

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CORBETT NAPIER
and
SANDY NAPIER

Appeal No. 98-0007
Application 08/440,907¹

ON BRIEF

Before CALVERT, MEISTER and McQUADE, Administrative Patent
Judges.

¹ Application for patent filed May 15, 1995.

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answer, we conclude that the appealed claims are patentable over Symon, and will not sustain the rejection.

The examiner in essence takes the position that:

(1) the first eleven lines of claim 1 "recite non-substantive intended use language that has no patentable significance"

(answer, page 3); (2) the Symon device, although not disclosed as attachable to an engine, is capable of being fastened to an engine; (3) element 218 of Symon is a face plate which is "rigidly" fastened to the boom "if all bolts one [sic, are] properly tightened" (answer, page 4), and in any event it would have been obvious to fasten it rigidly; (4) any one of the elements 218 of Symon may be termed the center support recited in claim 1.

Considering the examiner's argument (4) first, the last two lines of claim 1 recite:

a center support carried by said face plate
for engaging the drive pulley of such an
engine to control positioning of such an
engine relative to the face plate.

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Even assuming that it would have been obvious to use the apparatus shown in Symon's Fig. 5 to support an engine, we do not find included therein a center support as recited. The center support is defined functionally, i.e., by what it does; this is permissible, and such functional limitation cannot be ignored. However, an element which is defined functionally may be unpatentable if the functional limitation is an inherent characteristic of the prior art. In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). Here, elements 218 are simply coplanar arms which are equidistantly located on wheel 212, and on which bars 220 are pivotally mounted (col. 9, lines 40 to 46). Assuming that 212 and 218 may be designated the "face plate" called for by claim 1, there is no teaching or suggestion in Symon that one of the arms 218 would perform, or could be modified to perform, the recited function of engaging the drive pulley of an engine which was connected to the face plate. Alternatively, it does not appear that one of the arms 218 of Symon would inherently perform the recited

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function of engaging the drive pulley of an engine connected to the face plate.

We therefore conclude that a prima facie case of obviousness has not been established.

Rejections Under 37 CFR § 1.196(b)

The following rejections are entered pursuant to the provisions of 37 CFR § 1.196(b):

(A) Claims 1 to 10 are rejected for failure to comply with the provisions of the second paragraph of 35 U.S.C. § 112.

Claim 1, lines 8 and 9, recites "a flange protruding outwardly from the engine block for driving a fan blade." Although this language was present in original claim 1 and is found on page 4, lines 13 and 14 of the specification, no such flange

driving a fan blade is shown in the drawings,³ nor described in the detailed description on pages 5 to 9. Moreover, it is not clear what is meant by a flange driving a fan blade. In view of the lack of disclosure, one of ordinary skill in the

³ See 37 CFR § 1.83(a).

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art attempting to read the claims in light of the specification could not determine their scope with any reasonable degree of precision. Cf. In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971).

(B) Claim 6 is rejected for failure to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.

Claim 6 recites that "said face plate defines a load bearing surface area to engage with such a flange protruding outwardly from the engine block." As discussed above in rejection (A), there is no detailed description in the specification of the recited "flange," and thus there is no disclosure which would enable one of ordinary skill to provide a load bearing surface on the face plate to engage the flange. The only disclosure of any relevance would seem to be on page 8, lines 9 to 12, where it is stated that the fan blade assembly can be removed and the mounting studs of the fan blade assembly can abut the confronting surface of the face plate, but there is nothing in this

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disclosure about a flange (for driving a fan blade) engaging the face plate, as recited in claim 6.

Conclusion

The examiner's decision to reject claims 1 to 10 is reversed. Claims 1 to 10 are rejected pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered

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by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). REVERSED 37 CFR § 1.196(b)

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