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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JENS HOEHNE

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Appeal 2018-009221  
Application 14/168,140<sup>1</sup>  
Technology Center 3700

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Before ANTON W. FETTING, MICHAEL C. ASTORINO, and  
BRADLEY B. BAYAT, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), the Appellant appeals from the Examiner's decision rejecting claims 28–31, 35, 36, 38–44, 46, 47, 49, 51, and 52. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> “The real party in interest is the assignee, Pressure Wave Systems GmbH, a limited liability company formed under the laws of Germany.” Appeal Br. 1.

## STATEMENT OF THE CASE

### *Claimed Subject Matter*

Claims 28, 38, and 47 are the independent claims on appeal.

Claim 28, reproduced below, is illustrative of the claimed subject matter.

28. A device comprising:

a compressor arrangement with a compressor element, wherein the compressor element divides the compressor arrangement into a first volume and a second volume, and wherein the first volume contains a working gas that is compressed by the compressor element;

a hydraulic cylinder with a hydraulic piston, wherein the hydraulic piston is coupled to the compressor element;

a compensation container connected to the first volume by a gas line with a non-return valve that opens in the direction of the first volume, wherein the compensation container is connected by the gas line to the second volume, wherein the working gas flows between the compensation container and the second volume, and wherein the working gas flows from the compensation container to the first volume; and

a cooling device, wherein the first volume is connected to the cooling device such that compressed working gas from the first volume flows into the cooling device and expands in the cooling device.

### *Rejections*

Claims 28–31, 35, 38–42, 44, 46, 47, 49, and 52 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Suganami et al. (US 4,911,618, issued Mar. 27, 1990) (“Suganami”) and Ingersoll et al. (US 2012/0096845 A1, publication Apr. 26, 2012) (“Ingersoll”).

Claims 36 and 51 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Suganami, Ingersoll, and Dehne (US 3,640,082, issued Feb. 8, 1972).

Claim 43 is rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Suganami, Ingersoll, and Newcomb (US 1,307,210, issued June 17, 1919).

### ANALYSIS

Independent claim 28 recites:

a compensation container connected to the first volume by a gas line with a non-return valve that opens in the direction of the first volume, wherein the compensation container is connected by the gas line to the second volume, wherein the working gas flows between the compensation container and the second volume, and wherein the working gas flows from the compensation container to the first volume.

Appeal Br. 19 (Claims App'x). Independent claims 38 and 47 call for a similar compensation container. *See id.* at 20–22 (Claims App'x).

The Examiner's rejection of independent claims 28, 38, and 47 relies on a finding that the claimed "compensation container" reads on Suganami's purification chamber 16. Final Act. 8–10. In support of this finding, the Examiner provides a dictionary definition of the term "'compensate' as 'to offset an error, defect, or undesired effect'." Ans. 14; *Compensate Definition 2*, MERRIAM-WEBSTER.COM, <https://www.merriamwebster.com/dictionary/compensate> (last visited Sept. 11, 2019).

The Appellant argues that one of ordinary skill in the art reading the Specification would not have interpreted the term "compensate" as the Examiner does. *See* Appeal Br. 9; Reply Br. 6–8. The Appellant's argument is persuasive.

We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims "their broadest

reasonable interpretation consistent with the specification” and “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted).

At the outset, we note the Appellant’s claims and Specification lack an explicit definition for “compensation container” or “compensation.” The Examiner refers to the Specification to understand the use of the term “compensation container.” Specifically, the Examiner explains that the “[S]pecification states that any reduction in the volume of the working medium caused by cooling in the cooling device 21 can be compensated by the gas within the compensation [container] 32 (i.e. by allowing compensation gas to flow through the check valve 35 and into the chamber [(first gas volume)] 26).” Ans. 12; *see* Spec. Fig. 2. Similarly, the Appellant points to the Specification at paragraph 32, which describes “[t]he reduction of the volume of the working medium resulting from cooling down in the cooling device 21 can thereby be compensated.” Appeal Br. 9; *see id.* at 2–3.

Based on these similar understandings of how the Specification uses the term “compensation container,” as well as our own, we fail to understand how one of ordinary skill in the art, upon reading the Specification, would understand the claimed “compensation container” as a container that offsets an error, defect, or undesired effect. Additionally, we note that the Examiner fails to explain on the record how the Specification describes the “compensation container” as offsetting an error, defect, or undesired effect.

The Appellant argues “[f]rom the use of the term ‘compensation container’ in the claims and [S]pecification, it is clear that ‘compensation’

supplements something that has been diminished, such as compensation for the reduced volume of gas as the gas cools.” Appeal Br. 9. Consistent with the Appellant’s view, the term “compensate,” when used in the field of mechanics, is defined as, “to counterbalance (a force or the like); adjust or construct so as to offset or counterbalance variations or produce equilibrium”). *Compensate Definition 3 (Mechanics)*, DICTIONARY.COM, <https://www.dictionary.com/browse/compensate> (last visited Sept. 11, 2019). In view of the foregoing, we determine that the Appellant’s understanding of the term “compensation container” is in line with giving the claims “their broadest reasonable interpretation consistent with the specification” and “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d at 1364 (citations omitted).

As discussed above, the Examiner’s rejection of independent claims 28, 38, and 47 relies on a finding that the claimed “compensation container” reads on Suganami’s purification chamber 16. *See* Final Act. 8–12. The Examiner supports this finding by explaining that purification chamber 16 filters out impurities from a gas. *See* Ans. 13. However, we determine that the support for the Examiner’s finding is based on a definition of “compensation container” that is inconsistent with the Specification as understood by one of ordinary skill in the art. Further, we determine that the Examiner’s finding is inadequately supported under a proper construction of the term “compensation container.”

Thus, we do not sustain the Examiner’s rejection of independent claims 28, 38, and 47 as unpatentable over Suganami and Ingersoll. The remaining rejections based on Suganami and Ingersoll in combination with

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Dehne or Newcomb rely on the same inadequately supported finding discussed above. The inadequately supported finding is not cured by additional findings and/or reasoning. Thus, we do not sustain the rejections of claims 36, 43, and 51.

#### DECISION

We REVERSE the Examiner's decision rejecting claims 28–31, 35, 36, 38–44, 46, 47, 49, 51, and 52.

REVERSED