

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HAROLD W. SEEDS

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Appeal No. 1999-1489  
Application No. 08/691,193

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ON BRIEF  
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Before CALVERT, MCQUADE, and BAHR, Administrative Patent Judges.  
CALVERT, Administrative Patent Judge.

This is an appeal from the final rejection of claims 1 to 13, all the claims in the application.

The claims on appeal are drawn to a method of dynamically balancing a driveshaft assembly (claims 1 to 10) and a dynamically balanced driveshaft assembly (claims 11 to 13), and are reproduced in the appendix of appellant's brief.

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The reference applied in the final rejection is:

Kosik (German Application)                      3140368                      Jan. 5, 1983<sup>1</sup>

A prior art publication cited herein is:

Welding Handbook, Sec. 3A, pp. 50.3 to 50.6, 50.11 to 50.14 and  
50.30 to 50.33 (Am. Welding Socy. 1970) TS227.A5h

The appealed claims stand finally rejected as follows:

- (1) Claim 7, unpatentable for failure to comply with 35 U.S.C. § 112, second paragraph;
- (2) Claim 11, anticipated by Kosik, under 35 U.S.C. § 102(b);
- (3) Claims 1 to 10, 12 and 13, unpatentable over Kosik, under 35 U.S.C. § 103(a).<sup>2</sup>

Rejection (1)

Claim 7 reads:

7. The method as defined in claim 5 wherein the plate is

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<sup>1</sup>Our understanding of this reference is based on a translation prepared by the PTO, a copy of which is forwarded herewith to appellant. References in this decision to Kosik by page and line are to this translation.

<sup>2</sup>In the final rejection and examiner's answer, the examiner stated that claims "1-10, 11 and 12" were rejected on this ground, but it is evident from her subsequent discussion (e.g., on page 4 of the final rejection) that claims 1 to 10, 12 and 13 were intended, and appellant has included claim 13 in his argument of the rejection.

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made of steel or aluminum.

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The examiner finds this to be indefinite because (answer, page 3):

On line 2, the use of the alternative "or" is improper. If appellant wishes to claim alternatives they must be art recognized equivalents and in Markush form.

We will not sustain this rejection. The test for compliance with the second paragraph of § 112 is "whether a claim reasonably apprises those of skill in the art of its scope." In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). We have no doubt that one of ordinary skill would know precisely what the scope of claim 7 is.

We should add that use of the word "or" in a claim does not automatically render the claim indefinite, as the examiner seems to assume. See MPEP § 2173.05(h), part II (July 1998)("Alternative expressions using 'or' are acceptable, such as 'wherein R is A,B,C, or D.'")

Accordingly, rejection (1) will not be sustained.

Rejection (2)

Before considering the merits of this rejection, we note that at pages 5 and 6 of the brief appellant argues that the

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rejections of the claims over Kosik were not in compliance with 35 U.S.C.

§ 132 because appellant was not furnished with an English translation of Kosik's German text, and thus could not judge the propriety of continuing prosecution of the application.

Under 35 U.S.C. § 7(b), this Board's jurisdiction with respect to ex parte appeals under 35 U.S.C. § 134 is limited to reviewing adverse decisions of examiners which relate, at least indirectly, to matters involving the rejection of claims, i.e., to reviewing actions of examiners which in fact amount to a rejection of claims. See In re Haas, 486 F.2d 1053, 1056, 179 USPQ 623, 624-26 (CCPA 1973). In the present case, appellant's argument does not concern a matter which was the basis for the rejection of any claims, but rather questions the propriety of the PTO's long-established practice of not routinely providing a translation of a cited foreign-language reference. This is a procedural matter which we have no jurisdiction to consider; instead, it should properly be raised by way of a petition to the Commissioner under 37 CFR 1.181. Appellant's argument can therefore be given no consideration by us.

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Turning to the merits of rejection (2), Kosik discloses a balanced driveshaft comprising a tubular metal driveshaft (propeller shaft) 1, a plate 3 engaging the exterior of the driveshaft with a hole 4 through the plate and a metal stud 5 in

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the hole. The only limitation of claim 11 not expressly disclosed by Kosik is that the stud is "friction welded" to the exterior of the driveshaft; rather, Kosik discloses that the stud (pin) is welded to the exterior of the shaft by "fusion welding" (page 4, line 8), an especially suitable welding method being "the MIG [gas shielded arc] welding method" (page 3, lines 6 and 7).

