

**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(2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TADAHIRO OHMI,  
MICHIO YAMAJI, HIROSHI MOROKOSHI,  
SHIGERU ITOI, NOBUKAZU IKEDA,  
and TETSUYA KOJIMA

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Appeal No. 1999-0082  
Application 08/655,022

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HEARD: March 8, 2000

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Before ABRAMS, STAAB, and GONZALES, Administrative Patent  
Judges.

ABRAMS, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner  
finally rejecting claims 1-8, which at that point constituted  
all of the claims of record in the application. By amendment

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under 37 CFR §1.116, the appellants canceled claims 1-8 and entered claim 9, which is the only claim before us on appeal (see Paper No. 9).

The appellants' invention is directed to a fluid control device having a replaceable regulator. The claims on appeal have been reproduced in an appendix to the Brief.

**THE REFERENCES**

The references relied upon by the examiner to support the final rejection are:

Ohmi <i>et al.</i> (Ohmi)	5,366,261	Nov. 22, 1994
Abstract of Japanese Patent (Yuichi)	6241400	Aug. 30, 1994

**THE REJECTION**

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Yuichi in view of Ohmi.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and the appellants regarding the rejection, we make reference to the

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Examiner's Answer (Paper No. 15) and the Appellants' Briefs  
(Paper Nos. 13 and 17).

### OPINION

The appellants' invention is directed to the combination of a fluid control device having a regulator for controlling the flow through a channel, a connection member connected to the regulator, and means for detachably connecting the regulator. The claim establishes that there is an upper connector and a lower connector with an annular gasket interposed between abutting end faces of the connectors. Among the other structure recited in the claim are "annular projections" formed on the end faces and being operative to deform said gasket into sealing engagement with the end faces. The projections are radially spaced from the channel to define "concentrically disposed inner flat faces and outer flat faces on opposite sides of said projections," with the inner flat faces being mutually axially spaced closer together than the outer flat spaces. According to the appellants, the latter feature results in a better seal as the components are being attached together.

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It is the examiner's view that all of the subject matter recited in claim 9 is disclosed by Yuichi except for the projections and spacing of the inner and outer flat faces, which are taught by Ohmi, and that it would have been obvious to one of ordinary skill in the art to incorporate these features of Ohmi into the Yuichi regulator structure. We disagree, sharing the appellants' opinion that Ohmi does not disclose or teach the projections and the spacing of the inner and outer flat faces. Our reasons for arriving at this conclusion follow.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole

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or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, **Uniroyal, Inc. v. Rudkin-Wiley Corp.**, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

We agree with the examiner that Yuichi discloses the basic regulator structure recited in claim 9 but lacks the required projections and inner and outer flat faces. Where we part company with the examiner is that the missing structure is taught by Ohmi, for neither the description of the structure provided in the reference nor the common definition of "projection" supports the examiner's position. From our perspective, therefore, Ohmi does not disclose "projections" spaced from the channels "to define concentrically disposed inner flat faces and outer flat faces" with the inner flat faces being axially spaced closer than the outer ones, as is the examiner's contention with regard to Figures 5 and 6.

There are three reasons for reaching this conclusion. First, Ohmi has defined elements 33 and 34, which are immediately adjacent to the channels of the device, as "projections" (column 4, line 12). Interpreting Ohmi in this

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fashion results in there being no inner flat faces present at all, and the rejection fails on this ground. Second, the examiner's position here apparently is that, notwithstanding Ohmi's description of what constitutes the "projections," elements 33 and 34 comprise "projections" formed by the curved portions of elements 33 and 34 (the upper portions, as shown), which are spaced from the channels by inner flat faces (the lowermost portions, as shown). This thesis is not supported by the specification or evident from the drawings, and therefore in our opinion must be dismissed as mere speculation. Finally, it is our opinion that the elements designated by Ohmi as "projections" are not, in fact, "projections" when considered in the light of the common definition of the term and the understanding gained from the appellants' disclosure and claims, but more accurately would be defined as corners.

In any event, the combined teachings of the two references fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in claim 9. This being the case, we will not sustain the rejection.

The decision of the examiner is reversed.

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REVERSED

	Neal E. Abrams	)	
	Administrative Patent Judge	)	
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	Lawrence J. Staab	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	John F. Gonzales	)	)
	Administrative Patent Judge	)	

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