

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER ROMANN, FERDINAND REITER,
and RUDOLF BABITZKA

Appeal No. 2001-0089
Application No. 08/975,469

ON BRIEF¹

Before CALVERT, COHEN, and BAHR, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 7 through 9, and 16. Claim 10 through 15 stand withdrawn from consideration by the examiner, in accordance with 37 CFR

¹ An oral hearing set for May 22, 2001 was waived by appellants (Paper No. 42).

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1.142(b), as being based upon a non-elected invention. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to a method of forming a plastic sheath on an electromagnetic valve and an annular plastic ring in a retaining groove in an inlet end of the electromagnetic valve. A basic understanding of the invention can be derived from a reading of exemplary claims 7 and 16, copies of which appear in the APPENDIX to the revised brief filed August 31, 1999 (Paper No. 36).

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

Hensley	4,610,080	Sep. 9,
		1986

The following rejection is before us for review.

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Claims 7 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hensley.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper No. 37), while the complete statement of appellants' argument can be found in the brief² (Paper No. 36).

OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellants' specification and claims,³ the applied

² We are informed by appellants (brief, page 1) of the earlier decision in Appeal No. 97-0253 wherein "the claimed subject matter was different." That decision affirmed a rejection under 35 U.S.C. § 112, first paragraph, and reversed a rejection under 35 U.S.C. § 103 based upon the Hensley patent, the same patent applied in the current appeal.

³ Claim 16 (line 2), as it appears in the Appendix to the brief, lacks the recitation of --in a retaining groove-- after "ring", which recitation is found in the file copy of the claim. Thus, the examiner's indication (answer, page 2) that a correct copy of the claims is contained in the Appendix is in error.

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Hensley patent,⁴ the declaration of Waldemar Hans, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

We cannot sustain the rejection of appellants' claims under 35 U.S.C. § 103.

Initially, we appreciate from a reading of the specification, as originally filed, that an annular groove is provided on the circumference of the inlet-side end of a fuel inlet connecting piece whose radially extending side surfaces are formed by a plastic sheath surrounding a part of the valve, the groove base being formed by the circumference of the fuel inlet connecting piece (pages 1 and 2). The original

⁴ In our evaluation of the applied Hensley reference, we have considered all of the disclosure of this document 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).

specification further sets forth (page 5) that the plastic sheath 18 extends axially, originating from the fuel inlet connecting piece 1, and forms radially extending side surfaces of the annular groove 25 which is provided on the circumference of the inlet-side end 44 of the fuel inlet connecting piece 1. The groove base of the annular groove is specified as being formed by the circumference of the fuel inlet connecting piece 1. As recited in the original specification (page 5), "[t]he plastic sheath 18 engages into a retaining groove 46 at the inlet-side end 44 of the fuel inlet connecting piece 1."

Independent method claims 7 and 16 each respectively require, inter alia, the step of forming an annular plastic ring in a retaining groove⁵ in an inlet end of an electromagnetic valve. We understand this step to require

⁵ The term "annular plastic ring", which ring is formed in the retaining groove as claimed, is nomenclature which does not appear in the original specification. As indicated above, the original specification sets forth that the "plastic sheath 18" engages into the retaining groove 46.

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that the annular plastic ring be fabricated *in situ* within the retaining groove.

Turning now to the applied Hensley patent (Figures 1 and 3), we recognize the positioning of an unnumbered member in a groove at the upper end of the pole piece 18. Additionally, we find that the written specification of the patent does not provide any description of this member at all.

The examiner's view is that the claimed method would have been obvious from the Hensley document. We disagree.

Simply stated, the proffered evidence clearly fails to provide any suggestion whatsoever for the step of forming an annular plastic ring in a retaining groove in an inlet end of an electromagnetic valve, as now claimed. Since, as indicated, the examiner has not provided adequate evidence supporting the obviousness of the claimed invention, the rejection must be reversed.

REMAND TO THE EXAMINER

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We remand this application to the examiner as review the following matter.

The examiner should consider whether the claimed subject matter has descriptive support (35 U.S.C. § 112, first paragraph) in the underlying disclosure. As pointed out above, appellants' original disclosure explicitly teaches that plastic sheath 18 engages into the retaining groove 46. Thus, the now claimed "annular plastic ring" obviously evolved from the plastic sheath 18. However, the disclosure is silent as to what method steps effected the metamorphosis from the plastic sheath engaging the retaining groove to the plastic sheath and spaced "annular plastic ring" arrangement depicted in appellants' Figure 1. It is also noted that, as disclosed, the plastic sheath forms radially extending side surfaces of an annular groove 25. The examiner should review the language of each of claims 7 and 16, in particular, to ascertain if the disclosure supports forming an annular plastic ring in a retaining groove, forming a plastic sheath, and forming an annular groove bordered between the plastic sheath and the annular plastic ring. Further, the examiner should assess the

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disclosure to ascertain whether it supports the forming of an annular plastic ring "at a time different" from forming the plastic sheath, a feature of method claim 16.

The decision of the examiner is reversed.

REVERSED AND REMANDED

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