

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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRADLEY J. MILLER
and
ROLAND MABON

Appeal No. 2001-2586
Application No. 08/856,501

ON BRIEF

Before PATE, STAAB, and NASE, **Administrative Patent Judges**.

PATE, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 20. These are the only claims in the application.

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The claimed invention is directed to a method for making an abrasive tool. A stencil is placed against a tool body and a brazing paste is placed in the cavities of the stencil. After the stencil is removed to form parcels of brazing paste on the tool body, abrasive grains are deposited in the parcels. Then the tool is thermally processed to braze the abrasive grains to the cutting surface.

The claimed subject matter may be further understood with reference to the appealed claims appended to appellants' brief.

The references of record relied upon by the examiner as evidence of obviousness are:

Steindler	4,510,990	May 12, 1970
Tselesin	5,380,390	Jan. 10, 1995

THE REJECTION

Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as unpatentable over Tselesin in view of Steindler. The examiner states that to apply the technique of Tselesin to a curved surface of a preform to form a patterned abrasive member would have been obvious in view of Steindler.

OPINION

We have carefully reviewed the appealed claims in light of the arguments of the appellants and the examiner. As a result of this review, we have determined that the applied prior art does not establish a **prima facie** case of obviousness with respect to the claims on appeal. Accordingly, the rejection of all claims on appeal is reversed. Our reasons follow.

Tselesin discloses a method of making an abrasive article using a mask 14 and a brazing and fusing paste (col. 3, lines 32-41) to define parcels on a substrate 10. Appellants argue that the substrate 10 of Tselesin is not a tool body. We agree that appellants' claim requires a tool body, inasmuch as appellants so argue to differentiate the claimed subject matter from the prior art, and claim 1 refers to a abrasive tool body with a cutting surface both in the preamble and several locations in the body of the claim. We construe the claim term "representing a tool body for the abrasive tool" to denote that the metal preform is the tool body in nascent, unthermally processed form. We further note that the tool body preform is of some three-dimensional shape, i.e., spherical, conical or frustoconical.

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It is our finding that the substrate of Tselesin, although a preform, is not a tool body. The embodiments disclosed therein appear to be restricted to a flat, albeit flexible, two-dimensional shape. The examiner has argued that it would have been obvious to apply the technique of Tselesin to construct a three-dimensional tool in view of the teaching of Steindler. However, the examiner is unable to point to a suggestion or motivation for this modification of the Tselesin process. In our view it is simply not obvious to do so, barring some suggestion or motivation recognized in the art.

Additionally, if the rationale of the rejection were to have been the obviousness of placing the preforms of Tselesin on a tool body as shown in Steindler, such a process would require another step in the process of claims 1 or 8 and would not satisfy the "consisting essentially of" language of the claim. Such a modification would be the addition of another material step to the claimed invention.

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For the foregoing reasons, the rejection of all claims on
appeal is reversed.

REVERSED

WILLIAM F. PATE, III)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

WFP,III:svt

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