.

Appellant's invention relates to a watercraft (claims 1 through 5, 7 through 25 and 29) and to a method of operating a watercraft (claims 26 and 32 through 34). According to claim 1, the watercraft comprises an above-water transport unit (2), an underwater unit (3) for supporting the above-water unit and a means (4) for moving the two units towards and away from one another.

A copy of the appealed claims is appended to appellant's brief.

In rejecting the appealed claims, the examiner relies upon the following references:

Douglas	1,757,174	May 6, 1930
Anderson	2,596,194	May 13, 1952
Tulleners	3,430,595	Mar. 4, 1969
Barkley	3,541,987	Nov. 24, 1970

Laukien 4,411,213 Oct. 25, 1983

The grounds of rejection are as follows:

1. Claims 1, 2, 9 through 12, 14, 17 through 20, 24, 26, 32 and 33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Barkley.

2. Claims 3, 13, 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barkley in view of Douglas.

3. Claims 8, 21 and 25 stand rejected under 35 U.S.C.
§ 103 as being unpatentable over Barkley in view of Laukien.

4. Claims 4, 5 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barkley in view of Douglas and Laukien.

5. Claims 22 and 23 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Barkley in view of Tulleners.

6. Claims 29 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barkley in view of Anderson.

Reference is made to the examiner's answer for details of these rejections.

With regard to the examiner's § 102(b) rejection of claim 1, the Barkley patent discloses a watercraft having a pair of pontoon hulls 16 supporting a central hull 12 and a transport unit in the form of a superstructure 32 on the deck 30 of the central hull. Legs 14 attaching the pontoon hulls 19 to the central hull are pivotally secured to the central hull by pivots 46. Each leg 14 and its associated pontoon hull 19 are swingable as a unit about the associated pivot 46 by a hydraulic ram 58 to the positions shown in Figures 3-6 of the patent drawings.

Appellant does not dispute the examiner's finding that Barkley's pontoon hulls 16 define a unit which is disposed in

the water for supporting an above-water transport unit. Appellant also does not take issue with the examiner's finding on page 3 of the answer that Barkley's superstructure 32 is an above-water unit as broadly defined in claim 1. Appellant does, however, take issue with the examiner's finding that Barkley's pontoon hulls define an ?underwater unit? as recited in claim 1. Appellant also contends that Barkley's supporting unit (pontoon hulls 16) and the above-water unit 32 are not movable toward and away from one another as required by claim 1 because ?the pontoons 16 of Barkley are pivotally connected to the abovewater [sic] unit 12 by pivot axes 46 and remain at a fixed distance from such axes? (brief, page 10).

Admittedly, the operation of Barkley's hydraulic rams 58 do not move the patentee's pontoon hulls 16 toward and away from the pivots 46. However, they do move the pontoon hulls toward and away from the above-water superstructure 32 itself as they are swung between the positions shown in Figures 3 and 4 of the patent drawings. In this regard, it is clear that the linear distance between the longitudinal axis of the left hand

pontoon hull and a reference point on the above water unit 32, such as the lower left hand corner of the above-water unit 32 as viewed from Figures 3 and 4, increases as the left hand pontoon hull is moved from the position shown in Figure 3 to the position shown in Figure 4. Conversely, this linear distance is reduced as the left hand pontoon hull is moved from the position shown in Figure 4 to the position shown in Figure 3. Thus, when the claim language is given its broadest reasonable interpretation (See In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) without reading limitations from the specification into the claim (See Sjolund v. Musland, 847 F.2d 1573, 1582, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)), the recitation of the claimed

moving means does not distinguish from Barkley's hydraulic rams 58 and associated structure.[2]

[2] With regard to the claimed moving means, appellant has neither asserted nor shown that, with respect to the sixth paragraph in 35 U.S.C. § 112, the Barkley

With regard to the recitation that the supporting unit is an ?underwater unit,? Barkley's pontoon hulls 16 admittedly are not expressly disclosed as being fully submerged in the water. However, claim 1 is not directed to the combination of the watercraft and a body of water to support a recitation that the supporting unit is actually underwater in that body of water. Instead, claim 1 is directed to the watercraft per se. Thus, the recitation that the supporting unit is an ?underwater unit? is merely a statement of the manner in which the supporting unit is intended to be used when placed in a body of water.

Such a statement of intended use is not germane to the patentability of claim 1. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985); In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967) and In re Lemin, 326 F.2d 437, 440, 140 USPQ 273, 276 (CCPA 1964). In

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structure is not the equivalent of the structure disclosed in appellant's specification for accomplishing the claimed function. A corresponding observation was made by our reviewing court in In re Mulder, 716 F.2d 1542, 1549, 219 USPQ 189, 196 (Fed. Cir. 1983).

any case, it is sufficient that Barkley's pontoon hulls are inherently capable of being place underwater given appropriate load and buoyancy forces. Thus, claim 1 does not distinguish from Barkley by reciting that the supporting unit is an ?underwater unit.?

