

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN R. KEEGAN
and DIANE M. ENGLAND

Appeal No. 2005-2567
Application 10/032,606

ON BRIEF

Before KIMLIN, GARRIS and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain the grounds of rejections of appealed claim 2 under 35 U.S.C. § 102(e) (November 29, 2000) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Mieney et al. (Mieney) (answer, pages 4-7).¹

We refer to the answer and to the brief and reply brief for a complete exposition of the respective positions advanced by the examiner and appellants.

The dispositive issue in this appeal is whether the preambular language of claim 2

¹ Claim 2 is the sole claim on appeal. See the appendix to the brief. Claims 3 through 15 are also of record and have been withdrawn from consideration by the examiner under 37 CFR § 1.142(b).

“wherein resistance to the flow of electric current through the [fuel] cell is non-uniform over a flow area of the cell to regulate the flow of oxygen ions through any region of said cell in proportion to the partial pressure of hydrogen in said region,” which is antecedent to the limitation “wherein said electrical resistance is non-uniform over one of said anode, cathode, and electrolyte” in the body of the claim, must be given weight as a claim limitation which characterizes the claimed method in order to give meaning to the claim and properly define the invention (see reply brief, e.g., page 2).

We determine that when the subject preambular language coupled with the language in the body of the claim is considered in the context of the claimed invention as a whole, including consideration thereof in light of the written description in appellants’ specification, it must be given weight as a claim limitation which characterizes the claimed method in order to give meaning to the claim and properly define the invention. *See generally, In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1781 (Fed. Cir. 1992) (citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir. 1984)); *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989), *In re Stencel*, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

Thus, the subject claim language must be taken into account in giving the terms of claim 2 the broadest reasonable interpretation in ordinary usage as would be understood by one of ordinary skill in the art in light of the written description in the specification, including the drawings, as interpreted by this person, unless another meaning is intended by appellants as established in the written description of the specification, and without reading into the claims any limitation or particular embodiment disclosed in the specification. *See, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Indeed, consideration of a claim in any respect, including the application of prior art, requires that *all* claim limitations must be given effect. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974) (In considering grounds of rejection under 35 U.S.C. §§ 103 and 112, “every limitation in the claim must be given effect rather than considering one in isolation from the others.”).

We determine that when the subject claim language is given the broadest reasonable interpretation in context, the claimed fuel cell must be capable of non-uniform electrical

resistance over a flow area of the anode, cathode or electrolyte to the extent that the flow of oxygen ions through a region of the cell is regulated in proportion to the partial pressure of hydrogen in that region.

On this record, we agree with appellants (reply brief, e.g., pages 2-3 and 5-6) that the examiner has not established a *prima facie* case of anticipation or of obviousness of the invention encompassed by claim 2 over Mieney because the examiner did not consider all of the limitations of the claim, for indeed, the examiner did not do so (answer, e.g., pages 8-9). In this respect, we fail to find in the examiner's analysis of Mieney any consideration of the disclosure thereof, such as at page 2, [0020] and [0021], vis-à-vis the strategies disclosed by appellants for achieving a fuel cell capable of operating as required by the claim limitations as we interpreted them above (specification, e.g., pages 11-14).

Thus, the examiner has not established that the claimed fuel cell is either in fact inherently described to one skilled in the art by Mieney within the meaning of § 102(e), or reasonably appears to be identical or substantially identical to the fuel cells of Mieney within the meaning of § 103(a). Indeed, it is well settled that in order to establish that a claim element is inherent in the single prior art reference, it must be shown that such limitation is necessarily present in the description in the reference and that it would be recognized as such by one of ordinary skill in the art, as “[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted.]” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *see also Transclean Corp. v. Bridgewood Serv., Inc.*, 290 F.3d 1364, 1372-73, 62 USPQ2d 1865, 1870-71 (Fed. Cir. 2002); *MEHL/Biophile Int'l Corp. v. Milgram*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999); *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991); *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

It is further well settled that the conclusion that it reasonably appears that a claimed product and the product of the reference are identical or substantially identical must be based on evidence. *See In re Best*, 562 F.2d 1252, 1254-55, 195 USPQ 430, 432-33 (CCPA 1977) (“Because any sample of Hansford's calcined zeolitic catalyst would necessarily be cooled to facilitate subsequent handling, the conclusion of the examiner that such cooling is encompassed

by the terms of the appealed claims was reasonable.”); *see also In re Spada*, 911 F.2d 705, 708-09, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990) (“The Board held that the compositions claimed by Spada ‘appear to be identical’ to those described by Smith. While Spada criticizes the usage of the word ‘appear,’ we think that it was reasonable for the PTO to infer that the polymerization by both Smith and Spada of identical monomers, employing the same or similar polymerization techniques, would produce polymers having the identical composition.”).

Accordingly, on this record, we reverse the grounds of rejection of appealed claim 2.

The examiner’s decision is reversed.

Reversed

EDWARD C. KIMLIN
Administrative Patent Judge

BRADLEY R. GARRIS
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

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