From the argument on page 7 of the brief, appellant seems to be of the opinion that Kosik's non-disclosure of friction welding is dispositive of the § 102(b) rejection. However, implicit in the examiner's rejection of claim 11 is a finding that, notwithstanding the fact that Kosik does not disclose friction welding, the structure defined by claim 11 would not differ from that disclosed by Kosik. Since claim 11 is not drawn to a process which includes friction welding, but rather to the product of such a process, the claim is anticipated if the product defined therein is the same as the prior art product, even though made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). Since the Kosik apparatus is similar to that recited in claim 11 in that stud 5 is welded to the exterior of driveshaft 1, a prima

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facie case of anticipation has been made out, and the burden  
shifts

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to appellant to prove that the fusion welded product of Kosik does not necessarily or inherently possess the characteristics of his claimed friction welded product. Id. No such proof has been presented.

Rejection (2) will therefore be affirmed.

Rejection (3)

We will first consider claims 12 and 13:

12. The dynamically balanced driveshaft assembly as defined in claim 11 wherein the tubular driveshaft and the stud are aluminum.

13. The dynamically balanced driveshaft assembly as defined in claim 12 wherein the metal plate is steel.

Kosik discloses the limitations recited in these claims, i.e., an aluminum driveshaft (page 4, line 4) and stud (page 3, line 5), and steel plates (page 4, line 5). Accordingly, as discussed above, Kosik prima facie meets all the limitations of claims 12 and 13, and rejection (3) will be sustained as to them. While this is tantamount to a holding that claims 12 and 13 are anticipated, sustaining of the § 103 rejection is proper since "The complete disclosure of an invention in the prior art is the ultimate or epitome of obviousness." In re Avery, 518 F.2d 1228, 1234, 186 USPQ 161, 166 (CCPA 1975).

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As for claim 1, the examiner states the basis of the rejection as follows (answer, pages 4 and 5):

[F]riction welding is the creation of friction between two elements until pieces are heated to a point that allows plastic flow of the metals and then the pieces are pressed together so as to plastically deform the metals. Friction welding is recognized as being a simple and highly efficient method of attaching similar and nonsimilar [sic] metals. The "melting" welding of Kosik is not specific as to which type of welding is used to join the drive shaft and stud. Using friction welding would be efficient since it is well recognized as a simple and highly efficient method of attaching similar and nonsimilar [sic] metals. It would have been obvious for one of ordinary skill at the time the invention was made to attach the stud of Kosik to the drive shaft by friction welding since friction welding is well recognized as a simple and highly efficient method of attaching similar and nonsimilar [sic] metals.

It is fundamental that "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260,

1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). A rejection based on § 103 must rest on a factual basis, which the PTO has the duty of supplying, and these facts must be interpreted without hindsight reconstruction of the invention from the prior

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art. In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123  
(Fed. Cir. 1995). In the present case, the examiner asserts  
that friction

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welding is recognized as being a highly efficient method of attaching metals, but has adduced no evidence of such recognition by those of ordinary skill in the art. Cf. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). As appellant succinctly states on page 8 of the brief:

The mere fact that a particular welding step, per se is known, does not make every method that includes that particular welding step obvious.

Although friction welding is of course known, the record is devoid of any evidence of a suggestion, teaching or motivation which would have led one of ordinary skill to use friction welding instead of fusion welding (particularly MIG welding) in Kosik's disclosed process. Absent such evidence, it appears that any such modification of Kosik would be based on improper hindsight gleaned from appellant's own disclosure.

We, therefore, will not sustain the rejection of claim 1, nor of independent claim 8, as to which the applied prior art is similarly deficient. The rejection of dependent claims 2 to 7, 9 and 10 will likewise not be sustained. Moreover, the rejection of claims 4 and 5, which call for insertion of the stud into the hole in the plate after the stud is welded to the driveshaft, will not

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be sustained for the additional reason that we do not find any disclosure or teaching of such a process in Kosik.

Remand to the Examiner

As discussed above, we have not sustained the § 103 rejection of claims 1 to 10 because the examiner presented no evidence of a suggestion, teaching or motivation to use friction welding. However, it appears that such evidence may be available in the prior art. For example, on page 50.3 of the Welding Handbook, the last paragraph lists some advantages of friction welding in relation to other welding processes. Also, on several pages there is a disclosure of the use of friction welding to join aluminum parts, and Table 50.2 (page 50.13) even mentions aluminum 6061 alloy. Accordingly, the application is remanded to the examiner pursuant to 37 CFR 1.196(e) to determine whether at least claims 1 to 3 and 6 to 10 should be rejected under 35 U.S.C. § 103 as unpatentable over Kosik in view of the Welding Handbook and/or other prior art which may provide the evidence we have found to be lacking in this case.

Conclusion

The examiner's decision to reject claim 7 under 35 U.S.C. § 112, second paragraph, is reversed; to reject claim 11 under

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35 U.S.C. § 102(b) is affirmed; and to reject claims 1 to 10, 12 and 13 under 35 U.S.C. § 103 is reversed as to claims 1 to 10 and affirmed as to claims 12 and 13. The application is remanded to the examiner pursuant to 37 CFR 1.196(e).

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

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. MCQUADE	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
JENNIFER D. BAHR	)	
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