

REMARKS

This amendment and response are made in reply to the Office Action dated February 13, 2017, in which the Examiner:

rejected claim 1 on the grounds of nonstatutory double patenting as being unpatentable over claim 1 of co-pending Application No. 14/450,574;

rejected claims 1-8 and 10-17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 3,641,881 to Hashemi ("Hashemi");

rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,190,542 to Vickery ("Vickery");

rejected claims 1-3 and 21-22 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,675,173 to Jendrassik ("Jendrassik"); and

rejected claims 9 and 19 under 35 U.S.C. § 103(b) as being unpatentable over British Patent No. GB644,812 to Jendrassik (Jendrassik '812) in view of U.S. Publication No. 2014/0048143 to Lehner ("Lehner").

Claims 1-17, 19, 21 and 22 are pending in the application. Claims 18 and 20 were canceled in a previous response. Claims 1 and 22 are herein amended. The amendment to claim 1 finds support in dependent claim 21 and FIG. 1 of the application. New dependent claim 23 is herein added and also finds support in FIG. 1. Applicant submits that no new matter has been added. Claim 21 is herein canceled. Thus, claims 1-17, 19, 22 and 23 are presented for further consideration. Amended claim 1 is the sole independent claim.

Claim 1 stands rejected on the grounds of nonstatutory double patenting as being unpatentable over claim 1 of co-pending Application No. 14/450,574.

Applicant respectfully requests that the rejection for double patenting be held in abeyance until such time as the claims are in final form, and otherwise in condition for allowance, but for the double patenting rejection.

Claims 1-8 and 10-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hashemi.

An anticipation rejection under §102 is improper unless a single prior art reference shows or discloses each and every claim recitation. Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” (*See* MPEP § 2131).

Applicant respectfully submits that Hashemi does not show or disclose claim 1 of the present application in as complete detail as contained in the claim. For instance, Hashemi does not show or disclose “*a first front plate and a pressure shoe movably supported with respect to the drum,*” “*an outer pressure area of the wall of the pressure shoe is in fluid communication with a pressure in said port and an inner pressure area of the wall of the pressure shoe faces the drum,*” and “*the outer pressure area is larger than the inner pressure area such that a pressure in the port acting on the outer pressure area results in a force moving the pressure shoe toward the drum,*” as recited in amended claim 1.

In the Office Action, the Examiner cites Hashemi’s piston 128 as corresponding to a movably supported portion of the pressure shoe, as recited in claim 1. The Examiner also cited piston 128 as corresponding to a piston arranged in the pressure cylinder, as recited in claim 1. To the extent that the rejection of claim 1 as being anticipated by Hashemi relies on the assertion that Hashemi’s piston 128 corresponds to not only the claimed “movably supported pressure shoe,” but also the claimed “piston,” Applicant respectfully submits that the rejection of claim 1 as being anticipated by Hashemi is improper. It is improper for an Examiner to use a single structure/ element in the cited reference to disclose two separate claimed elements. (*See Ex parte Weideman*, No. 2008-003454; App. No. 10/035,334, slip op. 7 (BPAI Jan. 27, 2009) (“[I]t is improper to rely on the same structure in the Lohr reference as being responsive to two different elements ... in claim 1.”); *Ex Parte Koutsky*, Appeal No. 2008-0557, Decision on Appeal at 4 (BPAI Sep. 23, 2008) (TPK Ex. 2006) (“When a claim requires two separate elements, one element construed as having two separate functions will not suffice to meet the terms of the claim.”); *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the

three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.). Further, even assuming *arguendo* that Hashemi's piston 128 may be cited as corresponding to the claimed movably supported pressure shoe, Hashemi does not show or disclose that *“an outer pressure area of the wall of the pressure shoe is in fluid communication with a pressure in said port and an inner pressure area of the wall of the pressure shoe faces the drum,”* and *“the outer pressure area is larger than the inner pressure area such that a pressure in the port acting on the outer pressure area results in a force moving the pressure shoe toward the drum,”* as recited in amended independent claim 1.

For at least the reason stated herein, Hashemi does not anticipate amended independent claim 1. Claims 2-8 and 10-17 ultimately depend from claim 1 and include additional recitations thereto. For at least the same reasons stated in connection with independent claim 1, Hashemi also does not anticipate dependent claims 2-8 and 10-17. Therefore, Applicant requests that the rejection of claims 1-8 and 10-17 under 35 U.S.C. § 102(b) as being anticipated by Hashemi be withdrawn.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Vickery.

