UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS PINETTE

Appeal 2008-3043
Application 11/209,100
Technology Center 3700

Decided: December 17, 2008

Before: WILLIAM F. PATE, III, MURRIEL E. CRAWFORD and ANTON W. FETTING, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1-4, 7-12, 14 and 15. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The claimed subject matter is directed to a faucet assembly including a mounting arrangement for a ball valve assembly within the faucet (Spec. [0001]) having improved sealing properties (Spec. [0004]).

Independent claims 1 and 11 are representative of the claimed subject matter and are reproduced below:

> 1. A faucet assembly comprising:
> a housing defining a cavity;
> a ball valve disposed within said cavity to control water flow between an inlet and an outlet;
> a cam abutting directly against said ball valve to maintain said ball valve within said cavity; and
> a seal assembly including a seal between said cam and a portion of said ball valve that does not abut said cam, wherein said seal includes a first lip and a second lip spaced radially apart from said first lip that seals against the cam, and an annular space between the first lip and a second lip including a biasing member that biases said first lip portion radially inward into sealing contact with said ball valve.
>
> 11. A faucet assembly comprising:
> a housing defining a cavity;
> a ball valve disposed within said cavity to control water flow between an inlet and an outlet, said ball valve including a slot;
> a cam for fixing said ball valve within said cavity such that said ball valve is rotatable about an axis and linearly fixed within said cavity;
> a seal assembly supported within said cam for sealing between said cam and a surface of said ball valve that does not abut said cam; and
> a pin member fixed relative to the ball valve including a portion disposed within said slot on said ball valve for preventing linear movement of said ball valve relative to said housing.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kosatka	2,806,725	Sep. 17, 1957
Saffin Von Corpon	4,108,208	Aug. 22, 1978

The Examiner rejected claims 11-12, 14 and 15 under 35 U.S.C. § 112, first paragraph, as failing to comply with both the written description requirement and the enablement requirement.

The Examiner rejected claims 1 to 4 and 7-10 under 35 U.S.C. § 103(a) as unpatentable over Saffin Von Corpon in view of Kosatka

ISSUE

Has Appellant shown that the Examiner erred in rejecting claims 11, 12, 14 and 15 under 35 U.S.C. § 112 first paragraph as failing to comply with the written description requirement?

Has Appellant shown that the Examiner erred in rejecting claims 11, 12, 14 and 15 under 35 U.S.C. § 112 first paragraph as failing to comply with the enablement requirement?

Has Appellant shown that the Examiner erred in rejecting claims 1 to 4 and 7-10 under 35 U.S.C. § 103(a)?

FINDINGS OF FACT

1. During operation of Appellant's invention (Spec. p. 6), rotation of the ball valve 32 about the point 24 is limited by a pin member 40 disposed within a slot 42 of the ball valve 32.

2. The pin member 40 limits the amount of spherical movement allowable to maintain a desired alignment of the ball valve 32 with the inlets 14, 16 and the outlet 18.

3. Ball valve 32 is at all times free to move in at least one direction with respect to pin 40. The ball valve 32 would be unable to operate to control fluid flow absent this freedom of movement. The specification does not provide any direction or examples of how the ball valve 32 could operate properly absent this feature.

4. Saffin Von Corpon (cols. 1-4) discloses a faucet assembly (FIGS. 1 to 9) comprising a housing 1 defining a cavity (centrally of 1 – Fig. 1); a ball valve 25, 26 disposed within said cavity to control water flow between an inlet 17, 18 and an outlet 38; a cam 8 abutting directly against said ball valve (at 52) to maintain said ball valve within said cavity; and a seal assembly including a seal 48, 49 between said cam 8 and a portion of said ball valve (at 26) that does not abut said cam 8, wherein said seal includes a first lip 48 and a second lip 49 spaced radially apart from said first lip 48 that seals against the cam 8, and an annular space between the first lip 48 and a second lip 49 including a biasing member 50 that biases (col. 3, ll. 30-34; compressed between 8, 9, 49) said first lip portion 48 radially inward (from the surface toward the center) into sealing contact with said ball valve 25, 26.

PRINCIPLES OF LAW

New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. See, e.g., *In re Lukach*, 442 F.2d 967 (CCPA 1971).

