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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SAN QUACH and TRACY A. PROPHETER-HINCKLEY¹

Appeal 2018-007728
Application 14/749,000
Technology Center 1700

Before MICHAEL P. COLAIANNI, JEFFREY B. ROBERTSON, and
CHRISTOPHER C. KENNEDY, *Administrative Patent Judges*.

KENNEDY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1, 3, 5–14, and 23–26. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Pursuant to our authority under 37 C.F.R. § 41.50(b), we also enter a NEW GROUND OF REJECTION, set forth below.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as United Technologies Corporation. *See* App. Br. 1.

BACKGROUND

The subject matter on appeal relates to a core assembly for use in, e.g., a gas turbine engine. *E.g.*, Spec. p.1; Claim 1. Claim 1 is reproduced below from page 6 (Appendix of Claims) of the Appeal Brief:

1. A core assembly comprising:
 - a first core including:
 - an exterior surface having a pressure side and a suction side extending between an upstream end and a downstream end;
and
 - a first recessed area extending along the pressure side; and
 - a first insert including a first end, a second end, a first side, and a second side, wherein the first side includes a contact surface corresponding to and attached to the first recessed area.

ANALYSIS²

Claims 1, 3, 5–14, and 23–26 stand rejected under 35 U.S.C. § 102(a)(1) as anticipated by *Propheter-Hinckley* (US 2014/0072447 A1, published March 13, 2014) (“*Propheter*”).

The Examiner finds that *Propheter* anticipates claim 1. Ans. 4, 6 (annotated Fig. 2A). The Examiner relies principally on Figure 2A of *Propheter*, reproduced below with annotations added by the Board to identify specific elements of the Figure.

² The Examiner’s “Claim Objections,” *see* Ans. 3, concern procedural issues that are “not directly connected with the merits of issues involving rejections of claims,” and they are appropriately addressed by petition rather than appeal. *See* App. Br. 2 (requesting that the Board “reverse[]” the objections); *see also In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002) (quoting *In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971)); 37 C.F.R. § 1.181.

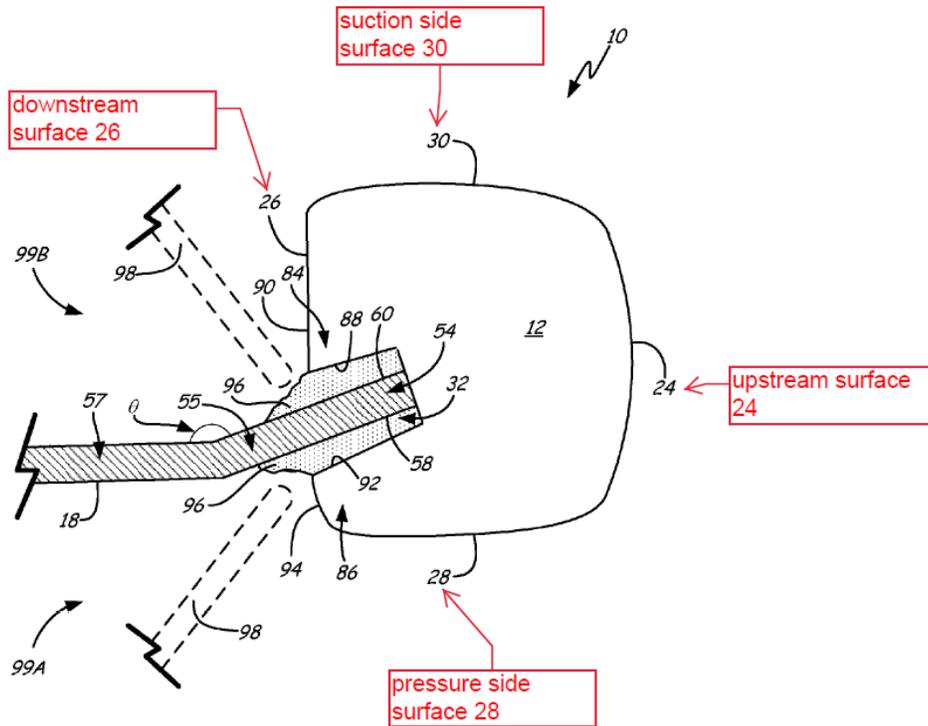


FIG. 2A

Of particular relevance to the issues raised by the Appellant, and with reference to Figure 2A above, the Examiner finds that Prophter's pressure side surface 28 corresponds to the "pressure side" of the exterior surface of the first core 12, as claimed, and that Prophter's slot 32 corresponds to the "first recessed area extending along the pressure side," as claimed. *Id.* at 4. For the first time in the Response to Argument section of the Answer, the Examiner explains that the Examiner is interpreting the term "pressure side" to encompass any portion of the walls of core 12 that are subject to pressure, including vertical portions of the walls that are identified by Prophter as downstream surface 26 and upstream surface 24. *Id.* at 8–9. According to the Examiner, refractory metal core ("RMC") 18 and slot 32 "divide[] the pressure side from the suction side," and, therefore, approximately half of slot 32 extends along a "pressure side" of first core 12. *Id.* at 8.

We reverse the Examiner's rejection. As an initial matter, we observe that the Examiner cites only paragraph 26 of Propheter to support the Examiner's finding that RMC 18 divides the pressure side from the suction side. Ans. 8. We discern no disclosure in paragraph 26 that persuasively supports that finding.

