

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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Appeal No. 1999-1530  
Application No. 08/728,607<sup>1</sup>

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ON BRIEF

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Before ABRAMS, NASE, and BAHR, 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 to 3, 8 to 19 and 21.<sup>2</sup> Claims 4 to 7 and 20 have been allowed. No claim has been canceled.

We AFFIRM.

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<sup>1</sup> Application for patent filed October 10, 1996.

<sup>2</sup> Claim 1 was amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to a brake hydraulic controller. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

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

Ohta et al. 1997 (Ohta)	5,634,695	June 3,  (filed March 22, 1995)
Tsuzuki et al. 1995 (Tsuzuki)	7-9970 <sup>3</sup>  (Japan)	Jan. 13,

Claims 1 to 3, 8 to 19 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ohta in view of Tsuzuki.<sup>4</sup>

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<sup>3</sup> In determining the teachings of Tsuzuki, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellants' convenience.

<sup>4</sup> The examiner's rejection recites that this rejection applies to claims 1-3 and 8-20. However, it is clear from the  
(continued...)

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 19, mailed December 7, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 18, filed October 27, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In the brief (p. 4), the appellants stated that

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<sup>4</sup>(...continued)  
body of the rejection that the rejection applies only to claims 1-3, 8-19 and 21 (claim 20 being a claim that has been indicated as being allowed).

claims 1-9 and 19-21 [sic, 1-3, 8, 9, 19 and 21] represent one group, claims 10 and 18 represent a second group and claims 11-17 represent a third group.

In accordance with 37 CFR § 1.192(c)(7), we have selected claims 1, 10 and 11 as the representative claims from the above-noted grouping of claims to decide the appeal on the rejection under 35 U.S.C. § 103.

**Claim 1**

We sustain the rejection of claim 1 under 35 U.S.C. § 103.

The examiner determined (answer, p. 4) that (1) Ohta teaches all the features of the claimed invention except for the cover including a seal groove and a sealing member disposed therein, and (2) Tsuzuki discloses a brake hydraulic controller having a seal groove and a sealing member fitted to the seal groove for elastically contacting the surface. In

applying the test for obviousness<sup>5</sup>, the examiner then concluded (answer, p. 5) that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the brake hydraulic controller of Ohta et al. with the seal arrangement as taught by '9970 [Tsuzuki] as an alternate means of securing the cover to the base.

The appellants have not contested the obviousness conclusion made by the examiner. However, the appellants do argue that the resulting combination would not have led one of ordinary skill in the art to arrive at the claimed invention.

In that regard, the appellants argue (brief, pp. 5-8) that Ohta does not disclose a cover as recited in claim 1. Specifically, the appellants point out that Ohta's cover 38 is not readable on the following part of claim 1

a cover attached to the base and having a surface, said surface having a downwardly extending rim extending about an edge of said surface and being positioned about a periphery of said base such that said surface covers the

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<sup>5</sup> 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).

first and second electromagnetic valves, the reservoir and the damper.

We do not agree.

As shown in Figures 4, 8 and 9, Ohta's brake control apparatus 15 (i.e., the brake hydraulic controller) includes, inter alia, a base 34, a cover 38, first and second electromagnetic valves  $V_{OFL}$ ,  $V_{CFL}$ , a reservoir  $19_1$  and a damper  $24_1$ . Cover 38 is attached to the base 34 by screws 80 and the cover includes (see Figure 3) a closing plate portion 38b (i.e., a surface) and a side wall portion 38a (i.e., a downwardly extending rim extending about an edge of the surface). As shown in Figures 3, 4, 8 and 9, the side wall portion 38a of cover 38 is positioned about a periphery of the base<sup>6</sup> 34 such that the closing plate portion 38b covers the first and second electromagnetic valves, the reservoir and the damper.<sup>7</sup>

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<sup>6</sup> The surface 34a of base 34 defines part of the periphery of base 34.

<sup>7</sup> While Ohta utilizes a press plate 52 and a closing plate 85 in addition to his cover 38 to cover the damper, we see no language in claim 1 precluding these elements.

For the reasons stated above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is affirmed.

**Claim 10**

We sustain the rejection of claim 10 under 35 U.S.C. § 103.

Claim 10 adds to parent claim 1 the further limitation that the sealing member and base "form a water-tight compartment" for the first and second electromagnetic valves, the reservoir and the damper.

The appellants argue (brief, pp. 8-9) that Ohta's structure does not appear to be water-tight because it does not have a seal about the periphery of the cover, nor can it accommodate such a seal. We find this argument to be unpersuasive for the following reasons.

First, the appellants have argued the deficiency of Ohta on an individual basis, however, nonobviousness cannot be

established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

Second, the appellants have argued that Ohta's cover cannot accommodate a seal. However, this ignores the combined teachings of the applied prior art<sup>8</sup> which in our opinion would have clearly suggested modifying Ohta's cover to accommodate a seal as suggested and taught by Tsuzuki's cover which has a seal to provide a water-tight compartment.<sup>9</sup>

For the reasons stated above, the decision of the examiner to reject claim 10 under 35 U.S.C. § 103 is affirmed.

#### **Claim 11**

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<sup>8</sup> See In re Keller, supra, at 642 F.2d 425, 208 USPQ 881.

<sup>9</sup> See page 1, lines 18-21, of the appellants' specification which discusses the teachings of Tsuzuki.

We sustain the rejection of claim 11 under 35 U.S.C. § 103.

Claim 11 adds to parent claim 1 the further limitation that the cover includes "means for maintaining a shape of said groove."

The appellants argue (brief, p. 9) that while Tsuzuki appears to show a seal groove, Tsuzuki does not teach or suggest a reinforcing member. We find this argument to be unpersuasive since it is not commensurate in scope to claim 11. In that regard, claim 11 does not recite "a reinforcing member." Rather claim 11 recites "means for maintaining a shape of said groove" which the examiner has determined (answer, pp. 5-6) is met by the combined teachings of the applied prior art. Since the appellants have not presented any other argument with respect to claim 11, the decision of the examiner to reject claim 11 under 35 U.S.C. § 103 is affirmed.

**Claims 2, 3, 8, 9, 12-19 and 21**

In accordance with 37 CFR § 1.192(c)(7), claims 2, 3, 8, 9, 12-19 and 21 fall with claims 1, 10 and 11. Thus, it follows that the decision of the examiner to reject claims 2, 3, 8, 9, 12-19 and 21 under 35 U.S.C. § 103 is also affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 8 to 19 and 21 under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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APPEAL NO. 1999-1530 - JUDGE NASE  
APPLICATION NO. 08/728,607

APJ NASE

APJ BAHR

APJ ABRAMS

DECISION: **AFFIRMED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 12 Aug 99

**FINAL TYPED:**

**Gloria: Note Panel change.**