Based on the foregoing analysis, we are satisfied that all of the limitations in claim 1 are either expressly or inherently disclosed in the Barkley patent. Barkley therefore anticipates the subject matter of claim 1. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Accordingly, we will sustain the § 102(b) rejection of claim 1.

We will also sustain the § 102(b) rejection of dependent claims 2, 9, 10, 14, 17 through 19 and 24 because the patentability of each of these claims has not been argued separately of claim 1. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and In re Burckel, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979).

With regard to claim 11, we cannot agree with appellant's argument that this claim patentably distinguishes from Barkley by reciting that the bracing means is part of the underwater unit. In Barkley, the hydraulic rams 58, upon being locked, define a bracing structure which rigidly joins the pontoon hulls 16 together through portions of legs 14 and hull 12. This bracing structure, like pontoon hulls 16, is inherently capable of being placed underwater. Accordingly, we will also sustain the § 102(b) rejection of claim 11 since each and every limitation encompassed by this claim is either expressly or inherently disclosed in Barkley. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d at 1444, 221 USPQ at 388.

However, we cannot sustain the § 102(b) rejection of claims 12 and 20. On page 3 of the answer, the examiner states in substance that the movable control surfaces of claim 12 are readable on Barkley's legs 14. However, there is no express or inherent disclosure in Barkley that any of the surfaces of legs 14 are capable of providing vertical stability by the exertion of forces at least equaling the buoyancy of the

above-water and underwater units. With regard to claim 20, there is no express or inherent disclosure in Barkley of a signal transmitting means extending through the patentee's hydraulic rams 58. Since these limitation are not met by Barkley, we cannot agree that Barkley constitutes a proper anticipatory reference for the subject matter of claims 12 and 20.

We also cannot sustain the § 102(b) rejection of method claims 26, 32 and 33. Claim 26 expressly recites the step of maintaining the supporting part of the watercraft below the surface of the water. Thus, in contrast to claim 1, claim 26 requires the supporting part to be underwater. Since this limitation is not expressly or inherently met by Barkley, we cannot agree that Barkley constitutes a proper anticipatory for the subject matter of claim 26 and, hence, for the subject matter of dependent claims 32 and 33.

With regard to the § 103 rejection of claims 3, 13, 15 and 16, the examiner concludes that the teachings of Douglas would have made it obvious to provide either of Barkley's

pontoon hulls 16 with a fuel chamber and also to provide Barkley's watercraft with a directional control rudder (presumably if it concluded that Barkley does not implicitly disclose a rudder).

With respect to claim 3, Douglas teaches the concept of providing a fuel tank in the supporting torpedo-shaped hull for the self-evident purpose of locating the fuel tank near the watercraft's engine and also for conveniently utilizing the available hollow storage space in the hull. Such a teaching would have been ample motivation for providing at least one of Barkley's torpedo-shaped hulls 16, which carries the engine driven propeller 26, with a fuel tank.

With regard to appellant's arguments on page 13 of the brief, the Douglas patent falls squarely within appellant's field of endeavor, namely watercraft. This reference, therefore, is properly taken into account in evaluating the patentability of the claimed subject matter under § 103. See In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

In view of the foregoing, we are satisfied that the combined teachings of the applied references would have suggested the subject matter of claim 3 to one of ordinary skill in the art to warrant a conclusion of obviousness under the test set forth in In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Accordingly, we will sustain the § 103 rejection of claim 3. We will also sustain the § 103 rejection of dependent claim 13 because the patentability of this claim has not been argued separately of claim 1. See Nielson, 816 F.2d at 1572, 2 USPQ2d at 1528 and Burckel, 592 F.2d at 1178-79, 201 USPQ at 70.

With regard to the § 103 rejection of claim 16, appellant does not contend that Douglas' tubular members 20 do not act as stiffening elements. Instead, appellant's only argument supporting patentability is that ?neither Barkley nor Douglas discloses a hollow stiffening element which accommodates a pipe? (brief, page 14). In Figure 4, Douglas shows a pipe type ladder (i.e., a ladder made from pipe like elements) extending through each element 20. In any event, in the course of

providing Barkley's watercraft with Douglas' hollow elements 20, it would have been obvious to pass various plumbing and conduit members though elements 20 as a convenient, protective way to interconnect equipment in the superstructure 32 and in the pontoon hulls 16. Accordingly, we will also sustain the § 103 rejection of claim 16.

