

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN T. RISSE

Appeal No. 97-0040
Application 08/303,065¹

HEARD: February 2, 1998

Before CALVERT, MEISTER and CRAWFORD, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 20, 22 to 27 and 29. Claim 21 has been cancelled, and claim 28 is indicated as allowable, if written in independent form².

¹ Application for patent filed September 8, 1994.

² On page 3 of the final rejection (Paper No. 8), the examiner stated that claim 28 also should be rewritten to overcome the rejection under 35 U.S.C. § 112, but claim 28 was not rejected on that, or any other, ground.

Appeal No. 97-0040
Application 08/303,065

The subject matter in issue concerns an apparatus for, and method of, parting-off a rotating workpiece. The claims on appeal, together with claims 21 and 28, are reproduced in the appendix to appellant's brief.

The references applied in the final rejection are:

Balmforth (British patent)	588,052	May 13, 1947
Armstrong (British patent)	2,139,529	Nov. 14, 1984

The claims on appeal stand finally rejected as follows:

- (1) Claims 1 to 18, for failing to comply with 35 U.S.C. § 112, second paragraph³;
- (2) Claims 1 to 8, 10 to 15, 17, 19, 20 and 29, as anticipated by Balmforth, under 35 U.S.C. § 102(b);
- (3) Claims 16 and 22 to 27, as unpatentable over Balmforth in view of Armstrong, under 35 U.S.C. § 103.

(1) Rejection Under 35 U.S.C. § 112, Second Paragraph

The appellant does not argue this rejection in his brief, but merely indicates his belief that the rejection would be overcome if claims 1 and 10 were amended. The rejection will therefore be sustained.

(2) Rejection Under 35 U.S.C. § 102(b)

³ The examiner did not list this rejection as one of the grounds of rejection in part (9) of the answer, but this was evidently an inadvertent omission, in view of his statement in the first sentence of part (11) of the answer.

Appeal No. 97-0040
Application 08/303,065

Claim 1, the first independent apparatus claim to which this rejection applies, reads:

1. An apparatus for parting-off a rotating workpiece, said apparatus comprising:

means for cutting the workpiece, said means for cutting forcible^[4] against the workpiece;

a rubbing pad, disposed proximately to said means for cutting, and forcible against the workpiece; and

means for substantially neutralizing in the immediate vicinity of said means for cutting and said rubbing pad reaction forces upon said means for cutting and said rubbing pad.

The examiner finds this claim to be anticipated by Balmforth in that the reference discloses a parting-off apparatus having a cutting means 6 and rubbing pad 14a, and items 1 (tool holder), 9 (bracket head), 10 (disc) and 14 (stop bar) would constitute the claimed means for substantially neutralizing reaction forces (element (c) of the claim) (Paper No. 3, page 5; answer, page 4). We do not agree.

In construing a claimed "means," the sixth paragraph of 35 U.S.C. § 112 requires that such means "be construed to cover the

⁴ The word "forcible," which means "effected by force" or "having force" (The Random House College Dictionary (1973)), appears to be used incorrectly (twice) in this claim. Appellant evidently intended to employ the word "forceable," i.e., "able to be forced," and we will so construe "forcible" here. However, the claim should be appropriately corrected in any subsequent prosecution.

Appeal No. 97-0040
Application 08/303,065

corresponding structure ... described in the specification and equivalents thereof." In re Donaldson Co., Inc., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994). In the present case, considering appellant's disclosure with respect to the "means for substantially neutralizing" recited as element (c) of claim 1, it is evident that the force neutralizing function arises from the use of a cutter and rubbing pad which are fixed to the tool body, in conjunction with the fact that the tool body is not cantilevered to the tool post (and thereby to the machine), but rather is pivotally mounted on the tool post and, through the cutter and rubbing pad, rides against the workpiece. The Balmforth patent does not disclose any such structure, nor an equivalent thereof, since the tool body 1, and therefore the cutter 6 and stop bar 14, are evidently attached to the body of the machine as a cantilever, in conventional fashion. We therefore conclude that claim 1 is not anticipated by Balmforth, and will not sustain the rejection of claim 1, nor of claims 2 and 8 dependent thereon, under § 102(b).

