

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER RUNGE, GERALD BOHM,
ARNO HAMAEEKERS and ANDREAS OLBRICH

Appeal No. 99-0638
Application No. 08/679,023¹

ON BRIEF

Before MEISTER, FRANKFORT, and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

¹ Application for patent filed July 12, 1996. According to the appellants, the application is a continuation of Application 08/326,445, filed October 20, 1994, now abandoned.

Appeal No. 99-0638
Application No. 08/679,023

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 5, 6 and 8 through 17, which are all of the claims pending in this application.²

We REVERSE.

² Claims 3, 4 and 7 have been canceled.

BACKGROUND

The appellants' invention relates to a vibration canceler on a shaft, the vibration canceler comprising at least two half-shells (2) having at least one elastic element (3) deformable in a circumferential direction, at least two inertial masses (4) and a fastening apparatus (5, 7) joining the inertial masses to one another. The fastening apparatus of the invention comprises at least one link element (5) and a lock element (7). A further understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:³

Hladky et al. (Hladky)	5,069,054	Dec. 3, 1991
Smith	5,193,432	Mar. 16, 1993
Wolf et al. (Wolf)	5,328,408	Jul. 12, 1994

(filed June 30, 1992)

³ Although not expressly relied upon by the examiner, we note the appellants' admitted prior art discussed in the last paragraph on page 1 of the appellants' specification, which appears to show that a vibration canceler as claimed is known, except for the particular fastening arrangements claimed. In the event of further prosecution, the examiner may want to consider whether the claims are unpatentable over this admitted prior art in combination with Hladky and/or other prior art.

The following rejections are before us for review.

Claims 1, 2, 5, 6 and 12 through 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wolf in view of Hladky.

Claims 8 through 11, 16 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wolf in view of Hladky as applied to claims 1, 2, 5, 6 and 12 through 15 above, and further in view of Smith.⁴

The complete text of the examiner's rejections and response to the argument presented by the appellants appears in the answer (Paper No. 21, mailed March 2, 1998), while the complete statement of the appellants' argument can be found in the brief (Paper No. 20, filed December 8, 1997).

OPINION

⁴ It is noted that the statement of the rejection of claim 17 in the final rejection (Paper No. 17) indicated that claim 17 is "unpatentable over Hladky et al. in view of Wolf et al. as applied to claims 1, 2, 5, 6 and 12-15 above, and further in view of Smith." From a review of the record, however, it is readily apparent that the intended combination was Wolf in view of Hladky, and further in view of Smith, as indicated on page 5 of the answer. The appellants apparently are not prejudiced by this interpretation since it is clear from the brief that the appellants also understood this to be the rejection intended (brief, page 7).

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 make the determinations which follow.

Regarding the rejection of claims 1, 2, 5, 6 and 12 through 15 under 35 U.S.C. § 103, the examiner expressly concedes that the vibration canceler of Wolf is not in at least two pieces (answer, page 4). In rejecting the claims, the examiner states that it would have been obvious to one of ordinary skill in the art at the time of the appellants' invention to make the vibration canceler of Wolf of at least two pieces as taught by Hladky "so that it would be easier to assemble the vibration canceler on the shaft" (answer, page 4).

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed

invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Here, the prior art contains no such teaching or suggestion. Hladky teaches a two-piece hinged clamping device for providing a quick change attachment of two shafts together in the context of replacing a working roll assembly in a rolling mill. In view of the disparate nature of Hladky vis-à-vis the vibration cancelor of Wolf, we are at a loss to understand why one of ordinary skill in the art would have been motivated to combine these two references in the manner proposed by the examiner.

Therefore, it is our opinions that the reference combination proposed by the examiner stems only from an impermissible hindsight reconstruction of the appellants' invention wherein the examiner has used the claims as a template to selectively piece together isolated disclosures in the prior art. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Accordingly, we cannot sustain the standing rejection of claims 1, 2, 5, 6 and 12 through 15 under 35 U.S.C. § 103.

We have reviewed the teachings of Smith, but find nothing therein which alters our view with regard to the basic combination of Wolf and Hladky. Accordingly, we must likewise reverse the standing rejection of claims 8 through 11, 16 and 17 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 5, 6 and 8 through 17 under 35 U.S.C. § 103 is REVERSED.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JENNIFER BAHR)	
Administrative Patent Judge)	

Appeal No. 99-0638
Application No. 08/679,023

Page 9

JB/caw

Appeal No. 99-0638
Application No. 08/679,023

Page 10

Kenyon & Kenyon
One Broadway
New York, NY 10004

Art Unit 3600 - OB/HD

APPEAL NO. 99-0638 - JUDGE BAHR
APPLICATION NO. 08/679,023

APJ BAHR

APJ MEISTER

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Carolyn Whitfield

DRAFT TYPED: 07 Dec 99

FINAL TYPED: 20 May 99