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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MERLE E. EVANS and  
JEROEN STIJN JULIAAN VAN WITTENBERGHE

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Appeal 2019-006784  
Application 15/449,350  
Technology Center 3600

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Before STEFAN STAICOVICI, EDWARD A. BROWN, and  
LEE L. STEPINA, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's decision objecting to Appellant's amendment, filed Feb. 13, 2018 under 35 U.S.C. § 132(a), for introducing new matter into the disclosure, and rejecting claims 16–24 under 35 U.S.C. § 112(a) for failing to comply with the written

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. ArcelorMittal Tubular Products Luxembourg S.A. is identified as the real party in interest in Appellant's Appeal Brief (filed June 11, 2019, hereinafter “Appeal Br.”) 2.

description requirement.<sup>2,3</sup> Final Action (dated June 13, 2018, hereinafter “Final Act.”) 2–3. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

## SUMMARY OF DECISION

We AFFIRM.

## INVENTION

Appellant’s invention relates to “threaded pipes and connectors for such pipes which may be used in the oil and natural gas industry.” Spec. para. 1.<sup>4</sup>

Claim 16, the sole independent claim, is representative of the claimed invention and reads as follows:

16. A threaded tubular connection comprising:
  - a pin, the pin having external threads, a concave pin seal surface, and a pin torque shoulder at a free end; and
  - a box for receiving the pin, the box having internal threads for interacting with the external threads, a convex box seal surface contacting the concave pin seal surface and a box torque shoulder for contacting the pin torque shoulder,
  - the pin and box defining a longitudinal axis,
  - the pin torque shoulder having at least one pin shoulder surface having a pin radius, the at least one pin shoulder surface being curved with respect to the longitudinal axis,

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<sup>2</sup> Claims 1–15 and 25–28 are canceled. Appeal Br. 2.

<sup>3</sup> The rejection of claims 16–24 under 35 U.S.C. § 103 as being unpatentable over Matsuki (US 3,870,351, issued Mar. 11, 1975) has been withdrawn. Examiner’s Answer (dated July 22, 2019, hereinafter “Ans.”); Final Act. 4–8.

<sup>4</sup> We refer to the Substitute Specification filed Apr. 28, 2017.

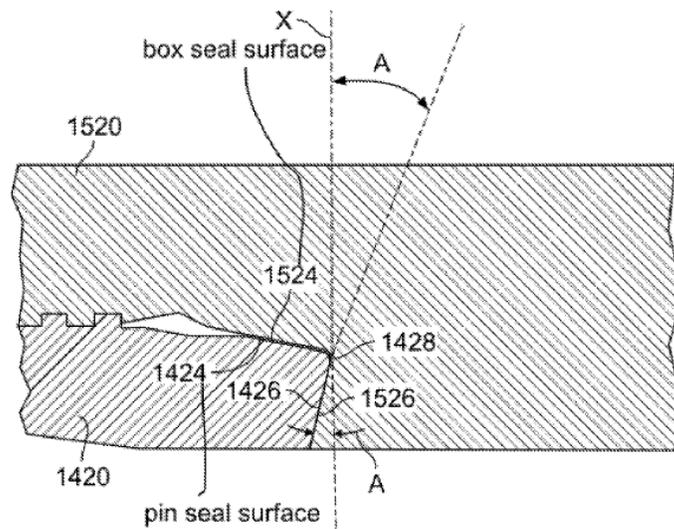
the box torque shoulder having at least one box shoulder surface having a box radius, the at least one box shoulder surface being curved with respect to the longitudinal axis.

#### ANALYSIS

Appellant does not present arguments for the patentability of claims 17–24 apart from claim 16. *See* Appeal Br. 3–4. Therefore, in accordance with 37 C.F.R. § 41.37(c)(1)(iv), we select claim 16 as the representative claim to decide the appeal of the rejection of these claims, with claims 17–24 standing or falling with claim 16.