The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required 'to recount his invention in such detail that his future claims can be determined to be encompassed within his original creation. *Amgen Inc. v. Hoechst Marion Roussel Inc*., 314 F.3d 1313, 1330 (Fed. Cir. 2003) (citing *Vas Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc*., 935 F.2d at 1563-64. When an explicit limitation in a claim is not present in the written description it must be shown that a person of ordinary skill would have understood that the description requires that limitation. *Hyatt v. Boone*, 146 F.3d 1348, 1353, (Fed. Cir. 1998). If the originally filed disclosure does not provide support for each claim limitation, a new or amended claim must be rejected under 35 U.S.C. 112, paragraph 1, as lacking adequate written description.

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact. *Regents of Univ. of Cal. v. Eli Lilly and Co*., 119 F.3d 1559, 1566 (Fed. Cir. 1997) citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). The Examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims.

In re Wertheim, 541 F.2d 257, 263 (CCPA 1976). Claim construction is an essential element in determining adequacy of the written description. (See e.g., MPEP § 2163).

The enablement requirement of 35 U.S.C. 112, first paragraph, is separate and distinct from the description requirement. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991) ("the purpose of the written description' requirement is broader than to merely explain how to make and use'").

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Minerals Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

Determining enablement is a question of law based on underlying factual findings. *In re Vaeck*, 947 F.2d 488, 495 (Fed. Cir. 1991). The determination that "undue experimentation" would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion that may be reached by weighing the following factual considerations: (A) The breadth of the claims; (B) The nature of the invention; (C) The state of the prior art; (D) The level of one of ordinary skill; (E) The level of predictability in the art; (F) The amount of direction provided by the inventor; (G) The existence of working examples; and (H) The quantity of experimentation needed to make or use the

invention based on the content of the disclosure. *In re Wands*, 858 F.2d at 737.

All questions of enablement are evaluated against the claimed subject matter. As concerns the breadth of a claim relevant to enablement, the only relevant concern should be whether the scope of enablement provided to one skilled in the art by the disclosure is commensurate with the scope of protection sought by the claims. *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003); *In re Moore*, 439 F.2d 1232, 1236 (CCPA 1971). See also *Plant Genetic Sys., N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1339 (Fed. Cir. 2003). The focus of the examination inquiry is whether everything within the scope of the claim is enabled. Accordingly, the first analytical step requires that the examiner determine exactly what subject matter is encompassed by the claims. See, e.g., *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003).

To learn the meaning of a term in the patent claim, the specification can be used as a dictionary. *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299 (Fed. Cir. 1999). Where no explicit definition for a term is given in the specification, the term should be given its ordinary meaning and broadest reasonable interpretation. *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368 (Fed. Cir. 2003). The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary

meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir.1987). Anticipation is a question of fact *In re Baxter Travenol Labs.* 952 F.2d 388, 390. and is the ultimate of obviousness. *Id.* at 391.

ANALYSIS

Construction of Claim 11

The portion of Appellant's specification cited and relied on to show compliance with the written description requirement is devoid of any explicit definition of the term "fixed" as it is used in the phrase, "a pin member fixed relative to the ball valve" in claim 11. As such, the phrase is presumed to take on the ordinary and customary meanings attributed to it by those of ordinary skill in the art. One of ordinary skill in the art would interpret the term to mean that the pin member, in its entirety, and the ball valve, in its entirety, are stationary with respect to each other.

Appellant argues that for the pin to restrict movement of the ball [valve] it would necessarily have to be fixed relative to the ball [valve]. This argument is not persuasive. In essence Appellant is arguing that the phrase, "a pin member fixed relative to the ball valve" should be interpreted to mean that the pin member is stationary in at least one direction, during at least some time interval, relative to at least some portion of the ball valve (i.e.,

during the period when the ball valve 32 is moved to a position such that the pin engages both the housing 12 and edge of the slot 42). This interpretation strays significantly from the ordinary and customary meaning that would be attributed to the phrase by those of ordinary skill in the art, and is therefore not adopted.

