

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(2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL E. ARGENT

Appeal No. 97-3345
Application 08/332,936¹

ON BRIEF

Before COHEN, MEISTER and CRAWFORD, Administrative Patent
Judges.

¹ Application for patent filed October 31, 1994. Accord-
ing to appellant, the application is a continuation-in-part of
Application 07/958,011, filed October 7, 1992, now U.S. Patent
5,360,242, issued November 1, 1994.

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COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 14 through 20 and 33 through 35, as amended (Paper No. 15) subsequent to the final rejection (Paper No. 11). Claims 2, 3, 9, 10, 12, 13, and 21 through 32, the only other claims remaining in the application, stand allowed.

Appellant's invention pertains to a method of pipelaying by connecting two lengths of steel pipe without welding the pipe. An understanding of the invention can be derived from a reading of exemplary claim 14, a copy of which appears in the APPENDIX to appellant's brief (Paper No. 14).

As evidence of obviousness, the examiner has applied the documents listed below:

Kessler et al. (Kessler) 1974	3,784,235	Jan. 8,
Nemoto et al. (Nemoto) 1978	4,091,630	May 30,

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McGugan 1981	4,298,221	Nov. 3,
Roberts 1989	4,865,359	Sept. 12,
St. Onge 1990	4,958,959	Sept. 25,
Sweeney 1991	5,015,014	May 14,
Shibahara et al. (Shibahara) 1992	5,104,263	Apr. 14,

The following rejections are before us for review.

Claims 14 through 18, 33, and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over McGugan in view of Sweeney and St. Onge.

Claim 19 stands rejected under 35 U.S.C. § 103 as being unpatentable over the art as applied to the claims above, further in view of Roberts or Kessler.

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Claim 35 stands rejected under 35 U.S.C. § 103 as being unpatentable over the art applied to claims 14 through 18, 33, and 34 above, further in view of Shibahara or Nemoto.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 16), while the complete statement of appellant's argument can be found in the brief (Paper No. 14).

In the brief (page 11), appellant indicates that claims 14 through 19 stand or fall together, and that claims 33 through 35 are separately patentable. In light of the above, we select claim 14 for review, with claims 15 through 19 standing or falling therewith; 37 CFR 1.192(c)(7). Accordingly, we focus upon claims 14, 33, 34, and 35, *infra*.

OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully

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considered appellant's specification and claims, the applied patents,² and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection of claims 14 through 18, 33, and 34

We affirm the rejection of claim 14 under 35 U.S.C.

§ 103. It follows that the rejection of claims 15 through 18 is

likewise affirmed since these claims stand or fall therewith, as previously indicated.

² In our evaluation of the applied patents, we have considered all of the disclosure thereof for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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Claim 14 addresses a method of pipelaying by connecting two lengths of steel pipe without welding the pipe comprising, inter alia, forming first and second tubular members of steel with each member having cylindrical exterior and interior surfaces with diameters that are the same as exterior and interior diameters of the steel pipe to be connected.

As evidence of obviousness, the examiner looked to the combined teachings of McGugan, Sweeney, and St. Onge.

Having reviewed the applied evidence, we reach the conclusion that it would have been obvious to one having ordinary skill in the art, from a collective assessment thereof, to form the tubular pin and box members (first and second tubular members) 1, 3 of McGugan with cylindrical exterior and interior surfaces having diameters that are the same as exterior and interior diameters of the steel pipe to be connected. As we see it, the motivation on the part of one

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having ordinary skill in the art for making this modification would have simply been to

obtain the expected benefits of a known alternative uniform diameter pipe configuration, as evidenced by the teachings of Sweeney (Figs. 4 and 5) and St. Onge (Figs. 5, 7 and 8; column 4, lines 62 through 67 and column 5, lines 40 through 43). For this reason, the rejection of claim 14 is determined to be appropriate.

As to claims 33 and 34, we conclude that the applied art would have been reasonably suggestive of the content of claim 33, but not of claim 34.

A reading of the Sweeney document (Fig. 6) reveals to us that it would have been clearly suggestive of a technique (column 6, lines 24 through 51) for pushing pipe sections together which uses a C-clamp 34 (clamp on right side of Fig. 6) configured to pass over a male connector and engage one end of a first tubular member 2N, as required by claim 33.

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On the other hand, we are of the opinion, as regards the content of claim 34, that the applied patents to St. Onge (protective plate 54 for pushing) and Sweeney (flanged plug 32 for pushing and technique shown in Fig. 6) would not have been suggestive of a male push ring configured to "pass inside the female connector" and engage one end of a second tubular connector, as claimed.

