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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HELMUTH SOKOLEAN

Appeal No. 97-2782
Application No. 08/368,993[1]

ON BRIEF

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

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 26 through 40 and 42 through 46, which are all of the claims pending in this application.[2]

[1] Application for patent filed January 5, 1995.

[2] It would appear from the status of amendments sections of both the brief and the answer that the appellant's

We AFFIRM-IN-PART.

---

amendment-after-final (Paper No. 16, fled February 3, 1997) was approved for entry by the examiner. We note that this amendment has not been clerically entered.

BACKGROUND

The appellant's invention relates to a ceiling element for a heating or cooling ceiling. An understanding of the invention can be derived from a reading of exemplary claim 26, which appears in the appendix to the appellant's brief.

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

Bergh	4,766,951	Aug. 30, 1988
Schmitt-Raiser et al. (Schmitt-Raiser)	5,042,570	Aug. 27, 1991

Claims 26, 29, 39, 40, 45 and 46 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bergh.

Claims 27[3], 28, 30 through 32, 35 through 38 and 42 through 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bergh.[4]

Claims 33 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bergh in view of Schmitt-Raiser.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 10, mailed August 2, 1996) and the examiner's answer (Paper No. 18, mailed March 17, 1997) for the examiner's

---

[3] In the final rejection, claim 27 was included in this rejection under 35 U.S.C. § 103. In the answer, the examiner lists claim 27 as being rejected under 35 U.S.C. § 102(b) but also mentions claim 27 in the body of the 35 U.S.C. § 103 rejection (answer, page 4, line 2). Since the answer did not specifically set forth that it contained a new ground of rejection, we will treat claim 27 as being rejected under 35 U.S.C. § 103 as set forth in the final rejection.

[4] We note the following obvious errors in claims 31 and 43. In claim 32, the phrase "said wall panel" should be --said ceiling panel-- for proper antecedent basis. In claim 43, "corners" (each ocurrence) should be --edges-- for consistency with the original disclosure. The appellant should correct these obvious errors as soon as possible.

complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 17, filed February 3, 1997) and reply brief (Paper No. 19, filed May 13, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation issue

The rejection of claims 26, 29 and 40 under 35 U.S.C. § 102(b) is sustained, but not the rejection of claims 39, 45 and 46.

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d

760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Claim 26

Claim 26 is drawn to a ceiling element comprising, inter alia, a ceiling panel, at least one hose guide, and a hose for conducting heat-transfer fluid. Claim 26 also recites that (1) the hose is made of a flexible material having a first cross-sectional shape when undeformed, and (2) the hose is flexibly deformed when received in the hose guide so as to assume a second cross-sectional shape.

Claim 26 is anticipated by Bergh. Bergh discloses a radiant, linear ceiling panel 12. As shown in Figures 1-4, the panel 12 comprises a panel 16, a radiator panel 22, a flexible clip 24 and a copper flow tube 38. The inward side 26 of the radiator panel 22 includes a longitudinally extending C-shaped channel 30 defined by channel walls 32. Bergh teaches (column 3, lines 33-52) that the

> copper flow tube 38 is grasped by the C-shaped channel 30 and runs almost the entire length of the panel, deviating from and curving up and out of the channel near its end.

> Contact between the tube 38 and the radiator panel 22 is important to maximize conductive heat exchange between water in the tube and the radiator panel and, ultimately, the panel shell. The tube can be inserted into the channel and then deformed to press its sides against the sides of the C-shaped channel 30. Of course, the invention contemplates that other variations of inserting the tube and obtaining maximum contact between the tube and channel are known in the art and may be utilized for purposes of this invention.
>
> Although copper is the preferred material from which to construct the tubing due to its excellent heat conductive and non-corrosive properties, the invention can utilize any type of tubing able to conduct heat from fluids of varying temperatures. Metals and other materials suitable for use are presently known in the art and may be substituted for the copper tube.

The argument presented by the appellant (brief, pp. 12-14) does not convince us that claim 26 is patentable. The appellant argues that Bergh does not contemplate his copper tube being flexible as recited in claim 26. We find this argument to be unpersuasive since the claimed flexible hose "reads on" Bergh's copper tube 38. In that regard, we find that Bergh inherently discloses to one skilled in the art that the cross-sectional shape of his copper tube 38 changes from its original shape (i.e., prior to its insertion into the channel 30) to the shape of the channel 30. This finding is based upon the following factors: (1) Bergh teaches that the

copper tube 38 is **deformed** to press its sides against the sides of the C-shaped channel 30, and (2) Bergh teaches that the copper tube 38 runs along almost the entire length of the panel and then deviating from and **curving** up and out of the channel 30 near its ends a shown in Figures 1, 3 and 4). The ability of the copper tube 38 to be deformed and to curve are sufficient to establish that the copper tube 38 is made of a flexible material which flexibly deforms when the copper tube 38 is placed within the channel 30.

