

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte ANDREA FLORIO and FABIO BUCCI

---

Appeal No. 2003-0222  
Application 09/555,910

---

ON BRIEF

---

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

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11 and 13 through 19, which are all of the claims remaining in this application. Claims 1 through 10 and 12 have been canceled.

Appellants' invention is directed to a valve with a ball of controlled deformation. Independent claim 11 is representative

Appeal No. 2003-0222  
Application 09/555,910

of the subject matter on appeal and a copy of that claim may be found in the Appendix to appellants' brief.

The sole prior art reference relied upon by the examiner in rejecting the appealed claims is:

Sanctuary	3,348,805	Oct. 24, 1967
-----------	-----------	---------------

Claims 11, 13, 14 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sanctuary.

Claims 15, 16, 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sanctuary.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 19, mailed June 5, 2002) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 17, filed May 6, 2002) and reply brief (Paper No. 20, filed July 31, 2002) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art Sanctuary reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

We look first to the examiner's rejection of claims 11, 13, 14 and 17 under 35 U.S.C. § 102(b) as being anticipated by Sanctuary. In the final rejection mailed February 13, 2002 (Paper No. 15), the totality of the examiner's statement with regard to claims 11, 13, 14 and 17 is that such claims are "rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Sanctuary." No attempt at all was made by the examiner to read the claims rejected under 35 U.S.C. § 102(b) on the ball valve structure of Sanctuary. In the Response to Arguments section of the final rejection, the examiner provides the following commentary:

It is the opinion of the Examiner that the ball structure *disclosed*, much less the claimed, does not overcome the invention of Sanctuary. The structure is virtually

Appeal No. 2003-0222  
Application 09/555,910

identical and any variations disclosed are deemed to be obvious in light of Sanctuary. The yielding zones are downstream of one of the valve seats and upstream of another. The same can be said for the instant invention. There is a spherical portion facing the inlet as well as the outlet. The lips are considered to be spherical surface portions. The rejections are deemed to be proper.

In the examiner's answer (Paper No. 19), the examiner has rejected claims 11, 13, 14 and 17 under 35 U.S.C. § 102(b) "as being anticipated by Sanctuary" and again not provided any indication of what elements or components in the Sanctuary patent are considered to correspond to the elements set forth in claims 11, 13, 14 and 17 on appeal, or provided any pertinent or cogent commentary responsive to appellants' arguments.

Appellants have argued in both the brief (page 5) and reply brief that the requirement for yielding zones in the spherical portion of the shutter element of claim 11 located downstream of the seat with respect to a pressure zone along a face of the shutter element exposed to the fluid in the inlet in the closure position of the shutter element, is not disclosed in Sanctuary. More specifically, appellants have pointed out that the entirety of the flange (33) and its edge (34) in the ball valve-closed position in Sanctuary contacts the seat (17), i.e., that no

Appeal No. 2003-0222  
Application 09/555,910

portion of the resilient lip or flange (33) in the ball valve of Sanctuary lies downstream of the seat (17) therein.

As a response to appellants' arguments, the best we get from the examiner is that the structure of the ball valve in Sanctuary is "virtually identical and any variations disclosed are deemed to be obvious in light of Sanctuary" (answer, page 5). In addition, the examiner makes the observation (also on page 5 of the answer) that "[t]he yielding zones [presumably of Sanctuary] are downstream of one of the valve seats and upstream of another" and that "[t]here is a spherical portion facing the inlet as well as the outlet." None of which comments seems to us to be specifically responsive to appellants' arguments.

As noted in MPEP § 1208, when preparing an Examiner's answer, for each rejection under 35 U.S.C. § 102, the examiner "shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. § 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." In the present case, the examiner has made no effort whatsoever to comply with this requirement. Accordingly, we find that the examiner has not

Appeal No. 2003-0222  
Application 09/555,910

made out a *prima facie* case of anticipation based on the Sanctuary patent. For this reason, and those put forth by appellants in the brief and reply brief, we will not sustain the examiner's rejection of claims 11, 13, 14 and 17 under 35 U.S.C. § 102(b) as being anticipated by Sanctuary.

In reaching our conclusion above vis-a-vis the examiner's rejection of claims 11, 13, 14 and 17 under 35 U.S.C. § 102(b), we understand the requirement in appellants' independent claim 11 for a shutter element having "yielding zones in the spherical portion disposed downstream of said seat," to be readable on those portions or zones of the yieldable portion of the ball/shutter element (13) at the inlet end of the valve that are located completely downstream of, and thus not in contact with, the ring seat (12). The "yielding zones" of appellants' invention can most clearly be seen in Figures 5 and 6 of the application drawings, particularly Figure 5. While the lip or flange (33) of the ball (15) formed as a result of the recess (32) extending into the ball in Sanctuary may well define a yielding portion at the inlet end (12) of the valve, given that the terminal edge (34) of that yielding portion is expressly described in Sanctuary (col. 3, lines 17-18) as being in contact

Appeal No. 2003-0222  
Application 09/555,910

with the seat (17), it is clear to us that Sanctuary has no yielding zones disposed downstream of the seat with respect to a pressure zone along a face of the shutter element exposed to the fluid in the inlet in the closure position of the shutter element, as required in claim 11 on appeal.

The examiner's rejection of claims 15, 16, 18 and 19 under 35 U.S.C. § 103(a) based on Sanctuary fares no better than the rejection discussed above. In the instance of the obviousness rejection, the examiner has "deemed" each of the differences between that which is claimed by appellants and that which might be present in Sanctuary to be "design choice" or "an obvious matter of design choice," and asserted that the structure seen in Sanctuary "is deemed to be a full equivalent" (answer, pages 3-4). The examiner also contends that appellants have "failed to state the criticality the different shapes bring to the invention." For the reasons set forth on pages 5 through 8 of the brief, we agree with appellants that the examiner has failed to put forth a *prima facie* case of obviousness. Accordingly, the examiner's rejection of dependent claims 15, 16, 18 and 19 under 35 U.S.C. § 103(a) will likewise not be sustained.

Appeal No. 2003-0222  
Application 09/555,910

It follows from the above determinations that the decision of the examiner rejecting claims 11 and 13 through 19 of the present application is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	

CEF:pgg

Appeal No. 2003-0222  
Application 09/555,910

Nixon & Vanderhye  
1100 North Glebe Road  
8th Floor  
Arlington, VA 22201-4714