The Written Description Requirement

Since there is no original disclosure that the pin member is fixed relative to the ball, the Examiner did not err in concluding that the phrase, "a pin member fixed relative to the ball valve" lacks descriptive support in the Specification as filed. Appellant has not established error in the Examiner's finding that the specification and claims as originally filed do not convey possession of "a pin member fixed relative to the ball valve" consistent with the definition of "fixed relative to" adopted above. Claim 11, along with dependent claims 12, 14 and 15, have therefore been properly rejected under 35 U.S.C. § 112 first paragraph, as failing to comply with the written description requirement.

The Enablement Requirement

Ball valve 32 would be unable to operate to control fluid flow with "a pin member fixed relative to the ball valve." The nature of the invention, that it is intended for the purpose of controlling fluid flow, mandates this capability. As to the so-called *Wands* factors, the specification provides no direction or examples as to how the ball valve could operate with "a pin member fixed relative to the ball valve." Extensive work, which would not

be routine in the art, would be necessary to make or use the invention with "a pin member fixed relative to the ball valve." Therefore, there is no original disclosure that would enable one skilled in the art to make and use the claimed invention with "a pin member fixed relative to the ball valve," absent undue experimentation. Thus, the Examiner did not err in concluding that the scope of enablement provided to one skilled in the art by the disclosure is not commensurate with the scope of protection sought by the claims. The rejection of claims 11, 12, 14 and 15 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, is therefore affirmed.

Construction of Claim 1

Appellant argues that the tongue portion 48 and heel portion 49 of the seal disclosed in Saffin Von Corpon is not properly read as the claimed first and second lip, respectively, because they are not "spaced radially apart", nor do they provide "an annular space [therebetween]." This argument hinges on the interpretation of the terms, "spaced radially" and "between." Appellant does not assert that there is any explicit definition for these terms within the specification. The terms are therefore presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art.

A radial direction would be interpreted by one of ordinary skill in the art as a direction along a radius of the ball valve 32 towards or away from its center. Elements "spaced radially apart" would therefore mean that there is a non-zero distance between the recited elements in that radial direction. A

space "between" elements would require the existence of an area within an interval separating the elements which is not occupied by those elements.

Claim Rejections under 35 U.S.C. § 103

Saffin Von Corpon, as best shown in Fig. 9, discloses a seal including a first lip 48 and a second lip 49. An exemplary radial direction may be defined by a line drawn from the center of sphere 25, 26 to the outermost point on the underside of outer lip 49. Since each lip has a different distance from the center of the sphere 25, 26 along this line, the lips 48, 49 may be considered "spaced radially apart" within the broadest reasonable interpretation of that term. Since there is an element 50, different from lips 48, 49 occupying an annular (Fig. 9 represents a cross section along a ring) space between the lips 48, 49 in this radial direction, the lips 48, 49 provide an "annular space [therebetween]" within the broadest reasonable interpretation of that term. Appellant has therefore not shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103 because Saffin Von Corpon fails to disclose lips which are "spaced radially apart" and having "an annular space [therebetween]."

Appellant's remaining arguments are directed to the propriety of the Examiners proposed combination with Kosatka, which the Examiner relied on to demonstrate the state of the art with respect to biasing a seal. Since we have agreed that the ring 50 may properly be read as the claimed "biasing member", Saffin Von Corpon does not need any further teaching from Kosatka in order to anticipate the subject matter of claims 1-4 and 7-10. These claims are prima facie obvious over the disclosure of Saffin Von

Corpon, since anticipation is the epitome of obviousness. *In re Baxter Travenol Labs*, 952 F.2d at 391. The rejection of claims 1 to 4 and 7-10 under 35 U.S.C. § 103(a) is therefore affirmed.

CONCLUSION OF LAW

On the record before us, Appellant has not shown that the Examiner erred in rejecting claims 11, 12, 14 and 15 under 35 U.S.C. § 112 first paragraph, nor has the Appellant shown that the Examiner erred in rejecting claims 1-4 and 7-10 under 35 U.S.C. § 103(a) .

DECISION

The Examiner's rejection of claims 11-12, 14 and 15 under 35 U.S.C. § 112 first paragraph, and of claims 1 to 4 and 7-10 under 35 U.S.C. § 103(a) is therefore affirmed.

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

PL: vsh

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