

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MAGNUS DANEK

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Appeal No. 96-2670  
Application 08/232,677<sup>1</sup>

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HEARD: June 9, 1998

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Before STAAB, McQUADE and CRAWFORD, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the final rejection of claims 1 through 34. Upon reconsideration, the examiner has withdrawn the rejections of claims 9 through 11 and 26 through 28. These claims, which have been indicated as containing allowable subject matter, now stand objected to as depending from a rejected base claim (see

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<sup>1</sup> Application for patent filed April 25, 1994.

page 1 in the examiner's answer, Paper No. 8). Thus, the appeal as to claims 9 through 11 and 26 through 28 is hereby dismissed, leaving for review the standing rejections of claims 1 through 8, 12 through 25 and 29 through 34.

The invention relates to a "hydraulic shock absorber for a vehicle suspension wherein the hysteresis effects of the compressibility of the fluid employed in the shock absorber can either be compensated for and/or employed to change the damping characteristics as desired" (specification, page 1). Claim 1 is illustrative and reads as follows:

1. A hydraulic shock absorber for a vehicle comprising a pair of relatively movable members each adapted to be fixed relative to a respective relatively movable component of a vehicle suspension system and defining a fluid chamber the volume of which varies upon relative suspension movement of said components, a conduit for transferring fluid to and from said chamber upon variations in the volume of said chamber, a damping arrangement for controlling the rate of flow through said conduit for damping said suspension movement, and compensating means for altering the damping rate to reflect the effect of the compressibility of the fluid in said shock absorber.

The reference relied upon by the examiner as evidence of anticipation is:

Bartholomaeus et al., German Patent Document (Bartholomaeus) <sup>2</sup>	3,742,883	Jul. 6, 1989
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<sup>2</sup> An English language translation of this reference is appended to the appellant's brief (Paper No. 7). An additional translation, prepared by the Patent and Trademark Office, is appended to this decision for the appellant's convenience.

Claims 1 through 8, 12 through 25 and 29 through 34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bartholomaus.

Reference is made to the appellant's brief (Paper No. 7) and to the examiner's final rejection and answer (Paper Nos. 5 and 8) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.<sup>3</sup>

Bartholomaus discloses a vehicle vibration damping system having a "failsafe" feature for preventing dangerous driving conditions should certain of its components fail. The system includes a cylinder 10 connected to the vehicle body and a piston 12, 14 connected to a vehicle wheel. The piston divides the cylinder into two chambers 18, 19 which communicate with a pressure medium pump 29 and a pressure medium tank through an arrangement of flow lines and a regulating valve 25. An electronic device 33 controls the position of the valve to regulate the damping characteristics of the system. The "failsafe" feature involves a valve 22 which places the cylinder chambers 18, 19 in fluid communication with one another upon failure of the pump and/or electronic control device to ensure that the system retains a certain degree of stability.

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed

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<sup>3</sup> The official version of the final rejection which appears in the record as Paper No. 5 consists only of a cover sheet (Form PTOL-326). A copy of the full version of this action which was mailed to the appellant is appended to the brief (Paper No. 7).

invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Claim 1, the only independent claim on appeal, recites a hydraulic shock absorber comprising, inter alia, “compensating means for altering the damping rate to reflect the effect of the compressibility of the fluid in said shock absorber.” The appellant contends that Bartholomaeus does not meet this claim limitation (see pages 5 and 6 in the brief). The examiner, on the other hand, submits that

the electronic control unit 33 in the device of Bartholomaeus et al is readable as being the compensation[sic, compensating] means in that the electronic control unit 33 does vary the amount of fluid within the cylinders 18, 19 by switching either of the valves 22 and/or 25 to their alternate positions thereby changing the effective flow volume through the conduit 23, 24 [answer, pages 2 and 3].

The Bartholomaeus reference does not support the examiner’s understanding of the relationship between the electronic control device 33 and valve 22 disclosed therein. As indicated above, valve 22 is part of a “failsafe” feature which is actuated upon failure of the pump 18 and/or the electronic control device 33. Nor does the Bartholomaeus reference provide any reasonable support for a finding that the electronic device 33, or any other structure disclosed therein, constitutes, either expressly or under principles of inherency, a compensating means for altering the damping rate to reflect the effect of the compressibility of the fluid in the shock absorber as recited in claim 1. Thus, Bartholomaeus does not disclose each and every element of the

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invention set forth in claim 1. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of this claim or of claims 2 through 8, 12 through 25 and 29 through 34 which depend therefrom.

The decision of the examiner is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

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