

**THE REASONS WHY THE FEDERAL CIRCUIT REVERSED THE
ANTICIPATION REJECTIONS UNDER 35 U.S.C. §102
IN THE CASE OF *IN RE: KENNETH ANDREW HODGES***

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In the precedential case of *In re: Kenneth Andrew Hodges*, decided on February 12, 2018, the U.S. PTO Patent Trial and Appeal Board (“Board”) affirmed the Examiner’s rejections of certain claims as anticipated under 35 U.S.C. §102 based on two prior art references (namely, Rasmussen or Frantz). Discussed below are the reasons why the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) reversed the Board’s anticipation determinations.

The patent application at issue is entitled “System and Method for Operating a Drain Valve” and is directed to a valve assembly for draining contaminants, condensation, and other fluids that adversely affect the efficiency and function of a pressurized system. The claims at issue on appeal stand or fall with independent claim 1, which recites (in pertinent part) as follows:

A drain valve comprising:

- a. a **valve body**, wherein said **valve body defines an inlet seat** and a first outlet seat downstream of said inlet seat;
- * * *
- d. a **sensor** downstream of said inlet seat, wherein said sensor generates a **signal** reflective of a pressure downstream of said inlet seat.

The claimed drain valve includes a single valve body, which defines an inlet seat and an outlet seat downstream thereto; two valves; and a sensor located between the two valves for measuring fluid pressure between the valves. As highlighted above, claim 1 recites the “inlet seat” that is “define[d]” by the “valve body,” and the “sensor” that “generates a signal reflective of a pressure.”

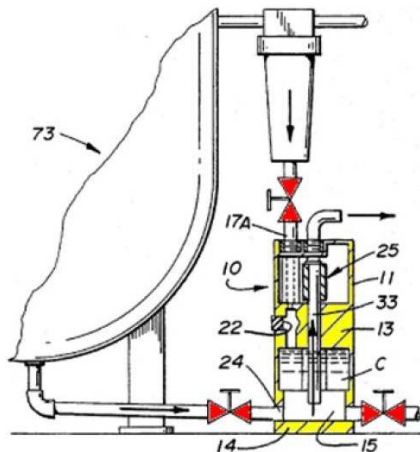


FIG. 7 of the Rasmussen Reference

The Rasmussen Reference: The Board found that Rasmussen inherently discloses the claimed inlet seat within an *unlabeled* valve depicted in Rasmussen’s FIG. 7 as shown on the previous page.

However, based on Rasmussen’s FIG. 7, the *unlabeled* valve (shown in red above inlet port 17A) sits above the housing 11 that contains the other valve components (shown in yellow). Based on such teachings in Rasmussen, the Federal Circuit held that, contrary to the Board’s position, Rasmussen’s *unlabeled* valve (relied upon by the Examiner for teaching the applicant’s claimed valve body) is not “an internal part” or “contained within” the outer casing of the drain valve, and consequently, Rasmussen’s *unlabeled* valve is outside of the outer casing of the drain valve, and cannot be part of the drain valve. Similarly, Rasmussen’s inlet seat within the *unlabeled* valve is not part of the drain valve; and therefore, the applicant’s claimed inlet seat, defined by the claimed valve body, is not taught and not anticipated under 35 U.S.C. §102 by Rasmussen.

The Frantz Reference: The Board affirmed the Examiner’s reliance on Frantz’s combined piston stem and piston head for teaching the applicant’s claimed “sensor.” The Board determined that Frantz’s piston stem and head generate a “signal,” as required by the claims on appeal, in the form of a mechanical force due to the pressure in the valve chambers. More particularly, the Board interpreted Frantz’s “movement of the needle of [a] pressure gauge in response to the sensed pressure” as meeting the applicant’s “signal” generated by the applicant’s claimed sensor.

On appeal, the Federal Circuit looked into the applicant’s specification in interpreting the terms “sensor” and “signal,” as recited in the claims. The applicant’s specification explains that: (i) the sensor may transmit the “signal to an indicator * * * to provide a visual or audible indicator of the operability of the drain valve,” and (ii) a controller can compare the “signal” to a predetermined limit and generate a control signal based on this comparison.

The Federal Circuit stated that “[d]uring examination, claim terms are given their broadest reasonable interpretation consistent with the specification as understood by those of ordinary skill in the art [citing *In re Am. Acad. of Sc. Tech. Ctr.*],” and held that, in this case, the above-described Board’s interpretation of “signal” is “unreasonably broad and inconsistent” with the applicant’s specification. In other words, Frantz’s piston stem and head combination cannot be reasonably or fairly characterized as a sensor that generates a “signal,” as in the applicant’s claims and as interpreted based on the applicant’s specification. Therefore, the anticipation rejection of the claims under 35 U.S.C. §102 based on Frantz is reversed.

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