

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL E. MOODY

Appeal No. 1998-2945
Application No. 08/624,734¹

ON BRIEF

Before CALVERT, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4 through 7 and 12 through 15. Claims 2 and 3 are allowed. Claims 8 through 11 have been objected to as depending from a non-allowed claim.

¹ Application for patent filed March 26, 1996.

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We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a power cylinder piston (claims 1 and 4 through 6) and a damped power cylinder system (claims 7 and 12 through 15). An understanding of the invention can be derived from a reading of exemplary claims 1 and 7 (the independent claims on appeal), which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims (i.e., the applied prior art) are:

Diesing et al. 3, 1961 (Diesing)	3,002,500	Oct.
Isham 1961	3,013,816	Dec. 19,
Taylor et al. 1989	4,815,574	Mar. 28,

Claims 1, 4, 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Taylor.

Claims 1 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Isham.

Claims 7 and 12 through 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Isham in view of Diesing.

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. 10, mailed April 14, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 9, filed January 6, 1998) and reply brief (Paper No. 11, filed June 15, 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 and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion

that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 4 through 7 and 12 through 15 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). 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). Furthermore, the conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed

invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The appellant argues (brief, pp. 3-7, and reply brief, p. 2) that the applied prior art does not suggest the claimed subject matter. We agree.

Claim 1 recites a power cylinder piston for connection to a power shaft within a power cylinder housing comprising, inter alia, a cylinder being disposed slidably within the power cylinder housing and an annularly corrugated sleeve disposed within the cylinder and secured to the cylinder ends.

Claim 7 recites a damped power cylinder system comprising, inter alia, a power cylinder housing and a piston slidably disposed within the power cylinder housing. Claim 7 further recites that the piston comprises, inter alia, a piston cylinder and an annularly corrugated sleeve disposed within the piston cylinder and secured to the piston cylinder ends.

The above-noted limitations of claims 1 and 7 are not suggested by the applied prior art. In that regard, the combined teachings of Taylor, Isham and Diesing would not have suggested a piston having an annularly corrugated sleeve disposed within the cylinder of the piston. To compensate for the inadequacy of the applied prior art, the examiner made determinations (answer, pages 4, 6 and 10) that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the cylinder assembly of Taylor (i.e., damper 10) or the cylinder assembly of Isham (i.e., section B) within a power cylinder housing as that is a recognized feature in the art for shielding a structure from exposure to the environment. However, this determination by the examiner has not been supported by any evidence that would have led an artisan to arrive at the claimed invention.

In our view, clearly the only suggestion for modifying Taylor or Isham in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under

35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Furthermore, it is our opinion that one of ordinary skill in the art would not have considered the cylinder assembly of Taylor (i.e., damper 10) or the cylinder assembly of Isham (i.e., section B) to be a "piston." It follows that we cannot sustain the examiner's rejections of claims 1 and 7 and claims 4 through 6 and 12 through 15 dependent thereon.

REMAND

We remand the application to the examiner to consider whether or not the following two errors render independent claims 1 and 7, and dependent claim 2, indefinite under the second paragraph of 35 U.S.C. § 112.²

² Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

First, the phrase "said power cylinder" in claim 1, lines 11-12, and claim 2, lines 10-11, lacks antecedent basis. While claims 1 and 2 have previously recited "power cylinder piston," "power cylinder housing," and "cylinder," it is not clear that "said power cylinder" was intended to refer back to any of those terms. In that regard, we note from Figures 1 and 2, that the power shaft 44 extends out of one end of the cylinder 32 for connection to the mechanism being operated (see page 4, lines 24-25, of the specification). Accordingly, the examiner should determine if the lack of antecedent basis for "said power cylinder" in claim 1 and claim 2 renders claims 1 and 2, and claims dependent thereon, indefinite under 35 U.S.C. § 112, 2nd.

Second, the two position valve clause in claim 7 (see lines 7-12) contains an error. Specifically, the two position valve clause recites that the "one end" of the power cylinder housing is connected to the working fluid exhaust in both positions (i.e., the one position and the second position) of the two position valve. As shown in Figure 1, in one position of the valve 24, the discharge line 20 is connected to the

right end of the power cylinder housing and in the other position of the valve 24, the discharge line 20 is connected to the left end of the power cylinder housing. Accordingly, the examiner should determine if this error in claim 7 renders claim 7, and claims dependent thereon, indefinite under 35 U.S.C. § 112, 2nd.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 4 through 7 and 12 through 15 under 35 U.S.C. § 103 is reversed. In addition, the application is remanded to the examiner to consider whether claims 1, 2 and 7 are indefinite under the second paragraph of 35 U.S.C. § 112.

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

REVERSED and REMANDED

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

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APPEAL NO. 1998-2945 - JUDGE NASE
APPLICATION NO. 08/624,734

APJ NASE

APJ FRANKFORT

APJ CALVERT

DECISION: **REVERSED; REMANDED**

Prepared By: Gloria Henderson

DRAFT TYPED: 10 May 99

FINAL TYPED: