

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GLEN T. PRESLEY

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Appeal No. 2003-1494  
Application 09/685,178

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ON BRIEF

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Before KRASS, STAAB and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief and reply brief, and based on our review, find that we cannot sustain the grounds of rejection advanced by the examiner on appeal: claims 1, 2, 4, 5, 7, 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Douglas in view of Baldwin; claims 3 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Douglas in view of Baldwin as applied to claims 1 and 7 above, and further in view of Graf; and claims 6 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Douglas in view of Baldwin as applied to claims 1 and 7

above, and further in view of Seitter et al.<sup>1,2</sup> We refer to the examiner's answer and to appellant's brief and reply brief for a complete exposition of the opposing views of the parties.

It is well settled that in order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988).

The dispositive issue in this appeal is whether Douglas would have reasonably suggested to one of ordinary skill in this art to use "a pressure-sensing switch having a single operating point" in an on demand fluid handling system as required by each of appealed independent claims 1 and 7. We find that, when considered in light of the written description in the specification as interpreted by one of ordinary skill in this art, *see, e.g., In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), this plain language of the appealed claims simply requires a pressure-sensing switch that operates at a single pre-set pressure. *See* specification, page 3, line 20, to page 4, line 3; *see also* brief, page 4, lines 5-8, and page 6, lines 8-9, and reply brief, page 2. We cannot agree with the examiner's position that since the pressure sensing switch in the preferred embodiment in the specification appears to have two operating points (page 6, line 20, to page 8, line 4), the subject claim language would encompass a switch that functions in the same manner (answer, pages 5-6). As the examiner notes (*id.*, page 6), limitations from the specification are

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<sup>1</sup> Appended claims 1 through 11 are all of the claims in the application. See the appendix to the brief.

not read into the claim language without basis therefor in that language, and we find no basis to read a two position switch into the language of the appealed claims. *See generally, Morris, supra; Zletz, supra.* Indeed, the claim language must be considered as it stands, regardless of the examiner's view of the sufficiency thereof vis-à-vis the disclosure in the specification (answer, pages 5-6). *Cf. Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir 1984).

Turning now to the disclosure of Douglas, on this record, we agree with appellant (brief, pages 4-5 and 6; reply brief, pages 1-2) that, as a matter of fact, the disclosure of Douglas at page 2, lines 7-13 and 60-63, would have reasonably disclosed to one of ordinary skill in this art a pressure-sensing switch mechanism that has two operating points and not “a pressure-sensing switch having a single operating point” as required by the appealed claims. We note here that the examiner does not rely on any of the other applied references with respect to this claim limitation.

Accordingly, appellant having rebutted the examiner's *prima facie* case of obviousness, we reverse the grounds of rejection. *See generally, Oetiker, supra.*

The examiner's decision is reversed.

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<sup>2</sup> Answer, pages 3-5.

*Reversed*

ERROL A. KRASS	)	
Administrative Patent Judge	)	
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	)	
LAWRENCE J. STAAB	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
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CHARLES F. WARREN	)	
Administrative Patent Judge	)	

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