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Pearne & Gordon LLP 1801 East 9th Street Suite 1200 Cleveland, OH 44114-3108			MCGOWAN, JAMIE LOUISE	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEAN-CHRISTOPHE GILLARD

Appeal 2019-003217
Application 14/762,511
Technology Center 3600

Before JENNIFER D. BAHR, CHARLES N. GREENHUT, and
JILL D. HILL, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–20. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as VSL International AG. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claims are directed to a hydromill wheel with single disc cutting rollers. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A hydromill wheel for excavating a trench in hard rock, the wheel comprising:
 - a drum arranged to be rotated about an axis extending laterally below a body of a hydromill; and
 - a plurality of single disc cutters mounted on a periphery of the drum, each said single disc cutter having a rotatable single cutting disc, each said rotatable single cutting disc having a single cutting edge arranged to come in contact with and crush or cut the rock during excavation, wherein a spacing between projections of at least two consecutive cutting discs on the drum axis is 5 % to 70 % of the cutting disc diameter, and wherein a weight of the hydromill is supported by the single disc cutters at a bottom of the drum for cutting the rock disposed below the hydromill.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Stötzer	US 5,035,071	July 30, 1991
Stoetzer	US 5,924,222	July 20, 1999

REJECTIONS

Claims 1, 3–9, 12, 14, 16, 19 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Stötzer '071.²

² We understand “Stoetzer” and “Stötzer” to be alternative forms of the same name. We refer to “Stötzer '071” as printed on the '071 patent, where the Examiner refers to “Stoetzer '071.”

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Claims 2, 11, 13, 15, 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stötzer '071. Final Act. 5.

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stötzer '071 and Stoetzer '222. Final Act. 7.

OPINION

Independent claim 1 requires, among other things, “wherein a spacing between projections of at least two consecutive cutting discs on the drum axis is 5 % to 70 % of the cutting disc diameter.” Appellant argues that such information cannot be deduced from Stötzer’s Figures alone. App. Br. 10–11. If any information can be deduced about the cutting disc spacing “on the drum axis” in Stötzer it would not appear to be deducible from Figure 2, the only portion of Stötzer cited by the Examiner for meeting this limitation. Final Act. 3; Ans. 5. This is because the drum axis goes into and out of the page in Figure 2 and there is no indication whatsoever as to cutter spacing in that direction. Accordingly, we cannot sustain the Examiner’s anticipation rejection on the basis set forth by the Examiner or the Examiner’s obviousness rejection of claim 10 which exhibits the same shortcoming.

Turning to independent claim 15, the Examiner determines:

It would have been an obvious matter of design choice to utilize cutting discs that would create fractures between 10mm and 70mm or between 10 mm and 40 mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level or ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Final Act. 6–7.

Determining that a claim element is the product of an “obvious design choice” is generally precluded where the claimed structure and the function

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it performs are different from the prior art. *See In re Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed.Cir.1992) (cited with approval in *In re Chu*, 66 F. 3d 292 (Fed. Cir. 1995). Here the Specification discusses the purpose of the range recited:

It has been discovered that the spacing of the disc traces, in other words their projection on the cutter wheel axis A, B, is preferably 5% to 70% of the disc diameter or if expressed directly in terms of length, then the lateral spacing (in the direction of the axis A, B) of the disc traces is preferably between 10 mm and 70 mm, and in some implementations between 10 and 40 mm. With this arrangement, for instance for typical granite with ultimate compressive strength equalling about 150 N/mm² and tensile strength of around 8 N/mm², cracks on the rock created by the disc cutters 11 still join.

Spec. 8:11–19.

Rather than provide any evidence or technical analysis relevant to the specific facts at issue relating to the fracture spacing the Examiner summarily reaches a conclusion of obviousness relying on, without more, a per se rule that “[a] change in size is generally recognized as being within the level or ordinary skill in the art.”

“This method of analysis is founded on legal error because it substitutes supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *In re Ochiai*, 71 F. 3d 1565, 1571 (Fed. Cir. 1995).

The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention — including all its limitations — with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board . . . But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative

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convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as *claimed* in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations.

Id at 1572.

For the foregoing reasons we do not sustain the Examiner's obviousness rejections.

CONCLUSION

The Examiner's rejections are reversed.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 3-9, 12, 14, 16, 19, 20	102(b)	Stötzer '071		1, 3-9, 12, 14, 16, 19, 20
2, 11, 13, 15, 17, 18	103(a)	Stötzer '071		2, 11, 13, 15, 17, 18
10	103(a)	Stötzer'071, Stoetzer '222		10
Overall Outcome				1-20

REVERSED