



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/734,978	01/06/2013	David William Stauffer		5951

111654 7590 11/20/2019
David William Stauffer
David Stauffer
5334 N Amherst
Portland, OR 97203

EXAMINER

SINGH, SUNIL

ART UNIT	PAPER NUMBER
----------	--------------

3678

MAIL DATE	DELIVERY MODE
-----------	---------------

11/20/2019

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID WILLIAM STAUFFER

Appeal 2019-003065
Application 13/734,978¹
Technology Center 3600

Before STEFAN STAICOVICI, MICHAEL J. FITZPATRICK, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant timely filed a Request for Rehearing (“Request”) under 37 C.F.R. § 41.52 on September 20, 2019, requesting that we reconsider our decision of August 16, 2019, (“Decision”) affirming the rejections under 35 U.S.C. § 103(a) of claims 1 and 2 as unpatentable over Pipeline Article² and Ross,³ and of claim 3 as unpatentable over Pipeline Article, Ross, Canadian Document,⁴ and Henderson.⁵

¹ The inventor, Mr. David William Stauffer, is identified as the real party in interest in Appellant’s Appeal Brief (filed Oct. 17, 2018, hereinafter “Appeal Br.”). Appeal Br. 5.

² Robin Madel, *A Really Big Straw for a Really Big Gulp: The Washington-to-California Pipeline*, pp. 1–2, Aug. 12, 2010, (“Pipeline Article”).

³ Ross, US 2012/0020734 A1, published Jan. 26, 2012.

⁴ Campbell et al., CA 2,296,088, published Apr. 4, 2001, (“Canadian Document”).

⁵ Henderson, US 2011/0254179 A1, published Oct. 20, 2011.

Rehearing generally is limited to matters overlooked or misapprehended by the Board in rendering the initial decision. 37 C.F.R. § 41.52(a)(1); *see also id.* at (a)(2)–(4) (identifying other matters rehearing may encompass, none of which is relevant here).

In the Request, Appellant contends that the Board has ignored Appellant’s claims 2 and 3. Request 3–5. We appreciate that the Decision does not include a separate discussion of dependent claims 2 and 3, however, we note that Appellant did not separately address the rejections of claims 2 and 3 in the Appeal Brief, filed Oct. 17, 2018.⁶ It is well settled that, apart from specific exceptions noted in 37 CFR § 41.52 (a)(2)–(a)(4), which do not apply here, “[a]rguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing.” MPEP § 1214.03; *see also Cooper v. Goldfarb*, 154 F.3d 1321, 1331 (Fed. Cir. 1998) (“A party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration.”).

Appellant further requests acceptance of amendments to claims 1–3. Request 5–18 (quoting Decision 9, which in turn cites pages 23 through 24 of the Specification), 35–37 (Appellant’s “NINTH AMENDED CLAIMS”).⁷ This is not a proper request *of the Board* as filing of Appellant’s amendments to claims 1–3 is after a decision by the Patent Trial and Appeal Board, and, thus, prosecution is

⁶ As discussed in the Decision, Appellant’s Supplemental Appeal Brief, filed February 12, 2019, was not entered by the Examiner in the record. *See* Decision 4, fn 6.

⁷ We note Appellant also refers to “EIGHTH AMENDED CLAIMS” as including a new claim 4 reciting “the 36 features listed on pages 23–24” of the Specification. *See* Request 6, 15. However, such an amendment has not been filed with the Request.

closed and “[A]ppellant is not entitled to have such amendment[s] entered as a matter of right.” MPEP § 1214.07; *see also* 37 C.F.R. § 41.33.

Appellant further contends that the Board erred in stating that “Appellant has not shown a persuasive technological incompatibility in the Examiner’s rejection.” Request 18 (quoting Decision 9–10). Appellant refers to features 31–36 on page 24 of the Appeal Brief, filed Oct. 17, 2018, as “ample evidence of technological incompatibility,” and then recites all of the features set forth on pages 23 through 24. *Id.* at 19–23. According to Appellant, “[f]eatures 33 through 36 are particularly notable in that the Examiner, after an extensive search, has not cited any prior art that has those flood control and fish migration features.” *Id.* at 23.

Appellant’s arguments were acknowledged on page 9 of the Decision where we stated that the features listed on pages 23 through 24 of the Appeal Brief “are not positively recited in claims 1–3.” As noted in the Decision, limitations not appearing in the claims cannot be relied upon for patentability. Decision 9.

