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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEVEN LEARY and MARGARET FITZGERALD

Appeal 2020-000068
Application 14/080,255[1]
Technology Center 3700

Before JOSEPH A. FISCHETTI, MICHAEL C. ASTORINO, and BRUCE T. WIEDER, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1–9, 11–14, 16–19, 22, 23, 26–29, 32, 33, 36, and 37. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Flange Skillets International, LLC. (Appeal Br. 1.)

CLAIMED SUBJECT MATTER

Appellant's "invention relates generally to an apparatus and method for insertion of gaskets and, more particularly, to an apparatus for and a method of inserting sealing gaskets between flange connectors of adjacent pipe sections of underwater pipe line sections." (Spec. 1, ll. 12–15.)

Claims 1 and 26 are the independent claims on appeal. Claim 1 is illustrative. It recites:

> 1. A gasket insertion apparatus comprising:
> a frame configured to have a gasket mounted therein;
> a handle; and
> at least one adjustable arm member extending from the handle, the at least one adjustable arm member formed from a malleable material and configured to transition from a first fixed position, in a same plane relative to the handle, to a second fixed position, the second fixed position not in the same plane relative to the handle,
> wherein a bottom edge of the at least one adjustable arm member is configured to rest upon a flange of a flange assembly when the at least one adjustable arm member is in the second fixed position.

REJECTIONS

Claims 1–6, 8, 9, 11, 12, 22, 23, 26, 27, 29, 32, 36, and 37 are rejected under 35 U.S.C. § 102(b) as anticipated by Vidrine (US 2011/0167607 A1, pub. July 14, 2011).

Claims 1–9, 11, 12, 22, 23, 26–29, 32, 36, and 37 are rejected under 35 U.S.C. § 103(a) as unpatentable over Vidrine and McCreary (US 2,339,479, iss. Jan. 18, 1944).

Claims 13, 14, 16–19, and 33 are rejected under 35 U.S.C. § 103(a) as unpatentable over Vidrine, McCreary, and McNeal (US 4,495,690, iss. Jan. 29, 1985).

ANALYSIS

The § 102(b) rejection

The Examiner finds that Vidrine teaches "a gasket insertion apparatus (10) comprising: a frame (12); a handle (18); and at least one adjustable arm member (37) extending from the handle (18), the at least one adjustable arm member formed from a malleable material." (Non-Final Action 2.) The Examiner also finds that Vidrine teaches

> that the apparatus may be made of any structurally suitable material such as aluminum or aluminum alloys, steel, stainless steel, mild steel, polymeric composites, or industrial laminates such as those Manufactured By Norplex-Micarta, Industrial Laminates/Norplex. Most of these materials are the same as the materials disclosed by Appellant to form the gasket insertion apparatus (see Appellant's specification, page 9, lines 14-16). Therefore, the characteristics of the materials for both apparatuses (Instant application and Vidrine) are going to be similar, thus the properties of being adjustable/deformable/ malleable are the same. Furthermore, these types of materials are inherently capable of being deformed.

(Answer 5.)

Appellant argues that "[a]n adjustable arm member is not disclosed or suggested by Vidrine." (Appeal Br. 4.) Specifically, Appellant argues that with regard to tabs 37 shown in Figures 1 and 2 of Vidrine, Vidrine "fails to teach or disclose that these tabs are 'configured to transition from a first fixed position, in the same plane relative to the handle, to a second fixed

position, the second fixed position not in the same plane relative to the handle', as recited in the pending claims." (*Id.* at 5.)

Vidrine discloses "[a] gasket insertion apparatus and method for inserting a fluid sealing gasket between the bolted connection flanges of adjacent underwater pipe line segments." (Vidrine, Abstract.) Vidrine further discloses that "[t]he apparatus **10** [(which includes tabs 37)] may be made of any structurally suitable material such as aluminum or aluminum alloys, steel, stainless steel, mild steel, polymeric composites, or industrial laminates." (*Id.* ¶ 14, 19, Figs. 1, 2.)

