

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD D. FORTINO and DAVID N. MANIEZ, JR.

Appeal 2007-1795
Application 10/418,693
Technology Center 3700

Decided: January 16, 2008

Before FRED J. McKELVEY, *Senior Administrative Patent Judge*,
WILLIAM F. PATE, III, and JOSEPH A. FISCHETTI, *Administrative
Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-30. We have jurisdiction under 35 U.S.C. § 6(b). (2002).

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Claim 1, reproduced below, is representative of the subject matter on appeal.

1. An assembly for turning an external handle of a tank dome valve about a vertical axis, the assembly comprising:

a mounting for removably mounting the assembly on a tank dome,

an adapter operated by a motor for engaging the valve handle and turning the handle when the motor operates, and

a positioning mechanism for selectively positioning the adapter relative to the mounting to establish a spatial relationship of each to the other for enabling the mounting to be placed at a desired location on the dome and the adapter to engage the valve handle, wherein the positioning mechanism comprises two degrees of freedom of motion in a horizontal plane for establishing the spatial relationship of the adapter to the mounting in the horizontal plane.

The Examiner relies upon the following as evidence of unpatentability:

Hickman	US 1,387,715	Aug. 16, 1921
Dean	US 5,340,078	Aug. 23, 1994
Slaydon	US 6,328,053	Dec. 11, 2001
Fortino ¹	US 6,957,802	Oct. 25, 2005

¹ Previously application 10/418,691 filed April 18, 2003.

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In addition to the prior art cited by the Examiner, we also refer to the following additional prior art.

Holdren US 6,062,754 May 16, 2000
Appellants' Admitted Prior Art (Specification 1:17-21)

The 35 U.S.C. § 102(e) Rejection based on Slayton

Claims 1 and 20-29 stand rejected under 35 U.S.C. § 102 (e) as anticipated by Slayton.

Within this group, independent claims 1 and 21 each require “a mounting for removably mounting the assembly on a tank dome” and “a positioning mechanism for selectively positioning the adapter relative to the mounting... the positioning mechanism comprises [two/three] degrees of freedom of motion for establishing the spatial relationship of the adapter to the mounting.” Independent claims 27 and 29 each require “a mounting of the assembly is supporting the assembly on the tank” and “relatively positioning the mounting and the adapter via a positioning mechanism of the valve operating assembly that has [two/three] degrees of freedom.” Thus, according to these claims, the assembly must be mounted to the tank or tank dome by a mounting which supports the assembly on the tank and the mounting and the tank must be selectively positioned by the positioning mechanism by at least two degrees of freedom.

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The Examiner reads the optional stand shown in Figure 5 as the positioning mechanism. (Answer 8, 9) As such, Slayton cannot anticipate claims 1, 20-29 because the stand shown in Figure 5 while its casters do allow three degrees of freedom, it does not position the mount (read as valve stem receptacle 116) relative to the console 100 (read as the adapter) because the spatial relationship between the mount and the adapter is fixed by the gear case 424 which is necessary for the transmission to work. Therefore, we will not sustain the rejection of claims 1, 20-29 under 35 U.S.C. § 102 (e) as anticipated by Slayton.

The 35 U.S.C. § 103(a) rejection

Claims 1-3, 12-16, and 18-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dean in view of Hickman. The Examiner found that “Dean appears to disclose all the limitations including the vertical and rotational (in the horizontal plane) degrees of freedom of the positioning mechanism.” (Final 6) However, this section of Dean is directed to rotational movement in the context of the retaining arm 55 and not anchor bracket 41 through which the powered adapter 21/22 is connected to the mount or collar 47. The bracket lower end is non-rotatably secured to the base plate 46 by a threaded connection. (Dean col. 3, ll. 43-59) Thus, the anchor bracket which is the equivalent of Appellants’ positioning mechanism is secured against movement to the mount 47, and thus is incapable of at least two degrees of freedom as required by the independent claims. Hickman does not provide any help in this regard because the

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standard or positioning mechanism 10 is fixed to its mount 11 as shown in Figure 1 by the illustrated weld.

Claim 30 requires a dome of a fluid containing tank having a valve and a handle, and an upright wall spaced horizontally from the valve handle such that the adapter is in engagement with the valve handle and the mounting is placed at a desired location on the upright wall. However, neither Dean nor Hickman discloses the environment of a tank having a dome comprised of an upright wall spaced horizontally from the valve as required by claim 30. Therefore we cannot sustain the rejection of claim 30.

New grounds of rejections pursuant to 37 C.F.R. § 41.50(b) (2006)

We reject independent claims 1, 21, 27, 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Appellants' admitted prior art (APA) in view of Hickman and Holdren.

