

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID C. KAMP

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Appeal No. 2001-1766  
Application 08/891,884

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ON BRIEF

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Before THOMAS, HAIRSTON, and BARRY, Administrative Patent Judges.  
HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 10.

The disclosed invention relates to a method and apparatus of providing for one-way flow of liquid in a liquid containment and dispensing device.

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Claim 10 is illustrative of the claimed invention, and  
it reads as follows:

10. A method of providing for one-way flow of liquid from a pouch through a pumping mechanism of a chassis of a liquid containment and dispensing device, the chassis having an inlet port in liquid communication with the pouch and the pumping mechanism, said method comprising:

providing a planar valve member within the chassis in alignment with the inlet port to block flow from the pumping mechanism to the pouch when pressure in the pumping mechanism is higher than pressure within the pouch, no portion of the planar valve being heat-staked to the chassis.

The references relied on by the examiner are:

Nakata	3,720,473	Mar. 13, 1973
Hirosawa et al. (Hirosawa)	5,523,780	June 4, 1996
Clark et al. (Clark)	5,734,401	Mar. 31, 1998
	(effective filing date Apr. 27, 1995)	

Claims 1 through 6, 9 and 10 stand rejected under  
35 U.S.C. § 103(a) as being unpatentable over Clark in view of  
Nakata.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a)  
as being unpatentable over Clark in view of Nakata and Hirosawa.

Reference is made to the briefs (paper numbers 13 and  
15) and the answer (paper number 14) for the respective positions  
of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the obviousness rejections of claims 1 through 10.

Clark uses a check valve 42 in a liquid containment and dispensing device (Figure 4) to provide for one-way flow of ink. The examiner acknowledges (answer, page 7) that Clark does not disclose that "no portion of the check valve is heated staked [sic, heat-staked] to the chassis." According to the examiner (answer, page 7), "Nakata teaches in Figures 5A-5B an ink cartridge comprising a check valve (15) having a small disk (50) made of an anticorrosion and elastic material such as a synthesis rubber or plastic material for easily replaced so that the cost would be reduced." Based upon the teachings of Nakata, the examiner is of the opinion that "[i]t would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the teaching of using a check valve comprising a small disk taught by Nakata into the ink cartridge of Clark et al for the purpose of easily replacing the check valve so that the cost would be reduced."

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Appellant argues (brief, page 7) that "Nakata is not even in an art that is 'analogous' to the art in which the devices of appellant and Clark et al. fall," that "there is no teaching in Nakata that there is or could be a problem in the device of Clark et al. with respect to the use of a heat staked check valve therein . . . ," and that a prima facie case of obviousness has not been presented because of the use of hindsight. Appellant also argues (reply brief, page 2) that Nakata lacks a teaching that the use of its disk check valve in lieu of the heat-staked check valve in Clark would have reduced the cost of the Clark device.

With the exception of the non-analogous art argument, we agree with the appellant's arguments. Although Nakata may not be in the same field of endeavor as Clark, he certainly is concerned with the same problem addressed by both the disclosed and claimed invention and Clark, namely, the one-way flow of a liquid in a liquid containment and dispensing device. In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Notwithstanding the fact that Nakata is analogous art to Clark, the applied references neither teach nor would they have

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suggested to one of ordinary skill in the art that the disk valve 50 disclosed by Nakata may be used in lieu of the heat-staked check valve 42 in Clark. More importantly, the applied references are silent as to the comparative costs of the two types of check valves. It follows, therefore, that the motivation for making the suggested modification to Clark is based upon the examiner's opinion. The factual question of motivation should be resolved based on evidence of record, and not on the subjective belief and unknown authority expressed by the examiner. In re Lee, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). Lastly, "obvious to try" is not the proper standard for determining obviousness of the claimed invention. In re O'Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

In summary, the obviousness rejection of claims 1 through 6, 9 and 10 is reversed. The obviousness rejection of claims 7 and 8 is reversed because the teachings of Hirose fail to cure the noted shortcoming in the teachings of Clark and Nakata.

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DECISION

The decision of the examiner rejecting claims 1 through  
10 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
KENNETH W. HAIRSTON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	

KWH:psb

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