For the reasons set forth above, the decision of the examiner to reject claim 26 under 35 U.S.C. § 102(b) is affirmed.

Claims 29 and 40

The appellant has grouped claims 26, 29 and 40 as standing or falling together.[5] Thereby, in accordance with 37 CFR

[5] See page 11 of the appellant's brief.

§ 1.192(c)(7), claims 29 and 40 fall with claim 26. Thus, it follows that the decision of the examiner to reject claims 29 and 40 under 35 U.S.C. § 102(b) is also affirmed.

Claims 39, 45 and 46

Claims 39, 45 and 46 add to their parent claims the further limitation that the hose is made of elastically flexible material which is elastically, flexibly deformed by being received in the hose guide.

The appellant argues (brief, p. 14) that Bergh does not disclose elastic deformability or deformation of the tube 38. We agree. While we agree with the examiner that the copper tube 38 of Bergh is inherently flexible for the reasons outlined above with respect to claim 26, we see no disclosure that would have inherently disclosed that the tube 38 is elastically flexible such that it is elastically, flexibly deformed by being received in the channel 30. While there may exist copper tubing which would be elastically flexible as recited in claims 39 and 45, the combination of such known

copper tubing with Bergh is an issue of patentability under 35 U.S.C. § 103 which is not before us in this appeal. Since all the limitations of claims 39, 45 and 46 are not met by Bergh, the decision of the examiner to reject claims 39, 45 and 46 is reversed.

The obviousness issue

The rejection of claims 27, 28, 30 through 38 and 42 through 44 under 35 U.S.C. § 103 is sustained.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 27, 28, 30-32, 35-38 and 42-44

The examiner determined that claims 27, 28, 30-32, 35-38 and 42-44 would have been obvious to one of ordinary skill in the art at the time the invention was made for the reasons set forth on pages 3-5 of the final rejection and pages 3-6 of the answer. The appellant has not contested these determinations. Instead, the appellant only points out (brief, pp. 15-17 and reply brief, pp. 1-3) the differences between the claimed subject matter and Bergh. However, 37 CFR § 1.192(c)(8)(iv) requires the argument in a brief specify the errors in the examiner's rejection under 35 U.S.C. § 103, and, if appropriate, the specific limitations in the rejected claims which are not described in the applied prior art, **and** shall explain how such limitations render the claimed subject matter unobvious over the prior art. Thus, the appellant has not provided any explanation as to how the limitations not disclosed by Bergh render the claimed subject matter unobvious over Bergh. Accordingly, since the appellant has not specified any error in the examiner's determinations that the limitations not disclosed by Bergh would have been obvious to one skilled in the art, we are constrained to sustain the

examiner's rejection of claims 27, 28, 30-32, 35-38 and 42-44 under 35 U.S.C. § 103.

Claims 33 and 34

The examiner determined that claims 33 and 34 would have been obvious to one of ordinary skill in the art at the time the invention was made for the reasons set forth on page 5 of the answer.

The appellant argues (brief, p. 16) that

> [w]hereas Schmitt-Raiser does disclose (at 10 in Figures 2 and 3) plural pipe guides mounted on the same ceiling panel, a feature called for by appellant's claims 33 and 34, it does not otherwise make up for the above-indicated deficiencies in the teachings of Bergh.
> Appellant's claim 34 additionally requires the same length of flexible hose to snake around through two or more hose guides. Bergh shows only one tubing channel, and in Schmitt-Raiser, distinctly plural pipes 5 received in the two guides 10.

The appellant's argument set forth above and on page 3 of the reply brief is unpersuasive for the following reasons. First, the appellant has not contested the examiner's determination that it would have been obvious to modify Bergh's structure with a plurality of guides as suggested by Schmitt-Raiser. Second, as pointed out above with respect to parent claim 26, there are no deficiencies in the teachings of Bergh upon which one can rest patentability of these dependent

claims. Third, claim 34 does not require the same length of flexible hose to snake around through two or more hose guides. Claim 34 only requires a plurality of hose guides arranged in series along a curved path wherein the hose is received in at least one hose guide. Thus, claim 34 does not require the same hose to be received in the plurality of hose guides.

For the reasons set forth above, the decision of the examiner to reject claims 33 and 34 under 35 U.S.C. § 103 is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 26 through 38, 40 and 42 through 44 is affirmed and the decision of the examiner to reject claims 39, 45 and 46 is reversed.

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

NEAL E. ABRAMS Administrative Patent Judge	)	
WILLIAM F. PATE, III Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

CUSHMAN DARBY & CUSHMAN, L.L.D.
NINTH FLOOR, EAST TOWER
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005-3918

APPEAL NO. 97-2782 - JUDGE NASE
APPLICATION NO. 08/368,993

APJ NASE

APJ ABRAMS

APJ PATE

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 06 Oct 98

FINAL TYPED: