

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BARRY J. MILLARD

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Appeal No. 1998-1928  
Application No. 08/543,153<sup>1</sup>

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ON BRIEF

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Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed October 13, 1995. According to the appellant, the application is a continuation of Application No. 08/087,774, filed November 12, 1993, now abandoned. According to the appellant, Application No. 08/087,774 was the national stage application of PCT/GB92/00069, filed January 14, 1992. In addition, PCT/GB92/00069 claimed priority of British Application No. 9100903.5, filed January 16, 1991.

Appeal No. 1998-1928  
Application No. 08/543,153

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2 through 14, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a rotary valve seal assembly. An understanding of the invention can be derived from a reading of claims 2 through 14, a copy of which appears in the appendix to the appellant's brief.<sup>2</sup>

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Johnson, Jr. 1953	2,631,907	Mar. 17,
Storms 1971	3,612,545	Oct. 12,
Duffy 1992	5,165,702	Nov. 24,

(filed May 20, 1991)

Claims 2 through 7, 10, 11 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Storms.

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<sup>2</sup> We note that claim 14 does not provide proper antecedent basis for "the inner axially extending circumferential face," "the ring member," "the resilient ring member," and "the groove bottom."

Claims 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Storms in view of Johnson, Jr.

Claims 12 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Duffy in view of Storms.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 21, mailed November 6, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 20, filed October 14, 1997) and reply brief (Paper No. 22, filed January 5, 1998) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification<sup>3</sup> and

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<sup>3</sup> We note that the 115° included angle referred to on page 9, lines 11-12, of the specification is not in harmony with the 155° included angle referred to on page 3, lines 25-26, of (continued...)

claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

**The anticipation issue**

We sustain the rejection of claims 2 through 7, 10, 11 and 14 under 35 U.S.C. § 102(b).

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358,

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<sup>3</sup>(...continued)  
the specification and claim 9.

1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

The appellant argues (brief, pp. 6-8, and reply brief, pp. 1-5) that certain features of claims 14, 7, 10 and 11 were not disclosed in Storms. We do not agree.

With regard to claim 14, the appellant argues (brief, pp. 6-7, and reply brief, pp. 1-5) that the recited

resilient ring member means located in abutment with the inner axially extending circumferential face of the seal body for urging said outer circumferential face radially outward sufficiently to maintain sealing abutment between said outer circumferential face and the bore

is not disclosed by Storms. Specifically, the appellant points out that the ring 35 of Storms is incapable of urging the seal element 25 radially outwardly. We disagree. In

determining whether or not the ring 35 of Storms is capable of urging the seal element 25 radially outwardly, we must consider all the teachings of Storms, particularly the teachings of Storms cited by the appellant in the reply brief (pp. 3-5), and especially Storms' teaching (column 3, lines 54-58) that

[c]ontrary to most split rings used in conjunction with seal elements, the restrainer ring does not operate as an energizing member in that it does not urge the seal element into sealing engagement through its own resilient character to any great extent.

When considering all the teachings of Storms, we reach the conclusion that to a small extent (i.e., not a great extent) the ring 35 of Storms does urge the seal element 25 radially outwardly. Thus, the appellant's argument with regard to claim 14 does not persuade us of any error in the examiner's rejection.

With regard to claim 7, the appellant argues (brief, pp. 7-8) that the combination recited in claim 7 is not disclosed by Storms. We do not agree. We agree with the appellant that Storms does not disclose the inner circumferential face of the seal element 25 and the outer circumferential face of the ring

35 having complimentary profiles which when engaged in abutment axially centralize the ring 35 and seal element 25. However, Storms does disclose (column 3, lines 45-49 and column 4, lines 4-24) that the outer peripheral surface 35a of the ring 35 is in opposed contacting relationship with the inner peripheral surface of the seal element 25 and that it is preferred that upon installation, there be a tight fit, and preferably an interference fit. Accordingly, Storms does disclose the inner circumferential face of the seal element 25 and the outer circumferential face of the ring 35 having complimentary profiles which inherently prevents relative axial movement between the ring 35 and seal element 25. Claim 7 is readable on Storms since claim 7 requires only that the complimentary profiles centralize the ring member and seal body and/or prevent relative axial movement between the ring member and seal body. Thus, the appellant's argument with regard to claim 7 does not persuade us of any error in the examiner's rejection.