Appellant's Specification discloses that "[a]rms **500** are sufficiently malleable or flexible to permit manual bending and may be made of any structurally suitable material, for example, aluminum or aluminum alloys, steel, stainless steel, mild steel, polymeric composites, sheet metal, and industrial laminates." (Spec. 11, ll. 17–20.) In view of Appellant's Specification's characterization of these materials, we agree with the Examiner that the disclosure of some of these same materials in Vidrine establishes that Vidrine discloses forming tabs 37 from a malleable material. (*See* Answer 5.)

But claim 1 recites more than the use of a malleable material to make the at least one adjustable arm member. Claim 1 also recites that the adjustable arm member is "configured to transition from a first fixed position, in a same plane relative to the handle, to a second fixed position, the second fixed position not in the same plane relative to the handle." In other words, it is not sufficient that Vidrine discloses that the adjustable arm member is formed from a malleable material. The Examiner agrees, noting that for the arm member to be configured to be adjustable, one must look to

both "the structure of the arm and the material characteristics thereof." (*Id.*) Thus, to anticipate claim 1, Vidrine must also expressly or inherently disclose that the arm/tab is configured to transition from a first fixed position, in a same plane relative to the handle, to a second fixed position, not in the same plane.

Vidrine's discussion of tabs 37 is limited. Vidrine discloses that "[c]ertain embodiments of the present invention may also include tabs **37,** which may be configured to rest the insertion apparatus **10** on flange **30** to provide additional stability." (Vidrine ¶ 19; *see also id.* at Figs. 1–2.) Nonetheless, the

> Examiner believes the material of arm members (37) of Vidrine is fully capable of being grabbed and bent in ANY number of desirable positions. Since this is an apparatus claim and all the structural limitations are met, there is no reason why the tab/arm of Vidrine could not be deformed or adjusted from one position to another.

(Answer 5–6.)

"[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

> If the prior art reference does not expressly set forth a particular element of the claim, that reference may still anticipate if that element is 'inherent' in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing

> may result from a given set of circumstances is not sufficient." *Id*. at 1269, 948 F.2d 1264, 20 U.S.P.Q.2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)).

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999).

Vidrine does not expressly set forth that tabs 37 are "configured to transition from a first fixed position, in a same plane relative to the handle, to a second fixed position, the second fixed position not in the same plane relative to the handle," as recited in claim 1. Nor do Figures 1 and 2 of Vidrine, which show tabs 37, expressly set forth such a configuration. *See Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951, 956 (Fed. Cir. 2000) ("[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue."). Thus, we must ask whether this claim element is necessarily present in the apparatus described in Vidrine.

Appellant argues that "Vidrine states that the tabs 'provide additional stability' in resting the insertion apparatus on the flange. Vidrine at Paragraph [0019]. If the tabs were adjustable or movable from one position to another, the stability of the apparatus would be compromised." (Appeal Br. 5.) Moreover, Vidrine is silent on any potential for movement or adjustment of the position(s) of tabs 37 from a first to a second fixed position relative to a plane of the handle in accordance with claim 1. Nor does the Examiner sufficiently explain why, in addition to being made of a malleable material, the tabs 37 of Vidrine are necessarily configured to transition from a first to a second fixed position. While it may be possible to

configure tabs 37 to so transition, we do not agree that this element is necessarily present in the apparatus described in Vidrine.

Absent the Examiner directing us to additional evidence, we do not agree that the missing descriptive matter, i.e., that the adjustable arm member is configured to transition from a first fixed position, in the same plane relative to the handle, to a second fixed position, not in the same plane, is necessarily present in the apparatus described in Vidrine.

In view of the above, we will reverse the rejection of claim 1 under § 102(b). Independent claim 26 includes similar language and for similar reasons, we will reverse the § 102(b) rejection of claim 26, and dependent claims 2–6, 8, 9, 11, 12, 22, 23, 27, 29, 32, 36, and 37.

