

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 MARK E. PALUSIS, CARLOS G. FIGUEROA,
DANIEL C. FRIEDBERG, GARY D. JONES and GUNTHER
EICHHORN

Appeal No. 99-0650
Application 08/726,978¹

ON BRIEF

Before ABRAMS, STAAB, and McQUADE, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the rejection of claims 1-3, 7 and 8, which claims have been twice rejected by the

¹ Application for patent filed October 7, 1996. According to appellants, the application is a division of Application 08/360,937, December 21, 1994, now U.S. Patent no. 5,592,814, issued January 14, 1997.

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examiner. Claims 4-6, the only other claims remaining in the application, have been indicated by the examiner as being allowable if rewritten in independent form to include all the limitations of base claim 1 and any intervening claim.

Appellants' invention pertains to a fastener for insertion through aligned holes in two composite sheets to hold the sheets together. Independent claim 8, a copy of which can be found in an appendix to appellants' brief, is illustrative of the appealed subject matter.

The references relied upon by the examiner in support of rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 are:

Cramer Jr. et al (Cramer) 1988	4,790,683	Dec. 13,
K.A.C. Limited ² 1958	1,167,899	Dec. 2,

Claims 1-3 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by French '899.

²Our understanding of this French language reference is derived from a translation thereof submitted by appellants during prosecution of the instant application. As indicated by the translation, this patent appears to have been filed in the French Patent Office on behalf of the inventor by K.A.C. Limited. In order to avoid confusion as to the reference intended, we will continue to use the designation French '899 used by the examiner in referring to this reference.

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Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over French '899 in view of Cramer.

The rejections are explained in the second office action (Paper No. 9) and the examiner's answer (Paper No. 17).

The opposing viewpoints of appellants are set forth in the brief (Paper No. 15).

Considering first the § 102 rejection of claims 1-3 and 8, anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. *See In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on"

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something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

Appellants disclose several embodiments of the claimed invention. Each embodiment includes a bolt having a shank portion and a head, a journal bearing for insertion into the bore of the composite sheets, resilient means between the shank portion of the bolt and the bore, and a nut on the bolt for compressing the composite sheets between the head of the bolt and the nut.

Independent claim 1 is directed to the Figures 2 and 4 embodiment of appellants' invention and calls for resilient means in the form of "a plurality of *circumferentially disposed* hollow resilient springs supporting the bolt mounted between said journal and said shank portion" (emphasis added). According to appellants' disclosure, these springs comprise "a plurality of hollow, thin-walled, springs 28 (bearing tubes) radially support[ing] the bolt 20" (specification, page 6). Figure 4 shows these hollow tubes 28 disposed in a

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circumferential array for placement about the shank portion of the bolt. The examiner contends that the springs 4 and 19 of French '899 respond to this claim limitation; however, we do not agree. From our perspective, the examiner's position constitutes an improper and strained reading of the claim language, especially when that language read in light of appellant's disclosure. While springs 5 and 19 of French '899 certainly constitute a plurality of springs, they are not collectively circumferentially disposed about the shank portion of the bolt. Rather, they are axially disposed along the shank. In light of the above, we will not sustain the standing § 102 rejection of claim 1 as being anticipated by French '899.

Independent claim 2 is directed to the Figure 3 embodiment of appellants' invention and calls for resilient means in the form of "a *plurality* of[] resilient *annular* springs *in a stack* that extends between the ends of the journal" (emphasis added). According to appellants' disclosure, "[t]hese springs 42, appearing as small, hollow, metal o-rings, are actually made of a tightly wound helical

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spring that is formed to be circular in plan and cross section (as shown)" (specification, page 7). As with the examiner's position with respect to the resilient means limitation of claim 1, the examiner contention here that the springs 4 and/or 19 of French '899 respond to the resilient means limitation of claim 2 once again is based on an improper and strained reading to the claim language in question. In our view, one of ordinary skill in the art would not consider the axially spaced helical springs 4 and/or 19 of French '899 as corresponding to the requirement of claim 2 that the springs comprise a plurality of resilient annular spring arranged in a stack, especially when appellants' claim language is read in light of the underlying specification. Accordingly, we will not sustain the standing § 102 rejection of claim 2, or claim 3 that depends therefrom, as being anticipated by French '899.

