

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENICHI HATTORI

Appeal No. 1999-1721
Application No. 08/734,125

HEARD: January 27, 2000

Before ABRAMS, McQUADE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 2, 3, 6-8, 35 and 37. Claims 5 and 9-33 stand withdrawn from further consideration under 37 CFR § 1.142(b) as being directed to a non-elected species and claims 36 and 38 stand objected to as being dependent upon a rejected claim. No other claims are pending in this application. We affirm-in-part and enter a new ground of rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a ball holder for use with a retainerless linear motion bearing and a rail, the bearing including a bearing body forming a saddle and a plurality of steel balls. Appellant's ball holder is used only when the bearing body is withdrawn from the rail to retain the steel balls within the bearing body so as to prevent them from falling off upon withdrawal of the bearing body from the rail (specification, page 2).

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

Hara	5,362,156	Nov. 8, 1994
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Appellant's admitted prior art on page 1 of the specification (AAPA)

The following rejections are before us for review.

1. Claims 2, 3, 6, 7, 35 and 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hara.¹
2. Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hara, as applied above, and further in view of AAPA.²

¹ In view of the examiner's comments on pages 2 and 3 of the answer (Paper No. 34) in the Status of Claims and Issues sections it is apparent to us that the examiner has withdrawn this rejection as to claims 36 and 38 and that the examiner's inclusion of claim 38 in the statement of this rejection on page 3 of the answer was an inadvertent error.

² Although this rejection is not reproduced in the Grounds of Rejection section of the answer, it is apparent from the brief as a whole, especially the comments in the Status of Claims section on page 3 and in the Response to Arguments section on page 5, that the examiner has not withdrawn this rejection.

Reference is made to the brief (Paper No. 33) and the answer (Paper No. 34) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 2, the only independent claim on appeal, reads as follows:

2. A ball holder for a retainerless saddle having a bearing body and a pair of end caps attached thereto, said ball holder to be used when the retainerless saddle is taken out of a rail, the retainerless saddle having a recess, the retainerless saddle to be assembled with the rail with a plurality of preloaded steel balls therebetween when said retainerless saddle is slid onto said rail to form a preloaded retainerless linear motion bearing assembly, said ball holder comprising:

an elongated shaft portion independent of the retainerless saddle and to be positioned within the recess of the retainerless saddle only when the retainerless saddle is taken out of the rail, the elongated shaft portion also being independent from the rail,

wherein said elongated shaft portion includes a plurality of ball holding means for directly holding the steel balls and for preventing said steel balls from falling off when the retainerless saddle is taken out of said rail, wherein the plurality of ball holding means comprises a circumferential surface of the elongated shaft portion along the axis thereof and are separate from the retainerless saddle, each of said ball holding means being positioned adjacent to each of grooves provided within the bearing body, such that each of said ball

holding means and each of said grooves of the bearing body form an independent raceway, wherein the positions of the ball holding means of said ball holder is substantially identical to that of the positions of grooves of a track shaft part of the rail, the ball holder is used only when the retainerless saddle is taken out of the rail to maintain the balls between the ball holder and the retainerless saddle and is moved out of the retainerless saddle when said saddle is inserted onto the rail to form a preloaded linear bearing assembly.

Anticipation under 35 U.S.C. § 102 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 RCA Corp. V. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

The examiner's position is that the track rail (2) of Hara anticipates the ball holder of claim 2. We observe that the track rail (2) of Hara comprises an elongated shaft portion, best shown in Figure 1, and two raceway grooves (5). The disclosed use of Hara's rails is as track rails on which equipment placed on a slide table (4) secured to a pair of sliders (1) is moved forward and backward. Each of the sliders (1) consists of a casing (3) having casing raceway grooves (9) formed in positions facing the raceway grooves (5) of the rails to define a raceway in which rolling elements or balls (7) are confined. A ball retaining band (18), best seen in Figure 5, is provided to prevent the balls from coming off the casing (column 7, lines 6-8).

Appellant concedes that Hara's rail "holds balls in position" but argues that it does not anticipate appellant's claim 2 because the ball holding means of Hara are part of Hara's rail and not a part of an elongated shaft portion which is "independent from the rail" as required

by claim 2 (brief, page 8). Appellant further argues that "a rail and an elongated shaft portion, which includes the claimed plurality of ball holding means, are set forth in claim 2 on appeal as two separate elements" (brief, page 9).