Applicant respectfully submits that Vickery does not show or disclose each and every recitation of amended independent claim 1. For instance Vickery does not show or disclose *“a first front plate and a pressure shoe movably supported with respect to the drum,”* *“an outer pressure area of the wall of the pressure shoe is in fluid communication with a pressure in said port and an inner pressure area of the wall of the pressure shoe faces the drum,”* and *“the outer pressure area is larger than the inner pressure area such that a pressure in the port acting on the outer pressure area results in a force moving the pressure shoe toward the drum,”* as recited in amended independent claim 1. As described in paragraphs [0007] and [0027] of the specification (*see* U.S. Publication 2015/0050163), pressure shoe 8 is movably supported, allowing pressure shoe 8 to move against drum 2.

In the Office Action, the Examiner cites Vickery's cover 49 as corresponding to the claimed pressure shoe, and Vickery's shroud 5 as corresponding to the claimed drum.

(See Office Action, p. 6). However, Vickery's Figure 1 shows that cover 49 is bolted to cylinder 43, which is integrally formed with end-plate 14. (See Vickery, col 2: ll. 55-60). End-plate 14 is further bolted to casing 12, which encloses shroud 5. (See Vickery, col 2: ll. 8-10). Therefore, Vickery's cover 49 (the alleged pressure shoe) is not movably supported with respect to shroud 5 (the alleged drum). Accordingly, Vickery does not show or disclose "*a first front plate and a pressure shoe movably supported with respect to the drum,*" "*an outer pressure area of the wall of the pressure shoe is in fluid communication with a pressure in said port and an inner pressure area of the wall of the pressure shoe faces the drum,*" and "*the outer pressure area is larger than the inner pressure area such that a pressure in the port acting on the outer pressure area results in a force moving the pressure shoe toward the drum,*" as recited in amended independent claim 1. Thus, Vickery does not anticipate amended independent claim 1. Therefore, Applicant requests that the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Vickery be withdrawn.

Claims 1-3 and 21-22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Jendrassik.

Applicant respectfully submits that Jendrassik does not show or disclose each and every recitation of amended independent claim 1. For instance Jendrassik does not show or disclose "*a first front plate and a pressure shoe movably supported with respect to the drum,*" "*an outer pressure area of the wall of the pressure shoe is in fluid communication with a pressure in said port and an inner pressure area of the wall of the pressure shoe faces the drum,*" and "*the outer pressure area is larger than the inner pressure area such that a pressure in the port acting on the outer pressure area results in a force moving the pressure shoe toward the drum,*" as recited in amended independent claim 1. As described in paragraphs [0007] and [0027] of the specification (see U.S. Publication 2015/0050163), pressure shoe 8 is movably supported, allowing pressure shoe 8 to move against drum 2.

In the Office Action, the Examiner cites Jendrassik's channel ring 17 forming channel 18 with sealing block 9 as corresponding to the claimed pressure shoe comprising a pressure cylinder with a piston. (See Office Action, p. 8). However, Jendrassik shows and describes that channel ring 17 is screwed to stator 2. (See Jendrassik, Figure 7; col. 4:

11. 33-40). Therefore, Jendrassik's channel ring 17 (the alleged pressure shoe) is not movably supported. Accordingly, Jendrassik does not show or disclose "*a first front plate and a pressure shoe movably supported with respect to the drum,*" "*an outer pressure area of the wall of the pressure shoe is in fluid communication with a pressure in said port and an inner pressure area of the wall of the pressure shoe faces the drum,*" and "*the outer pressure area is larger than the inner pressure area such that a pressure in the port acting on the outer pressure area results in a force moving the pressure shoe toward the drum,*" as recited in amended independent claim 1. Thus, Jendrassik does not anticipate amended independent claim 1. Claims 2-3 and 22 depend from claim 1 and include additional recitations thereto. For at least the same reasons stated in connection with independent claim 1, Jendrassik also does not anticipate dependent claims 2-3 and 22. Claim 21 is canceled. Therefore, Applicant requests that the rejection of claims 1-3 and 21-22 under 35 U.S.C. § 102(b) as being anticipated by Jendrassik be withdrawn.

