

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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW NOESTHEDEN

Appeal No. 2004-0481
Application 09/783,260

ON BRIEF

Before WARREN, OWENS and DELMENDO, *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 based on our review, find that we cannot sustain either of the grounds of rejections of appealed claims 1, 6 and 7,¹ all of the claims in the application, under 35 U.S.C. § 103(a) as being unpatentable over Strong in view of Flores et al. (Flores) and Lucore, II (Lucore), and over Mercier et al. (Mercier) in view of Flores and Lucore.²

We refer to the examiner's answer and to appellant's brief for a complete exposition of the respective positions advanced by the examiner and appellant.

¹ See the appendix to the brief.

² Answer, pages 3-6.

In order to establish a *prima facie* case of obviousness, 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 Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (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); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). The requirement for objective factual underpinnings for a rejection under § 103(a) extends to the determination of whether the references can be combined. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), and cases cited therein.

We agree with appellant (brief, e.g., pages 5-6) that the issues in this appeal as to both grounds of rejection, center on the claim language “means for removing air from an interior of said [elongated] conduit [having one end fluidly connected to said reservoir in a tank] . . . said removing means comprising an air bleed fluid circuit fluidly connected to said conduit adjacent said nozzle downstream from said gate valve [connected in series between said one end of said conduit and said reservoir]” in appealed claim 1. In giving the claim terms their broadest reasonable interpretation in light of the written description in the specification as interpreted by one of ordinary skill in this art, *see, e.g., In re Thrift*, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002); *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), the plain language of the appealed claims specifies an apparatus in which the air removing means is fluidly connected to the conduit adjacent to the nozzle downstream from the gate valve.

The examiner contends that Strong discloses, *inter alia*, “an air bleed fluid circuit 24” but does not disclose, *inter alia*, a tank or a gate valve, finding that one of ordinary skill in this art

would have “substituted the water supply of Strong with the tank of [Flores] for portability (see column 1, lines 5-10 for motivation)” (answer, pages 3-4), the cited passage from Flores disclosing that the invention therein is “a portable pressurized reservoir supply tank.”

Appellant argues that the combined teachings of the applied references would not have disclosed that air relief valve **24** removes air from transfer tube **46** during fluid flow through this conduit as shown in Strong **FIGs. 2** and **4** (brief, pages 6-8). The examiner responds that the “primary function [of air relief valve **24**] is to allow air to escape from conduit 18 and/or 46 and/or 78” (answer, pages 6-7).

We agree with appellant. We find no disclosure in Strong **FIGs. 2, 4** and **5** as explained in Strong (cols. 3-5), which would have taught one of ordinary skill in this art that air relief valve **24** is fluidly connected to any conduit from its position in tank **18**, in which the purpose thereof as disclosed by Strong, is to “allow for the escape of fluid displaced vessel air as the level raises above the level of the open end of trickle tube **58**” (col. 5, lines 3-6; see also col. 2, line 61, to col. 3, line 6). Indeed, one of ordinary skill in this art would have recognized that the “vessel” is tank **18**, and would have further recognized from **FIGs. 2** and **5** that there is no connection, directly or functionally, between air relief valve **24** and the fluid flowing through transfer tube **46** in tank **18** to which hose inlet **78** is attached.³ Thus, even if one of ordinary skill in this art would have attached the tank of Flores to hose inlet **78** of transfer tube **46** of tank **18**, as the examiner argues, this person still would not have arrived at the claimed invention encompassed by appealed claim 1. See *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988).

Accordingly, on this record, we conclude that the examiner has failed to establish a *prima facie* case of obviousness over the combined teachings of the applied prior art, and accordingly, we reverse the first ground of rejection.

³ It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, see *Fritch*, 972 F.2d at 1264-65, 23 USPQ2d at 1782-83; *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968); *Aller*, 220 F.2d at 458-59, 105 USPQ at 237, presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Turning now to the second ground of rejection, the examiner attempts to read limitations of appealed claim 1 on the bleeder valve shown in the drawing of Mercier (answer, page 5) which, upon even casual review, reveals little correspondence therebetween,⁴ except that the bleeder valve is disclosed by Mercier to “bleed accumulated gas from a pressure system” (e.g., col. 1, lines 34-37), and thus is an air removing means that is fluidly connected to the conduit in which it is situated through duct **22** (cols. 1-2). The examiner finds that Mercier does not disclose, *inter alia*, a tank or a gate valve, and in the same manner that we discussed above, contends that one of ordinary skill in this art would have “substituted the fluid supply of Mercier with the tank of [Flores]” (answer, page 5).

Appellant submits that Mercier “discloses an air bleed valve for use with hydraulic systems,” citing col. 1, lines 19-23, and admits that this reference is more pertinent than Strong “since at least the direction of the air bleed is like Applicant’s,” but argues that “there is no reason or motivation, other than hindsight provided by Appellant’s disclosure to combine an air bleed valve such as disclosed by [Mercier] with” the apparatus of Flores, because unlike the apparatus of Flores, the hydraulic systems are closed systems (brief, pages 9-10). In this respect, appellant points out that the purpose of the apparatus of Flores is to spray water through nozzle **60** into the air, and thus there is no motivation to remove air from the water (*id.*, page 10).

The examiner responds that Mercier “applies to the art of valves, more particularly of the type to provide bleeding under predetermined conditions of operation from the output line of a pump delivering fluid under pressure (see column 1, lines 15-18),” and Flores “is relied on for the teachings of a portable water supply in the form of a pressurized reservoir supply tank” (answer, page 7).

We agree with appellant. We find that Flores would have disclosed to one of ordinary skill in this art that “[t]he user activates the spray gun [**60**] to direct water upon a desired surface,” and thus, the discharge assembly can be “coupled to a plurality of different devices such as shower heads, sprinklers and drinking fountains” (col. 5, lines 50-59). The examiner submits only that this person would use the valve of Mercier with the tank of Flores because both involve

⁴ For example, “the casing being of reduced diameter at **16** adjacent the liquid outlet **15**” (col. 1, lines 62-63) provides “a venturi action” (col. 1, line 47) and not a “nozzle” function as the

pressure systems. We are of the opinion that the examiner overlooks the fact that there must be some reason associated with the use of the apparatus of Flores which would have suggested to this person to make the modification, and, we agree with appellant that there is no use disclosed in Flores which would have led this person to do so. Indeed, the fact that the valve of Mercier can be incorporated into the hose of the apparatus of Flores does not alone provide the basis for combining the applied prior art. *See, e.g., Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783 (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”).

Accordingly, on this record, the examiner has failed to point to some teaching, suggestion or motivation in the prior art to support the combination of Mercier and Flores, and thus, in the absence of a *prima facie* case of obviousness, we reverse this ground of rejection. *See Lee, supra; Smith Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999); *In re Mayne*, 1043 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997); *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783; *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 9292, 933 (Fed. Cir. 1984); *In re Keller*, 642 F.2d 413, 425-26, 208 USPQ 871, 881-82 (CCPA 1981).

A discussion of Lucore is not necessary to our decision.

The examiner’s decision is reversed.

examiner contends (*id.*).

Reversed

CHARLES F. WARREN
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

ROMULO H. DELMENDO
Administrative Patent Judge

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