We hasten to point out that appellant's claim 2 does not, as appellant suggests, positively recite both a rail and an elongated shaft portion. Rather, appellant's claim 2 is directed only to a ball holder "for" a retainerless saddle and "to be used" when the retainerless saddle is taken out of a rail. From our viewpoint, the rail (2) of Hara possesses all of the structural limitations of appellant's claim 2 and reasonably appears to be fully capable of functioning in the manner called for in claim 2 (i.e., for positioning within the recess of a retainerless saddle, only when the saddle is taken out of a second rail, independent from the disclosed rail, to prevent steel balls from falling off the saddle when the saddle is slid off the second rail). Accordingly, the functional language of claim 2 does not in this instance serve to patentably distinguish over the rail of Hara. See, e.g., In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 230-31 (CCPA 1971) and Ex parte Cordova, 10 USPQ2d 1949, 1950-51 (Bd. Pat. App. & Int. 1987).

Although appellant is correct that Hara does not address that the disclosed track rail is to be used in the manner claimed, the absence of a disclosure relating to function does not defeat the examiner's finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Accordingly, we shall sustain the examiner's rejection of claim 2 under 35 U.S.C. § 102(b) as being anticipated by Hara.

As to claim 3, the ball holding grooves (5) of Hara respond to the recited "grooves."³ Thus, we shall also sustain the examiner's rejection of claim 3.

As to claim 6, however, we agree with the appellant (brief, pages 9 and 10) that Hara does not teach that the rail is metal. Thus, we are constrained to reverse the examiner's rejection of claim 6 under 35 U.S.C. § 102.

As to claim 7, we note that the claim does not positively recite a steel ball. Consequently, the diameter of the raceway is not limited to any particular steel ball diameter and, as such, is sufficiently broad to encompass the diameter of the grooves (5) of Hara's rail. Therefore, we shall also sustain the examiner's rejection of claim 7.

As to claim 35, which recites that the elongated shaft is "elastic," we find untenable the examiner's argument that "[b]earing steel is, however, elastic" (answer, page 4). Therefore, we shall not sustain the examiner's rejection of claim 35.

As to claim 37, we find no teaching in Hara that the rail (2) comprises "first and second shaft parts adjoining each other" to support the examiner's statement (answer, page 4) "[t]hat would appear to be the case with Hara." It follows that we shall not sustain the examiner's rejection of claim 37.

³ We note that "said contact surfaces" in claim 3 appear to lack clear antecedent basis in the claim and leave this issue to be addressed in the event of any further prosecution before the examiner.

Turning next to the examiner's rejection of claim 8 under 35 U.S.C. § 103 as being unpatentable over Hara in view of AAPA, our discussion *supra* with regard to the recited raceway diameter in claim 7 applies equally to claim 8. Accordingly, we conclude that the subject matter of claim 8 is anticipated by Hara. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, we sustain the examiner's rejection of appealed claim 8 under 35 U.S.C. § 103.

NEW GROUND OF REJECTION

Pursuant to the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claim 6 is rejected under 35 U.S.C. § 103 as being unpatentable over Hara.

As discussed above, it is our opinion that Hara's rail anticipates the limitations of claim 2. Our discussion with regard to these limitations is equally applicable with regard to claim 6, which depends from claim 2, and is incorporated herein. Appellant's claim 6 further recites that the material of the ball holder is "a metal." While Hara does not disclose, expressly or under the principles of inherency, that the track rails (2) are made of metal, the rails (2) as

illustrated in Figures 3-11 appear from the cross-hatching thereof to be made of metal⁴.

Moreover, Hara discloses (column 1, lines 7-21) that the linear motion rolling guide unit of the invention is applicable to sliding portions of "machining tools, precision processing equipment and testing equipment" and is such that "a relatively heavy equipment is mounted on a slider" which is moved backward and forward on the track rails. In view of this disclosure, it would have been obvious to one of ordinary skill in the art to select a very strong and rigid material, such as a metal, for the track rails to bear the weight of the equipment moved thereon.⁵ This accords with the general principle that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 199, 125 USPQ 416, 418 (CCPA 1960).

CONCLUSION

To summarize, the decision of the examiner to reject claims 2, 3, 6, 7, 35 and 37 under 35 U.S.C. § 102 and claim 8 under 35 U.S.C. § 103 is affirmed as to claims 2, 3 and 7 and reversed as to claims 6, 35 and 37. A new rejection of claim 6 is entered pursuant to the provisions of 37 CFR § 1.196(b).

⁴ See Manual of Patent Examining Procedure (MPEP) § 608.02, page 600-84 (Seventh Edition, July 1998).

⁵ An artisan must be presumed to know something about the art apart from what the references disclose (see In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is presumed on the part of those practicing in the art. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, 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 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. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred

until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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; 37 CFR § 1.196(b)

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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