

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAMORU SUMIDA, NORIHISA FUKUTOMI,
MASAYUKI AOTA and KEITA HOSOYAMA

Appeal No. 2002-0607
Application No. 09/258,138

HEARD: April 01, 2003

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-6, all the claims currently pending in the application.

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Appellants' invention pertains to a fuel injection valve. A copy of the appealed claims is appended to appellants' main brief.

The references relied upon by the examiner in the final rejection are:

Stumpp et al. (Stumpp)	4,589,596	May 20, 1986
Itoh et al. (Itoh)	4,966,120	Oct. 30, 1990
Berton et al. (Berton)	5,129,658	Jul. 14, 1992
Belshaw et al. (Belshaw)	5,345,913	Sep. 13, 1994
Sumida et al. (Sumida)	5,630,400	May 20, 1997
Dietrich et al. (Dietrich) ¹	DE 3,340,445	May 15, 1985

The appealed claims stand finally rejected under 35 U.S.C. § 103(a) as follows:²

(1) claims 1 and 6, unpatentable over Sumida in view of Dietrich;

¹Our understanding of this German language patent document is derived in part from a translation thereof prepared by the Patent and Trademark Office. A copy of that translation is attached to this decision.

²In the "Grounds of Rejection" section on page 3 of the answer, we are directed to the final rejection (Paper No. 7) for a statement of the grounds of rejection. The final rejection (pages 2-3) in turn refers us to the first office action (Paper No. 5) for the examiner's rationale in rejecting the claims. This practice of indirectly incorporating by reference more than one prior office action in the answer does not comply with MPEP § 1208, which provides that incorporation by reference may be made only to a *single* other action, and that the examiner's answer should not refer, *either directly or indirectly*, to more than one prior office action. In the interest of judicial economy, we shall, in this instance, proceed to decide the appeal on the merits notwithstanding the examiner's clear disregard for established Office procedure in formulating the answer.

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(2) claim 2, unpatentable over Sumida in view of Dietrich,
and further in view of Stumpp;

(3) claim 3, unpatentable over Sumida in view of Dietrich,
and further in view of Belshaw;

(4) claim 4, unpatentable over Sumida in view of Dietrich,
and further in view of Itoh; and

(5) claim 5, unpatentable over Sumida in view of Dietrich,
and further in view of Berton.

Discussion

A review of the prosecution history of the present
application reveals the following:

- In the first office action (Paper No. 5), claim 1 was rejected by the examiner under 35 U.S.C. § 102(b) as being anticipated by Sumida. In support of this position, the examiner stated (page 2) that Sumida teaches "a compression between the two [unspecified] housing parts and an [unspecified] elastic ring is used to create further compression."
- In the final rejection (Paper No. 7), claim 1 (amended) was rejected by the examiner under 35 U.S.C. § 103(a) as being unpatentable over Sumida in view of Dietrich. The examiner stated (page 2) that Sumida "applies as per the last office action," and that Dietrich "teaches a housing part and a valve body within the housing part with the valve body having two diameters and a seal located at the shoulder between the diameters and between

this shoulder and the cylinder head (16) (see Figure 1).” No further explanation of how the cited references are to be applied against claim 1 is set forth.

- In response to appellants’ request for reconsideration (Paper No. 8), the examiner next issued an advisory letter (Paper No. 9) which included the following statement: “Dietrich clearly shows a seal surrounding the tip of the inner valve member. While this seal is not labeled[,] the drawing shows it against the valve tip and thus it will stop cylinder gases as claimed.”
- In the answer (Paper No. 14), we are informed (page 3) that “[t]he grounds for rejection of the claims are found in the Final Rejection of June 9, 2000.” In the “Response to Argument” section of the answer (page 4), the examiner further states, among other things, that Sumida “clearly teaches all of the limitations of claim 1 with the possible exception of the means ‘for preventing combustion gas in a cylinder from leaking to said housing main body’” and that Dietrich is cited to show a seal “located as claimed.”
- In the unauthorized supplemental examiner’s answer³ (Paper No. 17), the examiner states (page 2) that claim 1 does not require the valve main body to be a unitary body, that making the valve body into a one piece structure would have been obvious, and that in Sumida the sleeve (40) and the elements (14) and (7) form a valve main body having large and small diameter portions with a shoulder therebetween.