However, we will not sustain the § 103 rejection of claim 15. We find no teaching or suggestion in either Barkley or Douglas which would have motivated one of ordinary skill in the art to utilize a fuel conduit as a stiffening element as required by claim 15.

With regard to the § 103 rejection of claims 8, 21 and 25, the examiner concludes that the teachings of Laukien would have made it obvious to provide Barkley's pontoon hulls 16 with ballast tanks to improve the stability of the vessel, presumably by controlling the buoyancy of the hulls. Appellant's arguments supporting patentability of claim 8 as set forth on pages 14 and 15 of the brief are unpersuasive.

In the first place, the Laukien patent falls squarely within appellant's field of endeavor, namely watercraft. This reference, therefore, is properly taken into account in evaluating the patentability of the claimed subject matter under § 103. See Clay, 966 F.2d at 658, 23 USPQ2d at 1060.

Furthermore, contrary to appellant's additional arguments on page 14 of the brief, Laukien teaches in column 6, lines 12-17, that the ballast tanks are used to control buoyancy even under conditions in which the supporting hulls are not fully submerged, but are merely largely submerged to approach a condition similar to that contemplated by Barkley. One of ordinary skill in the art certainly would have recognized from the cited prior art that ballast tanks are useful for controlling the buoyancy of hulls in a semi-submerged state as well as a fully submerged state. Also, the mere fact that Barkley's watercraft may be regarded as being fairly stable does not mean that an additional advantage may not be derived from the use of a buoyancy-controlling ballast system.

For the foregoing reasons, we will sustain the § 103

rejection of claim 8. We will also sustain the § 103 rejection of dependent claim 25 because the patentability of this claim has not been argued separately of claims 1 and 8. See Nielson, 816 F.2d at 1572, 2 USPQ2d at 1528 and Burckel, 592 F.2d 1178-79, 201 USPQ at 70.

We cannot, however, sustain the § 103 rejection of claim 21. The applied references are devoid of any suggestion of providing Barkley's hydraulic rams 58 with conduits for any purpose, let alone the purpose recited in claim 21.

Turning now to the § 103 rejection of claims 4, 5 and 7, appellant merely argues that these claims are patentable for the reasons previously stated with respect to the Douglas and Laukien references. Those arguments were not persuasive when first considered and are not persuasive now for the reasons discussed supra. Accordingly, we will sustain the § 103 rejection of claims 4, 5 and 7.

However, we cannot sustain the § 103 rejection of claims 22 and 23. With regard to claim 22, the applied references are

devoid of any suggestion of extending electrical power transmitting means through Barkley's hydraulic rams 58. With regard to claim 23, the applied references are also devoid of any suggestion of extending any air conveying means through Barkley's hydraulic rams 58.

We also cannot sustain the § 103 rejection of dependent method claim 34 because the teachings of Anderson do not rectify the shortcomings of Barkley as discussed with respect to claim 26.

Finally, we will sustain the § 103 rejection of claim 29. Appellant's argument that Anderson would not have been considered by one of ordinary skill in the art as set forth on page 17 of the brief is unpersuasive. Like Douglas and Laukien, Anderson falls squarely within appellant's field of endeavor, namely watercraft. This reference, therefore, is properly taken into account in evaluating the patentability of the claimed subject matter under § 103. See Clay, 966 F.2d at 658, 23 USPQ2d at 1060.

The only other argument supporting patentability of claim 29 is that there would have been ?no reason to make [Barkley's] legs 14 telescoping based on the teachings of Anderson? (brief, page 18). This argument is also unpersuasive. Claim 29 does not require any elements of the moving means to be telescoping members. Therefore, the telescoping feature may not be relied on to support the patentability of claim 29 over the applied references. See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982) and In re Richards, 187 F.2d 643, 645, 89 USPQ 64, 66 (CCPA 1951).

In the final analysis, the movement of Barkley's left hand pontoon hull 16 and the patentee's superstructure 32 toward and away from each other is ?essentially linear? (claim 29, line 3) at least for a limited distance. Appellant has not argued otherwise.

The examiner's decision rejecting the appealed claims is affirmed with respect to claims 1 through 5, 7 through 11, 13, 14, 16 through 19, 24, 25 and 29, but is reversed with respect to claims 12, 15, 20 through 23, 26 and 32 through 34.

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

AFFIRMED-IN-PART

HARRISON E. McCANDLISH, Senior Administrative Patent Judge	)
JEFFREY V. NASE Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
MURRIEL E. CRAWFORD Administrative Patent Judge	)

T. Lewenstein
1516 W. Sunset Ridge Place
Tucson, AZ 85737