The argument advanced by appellant fails to persuade us that the examiner erred in rejecting claim 14 under 35 U.S.C. § 103. We are in basic agreement with the examiner's response to the argument presented (answer, pages 6 through 11) and add the additional commentary. The viewpoint (brief, page 15) that the proposed modification would appear to weaken the connectors and negatively "effect" [sic, affect] the operability of the connectors if not rendering them entirely inoperable for their intended purpose, is considered to be unsupported attorney argument. From our perspective, the evidence of obviousness is contrary to the view advocated.

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McGugan reveals uniformity for the pipe exterior (Fig. 1) and in another embodiment (Fig. 8) uniformity for the pipe interior. This teaching, with the knowledge in the art (Sweeney and St. Onge) of uniform exteriors and interiors as suitable for pipe arrangements, would clearly have been suggestive of the alternative of an operable uniform exterior and interior pipe arrangement, as proposed for the McGugan method of pipelaying. Like the examiner, we are also

not in accord with appellant's view of the Sweeney and St. Onge documents as being directed to nonanalogous subject matter (brief, pages 15 and 16). At the outset, we note that, as acknowledged by appellant (specification, page 2), there is simply a preference for using steel. This is certainly consistent with the evidence of obviousness before us which accurately reflects the alternatives of steel and plastic material pipes and connections in the art. In our opinion, it is fair to say that the teachings of Sweeney and St. Onge are reasonably pertinent to the pipe connection and configuration problems faced by both appellant and McGugan and, as such,

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would have logically commended themselves to one facing the afore- mentioned problems. See In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). It is additionally appellant's position (brief, page 17) that the references do not provide suggestion for their combination but have been combined using impermissible hindsight. We disagree. As set forth, supra, we have determined that the applied teachings provide ample suggestion for their combination. Further, the present rejection is not inappropriate as being based upon impermissible hindsight since, as revealed above, it is properly founded only upon knowledge which was within the level of ordinary skill at the

time the claimed invention was made. Thus, the rejection of claim 14 is sound. Relative to appellant's comments regarding claim 33 (brief, pages 17 through 19), we refer to our discussion, supra, wherein we concluded that the subject matter of this claim would have been suggested by the evidence of obviousness.

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The rejection of claim 19

The rejection of claim 19 is affirmed since it stands or falls with claim 14, as earlier indicated.

The rejection of claim 35

We affirm the rejection of this claim under 35 U.S.C. § 103.

Claim 34 depends from claim 14 and requires, inter alia, that the pipelaying method is trenchless excavation pipelaying with the pipes advanced through a generally horizontally bored hole.

It is significant to note that the patent to McGugan (column 1, lines 7 through 11) expressly acknowledges that the disclosed pipe connectors are particularly, "but not exclusively" designed and adapted for use in connecting pipes in the drilling and/or completion of off-shore oil and/or gas wells. Further, the patents to Shibahara (plastic or cast

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iron pipes; column 8, lines 56 through 61) and Nemoto (cast iron or steel pipes; column 1, lines 13 and 14) are viewed as representative of the knowledge in the art of the known method of trenchless excavation pipelaying, as acknowledged by appellant (specification, pages 2 and 3).

Considering the applied teachings as a whole, we conclude, as did the examiner, that it would have been obvious to practice the invention of McGugan with the pipes being placed horizontally in the earth. It readily appears to us that the incentive on the part of one having ordinary skill in the art for making this modification would have simply been to gain the expected benefits of the well-known trenchless excavation method.

The argument in the brief (pages 20 through 22) is not convincing of the patentability of claim 35. Akin to our analysis of the patents to Sweeney and St. Onge, *supra*, we

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readily perceive the teachings of Shibahara and Nemoto to be reasonably pertinent to pipelaying problems and arrangements of concern to McGugan as well as appellant,³ and hence analogous prior art. Further, assessed as a whole, and contrary to appellant's point of view, we consider the applied teachings to be suggestive of the claimed invention, without impermissible hindsight reliance upon appellant's own teaching.

In summary, this panel of the board has:

affirmed the rejection of claims 14 through 18, and 33 under 35 U.S.C. § 103 as being unpatentable over McGugan in view of Sweeney and St. Onge, but reversed the rejection of claim 34 on this same ground;

³ We note that appellant contemplated not only horizontal pipe orientation, but also vertical orientation (specification, page 8, lines 25 through 28).

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affirmed the rejection of claim 19 under 35 U.S.C. § 103 as being unpatentable over the art as applied to the claims above, further in view of Roberts or Kessler; and

affirmed the rejection of claim 35 under 35 U.S.C. § 103 as being unpatentable over the art applied to claims 14 through 18, 33, and 34 above, further in view of Shibahara or Nemoto.

The decision of the examiner is affirmed-in-part.

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

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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