The first independent method claim rejected under § 102(b) is claim 10:

10. A method of parting-off a rotating workpiece comprising the steps of:

Appeal No. 97-0040
Application 08/303,065

(a) pushing a cutting means against the workpiece, thereby cutting the workpiece;

(b) disposing a rubbing pad proximately to the cutting means;

(c) permitting the rubbing pad to rub against the workpiece; and

(d) substantially neutralizing in the immediate vicinity of the cutting means and the rubbing pad the reaction forces upon the cutting means and the rubbing pad.

It is evident that Balmforth discloses steps (a), (b) and (c) of claim 10. As for step (d), it appears to be of the type governed by the sixth paragraph of § 112, i.e., a "step for performing a specified function without the recital of ... acts in support thereof," and therefore "shall be construed to cover the corresponding ... acts described in the specification and equivalents thereof." See O.I. Corp. v. Tekmar Co., 115 F.3d 1576, 1582-83, 42 USPQ2d 1777, 1781-82 (Fed. Cir. 1997). Such "acts" in the instant case would correspond to providing the structure which, as discussed above, we construed as being covered by the "means for substantially neutralizing" recited in claim 1. Since Balmforth does not provide such structure, it consequently does not disclose any such acts, or any equivalents thereof, and thus does not constitute an anticipation of claim 10.

Accordingly, we will not sustain the rejection under § 102(b) of claim 10, nor of claims 11 to 15 and 17 dependent thereon.

The other independent method claim rejected as anticipated by Balmforth is claim 19:

19. A method for cutting a workpiece rotating within a lathe, the method comprising the steps of:

- (a) providing a tool body;
- (b) providing a tool body support means;
- (c) providing a rubbing pad upon the tool body;
- (d) mounting a cutting tip upon the tool body;
- (e) pressing the cutting tip against the workpiece, thereby inducing a first reaction force upon the cutting tip;
- (f) resting the rubbing pad upon the workpiece, thereby inducing a second reaction force upon the rubbing pad; and
- (g) resisting within the tool body the first reaction force and the second reaction force, whereby transfer of the reaction forces to the tool body support means is substantially neutralized.

We will not sustain this rejection, or the rejection of dependent claim 20, because Balmforth does not disclose, either expressly or inherently, step (g) of the claimed method. While the bar 14 and cutter 6 of Balmforth would both "resist" the reaction forces on them, it appears that such forces would be transmitted through the tool body 1 to the machine, rather than

Appeal No. 97-0040
Application 08/303,065

being resisted "within the tool body," as claimed. Also, transfer of these forces to the machine ("tool body support means") would not be "substantially neutralized" as recited in step (g).

Claim 29, the other independent apparatus claim, is also not anticipated by Balmforth. This claim requires, inter alia, "said [tool] body ... being progressively insertable into the kerf," and there is no disclosure or indication in Balmforth that tool body 1 could be inserted into the kerf cut by tool 6. The rejection of claim 29 will not be sustained.

(3) Rejection Under 35 U.S.C. § 103

Claim 16 is dependent from claim 14, claim 22 depends from claim 19, and claims 23 to 27 depend from claim 22. We have not sustained the rejection of claims 14 and 19 under § 102(b) as anticipated by Balmforth for the reasons discussed above, and do not consider that Armstrong supplies the deficiencies noted with regard to Balmforth. The rejection of claims 16 and 22 to 27 under § 103 therefore will not be sustained.

Conclusion

The examiner's decision to reject claims 1 to 18 under 35 U.S.C. § 112, second paragraph, is affirmed, to reject claims 1

Appeal No. 97-0040
Application 08/303,065

to 8, 10 to 15, 17, 19, 20 and 29 under 35 U.S.C. § 102(b) is reversed, and to reject claims 16 and 22 to 27 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge))	
)	
)	
JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge))	

Appeal No. 97-0040
Application 08/303,065

Rod D. Baker
Montgomery & Andrews
P.O. Box 26927
Albuquerque, NM 87125-6927