³ 37 CFR § 1.193(b)(1) states that a supplemental examiner’s answer is *not* permitted, unless the application is remanded by the Board for that purpose. Given our disposition of the present appeal, the examiner’s disregard for Office procedure in this respect is of no moment.

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The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *See In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). As stated by Judge Plager in his concurring opinion in *Oetiker*, 977 F.2d at 1449, 24 USPQ2d at 1447:

The process of patent examination is an interactive one The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner. The 'prima facie case' notion, the exact origin of which appears obscure . . . , seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the *prima facie* case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness.

In the present case, the examiner has made no explicit findings regarding, among other things, (1) the scope and contents of the applied prior art, (2) the *differences* between

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the applied prior art and appealed claim 1, (3) precisely *how* the primary reference to Sumida would have to be modified to make up for any such differences, (4) *why* any proposed modification would have been obvious to one of ordinary skill in the art, or (5) how the proposed modification(s) would result in the claimed subject matter *as a whole*. In addition, the examiner has not adequately addressed appellants' arguments throughout the main and reply briefs regarding the alleged ambiguity of Dietrich with respect to the construction of its fuel injector valve main body and the element at the base of Dietrich's valve main body purported by the examiner to be a seal element. Nor has the examiner adequately addressed appellants' argument on pages 3-5 of the main brief to the effect that the combined teachings of the applied references would not render obvious a fuel injection valve having both a seal held between a cylinder head and a shoulder defined between large and small diameter portions of the valve main body (as set forth in the penultimate paragraph of claim 1) *and* a securing means for securing the outer side of the large diameter portion of the valve main body to the housing main

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body (as set forth in the last paragraph of claim 1). While we might speculate as to precisely how the examiner intends to apply the Sumida and Dietrich references against claim 1, such speculation would not give appellants a fair opportunity to response. It is therefore our conclusion that the examiner has not met his initial burden of establishing a *prima facie* case of obviousness of independent claim 1.

In light of the foregoing, we are constrained to reverse the standing rejection of independent claim 1, as well as claim 6 that depends therefrom, as being unpatentable over Sumida in view of Dietrich. We are also constrained to reverse the standing rejections of dependent claims 2-5 under 35 U.S.C. § 103(a) since it is not apparent how the tertiary references applied in the rejections of these claims might cure the fundamental defects noted above in the examiner's *prima facie* case with respect to base claim 1.

Remand

This case is remanded to the examiner for consideration of following matters.

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Sumida discloses (see Figure 3) a fuel injection valve comprising a housing main body 14, a valve assembly within the housing main body comprising a valve main body 9 having a large diameter cylinder portion 8 and a small diameter cylinder portion 7, an annular seal 45, and a sleeve 40 press-fit onto the small diameter cylinder portion of the valve main body. The seal 45 is held between a shoulder portion 3 of a cylinder head 1 and an end face 41 of the sleeve 40. In addition, the housing main body 14 is secured to the outer side of the large diameter cylinder portion 8 of the valve main body 9 by means of coupling portion 16.

The examiner should determine whether claim 1 "reads on" (and is thus anticipated by⁴) the above described construction of Sumida. More particularly, the examiner should determine whether (1) the end face 41 of sleeve 40 of Sumida comprises "a shoulder

⁴ Anticipation, within the meaning of 35 U.S.C. § 102, "requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 722, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984), (and overruled in part on another issue) 775 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1985)).

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portion defined between said large-diameter and said small diameter cylinder portions," such that the seal 45 of Sumida "is held between a cylinder head and said shoulder portion when said valve assembly is inserted into the insertion port of said cylinder" as called for in claim 1, and whether (2), consistent with any reading the claimed shoulder portion on Sumida's end face 41, the remaining limitations of claim 1 (e.g., the "securing means" limitation set forth in the last paragraph) can be read on Sumida's fuel injector valve construction.

In the event the examiner determines that claim 1 does not distinguish over Sumida, the examiner should take whatever action is deemed appropriate with respect to claim 1, as well as claims 2-6 that depend therefrom.

Summary

The decision of the examiner finally rejecting the appealed claims is reversed.

This case is remanded to the examiner for consideration of the matter noted above.

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This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(D) (8th Ed., Rev. 1, Feb. 2003).

REVERSED AND REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
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