

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID J. CLINE, TIMOTHY S. CLARK, STEPHEN P. GORDON  
and MICHAEL R. ENGLE

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Appeal No. 2003-0132  
Application 09/741,356

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ON BRIEF

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Before ABRAMS, FRANKFORT, and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 17. Claims 18 through 22 have been withdrawn from further consideration by the examiner as being directed to a non-elected invention. Claims 23 through 27, the only other claims remaining in the application, stand allowed. Claim 28 has been canceled.

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On page 1 of the specification, appellants note that the field of the invention relates to devices that meter and dispense singular and plural component liquids and solids (e.g., powders). More particularly, appellants identify as a first aspect of the invention (specification, page 5), a dispensing system including a valved nozzle to dispense material from a progressive cavity pump, wherein the nozzle does not directly control the pump. Rather, a pressure sensor located downstream from the progressive cavity pump senses flow pressure in the system, which pressure is impacted upon by operation of the remote nozzle, and a controller responds to the pressure build-up or decay and controls the pump accordingly. Independent claims 1 and 9 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellants' brief.

As set forth on page 3 of the answer, the patents purportedly relied upon by the examiner in rejecting the appealed claims are:

Suh et al. (Suh)	4,170,319	Oct. 9, 1979
Cline et al. (Cline '686)	5,992,686	Nov. 30, 1999

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The sole rejection on appeal is set forth on page 4 of the answer as follows:

Claims 1-8 and 9-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-14 and 1-6 of U.S. Patent No. 5,992,686. Although the conflicting claims are not identical, they are not patentably distinct from each other because the inclusion of structures and limitations not found in claims 10-14 and 1-6 of U.S. Patent No. 5,992,686 as compared with claims 1-8 and 9-17 of the subject application are conventional and well know in the dispensing art. It therefore would have been obvious to one having ordinary skill in the art to have included these structures and limitations in order to obtain the benefit of their associated function as is old and well known in the art.

Of particular interest here is the fact that the Suh patent noted above is not set forth or specifically relied upon in the rejection as stated by the examiner. However, it appears that the examiner has, in the "Response to Argument" section of the answer, relied upon this patent. As noted by the Court of Customs and Patent Appeals in In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 (CCPA 1970), where a reference is relied upon to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the rejection.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the obviousness-type double patenting rejection, we refer to the examiner's answer (Paper No. 13, mailed July 8, 2002) and to appellants' brief (Paper No. 12, filed March 27, 2002) for a full exposition thereof.

#### OPINION

After careful consideration of appellants' specification and claims 1 through 17, the subject matter set forth in claims 1 through 6 and 10 through 14 of Cline '686, and each of the arguments and comments advanced by appellants and the examiner, we have reached the determinations which follow.

While the examiner has purportedly rejected claims 1 through 17 under the judicially created doctrine of obviousness-type double patenting, we observe that the examiner has apparently lost sight of the need for such a rejection to include an analysis paralleling that required in a 35 U.S.C. § 103 obviousness determination, i.e., an analysis including the factual inquiries set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966). More particularly, we note that the

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examiner has not determined the scope and content of a patent claim and the prior art relative to a claim in the application at issue, nor determined the differences between the scope and content of such patent claim and a claim in the application at issue. Nor has the examiner, in the rejection, set forth any evidential basis to support a conclusion that the invention defined in a claim at issue is an obvious variation of the invention defined in a claim in the prior patent and thus established that such a claim would constitute an unjustified extension of the term of the right to exclude granted by the patent.

The examiner's assertion (answer, page 4) that "the inclusion of structures and limitations not found in claims 10-14 and 1-6 of U.S. Patent No. 5,992,686 as compared with claims 1-8 and 9-17 of the subject application are conventional and well known in the dispensing art" and the conclusion that it therefore would have been obvious to one of ordinary skill in the art "to have included these structures and limitations in order to obtain the benefit of their associated function as is old and well known in the art" are nonsensical, woefully factually inadequate, and provide no meaningful insights or factual analysis for our

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review. By failing to properly ascertain the differences between the scope and content of a patent claim and a claim in the application at issue and failing to provide any fact-based analysis relying on evidence to support a conclusion that any of claims 1 through 17 of the present application are unpatentable under the judicially created doctrine of obviousness-type double patenting over any of claims 1 through 6 and 10 through 14 of U.S. Patent No. 5,992,686, the examiner has clearly failed to established a prima facie case of obviousness-type double patenting. Accordingly, we are unable to sustain the examiner's double patenting rejection of claims 1 through 17 as stated in the answer.<sup>1</sup>

In the interest of judicial economy and to relieve appellants of the need for any further protracted prosecution of the application, we will also comment upon the examiner's attempt to use the Suh patent in establishing that claims 1 through 17 of the present application are unpatentable under the judicially

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<sup>1</sup> In making any future rejection of the type present here, the examiner would be well served to review the memorandum issued to the Examining Corps by Deputy Commissioner for Patent Examination Policy, Steven G. Kunin, entitled "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice," dated February 21, 2002.

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created doctrine of obviousness-type double patenting over claims 1 through 6 and 10 through 14 of U.S. Patent No. 5,992,686. In that regard, we find that we are in general agreement with appellants' comments and arguments in the brief, pages 3-8, concerning this aspect of the examiner's position. Even if we were to agree with the examiner that Suh generally evidences the existence and use of a conduit, valves and a nozzle in a fluid delivery and mixing system at a time prior to that of appellants' invention, we find no basis in such patent for utilizing those elements in the particular locations and manner required in the dispensing systems of claims 1 through 17 on appeal or any basis for modifying the dispensing systems of claims 1 through 6 and 10 through 14 of U.S. Patent No. 5,992,686 so as to result in the systems now claimed by appellants.

Moreover, we would also note that at least independent claims 1 and 10 of U.S. Patent No. 5,992,686 include limitations not present in independent claims 1 and 9 of the present application, which differences have also not been addressed by the examiner, i.e., claim 1 of the patent requires that control of the motor be based on the pressure sensed by the pressure sensor and "on the pressure sensed by the pressure sensor as a function

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of time," which limitation is not in claim 9 of the application, while claim 10 of the patent requires a pump control system "including a preset target pressure" and that pump speed be controlled "as a function of the differential pressure between actual pressure of the pressure sensor and the preset target pressure by the pump control system," which limitations are not present in claim 1 of the application.

In the final analysis, it is clear to us that the examiner has not made out a prima facie case for obviousness-type double patenting.

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The examiner's decision rejecting claims 1 through 17 under the judicially created doctrine of obviousness-type double patenting is reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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