We reach an opposite conclusion with respect to the anticipation rejection of claim 8, which more broadly claims the resilient means. French '899 discloses a composite structure comprising two sheets 9, 23 held together by a fastener inserted through a bore in each sheet, with the

fastener comprising a bolt 1 having a shank portion 3 and a head 2. The French '899 device further includes a journal bearing 5 inserted into the bore in each sheet for receiving the bolt, resilient means, in the form of a helical spring 4, mounted between the shank portion and the journal bearing for resiliently supporting the bolt in the journal bearing, and a nut 13 on the bolt. The spring 4 transversely supports the bolt, at least to some extent. The nut 13 compresses the sheets between the nut and the head, with the tapered portion of the head 2 bearing against a complementary surface on the journal bearing. Based on the above, we consider that claim 8 "reads on" the French '899 device. It follows that we simply do not agree with appellants' argument on pages 6-7 of the brief that French '899 does not disclose (1) a nut for compressing the sheets between the nut and the head against the journal bearing, or (2) a journal bearing as claimed.³ In

³ With respect to the requirement of claim 8 that the means for resiliently supporting the bolt is constructed of metal, we note that appellants have not argued this limitation as a distinction over the applied reference. Thus, it will be assumed that this limitation is met by French '899. *Cf. In re Baxter Travenol Labs*, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to

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light of the foregoing, we will sustain the standing § 102 rejection of claim 8 as being anticipated by French '899.

Independent claim 7 is directed to the Figure 5 embodiment of appellants' invention and calls for resilient means in the form of "a wave spring . . . for supporting the bolt." The examiner acknowledges that French '899 lacks a wave spring, but has taken the position that "Cramer teaches the use of a wave spring 10 in a joint for the purpose of providing a device for absorbing differences in tolerance between a shaft and an opening" (second office action, page 3). Based on these teachings, the examiner concludes that it would have been obvious "to modify the device of French '899 as taught by Cramer for the purpose of absorbing differences in tolerance between the shaft and an opening" (second office action, page 3).

Initially, it is not clear to us precisely how the examiner proposes to modify the device of French '899 in view of Cramer. Specifically, it is not clear whether the examiner

examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); *In re Wiseman*, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (arguments must first be presented to the Board).

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proposes to *add* one or more wave springs to the French '899 device at, for example, the location(s) of the helical coil springs 4 and/or 19, or whether the examiner proposes to *replace* one or more of the springs 4 and 19 of the French '899 device with wave springs. In any event, regardless of the intended modification, the examiner's position is not well taken.

The structure of Cramer that the examiner refers to as a wave spring is actually a tolerance ring 10 comprising a spring steel cylinder 14 having corrugations 16. The Cramer device is intended to compensate for *radial* play between inner cylindrical member 18 and the hole 20 in a surrounding structure. It would not have been obvious to the ordinarily skilled artisan to *replace* either of the helical coil springs of French '899 with a tolerance ring of the type taught by Cramer because Cramer's tolerance ring would not be capable of providing the axial biasing forces French '899 intends the springs to provide. See *Ex parte Rosenfeld*, 130 USPQ 113, 115 (Bd. App. 1961) (modification that renders apparatus unsuitable for its intended purpose cannot be said to have

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been obvious to one of ordinary skill in the art). Likewise, the *addition* of one or more tolerance rings to the French '899 device at the location called for by claim 7 would not have been obvious because the added elements would not appear to serve any useful purpose in the French '899 device. In this regard, based on the teaching of the applied references alone, and without the benefit of hindsight knowledge acquired by first reading appellants' disclosure, there is no cogent reason for compensating for radial play between the various components of the French '899 device. We therefore will not sustain the standing § 103 rejection of claim 7.

Summary

The rejection of claims 1-3 and 8 as being anticipated by French '899 is reversed as to claims 1-3, but is affirmed as to claim 8.

The rejection of claim 7 as being unpatentable over French '899 in view of Cramer is reversed.

The decision of the examiner is affirmed-in-part.

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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

Neal E. Abrams)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
Lawrence J. Staab)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
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