

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD WERSHE

Appeal No. 2001-0090
Application No. 08/893,890

ON BRIEF

Before ABRAMS, NASE, and GONZALES, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 8, mailed July 13, 1999) of claim 1. On page 2 of the answer (Paper No. 14, mailed June 2, 2000), the examiner allowed claims 7 to 12 and objected to claims 2, 3 and 6 as depending from a non-allowed claim. On page 5 of the brief (Paper No. 11, filed March 20, 2000), the appellant

provided that for purposes of this appeal, claims 4 and 5 are assumed to be withdrawn.¹

We REVERSE.

BACKGROUND

The appellant's invention relates generally to improved spacers for the bearing assemblies for mounting the wheels of in-line roller skates (specification, p. 1). Claim 1 under appeal reads as follows:

In a bearing spacer device for axially separating ball bearings in a skate wheel hub, the device comprising:

an generally cylindrical center portion having an outer surface extending between first and second axially opposite center portion ends and a central longitudinal axis extending between the first and second center portion ends; a pair of radial shoulders disposed at the first and second center portion ends to abut and axially space the individual ball bearings within the skate wheel hub;

a central bore extending coaxially through the center portion to receive an axle pin for mounting the skate wheel to a skate;

the improvement comprising:

¹ We view this as the appellant's acquiesce in the examiner's earlier determination (Paper No. 5, mailed November 5, 1999) that claims 4 and 5 were not readable on the elected species of Figures 1-6.

a discontinuity formed in the outer surface of the center portion.

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

Bescoby et al. (Bescoby)	4,896,975	Jan. 30, 1990
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In addition, the examiner also relied upon the appellant's admission of prior art set forth in the preamble of claim 1 since claim 1 is drafted as a Jepson² type claim in which the preamble of the claim is an admission of prior art. Note, In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982). (Admitted Prior Art)

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Bescoby.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection and the answer for the examiner's complete reasoning in support of the

² Ex parte Jepson, 1917 C.D. 62, 243 O.G. 525 (Ass't Comm'r Pat. 1917), incorporated into the rules as 37 CFR § 1.75(e).

rejection, and to the brief for the appellant's arguments
thereagainst.

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, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to claim 1 under appeal. Accordingly, we will not sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103. Our reasoning for this determination follows.

The Admitted Prior Art clearly teaches all the limitations of claim 1 except for "a discontinuity formed in the outer surface of the center portion."

Bescoby's invention relates in particular to an apparatus and method for providing a cooled bearing surface for a ceramic shaft. Figure 1 perspectively shows a ceramic shaft 12 having a plurality of fins 14 extending radially outward from a central portion thereof. A bearing runner 16 in the

shape of a thin cylindrical sleeve is mounted at the radially outward ends of the fins 14, bearing runner 16 being axially concentric with the ceramic shaft 12. Figure 2 shows a cross sectional view of a turbomachine 20 which includes the ceramic shaft 12, fins 14, and bearing runner 16 as an integral member therein. The turbomachine 20 includes a turbine 22 and a compressor 24 attached to opposite ends of the ceramic shaft 12, mounted within a housing 26 which includes a central body 28, a turbine scroll 30, and a compressor scroll 32. The central body 28 contains a fluid bearing 34 mounted therein and positioned radially outward from the bearing runner 16. Annular cavities 36, 38 are defined within the central body at opposite axial ends of the bearing runner 16.

Bescoby's turbomachine 20 operates on a flow of high pressure fluid which is directed upon the turbine 22 which extracts useful work therefrom. The turbine 22 in turn drives the compressor 24 which pressurizes a fluid from a first low pressure source to a higher pressure. Within the central body 28 the fluid bearing 34 utilizes the rotation of the shaft 12 and bearing runner 16 to produce a hydrodynamic

film of fluid between the fluid bearing 34 and the bearing runner 16 to support the shaft 12.

Bescoby teaches that in order to provide a flow of cooling fluid to the matrix of fins 14 as well as the fluid bearings 34, the central body may include first, second and third passageways 40, 42, 44. The first and third passageways 40, 44 are connected via a conduit 48 to a source of pressurized air which may be taken from downstream of the compressor 24. In order to recirculate the process fluid, the second passageway 42 is connected to a second conduit 50 which returns the process fluid to a low pressure location upstream of the compressor 24. By this assembly, pressurized process fluid flows into annular cavity 36, through the fins 14 to annular cavity 38, thereby the fins 14 act as a heat exchanger, reducing heat transfer to the bearing runner 16.

As set forth on page 3 of the final rejection, the examiner applied the test for obviousness set forth in In re

Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).³ In applying that test, the examiner then determined that it would have been obvious to a person having ordinary skill in the art to provide the Admitted Prior Art's spacer with longitudinally extending grooves in view of the teaching of Bescoby of doing so for the purpose of cooling.

The appellant argues (brief, pp. 7-9) that the applied prior art does not suggest the subject matter of claim 1. We agree.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." Id. 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). And

³ The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art.

"teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the prior art contains none. In fact, the advantages of utilizing a discontinuity formed in the outer surface of the center portion of the bearing spacer device (e.g., reduction in weight, dissipates more heat) are not appreciated by the prior art applied by the examiner. In fact, as correctly pointed out by the appellant in the brief (p. 8), Bescoby does not teach or suggest any discontinuity formed in the outer surface of bearing runner 16.

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential

that "the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id. Since all the limitations of claim 1 are not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of claim 1.

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN F. GONZALES)	
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