As further evidence of technological incompatibility, Appellant notes that Ross’ pipeline “must be at or above the water surface,” whereas the pipe in the Pipeline Article is located at a depth of “328 feet below the surface.” Request 29 (emphasis omitted). Appellant further notes that Ross’ pipeline has a diameter of 10 feet, whereas the diameter of the pipe in Pipeline Article is 10 meters (about 30 feet). *Id.* at 29–30. Nonetheless, as Appellant did not make an argument that a skilled artisan would not combine the teachings of Pipeline Article and Ross because of the above noted differences, we did not overlook or misapprehend the differences between the pipelines of Pipeline Article and Ross. Moreover, Appellant’s argument does not address the Examiner’s combination because the Examiner is not employing the particular diameter and location of Ross’ pipeline

to modify the pipe of the Pipeline Article. “Combining the *teachings* of references does not involve an ability to combine their specific structures.” *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973). Rather, as stated in the Decision, the Examiner is modifying the pipe of the Pipeline Article “to have the pipe[] be air-tight and water-tight and powered by gravity and siphon principles as taught by Ross’ in order to ‘allow[] fresh water to be delivered to a desired end user.’” Decision 5.

Appellant further contends that neither the Examiner nor the Board found motivation in the cited prior art to make Appellant’s invention, and the Board has improperly ignored the Examiner’s statement that such motivation is not found in the cited prior art. Request 23–25 (quoting pages 29 through 30 of the Examiner’s Answer, dated Feb. 1, 2019, (hereinafter “Ans.”)).

We acknowledged Appellant’s arguments regarding motivation on page 8 of the Decision, where we stated that the reasoning to *combine* the teachings of the prior art does not need to come from the references themselves. As also noted in the Decision, “[t]he proper inquiry is whether the Examiner has articulated adequate reasoning based on a rational underpinning to explain why a person of ordinary skill in the art would have combined the teachings of the applied prior art.” Decision 8. Accordingly, the Decision explicitly states that “the Examiner has provided sufficient reasoning with rational underpinning to combine the teachings of Pipeline Article and Ross, namely, to ‘allow[] fresh water to be delivered to a desired end user.’” *Id.* at 4–5 (quoting Final Act. 5). Furthermore, in regards to the Examiner’s statement from page 29 of the Answer, we note that the cited paragraph merely paraphrases Appellant’s position (“Appellant argues that no one in the last five thousand years . . .”).

Appellant further asserts that: (1) there is no “motivation, suggestion or teaching” to make Appellant’s invention; (2) the combined teachings of the prior art does not include all of the elements of Appellant’s invention; (3) Appellant’s invention includes “new elements in a new combination with old elements”; and (4) an increase of ten times in the number of river pipelines results a new and unexpected result. *See* Request 25–26, 28. However, Appellant’s assertions are conclusory and fail to point out matters overlooked or misapprehended by the Board in the Decision. Moreover, Appellant’s argument that a ten-fold increase in the number of pipelines “can change climate change or global warming” is unsupported attorney argument that cannot take the place of evidence in the record. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997).

Appellant also contends that the Board erred in its conclusion that it would have been obvious to a skilled artisan to locate the river water input point of the pipe of Pipeline Article, as modified by Ross, at an altitude of about 100 meters, upriver from the mouth of the Columbia River, because such a location avoids salt-water intrusion. *See* Request 26–28 (quoting Decision 7). Appellant notes that “[t]here is no ‘salt-water intrusion’ of the Pacific Ocean where the altitude of the Columbia River reaches 100 meters above sea level,” because such a location is “400 miles up the river,” and, furthermore, because “the 1 to 4 Knot current of the Columbia River at Astoria is pushing against any salt-water intrusion at all by the salt-water of the Pacific Ocean.” *Id.* at 27.

As Appellant did not make such arguments in the Appeal Brief, the arguments fail to point out matters overlooked or misapprehended by the Board in the Decision. Moreover, the Board also concluded that a skilled artisan would know to choose the location of the river water input point of the pipe of Pipeline

Article, as modified by Ross, to be at an altitude above 100 meters because the output delivery point is below 100 meters, and the skilled artisan is presumed to understand gravity and siphon principles. Decision 8 (quoting Final Act. 7; *In re Jacoby*, 309 F.2d 513, 516 (CCPA 1962)).

Finally, Appellant’s “CONCLUSION” section constitutes a collection of conclusory statements and fails to point out matters overlooked or misapprehended by the Board in the Decision. *See* Request 30–33.

Accordingly, for the foregoing reasons, Appellant’s Request does not persuade us that the Decision misapprehended or overlooked any matter or that we erred in affirming the Examiner’s rejection of claims 1–3 under 35 U.S.C. § 103(a).

CONCLUSION

We have granted Appellant’s Request to the extent that we have considered our Decision in light of the points raised therein, but have denied the Request with respect to any modification to the Decision.

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
1, 2	103(a)	Pipeline Article, Ross	1, 2	
3	103(a)	Pipeline Article, Ross, Canadian Document, Henderson	3	
Overall outcome			1–3	

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
3	112(b)	Indefiniteness		3
1, 2	103(a)	Pipeline Article, Ross	1, 2	
3	103(a)	Pipeline Article, Ross, Canadian Document, Henderson	3	
Overall outcome			1-3	

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED