

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GEORGE E. SGOURAKES

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Appeal No. 2003-1258  
Application No. 09/745,757

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ON BRIEF

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Before LIEBERMAN, JEFFREY T. SMITH, and PAWLIKOWSKI, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 12 through 14 which are all the claims pending in this application.<sup>1</sup>

THE INVENTION

The invention is directed to a fuel transfer apparatus having among other

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<sup>1</sup>Although the Brief is labeled "Amendment After Final" Paper No. 10, it otherwise refers to and contains the present Appeal Brief.

components a displacement rod having a cross hole and a passageway. The cross hole has a first position wherein it vents an undesired fluid through the passageway to the outside of the container. In a second position the cross hole is outside the container. Additional limitations are described in the following illustrative claim.

### THE CLAIM

Claim 12 is illustrative of appellant's invention and is reproduced below:

12. A fluid transfer apparatus comprising:

a container having a first end and a second end and being made of a substantially rigid material, said container having a substantially hollow bore extending therethrough from said first end to said second end, and at least one opening for receiving and discharging fluid;

a first seal located at said first end;

a second seal located at said second end; and,

a displacement rod slidably inserted through an opening in one of said first and second seals so that a portion of said displacement rod fits inside said container, said displacement rod changing the displacement volume in the container as said displacement rod is moved within said container, said displacement rod further having a cross hole and a passageway, said cross hole having at least a first position within said container to vent an undesired fluid through said passage way to the outside of said container and a second position wherein said cross hole is outside the container wherein said cross hole is not in fluid communication with the interior of said container to control the venting of undesired fluids by the position of the displacement rod.

### THE REFERENCE OF RECORD

As evidence of obviousness, the examiner relies upon the following reference:

Appeal No. 2003-1258  
Application No. 09/745,757

3

Gordon et al. (Gordon)

4,848,167

Jul. 18, 1989

### THE REJECTION

Claims 12 through 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gordon.

### OPINION

We have carefully considered all of the arguments advanced by the appellant and the examiner and agree with the appellant that the rejection of the claims under Section 103(a) is not well founded. Accordingly, we reverse the rejection.

### THE REJECTION UNDER SECTION 103(a)

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). It is the examiner's position that the reference to Gordon teaches that, "the rod having a recess that 42 provides a hole from the container 16 interior to its exterior, thus allowing for a fluid passageway." See Answer page 3. We disagree with the examiner's analysis.

The claimed subject matter before us requires the presence of a displacement rod describing part of its internal structure wherein, "said displacement rod further having a cross hole and a passageway." See claim 12. Accordingly, the rod in and of itself must have both a cross hole and a passageway. Furthermore the rods cross hole must have "at least a first position within said container to vent an undesired fluid through said

passageway to the outside of said container." See claim 12.

In contrast Gordon is directed to a sampler 10 having a, "rod 34 pushed into second body 16 until recess 42 and passageway 32 are longitudinally coincident (FIG. 13)." See Gordon, col. 5, lines 19-21. This arrangement provides a gap through passageway 32 such that when the sampler 10 is tilted it enables solvent to leak from the apparatus. It is however, the second body 16 relied upon by the examiner as, "a container having a first end and a second end, and being made of a substantially rigid material," Answer, page 2, which provides for the passageway through which the solvent passes to the outside of the container. This passageway however, as explained above is an integral part of the container and not of the displacement rod as required by the claimed subject matter. Accordingly, the sampler structure disclosed by Gordon does not meet the requirements of the claimed subject matter.

Based upon the above analysis, we have determined that the examiner's legal conclusion of obviousness is not supported by the facts. "Where the legal conclusion is not supported by [the] facts[,] it cannot stand." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000 (1968).

OTHER MATTERS

There appears to be an inconsistency between claims 12 and 13. Claim 12 requires a second seal at a second end. In contrast claim 13 requires a constant area seal. It appears however, that this seal is located at the first end, not the second end. Accordingly, the examiner should consider the appropriateness of entering a rejection under the second paragraph of 35 U.S.C. § 112 on the grounds of indefiniteness and whether the language of the claimed subject matter complies with the written description requirement of the first paragraph of 35 U.S.C. 112.

DECISION

The rejection of claims 12 through 14 under 35 U.S.C. §103(a) as being unpatentable over Gordon is reversed.

The decision of the examiner is reversed.

REVERSED

PAUL LIEBERMAN	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JEFFREY T. SMITH	)	APPEALS
Administrative Patent Judge	)	AND
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BEVERLY A. PAWLIKOWSKI	)	
Administrative Patent Judge	)	

Appeal No. 2003-1258  
Application No. 09/745,757

8

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