With regard to claim 10, the appellant states (brief, p. 8) that the limitations recited in claim 10 are not disclosed

by Storms. We do not agree. As shown in Figures 1 and 5 of Storms, the combined radial height of the ring 35 and seal element 25 is greater than the axial width of the seal element 25. Thus, the appellant's argument with regard to claim 10 does not persuade us of any error in the examiner's rejection.

With regard to claim 11, the appellant asserts (brief, p. 8) that claim 11 is not met by Storms. We do not agree. We agree with the appellant that the radially extending end face of Storms' seal element 25 does not extend the entire combined radial height of the ring 35 and seal element 25. However, as shown in Figures 1 and 5, the radially extending end face of Storms' seal element 25 does extend the majority of the combined radial height of the ring 35 and seal element 25. Claim 11 is readable on Storms since claim 11 requires only that the radially extending end face of the seal body extend the entire **or** majority of the combined radial height of the ring and seal body. Thus, the appellant's argument with regard to claim 11 does not persuade us of any error in the examiner's rejection.

For the reasons stated above, the decision of the examiner to reject claims 2 through 7, 10, 11 and 14 under 35 U.S.C. § 102(b) is affirmed.

**The obviousness issues**

We sustain the rejection of claims 12 and 13 under 35 U.S.C. § 103, but not the rejection of claims 8 and 9.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

*Claims 12 and 13*

The examiner found (answer, pp. 4-5) that

[i]n discussing the prior art, Duffy discloses a known power steering mechanism and valve substantially as claimed. It is noted that the filing date of Duffy is not earlier than Appellant's priority date, however, Duffy discloses that the assembly was disclosed in patent 4,570,736 which issued in 1986, well before Appellant's priority date.

The examiner then determined (answer, p. 5) that

[i]t would have been obvious to use the seal disclosed by Storms in the assembly of Duffy, since Duffy is silent regarding the details of the seal and since Storms discloses that this seal is desirable for use in hydraulic systems.

The appellant argues (brief, p. 9) that there is no disclosure in Duffy that cures the deficiencies of Storms discussed previously in the anticipation rejection and that the filing date of Duffy is not earlier than the appellant's priority date. We find that the appellant's argument does not persuade us of any error in the examiner's rejection of claims 12 and 13. In that regard, we note as discussed above that there were no deficiencies in Storms with regard to the anticipation rejection of parent claim 14. While the filing date of Duffy is not earlier than the appellant's priority date, we believe that the examiner's reliance of the known power steering mechanism (see column 1, lines 5-51 of Duffy) disclosed in patent 4,570,736 is tantamount to applying U.S. Patent No. 4,570,736 (issued February 18, 1986) itself. Accordingly, the appellant's priority date of January 16, 1991 is insufficient to remove the known power steering mechanism

disclosed in patent 4,570,736 set forth in Duffy's "BACKGROUND OF THE INVENTION" as available prior art under 35 U.S.C. § 103.

For the reasons stated above, the decision of the examiner to reject claims 12 and 13 under 35 U.S.C. § 103 is affirmed.

*Claims 8 and 9*

The examiner found (answer, p. 4) that

Storms does not disclose that the ring member and seal body have inclined surfaces. Johnson, however, discloses a similar seal having inclined surfaces, as shown in figure 6.

The examiner then determined (answer, p. 4) that

[i]t would have been obvious to modify Storms, by making the surfaces inclined, as taught by Johnson, thereby limiting relative movement between the ring member and seal body.

The appellant argues (brief, p. 8) that the applied prior art does not suggest the claimed subject matter. We agree.

As set forth above, obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do

so." Id. Here, the prior art contains none. In fact, the advantages of utilizing "opposed surfaces inclined relative to the axis of the ring member/seal body" are not appreciated by the prior art applied by the examiner.

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id. Since the limitation "opposed

surfaces inclined relative to the axis of the ring member/seal body" of claim 8 is not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of claims 8 and 9.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2 through 7, 10, 11 and 14 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to reject claims 12 and 13 under 35 U.S.C. § 103 is affirmed; and the decision of the examiner to reject claims 8 and 9 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPEAL NO. 1998-1928 - JUDGE NASE  
APPLICATION NO. 08/543,153

APJ NASE

APJ ABRAMS

APJ CALVERT

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 13 Apr 99

**FINAL TYPED:**