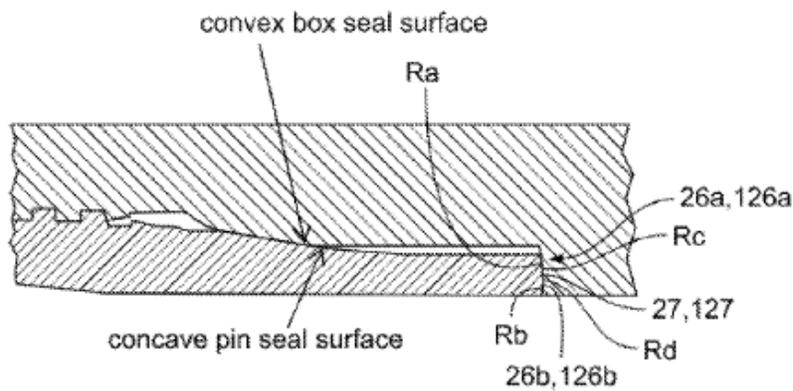
The Examiner finds that Appellant’s original disclosure does not support the limitations of “a concave pin seal surface” and “a convex box seal surface,” as recited in claim 16. According to the Examiner, Appellant elected to prosecute the embodiment illustrated in Figure 8 of the Drawings, in which (1) “the seal surfaces are not even identified” and (2) “it is impossible to discern . . . whether the pin seal surface is concave, convex, frusto-conical or tapered, and likewise whether the box seal surface is convex, concave, frusto-conical or tapered.” Advisory Action (dated Jan. 25, 2019, hereinafter Adv. Act.) 2. The Examiner further notes that “there is nothing in the [S]pecification which describes the shape or configuration of the seal surfaces.” *Id.*

In response, Appellant provides annotated Figures 1A and 8 of the Drawings as shown below:



**FIG. 1A**  
**(Prior Art)**

Appellant’s annotated Figure 1A of the Drawings illustrates “straight frusto-conical [pin and box] seal surfaces” 1424, 1524. Reply Brief (filed Sept. 17, 2019, hereinafter “Reply Br.”) 3.



**FIG. 8**

Appellant’s annotated Figure 8 of the Drawings illustrates a “convex box seal surface” and “concave pin seal surface.” Appeal Br. 4. Thus, according to Appellant, “Fig. 8 clearly shows the pin seal surface being concave and the box seal surface being convex” and in conjunction with paragraph 34 of

the Specification “describe pin 20 and box 120 similarly to . . . Fig. 2A with pin seal surface 24 and box seal surface 124.” *Id.*; Reply Br. 2.

“The test for the sufficiency of the written description ‘is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.’” *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 682 (Fed. Cir. 2015) (quoting *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)). Here, we agree with the Examiner “there is nothing in the [S]pecification which describes the shape or configuration of the seal surfaces.” Ans. 4. At best, the Specification describes pin seal surface 24 and box seal surface 124 generically as surfaces that are forced together to come into contact, i.e., wedged. *See* Spec. Abstract, paras. 20, 22, 25, 26, 28. Paragraph 34 of the Specification, to which Appellant cites to as support, refers to pin and box torque shoulders 26, 126 and does not mention in any manner the shape or configuration of pin and box seal surfaces 24, 124. Hence, Appellant’s Specification provides no details on the shape or configuration of pin seal surface 24 and box seal surface 124, as recited by claim 16.

As to Appellant’s Drawings, we note that consistent with the description in the Specification, at least each of Figures 2A, 3A, 5A, and 7 illustrates pin seal surface 24 and box seal surface 124 as contacting surfaces. We appreciate that “drawings alone may be sufficient to provide the ‘written description of the invention’ required by § 112, first paragraph.” *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). However, in this case, we agree with the Examiner that “it is unclear” to a person of ordinary skill in the art, when viewing Appellant’s Figures 2A and

8, that pin and box seal surfaces 24, 124 are concave and convex, respectively. Ans. 4. In other words, a skilled artisan would not reasonably observe from Appellant's Figures 2A and 8 that contacting pin and box seal surfaces 24, 124 are concave and convex, respectively. Moreover, we do not discern any substantial visible difference in the contacting "straight" frusto-conical sealing surfaces illustrated in Appellant's Figure 1A and sealing surfaces 24, 124 in Figure 8.

As such, for the foregoing reasons, we agree with the Examiner's conclusion that Appellant's original disclosure does not reasonably convey to those skilled in the art that Appellant had possession of the subject matter of claim 16 as of the filing date of the present application. Accordingly, we sustain the rejection of claim 16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 17–24 fall with claim 16.

The Examiner also objected under 35 U.S.C. § 132(a) to an amendment to the Specification filed on Feb. 13, 2018 on the ground that the amendment introduced new matter into the original disclosure. Final Act. 2. Ordinarily, an objection is reviewable by petition under 37 C.F.R. § 1.181 and a rejection is appealable to the Patent Trial and Appeal Board. When the issue of new matter presented is the subject of both an objection and a rejection, however, the issue is appealable. Manual of Patent Examining Procedure (MPEP) § 2163.06, II. Review of New Matter Objections And/Or Rejections (9th Ed., Rev. 8, January 2018). *See also* MPEP § 608.04(c) ("where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that

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new matter has been introduced into the specification also.”). To the extent that the objection to the Specification in the Final Rejection turns on the same issues as the rejection under 35 U.S.C. § 112(a), our decision with respect to the rejection is dispositive as to the corresponding objection.

#### CONCLUSION

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/ Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
16–24	112(a)	Written Description	16–24	

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

AFFIRMED