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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NICKOLAS BERNHEART NESLAND, SR.
and MARK ALLEN CONOVER

Appeal 2020-003211
Application 14/996,322
Technology Center 2800

Before ST. JOHN COURTENAY, III, ERIC S. FRAHM, and
BETH Z. SHAW, *Administrative Patent Judges*.

FRAHM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Final Rejection of claims 1–14, 21, and 22, which constitute all pending claims on appeal.¹

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42 (2017). “The word ‘applicant’ when used in this title refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in §§ 1.43, 1.45, or 1.46.” 37 C.F.R. § 1.42(a). Appellant identifies Fluidmatics, LLC, as the real party in interest. Appeal Br. 2.

Claims 15–20 have been canceled. *See* Appeal Br. 20. An oral hearing was conducted on January 26, 2021.² We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

DISCLOSED AND CLAIMED INVENTION

Appellant’s disclosed and claimed invention concerns detecting and monitoring of contaminants in hydraulic and lubricating fluids used in various types of hydraulic control systems, machines, and motors. Because contaminants in hydraulic and lubricating fluids in hydraulic control systems, machines, and motors degrade these fluids and cause system failures and inefficiencies, Appellant recognizes that “it is desirable and often necessary to regularly test hydraulic and lubricating fluid for particle contamination.” *See* Spec. 1:9–20. Accordingly, Appellant’s disclosed invention, entitled “Hydraulic and Lubricating Fluid Contamination Sensor System” (Title), “is a method and apparatus for maintaining the rate of flow of hydraulic or lubricating fluid through a particle contamination sensor or monitor at an acceptable level.” Spec. 2:27–29, Figs. 2, 4–5. This is done by “maintaining the rate of flow at an acceptable level” to “improve[] the accuracy of information produced by the contamination by the contamination sensor or monitor.” Spec. 2:29–31.

² Appellant was represented at the oral hearing by Todd M. Oberdick, USPTO Registration No. 44,268.

Appellant claims a fluid contamination monitor system (independent claim 1) and a method of determining particle contamination of a fluid (independent claim 8), which are illustrative of the claimed subject matter:

1. A fluid contamination monitor system comprising:
 - a variable speed pump* that receives fluid whose particle contamination is to be monitored and supplies the fluid to a contamination monitor *at a controllable rate of flow*;
 - a contamination monitor that receives the fluid whose particle contamination is to be monitored from said variable speed pump, said contamination monitor generating information regarding the rate of flow of the fluid received from the variable speed pump and displaying information regarding the particle contamination of the fluid; and
 - a controller that *controls the operation of the variable speed pump so as to keep the rate of flow at a target level*.

Appeal Br. 17, Claims Appendix (emphases added).

8. A method of determining the particle contamination of a fluid, comprising the steps of:
 - controlling the rate of flow* of the fluid whose particle contamination is to be monitored *such that the rate of flow is at a target level*; and
 - monitoring the flow of fluid* whose rate is controlled and producing information regarding the particle contamination of the fluid.

Appeal Br. 18–19, Claims Appendix (emphases added).

REJECTION

The Examiner made the following rejection:

Claims 1–14, 21, and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rasor (US 2014/0233605 A1; published Aug. 21,

2014) and Juhasz (US 6,619,112 B2; issued Sept. 16, 2003). Final Act. 3–6; *see also* Ans. 3–4.

ISSUE

Based on Appellant’s arguments in the Appeal Brief (Appeal Br. 5–16), Reply Brief (Reply Br. 2–10),³ and Oral Hearing, the following principal issue is presented on appeal:

Did the Examiner err in rejecting claims 1–14, 21, and 22 under 35 U.S.C. § 103 as being unpatentable over the combination of Razor and Juhasz, because there is not proper motivation to combine Razor and Juhasz?

ANALYSIS

We have reviewed the Examiner’s rejection (*see* Final Act. 3–6) in light of Appellant’s arguments that the Examiner has erred, as well as the Examiner’s response to Appellant’s arguments in the Appeal Brief. Appeal Br. 5–16; *see also* Reply Br. 2–10; Ans. 3–4; and *generally* Oral Hearing. Appellant’s contentions that the Examiner has not provided a sufficient motivation to combine Razor and Juhasz are persuasive. We provide the following explanation for emphasis. *See* Appeal Br. 11, 13–14; *see also* Reply Br. 2–3, 5–6.

The USPTO “must examine the relevant data and articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made.” *Motor Vehicle Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983) (citations omitted); *see also Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d

³ Appellant argues claims 2–14, 21, and 22 on the same basis as claims 1 and 8. *See* Appeal Br. 5–16; *see also* Reply Br. 2–10.

1309, 1322 (Fed. Cir. 2016) (Stating that, as an administrative agency, the PTAB “must articulate logical and rational reasons for [its] decisions.”) (citations omitted).

“If all elements of a claim are found in the prior art, as is the case here, the factfinder must further consider the factual questions of whether a person of ordinary skill in the art would be motivated to combine those references.” *Dome Patent L.P. v. Lee*, 799 F.3d 1372, 1380 (Fed. Cir. 2015); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at 418; *see also Metalcraft of Mayville, Inc., v. The Toro Co.*, 848 F.3d 1358, 1367 (2017) (Fed. Cir. 2017) (“Without any explanation as to . . . why the references would be combined to arrive at the claimed invention, we are left with only hindsight bias that *KSR* warns against. [W]e cannot allow hindsight bias to be the thread that stitches together prior art patches into something that is the claimed invention.”).

Here, the Examiner has provided a motivation stemming directly from Appellant’s application, namely, to modify Rasor with Juhasz’s variable speed pump and/or method of monitoring and controlling fluid flow rate at a target level in order “to address parameters of the system changing over time, without having to keep replacing the speed pump of Rasor.” Ans. 4. In this light, we are persuaded by Appellant’s arguments that the Examiner

employed impermissible hindsight and used knowledge gleaned only from the present application that was not within the level of ordinary skill at the time the claimed invention was made. *See* Appeal Br. 13–14; *see also* Reply Br. 5–6; and *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

Based on the foregoing, we find that the Examiner has not properly established articulated reasoning with a rational underpinning to support the legal conclusion of obviousness for claims 1 and 8, resulting in a failure to establish a prima facie of obviousness. Thus, Appellant has overcome the Examiner’s prima facie case of obviousness with respect to independent claims 1 and 8. As a result, Appellant has shown the Examiner erred in rejecting claims 1–14, 21, and 22 under 35 U.S.C. § 103 as being unpatentable over the combination of Razor and Juhasz.

DECISION

For the reasons explained above, we do not sustain the rejection of claims 1–14, 21, and 22 under 35 U.S.C. § 103 as being unpatentable over the combination of Razor and Juhasz.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	References/Basis	Affirmed	Reversed
1–14, 21, 22	103	Razor, Juhasz		1–14, 21, 22

REVERSED