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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DIETER LUTZ

Appeal 2010-007127
Application 11/354,781
Technology Center 3700

Before: JOHN C. KERINS, STEFAN STAICOVICI, and
CHARLES N. GREENHUT, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1-6. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

The claims are directed to a method for adjusting the throttling action of a valve. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1 Method for manufacturing a valve comprising a through channel and a valve disk which covers the channel and deforms to throttle a fluid passing through the channel, method comprising:

forming at least one bending axis in the disk by using a laser beam to locally heat the disk in order to cause partial local melting, wherein the at least one bending axis in the disk minimizes deviations from a predetermined throttling action.

REFERENCES

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

Nicholls	US 4,121,704	Oct. 24, 1978
Frackiewicz	US 5,228,324	Jul. 20, 1993

REJECTION

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicholls in view of Frackiewicz. Ans. 3.

OPINION

The Examiner incorrectly interpreted the valve disk of claim 1 to encompass limit stop 7 of Nicholls. Ans. 3, *citing* Nicholls, fig. 1. Element 7 of Nicholls, identified by the Examiner as the “valve disk,” is referred to by Nicholls as a “limit stop” which limits the flex of the valve member 4. *See* Nicholls, col. 1, ll. 54-55, fig. 1. The Examiner’s interpretation conflicts with the ordinary meaning of the term as it would be understood by one skilled in the art. Nicholls teaches that “valve members **4** and **5** . . . are in the form of resiliently flexible annular *discs*.” *See* col. 2, ll. 3-7 (emphasis added). Nicholls additionally teaches that discs 4 and 5 are valve discs which “flex and lift off seat **17**” when “downward movement of the piston causes liquid to flow upwardly through the piston and through the holes in the seat member 2.” *See* Nicholls col. 2, ll. 13-18. Therefore, a person of ordinary skill in the art, based on the disclosure of Nicholls, would be led to understand that the “valve disk” recited in claim 1 reads on valve discs 4 or 5, as opposed to limit stop 7 proposed by the Examiner. Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999).

Prior art references may be ‘indicative of what all those skilled in the art generally believe a certain term means ... [and] can often help to demonstrate how a disputed term is used by those skilled in the art.’ ... Accordingly, the PTO’s interpretation of claim terms should not be so broad that it conflicts with the meaning given to identical terms in other patents from analogous art.

Id. (internal citations omitted).

Further, limit stop 7 of Nicholls fails to “cover[] the channel [of the valve] and deform[] to throttle a fluid passing through the channel [of the

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valve].” The body of the claim relies on the preamble for antecedent basis for the “valve disk.” The preamble limits the disk to a particular type of structure used in the method—one that deforms to throttle a fluid. As the Appellant chose to use both the preamble and the body of the claim to define the subject matter of the claimed invention, the preamble is limiting. *See e.g., C.W. Zumbiel Co., Inc. v. Kappos* 702 F.3d 1371, 1385 (Fed. Cir. 2012); *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 952-53 (Fed. Cir. 2006) (“when the limitations in the body of the claim ‘rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention’” (citations omitted)).

Since this improper interpretation forms the basis for the Examiner’s rejection of claims 1-6, we are constrained to reverse this rejection.

DECISION

The Examiner’s rejection of claims 1-6 is reversed.

REVERSED

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