

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH J. SUSNJARA

Appeal No. 2000-2154
Application 09/136,761

ON BRIEF

Before CALVERT, STAAB, and BAHR, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 10, all the claims in the application.

The claims on appeal are drawn to a tool mountable on a high speed spindle of a CNC machine tool, and are reproduced

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in the appendix of appellant's brief.¹

The references applied in the final rejection are:

Held	3,711,999	Jan.
23, 1973		
Mdller	4,833,764	May 30,
1989		

An additional reference applied herein in a rejection pursuant to 37 CFR 1.196(b), is:

1 Kirk-Othmer, Encyclopedia of Chemical Technology (4th Ed., 1991) pp. 25 to 27 (Kirk-Othmer).²

The appealed claims stand finally rejected on the following grounds:

- (1) Claims 1 to 3 and 6, anticipated by Mdller, under 35 U.S.C. § 102(b);
- (2) Claims 4 and 5, unpatentable over Mdller in view of Held, under 35 U.S.C. § 103(a);
- (3) Claims 7 to 10, unpatentable over Mdller in view of Held and official notice, under 35 U.S.C. § 103(a).

¹In reviewing the application, we note that Fig. 1 should be labeled "Prior Art." MPEP § 608.02(g).

²A copy of this reference is forwarded to appellant herewith.

Rejection (1)

Mdller discloses a CNC machine tool including a motor (working unit) 54₃, driving a grinding wheel 56₃ (Fig. 4B). The grinding wheel is described at col. 5, line 45 to 48, as follows:

The grinding wheel 56₃ may be, e.g., a grinding wheel with a quasi-variable-shape profile, comprising a metallic support body bearing a CBN (cubic boron nitride) coating.

The examiner takes the position that Mdller's grinding tool 56₃ anticipates claims 1 to 3 and 6.

With respect to claim 1, appellant argues in essence that the Mdller tool does not have "an annular side surface engageable with the side edge of a flat workpiece positioned directly on said support surface", as claimed, because in none of the workpiece holding arrangements disclosed by Mdller in Figs. 6, 7 and 8 are the side edges of the workpiece "conveniently exposed to have a meaningful engagement with a head section of a tool" (brief, page 10). This argument is not persuasive. In the first place, the workpiece holder shown in Fig. 7 of Mdller clamps the workpiece 84 in such a manner that two of its side edges are exposed and would be

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engageable by the annular side surface of tool 56₃. Moreover, and more fundamentally, the annular side surface of the tool 56₃ would clearly be capable of engaging the side edge of a flat workpiece; the fact that it might not be used for that purpose in the CNC machine of **Mdller** is of no relevance to the question of anticipation of claim 1, because that claim is drawn to the tool per se, rather than the tool in combination with the CNC machine tool. As stated in In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), "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." See also In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967).

Appellant also argues that the annular surface of the tool 56₃ of **Mdller** does not have "a profile corresponding to the profile of said side edge [of the flat workpiece]", as recited in claim 1. Here again, however, the workpiece is not claimed as part of the combination. As disclosed by **Mdller**, supra, the grinding wheel 56₃ has a "quasi-variable-shape profile," which would be capable of corresponding to a side

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edge profile. Also, once a side edge has been ground by Mdller's grinding wheel, the profile of the wheel's annular surface and the profile of the side edge would be the same.

Appellant further contends on page 3 of the reply brief that if he asserted claim 1 in court, the court would "insist that a correct interpretation should include all features in independent claim 1." Nevertheless, whatever may be the merits of this argument, the Court in In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997), reaffirmed that during prosecution before the PTO, claims are to be given their broadest

reasonable interpretation, rather than to be interpreted as they would be by a court in a post-issuance proceeding. We have given claim 1 its broadest reasonable interpretation here.

Accordingly, we conclude that Mdller meets all the structure recited in claim 1, and will sustain the rejection

as to that claim.³

With regard to claim 3, appellant argues that **Mdller** does not disclose "an annular side surface that would operatively engage a side surface of a workpiece yet having a bottom surface staying just clear of a support surface" (brief, page 12). This requires consideration of claim 2, from which claim 3 depends; claim 2 recites that the head section of the tool "includes a bottom surface lying in a plane disposed perpendicular to an axis of said shank section." **Mdller** does not anticipate this limitation, because there is no description or showing in **Mdller** of what the shape of the bottom of tool 56₃ is. The rejection of claims 2 and 3 therefore will not be sustained.

Appellant further contends that **Mdller** does not disclose that the tool 56₃ is made of carbide steel, as required by claim 6. We agree. Since **Mdller** only states that the body of

³Since appellant states on page 8 of the brief that claims 1 to 3 and 6 stand or fall together, we might well also sustain the rejection of claims 2, 3 and 6. However, we have treated them separately in view of the separate arguments presented in the brief.

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tool 56₃ is "metallic," the recitation of "carbide steel" is not anticipated, and the rejection of claim 6 will not be sustained. See Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986) ("absence from the reference of any claimed element negates anticipation").