APA discloses that tank cars having domes where various valves are located is known. APA further describes that valve handles are housed within a protective housing or wall that has a hinged lid or cover that is opened to expose the valve handles. (Specification 1:17-21) APA further describes that it is known to use a power actuator fitted to the handle to open and close the valve when conditions call for it. (Specification 1:23-24)

Hickman discloses a mounting or clamp 12 which removably mounts the assembly to a base. Hickman further discloses an adapter 29, 29, 18 which engages the valve handle 45 and turns the handle via a manual operating bar 24. Also, Hickman discloses a positioning mechanism

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(vertically telescoping standard 10 and horizontally slidably mounted supporting arm 14) which provides two degrees of freedom. The standard 10 is not however rotatably mounted to the clamp 10 at its base, but rather is welded to it. Thus, the supporting arm 14 in the horizontal plane which contains the arm 14 does not have two degrees of freedom, nor does the positioning mechanism (standard 10 and supporting arm 14) have three degrees of freedom when the adapter is in contact with the valve handle 45.

Holdren discloses a universal support/positioning mechanism 10 which includes a mounting 11 and a linearly adjustable extension arm 16 which is connected to the mounting 11 via a rotatable disk 14 thereby allowing the linear adjustable extension arm to be rotated about an axis extending perpendicularly to the horizontal plane which contains the extension arm.

Thus, what one skilled in the art learns from the prior art, taken individually and as a whole, is that Appellants have used known elements in the positioning mechanism and the dome tank arts to achieve their expected result. Such known elements include: (1) a positioning mechanism having a pivoting linear adjustable arm at the mounting as taught by Holdren's arm 16; (2) valve adapters which attach to a valve handle having both vertical and horizontal adjustment features and a clamping mechanism connecting the adapter to a fixed base distal from the valve; (3) a power actuator fitted to the handle of the valve as taught by APA. Thus, one skilled in the art would have known to use a vertically and horizontally adjustable positioning

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mechanism of Hickman with the pivotal mounting connection of Holdren in the power valve adapter described in APA because common sense tells a person having ordinary skill in the art that such an arrangement would provide a valve opening mechanism which is more adaptable to the various valve and housing configurations found on different tank cars. The application of common sense is relevant in determining whether to combine teachings of references. *See KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1742 (2007).

We remand dependent claims 2-20, 22-26 and 28 to the Examiner for consideration as to whether they are unpatentable under 35 U.S.C. § 103(a) based on Appellants' admitted prior art (APA) in view of Hickman and Holdren as set forth above and/or based on any other prior art which may be discovered and applied by the Examiner.

Double Patenting Rejection

In the Final Action dated September 10, 2004, claims 1-30 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending application 10/418,691. Since this time, application 10/418,691 on which the provisional double patenting rejection was based, has now matured into US Patent No. 6,957,802 issued on October 25, 2005. We thus construe the provisional double patenting rejection existing at the time this

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appeal was filed, to be converted into a double patenting rejection based on issued US Patent 6,957,802.

That said, we sustain the double patenting rejection of claims 1-30 based on US 6,957,802. We find that claim 1 of US 6,957,802 contains all the limitations of claim 1 of the application on appeal here.² Thus, claim 1 of the instant appeal is made obvious and/or anticipated by claim 1 of US 6,957,802³, and the double patenting rejection is proper.

Appellants argue that the provisional double patenting rejection is improper “[b]ecause both applications are on appeal with no claims allowed, a requirement for a terminal disclaimer at this time forces the patent owner to make a premature, and necessarily uninformed, decision.” (Appeal Br. 9) However, since Appellants now have the benefit of knowing the scope of the claims as issued in the reference patent, the argument is now considered moot.

The filing of a terminal disclaimer can overcome this double patenting rejection.

² Claim 1 of US 6,957,802 further recites a torque limiter, and except for that additional limitation, the two claims are essentially identical.

³ US Patent 6,957,802, and application 10/418,693 on which this appeal is based, both share the same filing date of April 18, 2003. Since both applications were filed on the same day, a one-way test need only be applied. *See, e.g., In re Berg*, 140 F.3d 1428, 1433, 1434 (Fed. Cir. 1998).

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CONCLUSIONS OF LAW

1. We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 US Patent 6,957,802.

2. Pursuant to 37 C.F.R. § 41.50(b) (2006) we enter the following new rejection: Claims 1, 21, 27, 29 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Appellants' admitted prior art (APA) in view of Hickman and Holdren.

3. We remand the application to the Examiner for consideration of dependent claims 2-20, 22-26 and 28, as to whether they are unpatentable under 35 U.S.C. § 103(a) based on Appellants' admitted prior art (APA) in view of Hickman and Holder as set forth above and/or based on any other prior art which may be discovered and applied to the rejection by the Examiner.

4. Appellant is not entitled to a patent containing the claims on appeal.

DECISION

It is hereby ORDERED that the decision of the Examiner rejecting claims 1-30 is *AFFIRMED*.

It is FURTHER ORDERED that since our rationale differs from the rationale of the Examiner, our affirmation is designated as a new ground of rejection. 37 C.F.R. § 41.50(b) (2006).

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37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner,

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner do not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED
37 C.F.R. § 41.50(b)

vsh

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