

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNARD PARISI and DAVID J. BURKE

Appeal No. 1998-3314
Application 08/666,093¹

ON BRIEF

Before FRANKFORT, STAAB and BAHR, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

On Request for Rehearing

Appellants request rehearing of our decision of October 29, 1999, wherein we reversed the examiner's final rejection of claims 1-3, 8, 9, 11-13, 16, and 19, and affirmed the

¹ Application for patent filed June 19, 1996.

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examiner's final rejection of claims 25 and 26.

Appellants contend that we "misapprehended or overlooked the definitive recitations of claim 25 and [have] misinterpreted the language of claim 25 in affirming the rejection of claim 25 as being anticipated by Cornell" (request, page 1). Specifically, appellants contend that Cornell does not anticipate claim 25 because (1) the opening 32 of the ball valve of Cornell is, by definition, not a "socket" as claimed, (2) claim 25 requires that the shaft is removably received in the socket and the presence of the pin 31 prevents Cornell's arm 29 from being removed from the opening 32, (3) the arm 29 and opening 32 of Cornell are not in "mating relation" in the manner called for in claim 25, and (4) the phrase "for rotation of said ball valve with said shaft" appearing in the last paragraph of claim 25 means that the shaft must rotate in order to rotate the ball valve, and Cornell's arm 19 does not operate in this manner.

As to (1), we simply do not agree with appellants that

opening 32 in Cornell's ball valve cannot be regarded as forming a socket. As we noted on page 5 of our decision, the word "socket" may mean "an opening into which an inserted part is

designed to fit,"² which, in our view, fairly describes the relationship between the upper end of Cornell's arm 29 and the opening 32 in the valve member 17.

Concerning (2), as we stated on page 6 of our decision, we understood appellants' argument that Cornell does not have a shaft "removably received in said socket in mating relation" as urging that Cornell does not disclose a shaft received in mating relationship with the socket. Appellants have sharpened their argument and now specifically argue that Cornell's arm is not "removable" because of the presence of the pin 31. We have carefully reconsidered our decision in light of appellants' argument but continue in our belief that the examiner did not err in rejecting claim 25 as being

² Webster's II New Riverside University Dictionary, The Riverside Publishing Company, copyright © 1984 by Houghton Mifflin Company.

anticipated by Cornell.

Cornell's valve member 17 and arm 29 are separate and distinct elements. One skilled in the art would readily understand that in assembling the arm of Cornell to the valve member, the upper end of arm 29 is initially positioned in the opening 32 of the valve member and then retained therein by pin

31. It reasonably appears that arm 29 of Cornell may be separated from the valve member while leaving both the arm and valve member fully intact by simply reversing this process, that is, by first removing the pin 31 by any appropriate means (e.g., drilling it out). In that the separation of appellants' shaft 29 from the valve member appears to require the removal of at least one element (e.g., nut 32) in order to allow for removal of the shaft, we do not regard claim 25 as being of such limited scope as to exclude an arrangement like that disclosed by Cornell where pin 31 must first be removed in order to allow for separation of the arm from the valve member.

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Regarding (3), we are unable to agree with appellants that the reception of the upper end of Cornell's arm 29 in the opening 32 in the valve member is not in the nature of a "mating relation." In this regard, we note that the dimension of the opening in the valve member and the dimension of the arm 29 closely conform to one another, as least as shown in Cornell's Figure 4.

With respect to (4), appellants are simply wrong that "by express wording, the shaft is to rotate the ball valve with *rotation* of the shaft," or that "there is an express recitation

that *it is the shaft which rotates* and, in so doing, rotates the ball valve" (request for rehearing, page 3; emphasis added). An inspection of the actual claim language in question reveals that there is no such requirement, either express or implied, that the shaft rotates. Moreover, for the reasons explained on pages 5 and 6 of our decision, we do not agree with appellants that our broader interpretation of the language appearing in the last paragraph of claim 25

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emasculates the language of claim 25, is redundant, or is illogical. Instead, the claim language appellants have chosen to employ is simply broad.³

Appellants' request for rehearing is granted to the extent of reconsidering our decision but is denied with respect to making any changes thereto.

DENIED

³In contrast, we note claim 2, which expressly calls for the shaft to be coupled to the ball valve "to effect rotation of said ball valve . . . *in response to rotation of said shaft*" (emphasis added).

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