

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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Appeal No. 2006-0523  
Application No. 10/282,658

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ON BRIEF

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Before FRANKFORT, CRAWFORD, and BAHR, Administrative Patent Judges.  
CRAWFORD, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 9, 10, 12, 14 to 16, 18, 20 to 32, which are all of the claims pending in this application.  
Claims 1 to 8, 11, 13, 17 and 19 have been cancelled.

The appellant's invention relates to a shock absorber having a check valve damping adjustment (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The Prior Art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Silberstein Spiess et al. (Spiess)	4,874,066 5,085,299	Oct. 17, 1989 Feb. 4, 1992
Jenni (Swiss Patent Document)	674,251	May 15, 1990
Shimoda et al. (Shimoda) (Japanese Patent Document)	2001-099338	Apr. 10, 2001

The Rejections

Claims 9, 10, 12, 14 to 16, 18 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Spiess in view of Jenni.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Spiess in view of Jenni and Shimoda.

Claims 21 to 26 stand rejected under 35 U.S.C. § 103 as being unpatentable in view of Jenni in view of Shimoda.

Claims 27 to 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Silberstein in view of Jenni.

Claims 30 to 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Silberstein in view of Jenni and Shimoda.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed June 28, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed May 13, 2005) and reply brief (filed August 25, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 9, 10, 12, 14 to 16, 18 and 20 under 35 U.S.C. § 103 as being unpatentable over Spiess in view of Jenni. We initially note that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The examiner finds that Spiess describes the invention as recited in claim 9 including a check valve 101 disposed in a cylindrical chamber in a piston, except that

Spiess does not describe a polygonal check valve (see answer at page 3). The examiner relies on Jenni for teaching a polygonal check valve.

The appellant argues that Spiess does not describe a rod with a cylindrical chamber containing a check valve like that defined in claim 9 on appeal. Rather, in appellant's view the cylindrical chamber 96 which contains a valve 101 is contained in a cylindrical chamber within the piston rather than the rod.

We agree with the appellant. The chamber 96 of Speiss is disposed in the head portion of piston 14 (see Fig. 1). In addition, rod 12 does not include first and second portions respectively adjacent first and second chambers of the cavity as required by claim 9.

In view of the foregoing, we will not sustain this rejection as it is directed to claim 9 and claims 10, 12, 14 to 16, 18 and 20 dependent thereon.

We turn next to the examiner's rejection of claim 15 under 35 U.S.C. § 103 as being unpatentable over Spiess in view of Jenni and further in view of Shimoda.

Claim 15 depends from claim 9 and thus includes the subject matter of a cylindrical chamber having a check valve therein formed in the rod. As we noted above, Spiess does not describe a rod with a cylindrical chamber having a check valve therein nor a rod that has first and second portions respectively adjacent first and second chambers of the cavity. We have reviewed the disclosure of Shimoda and found that

Shimoda does not cure the deficiency noted above for the Spiess and Jenni combination. Therefore, we will not sustain this rejection.

We turn next to the examiner's rejection of claims 21 to 26 under 35 U.S.C. § 103 as being unpatentable over Jenni in view of Shimoda.

The examiner is of the opinion that Jenni describes the invention as recited in claim 21 except that Jenni does not describe a check valve having linear engagement surfaces between the flat surfaces. The examiner relies on Shimoda for teaching linear engagement surfaces between flat portions of the valve (Fig. 8) and concludes it would have been obvious to place the linear engagement surfaces of Jenni between flat portions of the valve as taught by Shimoda as such would be an obvious design choice and would improve the flow characteristics of the valve. (final rejection page 4).

We agree with the appellant that :

The Jenni reference is directed to providing a valve assembly that does not rotate. Jenni accomplishes this by providing guide ribs 9 on the duct 2 that cooperate with flat or level surfaces 17 (see Claim 1). To move these engagement portions to be positioned on the non-flat portions would clearly defeat the benefits provided by Jenni [reply brief at page 8].

We additionally note that it is an object of the Jenni invention to provide a check valve where one can guarantee the touching of the closing body upon the seal portion when the valve is in the closing position (page 3) and that it is the engagement of the flat surfaces 17 with the guides 9 which prevent the twisting of the closing body. As such, in our view, a person of ordinary skill in the art would not be motivated to move the linear engagement surfaces to non-flat portions of the valve, as taught by Shimoda, as such would defeat the purpose of the Jenni invention.

In view of the foregoing, we will not sustain this rejection as it is directed to claim 21 or claims 22 to 26 dependent thereon.

We turn next to the examiner's rejection of claims 27 to 29 under 35 U.S.C. § 103 as being unpatentable over Silberstein in view of Jenni.

The examiner is of the opinion that Silberstein discloses the invention of claim 27 except that Silberstein does not disclose a polygonal check valve. The examiner relies on Jenni for describing a polygonal check valve. The examiner concludes:

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the shock absorber of Silberstien [sic] with the check valve of Jenni in order to improve the flow characteristics of the valve [Office Action dated December 30, 2004, page 5].

Appellants argue that there is no motivation to combine the teachings of Silberstein and Jenni to arrive at the subject matter of claim 27. Specifically, appellants argue:

. . . there is no support for the examiner's assertion that the Jenni valve has improved flow characteristics over Silberstein. Silberstein does not allude to any problems relating to fluid flow, and further, Jenni does not disclose that a polygonal check valve is a solution for improving fluid flow characteristics. In fact the polygonal surfaces in Jenni, i.e. the three flat surfaces 17, have nothing to do with flow and instead prevent rotation of the valve. There is absolutely no evidence in any of the references or prior art to support the examiner's assertion that modifying Silberstein to include the check valve of Jenni would improve Silberstein's flow characteristics [brief at page 17].

In response, the examiner asserts that there would also be motivation for modifying the Silberstein valve so as to have a polygonal shape as taught by Jenni, i.e., to improve the sealing characteristics of the Silberstein valve.

The appellants respond that Silberstien does not allude to any problems associated with positioning a valve against a seal.

We agree with the appellants. In our view the only reason for modifying the shock absorber of Silberstein so as to have the check valve described in Jenni is the hindsight reconstruction of the prior art using appellants invention as a template. Therefore, we will not sustain this rejection.

We will likewise not sustain the rejection of claims 30 to 32 under 35 U.S.C. § 103 as being unpatentable over Silberstein in view of Jenni and Shimoda as this rejection relies on the combination of Silberstein and Jenni.

The decision of the examiner is reversed.

CHARLES E. FRANKFORT  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
MURRIEL E. CRAWFORD ) APPEALS  
Administrative Patent Judge ) AND  
 ) INTERFERENCES  
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JENNIFER D. BAHR )  
Administrative Patent Judge )

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