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ANDREWS KURTH KENYON LLP ONE BROADWAY NEW YORK, NY 10004			CERNOCH, STEVEN MICHAEL	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FERDINAND REITER

Appeal 2015-000622
Application 11/662,621
Technology Center 3700

Before PHILLIP J. KAUFFMAN, LYNNE H. BROWNE, and
HYUN J. JUNG, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the rejection of claims 18, 19, 22–25, and 28–34.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We reverse and enter a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

¹ Appellant mistakenly lists claim 8 as appealed (Br. 1) and elsewhere correctly identifies claim 18 (Br. 2).

CLAIMED SUBJECT MATTER

The claims are directed to a fuel injector. Claim 18, reproduced below, is illustrative of the claimed subject matter:

18. A fuel injector, comprising:
a valve housing;
a solenoid coil;
a restoring spring;
an armature, wherein the armature is acted upon by the restoring spring, and wherein the armature cooperates with the solenoid coil;
a valve needle, wherein valve needle and the armature together form an axially displaceable valve part;
a sealing seat formed by a valve-closure member and a valve-seat body, wherein the valve closure member is provided on the valve needle; and
a disk made of an elastomeric material affixed between the solenoid coil and the valve housing in a direction parallel to a path of movement of the armature, the solenoid coil contacting a first surface of the disk and the valve housing contacting a second surface of the disk that is opposite the first surface,
a valve sleeve, wherein an inner radius of the disk is smaller than a radius of the valve sleeve, wherein the valve sleeve reaches through the solenoid coil on the inside,
wherein the inner radius of the disk is dimensioned to provide sealing of the valve sleeve, the disk in the installed state wrapping around the valve sleeve.

REFERENCES

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

Casey	US 4,951,878	Aug. 28, 1990
Cerny	US 5,263,647	Nov. 23, 1993
Yokota	US 5,566,921	Oct. 22, 1996

REJECTIONS

- I. Claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Casey and Cerny.
- II. Claims 22–25 and 28–34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Casey, Cerny, and Yokota.

DISCUSSION

New Ground of Rejection

Claims 18, 19, 22–25, and 28–34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Independent claim 18 requires “a disk made of an elastomeric material *affixed* between the solenoid coil and the valve housing *in a direction parallel* to a path of movement of the armature.” Appeal Br. Claim App. 1 (emphasis added). It is unclear how a disk can be affixed (i.e. attached physically²) in a direction. Even if we are to assume that this claim limitation refers to outer surfaces of the disk being affixed, it is unclear how those surfaces are affixed in a direction.³ It is possible that the claim was intended to require that the disk be affixed such that some feature of the disk is oriented in a direction parallel to a path of movement of the armature.

² An ordinary and customary definition of “affix” is “to attach physically.” Merriam-webster.com, <http://www.merriam-webster.com/dictionary/affixed> (last accessed November 7, 2016).

³ We note that although the Abstract describes the rubber disk 25 as “affixed underneath the solenoid,” claim 1 requires “an elastomeric material [that] is affixed between the solenoid coil (2) and a valve housing (4),” and claim 5 requires that “the disk (25) is affixed on a coil brace (3) of the solenoid coil (2), the Specification does not describe the disk being affixed “in a direction” or explain what is meant by this claim terminology. Abstract, Spec. 8.

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However, we do not speculate as to the meaning of claim terms. “If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious—the claim becomes indefinite.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Claims 19, 22–25, and 28–34 depend from claim 18 and likewise are indefinite.

Rejections I and II

Having determined that claims 18, 19, 22–25, and 28–34 are indefinite, we cannot sustain the rejections of these claims under 35 U.S.C. § 103(a) because to do so would require speculation as to the scope of the claims. *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (Holding that the Board erred in affirming a rejection of indefinite claims under 35 U.S.C. § 103(a)).

DECISION

We enter a NEW GROUND OF REJECTION of claims 18, 19, 22–25, and 28–34 under 35 U.S.C. § 112, second paragraph.

The Examiner’s rejections of claims 18, 19, 22–25, and 28–34 are REVERSED.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, 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:

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(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, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

REVERSED; 37 C.F.R. § 41.50(b)