The § 103(a) rejection

In rejecting claim 1 under § 103(a), the Examiner finds that Vidrine "does not explicitly teach to transition the at least one adjustable arm member from a first fixed position relative to the handle, the first fixed position in a same plane relative to the handle to a second fixed position relative to the handle."[2] (Non-Final Action 10.) The Examiner relies on McCreary "solely to teach that it is known to manufacture a flat apparatus (bendable tongue 20) in a compact position that eventually, when used, is bent away from its original planar configuration to an expanded position, i.e. its final desired shape (McCreary, Figures 1, 5 and 6)." (Answer 7.)

[2] We note that claim 1 does not recite "to transition the at least one adjustable arm member." Rather, claim 1 recites "configured to transition."

McCreary discloses

> a composite gasket or gasket assembly comprising two component elements or parts, first: a pressure sealing element or gasket proper, also designated as a packing element, serving to cooperate with the opposed faces of the joint for sealing the pressure, and second: a gauge element or compression limiting element for limiting the approach of the joint faces toward each other and thus limiting the extent to which the sealing element may be compressed by the faces of the joint.

(McCreary, col. 1, ll. 8–18.) McCreary further discloses that the gasket includes "a pliable non-resilient interlocking means which comprises a bendable portion which can readily be bent by means of hand tools to effect the interlocking and which will permanently remain fixed in the bent interlocked position until manually returned to a non-interlocking position." (*Id.* at col. 2, ll. 43–49.)

The Examiner determines that

> it would be obvious to one having ordinary skill in the art to use the teachings of McCleary [sic] to manufacture the gasket apparatus of Vidrine as a flat component with all the portions of the apparatus in the same plane to maintain a compact position for fabrication and storage, and when in use, bend the tabs to the desired expanded position.

(Answer 7.) This suggests that the Examiner finds in McCreary, or at least in the combination of Vidrine and McCreary, some reason to modify tabs 37 of Vidrine to make them adjustable. But the Examiner goes on to explain that

> *since Vidrine is capable of adjustment in any number of desirable positions (including the claimed positions)*, McCreary was used to teach that when a user is ready to use the apparatus, portions of the apparatus can be bent away, these portions having a transition from a compact position to an expanded position to serve its desired function.

(*Id.* at 7–8 (emphasis added).) In short, the Examiner's obviousness determination, like the Examiner's anticipation determination, relies on Vidrine disclosing that tabs (37) are adjustable. However, for the reasons discussed above, we do not agree that Vidrine discloses that tabs 37 are adjustable. (*See id.*)

In view of the above, we will reverse the rejection of claim 1 under § 103(a). Independent claim 26 includes similar language and for similar reasons we will reverse the rejection of claim 26 under § 103(a). With regard to dependent claims 13, 14, 16–19, and 33, McNeal does not cure the described deficiency. Therefore, we will also reverse the § 103(a) rejections of dependent claims 2–9, 11–14, 16–19, 22, 23, 27–29, 32, 33, 36, and 37.

CONCLUSION

The Examiner's rejection of claims 1–6, 8, 9, 11, 12, 22, 23, 26, 27, 29, 32, 36, and 37 under 35 U.S.C. § 102(b) is reversed.

The Examiner's rejections of claims 1–9, 11–14, 16–19, 22, 23, 26–29, 32, 33, 36, and 37 under 35 U.S.C. § 103(a) are reversed.

Specifically:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–6, 8, 9, 11, 12, 22, 23, 26, 27, 29, 32, 36, 37	102(b)	Vidrine		1–6, 8, 9, 11, 12, 22, 23, 26, 27, 29, 32, 36, 37
1–9, 11, 12, 22, 23, 26–29, 32, 36, 37	103(a)	Vidrine, McCreary		1–9, 11, 12, 22, 23, 26–29, 32, 36, 37
13, 14, 16–19, 33	103(a)	Vidrine, McCreary, McNeal		13, 14, 16–19, 33
Overall Outcome				1–9, 11–14, 16–19, 22, 23, 26–29, 32, 33, 36, 37

REVERSED