

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TSUNEKAZU UDAGAWA

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Appeal No. 97-1250  
Application 08/347,087<sup>1</sup>

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ON BRIEF

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Before CALVERT, COHEN and McQUADE, Administrative Patent Judges.  
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal originally was taken from the final rejection of claims 1 and 3 through 11. The appellant has since canceled claim 4, amended claims 3, 5, 7 and 11, and added claim 12. The record indicates that claims 1, 3, 5, 6 and 8 through 12 currently stand rejected and that claim 7, which had been

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<sup>1</sup> Application for patent filed November 23, 1994.

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indicated as containing allowable subject matter, currently stands objected to as depending from a rejected base claim. Thus, the appeal as to claim 7 is hereby dismissed, leaving for review the standing rejections of claims 1, 3, 5, 6 and 8 through 12, the only other claims presently pending in the application.

The subject matter on appeal relates to a metal laminate cylinder head gasket. Copies of claims 1, 3, 5, 6 and 8 through 12 appear in the appendix to the appellant's brief (Paper No. 13).

The reference relied upon by the examiner as evidence of anticipation and obviousness is:

Udagawa	0,440,831	Aug. 14, 1991
(European Patent Document)		

Claims 1, 3, 5, 6, 9, 10 and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Udagawa, and claims 8 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Udagawa.<sup>2</sup>

Reference is made to the appellant's brief and to the examiner's answer for the respective positions of the appellant

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<sup>2</sup> The 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 102(b) rejections of claim 11 which were set forth in the final rejection are presumed to have been withdrawn since they have not been restated in the examiner's answer (Paper No. 14). See Ex parte Emm, 118 USPQ 180, 181 (Bd App 1957).

and the examiner with regard to the merits of these rejections.

Udagawa discloses "a steel laminate gasket for an internal combustion engine to securely seal around cylinder holes" (page 2, column 1, lines 4 through 7). Each of the gasket embodiments described by Udagawa includes holes Hc corresponding to the cylinder holes of the engine. The Figure 6 embodiment relied upon by the examiner is described as follows:

FIG. 6 shows a fourth embodiment D of a steel laminate gasket of the invention. The gasket D comprises an upper plate D10 with a curved portion D10a, a flange D10b and a bead D10c, a middle plate D11 with a bead (not shown) around the water hole Hw, and a lower plate D12, similar to the gasket B.

However, the lower plate D12 does not have a core, and instead, a core D10d is integrally formed with the flange D10b. Namely, the core D10b [sic, D10d] is formed by bending the same to be located on the flange D10c [sic, D10b]. An end D12a of the lower plate D12 is located on the core D10d. The gasket D operates as in the gasket B [page 4, column 6, lines 6 through 19].

Claims 1 and 12, the two independent claims on appeal, recite a metal laminate type cylinder head gasket comprising, inter alia, a first metal plate including a first hole corresponding to a cylinder bore, a heat preventing portion for defining the first hole and being formed at an inner end portion of the first plate, and a main sealing portion situated around the heat preventing portion and being formed of at least three

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annular portions and laminated together by bending the first metal plate outside the inner end portion.

With regard to the standing 35 U.S.C. § 102(b) rejection of these independent claims, anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

According to the examiner, Udagawa meets the foregoing limitations in claims 1 and 12 because "[i]n figure 6, Udagawa discloses a gasket as claimed. The gasket has a first metal plate having a heat preventing portion D10a, a main sealing portion (D10d, D10b, and the upper portion of the first metal plate)" (answer, third page).

The appellant, on the other hand, contends that

[i]n the present invention, the heat preventing portion is formed at the inner end portion of the first plate, and the main sealing portion is formed by bending the first metal plate outside the inner end portion. . . .

In Udagawa, however, the solid portion is formed of the flange D10b and the core D10d formed at the inner end portion, and the portion of the upper plate D10. Also, in Udagawa, the curved portion D10a which is deemed as the heat preventing portion by the Examiner is not formed at the inner end portion [brief, page 7].

Alternatively, the appellant argues that

[a]ssuming that the curved portion D10a of Udagawa is considered to be formed at the inner end portion of the upper plate, the flange D10b and the core D10d of Udagawa should be considered as a part of the inner end portion. In this case, the main sealing portion of Udagawa is formed by the flange D10b and the core D10d located in the inner end portion and a part of the plate D10 located above the core D10d. In the invention, however, the main sealing portion is formed by bending the first metal plate outside the inner end portion, not by the inner end portion. Thus, the main sealing portion of Udagawa is not formed by the first metal plate outside the inner end portion as defined in claim 1 of the invention [brief, pages 7 and 8].

The examiner's determination that the curved portion D10a on the Udagawa gasket meets the limitations in claims 1 and 12 requiring a heat preventing portion formed at an inner end portion of the first plate is well founded. During patent examination, claims are given their broadest reasonable interpretation consistent with the underlying specification without reading limitations from the specification into the claims. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Pursuant to this principle of claim construction, the words "an inner end portion of the first plate" in claims 1 and 12 are properly interpreted as referring to the

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portion of the first plate which is closest to and defines the hole in the plate corresponding to the cylinder bore of the engine. It is not disputed that the curved portion D10a on the Udagawa gasket constitutes a heat preventing portion. Since this heat preventing portion D10a comprises the portion of the plate D10 which is closest to and defines the hole Hc corresponding to the cylinder bore of the engine, it is formed at an inner end portion of the plate as recited in claims 1 and 12.

The Udagawa gasket does not meet, however, the limitations in claims 1 and 12 requiring a main sealing portion situated around the heat preventing portion and being formed of at least three annular portions and laminated together by bending the first metal plate outside the inner end portion. Even if the flange D10b, core D10d, and the overlying portion of plate D10 in the Udagawa gasket D are assumed to comprise a main sealing portion formed of at least three annular portions as submitted by the examiner, they are not laminated together by bending the plate outside the inner end portion of the first plate as recited in claims 1 and 12. More particularly, although the bend between the flange D10b and core D10d lies outside the inner end portion of Udagawa's plate D10, the bend between the flange D10b and the overlying portion of the plate D10 does not.

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Thus, the examiner's finding that the subject matter recited in independent claims 1 and 12 is anticipated by Udagawa's Figure 6 gasket embodiment is not well taken. Since this subject matter is not anticipated by any of the other gasket embodiments disclosed by Udagawa, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 1 and 12, or of claims 3, 5, 6, 9 and 10 which depend therefrom.

As for the standing 35 U.S.C. § 103 rejection of claims 8 and 11, the test for obviousness is what the teachings of the prior art would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In addition to not disclosing a gasket having a main sealing portion situated around a heat preventing portion and being formed of at least three annular portions and laminated together by bending the first metal plate outside its inner end portion as recited in independent claim 1, Udagawa would not have suggested same to one of ordinary skill in the art. Thus, we shall not sustain the standing 35 U.S.C. § 103 rejection of claims 8 and 11, which depend from claim 1, as being unpatentable over Udagawa.

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The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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IRWIN CHARLES COHEN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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