In any event, even if paragraph 26 did support that finding, the Examiner's interpretation of "pressure side" as encompassing portions of Propheter's vertical surfaces 24 and 26, so long as they are subject to some pressure, is overly broad and is inconsistent with the Specification. *See In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) ("[T]he PTO must give claims their broadest reasonable construction consistent with the specification."). The claim itself defines the "pressure side" as "extending between an upstream end and a downstream end" and does not indicate that the "pressure side" includes parts of the upstream and downstream ends. *See* claim 1. As the Appellant explains in the Reply Brief, the Specification repeatedly indicates that upstream ends (or surfaces) and downstream ends (or surfaces) are separate and distinct from the pressure side and the suction side. *See* Reply Br. 3; Spec. Figs. 4–14 & ¶¶ 57, 66, 69, 72, 75, 78, 84, 88. Additionally, in several instances the Specification refers to "the entire pressure side," indicating that the term "pressure side" does not encompass any portion of the vertical surfaces of the upstream and downstream surfaces. *E.g.*, Spec. ¶¶ 66, 69, 88. To give one example, the Specification explains that, in Figure 7, "a recessed area 228 is formed along *the entire pressure side 224*," indicating that the bottom horizontal surface 224 is the "entire" pressure side, and that the "pressure side" does not extend any vertical distance up the downstream and upstream

surfaces 220 and 222. *See* Spec. ¶ 66 (emphasis added). The Examiner does not identify any portion of the claims or the Specification that indicates that the term “pressure side” may encompass portions of the upstream and downstream surfaces.

The nomenclature of the Specification described above is consistent with that of Propheter, which, with reference to Figure 2A, describes vertical surfaces 24 and 26 as “upstream surface 24” and “downstream surface 26,” and separately describes horizontal surfaces 28 and 30 as “pressure side surface 28” and “suction side surface 30.” *See* Propheter Fig. 2A & ¶¶ 19, 26–28. The Examiner identifies no portion of Propheter that would indicate that any portion of either the upstream surface 24 or the downstream surface 26 should be considered to be part of Propheter’s pressure side surface 28. On the contrary, and as explained in the new ground of rejection, Propheter discloses an embodiment, distinct from Figure 2A (relied on by the Examiner), that expressly describes and depicts “slots” that are “located along the pressure or suction side of a ceramic core.” Propheter ¶ 31; Fig. 3. That embodiment stands in direct contrast to the embodiment relied on by the Examiner, Figure 2A, in which the slot is recessed into downstream surface 26. *See* Fig. 2A.

On this record, the Examiner has not adequately established that slot 32 of Figure 2A falls within the scope of the term “a first recessed area *extending along the pressure side.*” Accordingly, we reverse the Examiner’s rejection of claim 1. Because the Examiner’s rejection of claims 3, 5–14, and 23–26 does not remedy the error identified above, we likewise reverse the Examiner’s rejection of those claims.

New Ground of Rejection

Claim 1 is rejected under 35 U.S.C. § 102(a)(1) as anticipated by Propheter, or, alternatively, under 35 U.S.C. § 103 as unpatentable over Propheter.

As set forth above, in addition to the embodiment relied on by the Examiner in which Propheter's slot is recessed into downstream surface 26 rather than into pressure side 28, Propheter expressly discloses that "[t]he slots that receive an RMC can also be located along the pressure or suction side of a ceramic core." Propheter ¶ 31. Consistent with that disclosure, Figure 3 of Propheter is reproduced below.

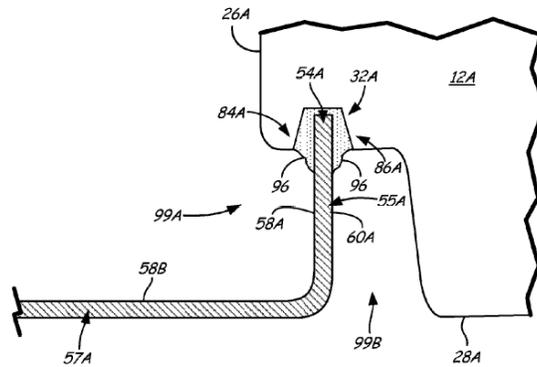


Figure 3 depicts a core assembly comprising first core 12A that has an exterior surface with pressure side 28A, a suction side at the top of the figure (unlabeled), downstream end 26A, an upstream end at the right of the figure (unlabeled), a first recessed area 32A extending along the pressure side, and a first insert 57A/54A that includes first and second ends, first and second sides, and the first side includes a contact surface corresponding to and attached to the first recessed area 32A. See Propheter Fig. 3 & ¶¶ 31–32.

Even if Propheter does not anticipate claim 1, the subject matter of claim 1 would have been obvious in view of Propheter. Paragraph 30 describes, *inter alia*, Figure 2A, which is the figure relied on by the

Examiner. As stated above, paragraph 31 expressly teaches that “[t]he slots that receive an RMC,” e.g., slot 32 of Figure 2A, “can also be located along the pressure . . . side of a ceramic core.” Propheeter ¶ 31. As described above and as set forth by the Examiner, Figure 2A discloses subject matter that falls within the scope of claim 1 except that Figure 2A’s slot 32 is not located “along the pressure side,” as required by claim 1. In view of the express teaching in Propheeter ¶ 31 that the slot “can also be located along the pressure . . . side,” it would have been obvious to locate slot 32 along pressure side surface 28. *See* Fig. 2A. Thus, the subject matter of claim 1 would have been obvious in view of Propheeter, even if not anticipated by the embodiment of Figure 3.

We leave consideration of the dependent claims to the Examiner.

CONCLUSION

In Summary:

Claims Rejected	35 U.S.C. §	Reference/Basis	Affirmed	Reversed	New Ground
1, 3, 5–14, 23–26	102(a)(1)	Propheeter		1, 3, 5–14, 23–26	
	102(a)(1)	Propheeter			1
	103	Propheeter			1
Overall Outcome				1, 3, 5–14, 23–26	1

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 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, in which event the prosecution will be remanded to the Examiner. . . .

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

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)