

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: June 6, 2008

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

FISCHETTI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

I. Appellants have filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(3) (2007) of our Decision of January 16, 2008. The Decision affirmed the Examiner's rejection of claims 1-30, but did so using a different

ground of rejection, namely, rejecting all claims using Appellants' admitted prior art (APA) in view of Hickman and Holdren.

II. Appellants traverse the Board's Affirmance of the obviousness type double patenting rejection based on the following points:

a. Appellants allege that the Board has "changed the basis for the double patenting rejection [by] now relying on the fact that the commonly own application relied on as a reference has become a patent." (Request for Rehearing 2). We disagree with Appellants' reasoning because the underlying rejection, namely an obviousness type double patenting rejection, remains, in substance, the same rejection. The fact that the status of the referenced application changed to a patent does not effect the basis for the rejection because the underlying facts with which the Examiner based the rejection, did not change with the status. The Examiner in the Final Rejection dated September 10, 2004 had carefully outlined claims 1 and 21 of US 10/418,691 so as to give a literal comparison with those claims in the case at issue. A review of claims 1 and 21 in the now issued US 6,957,802 reveals no change in what the Examiner outlined in the Final Office Action, and thus the substance of the rejections remains unchanged.

b. Appellants also argue "[t]he Decision ignores the Examiner's failure to explain why the claims on appeal would have been obvious." (Request for Rehearing 2). However, Appellants' Appeal Brief did not challenge any failure by the Examiner to explain the obviousness type double patenting rejection. Rather, Appellants' Brief seized on that idea that "a requirement for a terminal disclaimer at this time forces the patent owner to make a premature, and necessarily uninformed, decision." (Appeal Br. 9). Since Appellants now have the benefit of the scope of the claims of US 6,957,802,

the argument carries little weight.

III. Appellants Traverse the Board's New Ground of Rejection (NGR)

a. Appellants assert that because the Appeal Brief argues each of independent claims 1, 21, 27, 29, and 30 separately, the NGR should also have addressed these claims in the same way. However, the NGR modification to APA using Hickman and Holdren provides a combination covering all the limitations of independent claims 1, 21, 27, 29, and 30, and thus the NGR is properly grounded as to all limitations.

b. Appellants assert that the NGR fails “to recognize the context in which the inventive valve closure assembly is used and the inventive method is practiced.” (Request for Rehearing 3). In support of this assertion, Appellants first allege that APA merely describes what is shown in Dean, and therefore is merely cumulative to Dean. *Id.* We disagree, because Appellants’ APA distinguishes from Dean stating that the “valve closure assembly is hoisted onto the dome and mounted there.” (Specification 1:23, 24). Appellants’ Specification, particularly directed to Figures 34 and 35, describes that the dome is comprised of a side wall **162** (Specification 12:7-8) which is laterally offset from the valve handles A1-A4 (Specification 12:4-21). Thus, when the APA assembly is mounted on the dome, it is laterally offset from the valve. By contrast, in Dean, the valve closure assembly mounts directly on top of the valve (Dean, col.3, ll. 43-49), and thus there is no lateral offset between the mount and the valve.

Second, Appellants assert that Hickman “mounts on a faucet and not on any surrounding structure containing the faucet” (Request for Rehearing 3). We disagree. The spout in Hickman is analogous to the dome wall **612** in APA in that the positioning mechanism **10** and **14** in Hickman mounts to

the spout and not coincidentally on the valve, and thus spans a distance offset from the vertical axis of the turning stem **44** of the valve.

c. Appellants argue that the USPTO classification of the Holden device is indicative of its being nonanalogous art. We disagree. The classification of a device while being some evidence of “analogy” is far outweighed by the similarities and differences in structure and function of the devices found in the prior art. *See In re Ellis*, 476 F.2d 1370, 1372 (CCPA 1973). The analogous-art test requires that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’ -in other words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” *Id.* (quoting *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979))). *In re Kahn*, 441 F.3d 977, 986-87 (Fed. Cir. 2006). The general problem facing the Appellants is the need to accommodate car-to-car dome variations by providing an adjustable positioning mechanism (Specification 2:7-9). Likewise, in Holdren, the problem faced is to provide an infinitely adjustable position mechanism (Holdren, col.1, ll. 50-53) to support the movements of a user. Thus, Holdren is reasonably pertinent to the problem Appellants were trying to solve, because it is concerned with the general problem of an infinitely adjustable positioning mechanism, and is thus analogous art.

Appellants assert that the Board has substituted a common sense test for that provided by the *Graham v. Deere* inquiry. We disagree. The NGR is careful to set forth and use the *Graham* factors in fashioning the NGR in that it points out the differences between the prior art and what is claimed, the level of skill in that art, and what one learns from the prior art (Decision, 5-6). *KSR* merely suggests that the application of common sense is relevant in determining whether to combine based on the information collected in the *Graham* inquiry, and we make such a determination using common sense as a point of relevance.

e. Appellants next make three specific challenges to the combination of APA in view of Hickman and Holdren alleging, *inter alia*, that “the Decision contains incorrect descriptions of the subject matter...” (Request for Rehearing 5-6). Appellants maintain that: 1. Holdren's device is not a positioning mechanism. However, the Holdren device restrains the arm of a person to allow it to more accurately position the limb via the linkages in the mechanism, and thus qualifies as a positioning mechanism. Appellants next argue that: 2. Hickman clamps not to a base distal to the valve, but rather to the faucet itself at the spout. However, as discussed *supra*, the mounting member **10** in Hickman is located along the spout which is radially outwardly located from the valve, and thus is analogous to the wall mount of the dome because the base of the part **10** in Hickman is spaced laterally apart from the valve. Appellants also assert that: 3. the power actuator is not fitted to the handle of the valve, but rather an adapter is used as an intermediary. However, Hickman uses clamping screws **30** effectively as an adapter because the screws are adjustable to accommodate differing diameter handles.

e. Finally, Appellants argue that because Holdren is nonanalogous art, the decision erroneously applies a common sense test under *KSR* because this test “is to be applied using patents from the same field of endeavor, or if not within that field, reasonably pertinent to the problem being addressed.” (Request for Rehearing 6-7). However, as established *supra*, the general problem addressed by Holdren is one of adjustability and positioning, and is resolved by an adjustable positioning mechanism having an articulated working end, like that of Appellants.

CONCLUSIONS OF LAW

We conclude:

Our decision to affirm the decision of the Examiner to reject the claims on appeal under 35 U.S.C. § 103(a) over prior art has not been shown to have been erroneous.

On the record before us, the Appellants are not entitled to a patent claiming rejected claims 1-30 on appeal.

This decision on rehearing is a FINAL agency action.

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

REHEARING DENIED

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