Claims 9 and 19 stand rejected under 35 U.S.C. § 103(b) as being unpatentable over Jendrassik '812 in view of Lehner.

An obviousness rejection under 35 U.S.C. § 103(a) (pre-AIA) is improper unless the Examiner establishes a *prima facie* case of obviousness. A *prima facie* case of obviousness is not established unless the prior art references, alone or in combination, teach or suggest the claimed subject matter as a whole.

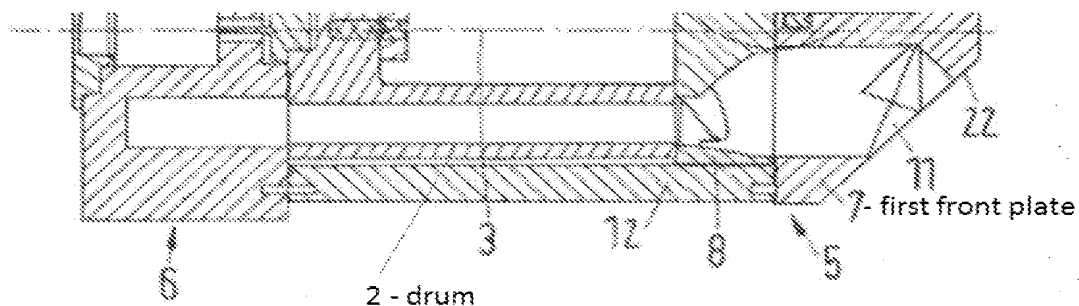
Claims 9 and 19 depend from claim 1 and include additional recitations thereto. In the Office Action, the Examiner asserts that "Jendrassik '812 discloses the limitations of claims 1-2, discussed previously." (See Office Action, page 8). However, the Examiner previously cited Jendrassik against claims 1-2, but not Jendrassik '812. Notwithstanding the Examiner deficiency in the rejection of the claims based on Jendrassik '812, Applicant herein addresses the merits of the obviousness rejection of claims 9 and 10 as being obvious over Jendrassik '812 in view of Lehner. Jendrassik '812 and Lehner, whether alone or in combination, do not teach or suggest each and every recitation of amended independent claim 1. For instance, neither Jendrassik '812 nor Lehner teaches or suggests "*a first front plate and a pressure shoe movably supported with respect to the drum,*" "*an outer pressure area of the wall of the pressure shoe is in fluid communication with a pressure in said port and an inner pressure area of the wall of the pressure shoe faces the*

drum,” and “the outer pressure area is larger than the inner pressure area such that a pressure in the port acting on the outer pressure area results in a force moving the pressure shoe toward the drum,” as recited in amended independent claim 1. Thus, even if Jendrassik '812 and Lehner were combined, the combination would still fail to teach or suggest each and every recitation of amended independent claim 1.

For at least the reasons stated herein, Jendrassik '812 and Lehner, whether alone or in combination, do not render amended claim 1 obvious. For at least the same reasons stated in connection with independent claim 1, Jendrassik '812 and Lehner also do not render dependent claims 9 and 19 obvious. Therefore, Applicant requests that the rejection of claims 9 and 19 under 35 U.S.C. § 103 as being unpatentable over Jendrassik in view of Lehner be withdrawn.

New claim 23 is patentable over Hashemi, Vickery, Jendrassik and Lehner.

Applicant respectfully submits that dependent claim 23 is not anticipated by Hashemi or Vickery or obvious over Hashemi, Vickery, Jendrassik, and Lehner. Specifically, Hashemi, Vickery, Jendrassik and Lehner do not show, disclose, teach or suggest “*wherein a wall of the pressure shoe is tapered from the drum to the first front plate.*” As shown in annotated FIG. 1 below, a wall of the pressure shoe 8 of the present application tapers from the drum 2 to the first front plate 7.



Application Annotated FIG. 1

Having addressed and/or traversed each and every rejection, Applicant respectfully requests that claims 1-17, 19, 22 and 23 be passed to issue.

Applicant believes no fees are due in connection with this amendment and response. However, if any fees are deemed necessary, authorization is granted to charge any such fees to Deposit Account No. 13-0235.

Respectfully submitted,

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