

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RUEBEN B. WARNER and JOSEPH P. GASER

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Appeal No. 1998-2833  
Application No. 08/585,403

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ON BRIEF

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Before, and COHEN, CRAWFORD and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 19 and 36 through 39. Claims 20 through 35 have been canceled. In an advisory action mailed February 10, 1998, the examiner has indicated that claims 1 through 9, 36 and 37 are allowed. Additionally, on page 2 of the answer, the examiner has allowed claims 38 and 39 and

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indicated

that claims 11 through 18 are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, the appeal as to claims 1 through 9, 11 through 18 and 36 through 39 is dismissed, leaving claims 10 and 19 for our consideration.

We REVERSE.

The invention relates to a honing tool having a holder, a bundle of monofilaments extending a short distance from the holder with the tips of the monofilaments forming the working face of the tool and the entire bundle being infused with and encapsulated in a matrix of an elastomer (specification, page 4). The claims on appeal are reproduced below:

10. A honing tool comprising a holder, a compact bundle of abrasive containing monofilaments projecting a short distance from the holder with the tips of the monofilaments forming the working face of the tool, the interstices between said monofilaments being substantially completely filled with a foamed elastomer providing increased lateral stability to the projecting portion of the monofilaments of the bundle and

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maintaining the abrasive tips in relation to each other as the abrasive working face of the honing tool.

19. A honing tool as set forth in claim 10 including a layer of adhesive securing the bundle to the bottom of said holder.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Scheider et al. 1993 (Scheider '847)	5,216,847	Jun. 08,
Scheider et al. 1994 (Scheider '603)	5,318,603	Jun. 07,

Claims 10 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheider '603 or Scheider '847.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 13, mailed 3/26/98) for the examiner's complete reasoning in support of the rejection, and to the main brief (Paper No. 12, filed 3/9/98) and the reply brief (Paper No. 14, filed

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5/12/98) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the

examiner. As a consequence of our review, we conclude that the rejection cannot be sustained.

Both Scheider '603 and Scheider '847 disclose a honing tool comprising a relatively short bundle 40 of plastic abrasive loaded monofilaments and a rectangular cup element 42 which is an integral part of a holder 44. The bundles 40 are bonded to the bottom surface or wall 45 of the cup element 42 by a layer of adhesive 46, e.g., a cyanoacrylate adhesive. See, e.g., Scheider '847 at col. 1, line 63 through col. 2, line 4; col. 3, line 25-31; col. 4, lines 9-13; and col. 6, lines 16-24.

It is the examiner's position (answer, pages 4 and 5) that the adhesive layer 46 taught by the references

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substantially completely fills the lower interstices of the bundle 40 and, thus, that each reference discloses the claimed invention, except for the specific filling material, e.g., foamed elastomer. This difference in materials is deemed by the examiner to be a matter of design choice, citing In re Leshin, 277 F.2d 197, 125 USPQ 416 (CCPA 1960).

Appellant, on the other hand, argues that the references lack teachings or suggestions that the interstices between the monofilaments are "substantially completely filled" with adhesive 46, much less completely filled with foamed elastomer as required by claim 10. Further, appellants argue that the monofilament tips that are in contact with the adhesive layer 46 in both references are at the wrong end of the bundle and, thus, the adhesive layer 46 does not perform the functions of the foamed elastomer filling recited in claim 10, namely, "providing increased lateral stability to the projecting

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portion of the monofilaments of the bundle and maintaining the abrasive tips in relation to each other as the abrasive working face of the honing tool" (underlining added for emphasis). As to claim 19, the appellants argue that if the teachings of the references were modified by substituting foamed elastomer for the cyanoacrylate adhesive, the resulting structure would lack the "layer of adhesive" called for in claim 19.

We do not agree with the examiner's position. While it is well settled that the claims in a patent application are to be given their broadest reasonable interpretation during prosecution

of a patent application, this interpretation, in addition to being reasonable, must also be consistent with the specification

(see, e.g., In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320,

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(Fed. Cir. 1989)). Here, the appellants' specification does not mention "substantially completely fills" but, instead, teaches that "[t]he projecting portion of the bundle [i.e., the portion of the bundle extending without the holder] is preferably enclosed in a mold during injection so that the bundle to the tip work face is infused and encapsulated by the elastomer" (page 5) and that the injection of the elastomer into the bundle "may be 4at significant pressure and infuses the elastomer matrix bond into all of the interstices of the bundle" (page 8). Accord-ingly, we conclude that the term "completely fills" means complete filling of all of the interstices in the bundle from the bottom of the cup holder to the working face tips and that while the modifier "substantially" broadens the term to some degree, it is well settled that such a modifier cannot be allowed to negate the meaning of the term which it modifies. See, e.g., Arvin

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Industries, Inc. v. Berns Air King Corp., 525 F.2d 182, 185,  
188 USPQ 49, 51 (7th Cir. 1975).

When viewed in this context, we are satisfied that the recitation of "substantially completely filled" in independent claim 10 would have been viewed by the person of ordinary skill in this art to merely allow for a reasonable and minor deviation in completely filling all of the interstices in the bundle from the bottom of the cup holder to the working face tips with the foam elastomer.

In order to establish the prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Like appellants, we are unable to find where in the references it is either taught or suggested that the adhesive 46 "substantially completely" fills the interstices between the monofilaments. Since all the claim limitations are not taught or suggested by the applied prior art, the examiner has failed to establish a prima facie case for the

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obviousness of independent 10 and the rejection of that claim cannot be sustained.

Claim 19 is dependent on claim 10 and contains all of the limitations of its parent claim. Therefore, we will also not sustain the standing 35 U.S.C. § 103(a) rejection of claim 19.

CONCLUSION

To summarize, the rejection of claims 10 and 19 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
MURRIEL E. CRAWFORD	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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