Rejection (2)

On page 3 of the final rejection, the examiner states the basis of this rejection as:

Miller [sic] teaches all the limitations of the claims except for a tool whose annular side surface is provided with a plurality of circumferentially spaced flutes. Held teaches a [sic] abrasive tool, 10, with flutes, 12f. It would have been obvious to one having ordinary skill in the art at the time that the invention was made to construct the abrasive tool of Miller [sic], with flutes as taught by Held, in order to aid in the removal of abraded particles during the machining process.

We consider this rejection to be well taken. Held teaches the provision of flutes in the annular surface of an abrading wheel in order to effect air cooling. In view of this teaching, one of ordinary skill would have been motivated to provide such flutes in the annular surface of Miller's grinding wheel 56₃, in order to obtain the advantage thereof

disclosed by Held. While the purpose of the flutes of Held may not be precisely the same as that of appellant's flutes (cooling vs. "to facilitate material removal"⁴), "the motivation in the prior art to combine the references does not have to be identical to that of the applicant to establish obviousness." In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996).

Appellant contends that it would not have been obvious to combine Mdller and Held. Referring to col. 3, lines 33 to 36 of Mdller, he asserts, as we understand it, that since Mdller supplies liquid coolant to the point of machining, one of ordinary skill would not provide flutes in Mdller's grinding wheel 56₃ because they would trap the abraded particles (brief, page 14). We do not agree with this argument because, first, the cited portion of Mdller only refers to coolant, not liquid coolant; the coolant could equally well be air or other gas, in which case there would be no adhesion of the particles in the flutes as appellant asserts. Moreover, there is no evidence in the record to support appellant's assertions,

⁴Specification, page 5, line 7.

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which simply amount

to attorney argument and do not convince us that one of ordinary skill would be dissuaded from modifying **Md**ller as suggested by Held.

Rejection (2) will accordingly be sustained.

Rejection (3)

Claims 7 to 10 read:

7. A tool according to Claim 1 wherein said abrasive particles have a grit size of 150.

8. A tool according to Claim 1 wherein said abrasive particles consist of diamond grit.

9. A tool according to Claim 8 wherein said abrasive particles have a grit size of 150.

10. A tool according to Claim 1 wherein said member is formed of carbide steel and said particles are formed of a synthetic diamond material having a grit size of 150.

In making this rejection, the examiner stated on page 3 of the final rejection that:

Claim 7-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller [sic] as modified by Held⁵

⁵ Since claims 7 to 10 do not recite any flutes, it is not apparent why the examiner included Held in this rejection.

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as applied to claim[s] 1-6 above, and further in view of official notice that grit type and size are old and well known in the art..

Miller [sic] as modified by Held, teaches all the limitations of the claims, except for the grit size and type as claimed. The size of the grit and the type specified in the claims present nothing more than old and well known choices to one of ordinary skill in the art.

Appellant, on pages 15 and 16 of the brief, contends that the PTO has not met its initial burden of proof as to the rejection of claims 7 to 10, and notes that there is no evidence in the applied prior art references that the claimed abrasive materials and grit size are known. Notwithstanding this, however, the examiner still states on page 4 and 5 of the answer that:

the size of the grit and the type specified present nothing more than old and well known choices to one of ordinary skill in the art. Since this statement of fact was not challenged, it has become fact in this application and is therefore evidence.

This rejection will not be sustained. Here, where the appellant did challenge the examiner's statement by demanding evidence that the officially-noticed facts were well known, it

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was incumbent on the examiner to cite a reference or references showing such facts,⁶ but the examiner has not done so.

Rejection Pursuant to 37 CFR 1.196(b)

Pursuant to 37 CFR 1.196(b), claims 7 to 9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Mdller in view of Kirk-Othmer.

As noted previously, Mdller discloses that the abrasive on grinding wheel 56₃ may be cubic boron nitride. Kirk-Othmer discloses at pages 25 and 26 both diamond grit and cubic boron nitride as known abrasives. With regard to claims 8 and 9, it would have been obvious to use diamond grit instead of cubic boron nitride as the abrasive for use on Mdller's grinding wheel, this being merely the selection of one known abrasive in place of another depending on their known characteristics, cost, and other factors. As for claims 7 and 9, which recite a grit size of 150, Kirk-Othmer shows at page 27 that abrasive

⁶ See MPEP § 2144.03 and Barry, Did You Ever Notice? Official Notice in Rejections, 81 JPTOS 129, 138 (Feb. 1999).

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grits are available in a wide range of sizes, including 150. To select a particular grit size for use on **Md**ller's grinding wheel would have been an obvious matter of choice, depending on how fine a finish was desired on the particular workpiece being machined.

Conclusion

The examiner's decision to reject claims 1 to 10 is affirmed as to claims 1, 4 and 5, and reversed as to claims 2, 3 and 6 to 10. Claims 7 to 9 are rejected pursuant to 37 CFR 1.196(b).

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. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark 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:

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(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

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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 reconsideration 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; 196(b)

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