

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte MASANORI TAKAHASHI

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Appeal No. 2006-2577  
Application No. 09/612,403

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HEARD: December 12, 2005

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Before PATE, MARTIN, and LORIN, Administrative Patent Judges.

PATE, Administrative Patent Judge.

### DECISION ON APPEAL

We have carefully reviewed the rejections on appeal in light of the applied prior art and the arguments of appellant and the examiner. As a result of this review we have determined that claims 1-19 and 22 stand properly rejected under section 251. The rejection of these claims is affirmed. We have further determined that the subject matter of claim 19 is *prima facie* obvious from the applied

prior art. Appellant has not provided additional evidence rebutting the *prima facie* case. Accordingly, the rejection of claim 19 is affirmed. We note that appellant has not argued the rejection of dependent claim 22 apart from claim 19 from which it depends. Thus, claim 22 falls with independent claim 19.

As noted by the examiner in the answer, the rejection of claims 1-19 and 22 under 35 USC § 251 based on reissue recapture have been withdrawn by the examiner. Accordingly, we turn to the rejection under 35 USC § 251 based on a defective reissue oath. The examiner has rejected the claims on two bases. First the examiner states that the reissue oath is defective for failure to identify the foreign priority application. Additionally, the examiner states that the appellant has not noted with specificity in the reissue oath the claim wording that is alleged as requiring reissue.

With respect to the foreign priority we note that the examiner is correct in that 37 CFR § 1.175, the regulation that deals with the contents of a reissue oath, requires compliance with 37 § CFR 1.63. Thus, it is apparent that the foreign priority data must be included in the reissue oath. Appellant argues that the PTO form PTO/SB/51 (12-97) does not appear to have a space for such information. It is

noted that the form has now been corrected. While the declaration form used by appellant does appear to be misleading, neither the examiner nor this panel has the authority to waive the explicit requirements of the regulation in this regard. The rejection based on an improper reissue oath to the extent it is based on foreign priority is affirmed.

Turning to the issue of lack of specific detail as to at least one error in appellant's reissue oath, here again the policy of the USPTO requiring the enumeration of a specific error has been upheld by our reviewing court. Appellant's declaration does not include the specific identification of at least one error. Accordingly appellant's declaration is not in compliance with 37 CFR § 1.175 and thus is properly rejected under 35 USC § 251. The rejection based on improper reissue oath as it pertains to stating at least one error being relied upon as a basis for reissue is also affirmed.

Turning to the rejections on obviousness grounds, it is our finding that Iwai discloses an outboard engine of the two-stroke type with a cylinder block 12, a cylinder head 24, a crankcase chamber 39, a crankshaft 22, and pistons 15, 16. In a two stroke engine, oil is typically added to the fuel for lubrication purposes, so Iwai is also

provided with an oil supply reservoir 79 placed under the protective cowling 88. The protective cowling is constructed of two parts--an upper cover 89 and a lower tray 91. The oil supply tank 79 has a fill opening closed by cap 86. In order to fill the oil reservoir 79 and check the oil level on gauge 87 without removal of the upper cover 89 of the protective cowling, the upper cover has an oil supply cover 96 pivotally mounted on the upper cover by means of pivot pin 99. The oil supply cover has a spring to bias the cover in an open position and a latch 104 to secure it closed.

The patent to Brehmer discloses a transom extension for an outboard engine. The extension is a hollow box-like structure with an access panel 46 in the form of a removable lid. The removable lid appears to be completely detachable from the transom extension. The lid provides access to the interior of the sealed compartment 45 of the transom extension. Thus Brehmer is an example of an access plate secured with screws and completely detachable to enable access to an interior opening. In our view it would have been obvious to replace the spring-biased pivoting oil supply cover 96 with its single latch and spring-biased pivot with a completely detachable, removable lid secured by multiple fasteners as disclosed by Brehmer for the self-

evident advantage of a more secure fastening attachment that is better able to resist shock and vibration.

Suzuki discloses a outboard engine with engine shown in phantom at 21. The engine is contained within a protective cowling which has a lower tray portion 22 and an upper cover portion 23. The sloping front side of the top cover 23 is provided with an opening 55. An operational panel is pivotal hinged at 57 to close the opening 55. The panel is held in position with one or more threaded fasteners 63. In our view, it would have been obvious to utilize the complete detachable access plate of Brehmer in the motion of Suzuki for the self-evident advantage that the plate is completely removable and thus not suspended from the lower tray and blocking access thereto.

Turning appellant's arguments, we note that appellant's argument is based on claim construction and the examiner's alleged misconstruction of one claim limitation. The PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's

specification. *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

The Federal Circuit recently restated: "It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)). "The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation." *Id.* "Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Id.*

In this instance, the disputed claim term "serviceable element" is not found in appellant's specification. The specification does discuss oil filters which appear to be the main goal of the invention and does mention servicing oil filters numerous times. Appellant does not explicitly define the term serviceable element in the brief but it appears that the appellant regards servicing the engine as something different from adding fuel to a tank under the

housing or cowling. See brief page 4, last paragraph. We take administrative notice that outboard motors are typically fueled by external fuel tanks, and the relevance of appellant's fuel comparison is not immediately apparent.

Since the specification does not define the claim term, it seems appropriate that the term be given its broadest reasonable construction as interpreted by a person of ordinary skill in the art. "Serviceable element" is a broad term and we are of the view that it should be construed as any element or part of the engine that requires periodic or emergency access in order to sustain or restore full operability to the components. As such, one of ordinary skill would construe the starter rope mechanism and the oil injection reservoir as both qualifying as serviceable elements. Therefore, it can be seen that the examiner has not misconstrued the claim term, and appellant's argument with respect thereto are not credited.

In summary the rejections of claims 1-19 and 22 under section 251 are affirmed.

The rejections of claim 19 and 22 under section 103 are affirmed.

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

AFFIRMED

WILLIAM F. PATE, III )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
JOHN C. MARTIN ) APPEALS  
Administrative Patent Judge ) AND  
 ) INTERFERENCES  
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HUBERT C. LORIN )  
Administrative Patent Judge )

WFP/lp

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