

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS W. PARKER

Appeal No. 96-4164
Application 08/467,295¹

ON BRIEF

Before CALVERT, FRANKFORT and STAAB, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed June 6, 1995. According to appellant, the application is a division of Application 08/307,348, filed September 16, 1994.

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DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 14, 22 and 23. Claims 1 through 12 have been canceled. Claims 13 and 15 through 21 stand allowed. Claim 24, the only other claim pending in the application, was objected to, but has been indicated to be allowable if rewritten in independent form.

Appellant's invention relates to a method of operating a reversing valve, such as that found in a vapor compression refrigeration system (e.g., a heat pump system). Of importance to appellant is that the reversing valve be so constructed and arranged that the valve member "is relieved from system fluid pressure forcing it against its seat as it moves between alternative flow directing positions along a path of travel by which it is separated from its seat, thereby avoiding substantial friction forces opposing valve member motion and enabling use of simple, low force valve actuators" (specification, page 4, lines 17-23). Independent claim 14 is representative of the subject matter on

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appeal and a copy of that claim may be found in Appendix A of appellant's brief.

The sole prior art reference of record relied upon by the examiner in rejecting claims 14, 22 and 23 is:

Van Allen et al. (Van Allen) 2,855,000 Oct. 7, 1958

Claims 14, 22 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Van Allen. According to the examiner (answer, page 3), "[t]he method steps recited [in the claims on appeal] are inherent to the apparatus of Van Allen et al."

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above § 102 rejection, we make reference to the examiner's answer (Paper No. 8, mailed September 4, 1996) for the examiner's complete reasoning in support of the rejection, and to appellant's brief (Paper No. 7, filed August 2, 1996) for appellant's arguments thereagainst.

OPINION

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In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's rejection cannot be sustained. Our reasons follow.

Claim 14 on appeal expressly requires that the method therein include, inter alia, the steps of "e. moving said valve member out of engagement with the seating face; f. shifting said valve member into juxtaposition with a second position; and, g. seating the valve member against a sealing face in the second position" As urged by appellant on page 7 of the brief, the specific issue before us on appeal is whether the above-noted steps of the claimed method are inherent in the operation of the valve disclosed by Van Allen. Like appellant, we find that the method set forth in claim 14 on appeal, and, more specifically, steps e), f) and g) thereof are not inherent to the apparatus of Van Allen.

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The examiner's position (answer, pages 5-10) that the claimed method steps are inherent to the apparatus of Van Allen, in our opinion, is without factual support in the applied reference and is based on extensive speculation by the examiner. In contrast to the position of the examiner, we find that the method as set forth in claim 14 on appeal cannot be said to be the natural result flowing from the operation of the apparatus of Van Allen, and, more particularly, that the steps e), f) and g) recited in claim 14 cannot be said to be inevitably present in the operation of the apparatus of Van Allen. See, for example, In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). Even though it appears possible that the high pressure side of the valve member (38) of Van Allen might move out of engagement with the header (16) under some given set of circumstances if the ports (52) and (68) were sized to permit a sufficient reduction of the high pressure in the chamber (11), any such movement of the valve member is contrary to the clear intent of Van Allen. In this regard, we agree with the arguments made by appellant on pages 11 through 14 of the brief and in paragraphs 9 through 14 of the declaration filed December 4, 1995 (as an attachment to Paper No. 4).

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Moreover, we note that it has been a long-standing maxim of patent law that, during examination, "claims are to be given their broadest reasonable interpretation consistent with the specification" and in, addition, that the "claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)(emphasis added). Our Court of review has also informed us that the drawings included in the application may aid in the interpretation of claim limitations, in that the "drawings alone may be sufficient to provide the 'written description of the invention' required by § 112, first paragraph. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Thus, in those instances where a visual representation can flesh out words, as in the present application, drawings can and should be used like the written specification to provide evidence relevant to claim interpretation and used to interpret what the inventor intended by the claim terms. Applying these precepts to the present application, we find that, when the claim language under consideration is read in light of the present application disclosure as such would be interpreted by the hypothetical per-

son possessing ordinary skill in the art, and particularly when this language is viewed in light of the invention as seen in Figure 5B of the application drawings, the claim language requiring the step of "moving said valve member out of engagement with the seating face" in appellant's claim 14 on appeal would be understood to require that the entirety of the valve member be moved out of engagement with the seating face, prior to shifting of the valve member to the second position, which step is clearly not present in Van Allen. Note particularly, page 9, lines 15-17, of appellant's specification, wherein it is indicated that the valve member "moves to its second position by shifting axially away from the port plate 36," rotating 90 degrees about the longitudinal housing assembly axis (70) and then shifting back into engagement with the port plate (36). In the paragraph bridging pages 15 and 16 of appellant's specification, it is again emphasized that the valve member (24) is unseated and shifted axially away from the port plate (36), with the result that the valve member is "freely rotatable relative to the guide member 72 and slide 102 so that negligible frictional resistance to valve member rotation about the axis 70 exists." Thus, it is clear that the examiner's comments in the paragraph

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bridging pages 7 and 8 of the answer, concerning the scope of claim 14 on appeal and step e) in particular, are based on too broad a construction of step e) when such step is properly understood and interpreted in light of appellant's disclosure. The above interpretation of step e) of claim 14 on appeal is consistent with appellant's arguments bridging pages 12-14 of the brief and with his position as expressed in the declaration filed December 4, 1995.

To summarize our decision, the examiner's rejection of claims 14, 22 and 23 under 35 U.S.C. § 102(b) has been reversed.

REVERSED

IAN A. CALVERT)
Administrative Patent Judge)
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CHARLES E. FRANKFORT)
Administrative Patent Judge)
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LAWRENCE J. STAAB)
Administrative Patent Judge)

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