

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD D. HEIN and WALTER J. KELLY

Appeal No. 95-4486
Application No. 08/158,713¹

ON BRIEF

Before MEISTER, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6 through 12, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed November 24, 1993. According to the appellants, the application is a continuation of Application No. 07/874,930, filed April 28, 1992, now abandoned.

BACKGROUND

The appellants' invention relates to a prepackaged fluid-damping article for elastomeric mounts. An understanding of the invention can be derived from a reading of exemplary claim 6, which appears in the appendix to the appellants' brief.

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

Schubert	4,742,998	May 10, 1988
Kato et al. (Kato)	4,981,286	Jan. 1, 1991
Hoying et al. (Hoying)	4,991,826	Feb. 12, 1991

Claims 6 through 12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claim 6 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Kato.

Claims 7, 8, 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kato in view of Hoying.

Claims 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kato in view of Hoying and Schubert.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 24, mailed April 13, 1995) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 22, filed January 12, 1995) and reply brief (Paper No. 25, filed May 4, 1995) for the appellants' arguments thereagainst.

OPINION

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

The indefiniteness issue

We will not sustain the examiner's rejection of claims 6 through 12 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire.

Furthermore, the appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we analyze the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal.

The examiner determined (answer, p. 3) that the recitation of "being sealed prior to assembly" in claims 6 and 12 renders the claims indefinite.

The appellants argue (brief, pp. 6-7 and reply brief, pp. 1-2) that the claims under appeal are definite under the standards of 35 U.S.C. § 112, second paragraph. We agree. It is our opinion that claims 6 and 12 do set out and circumscribe a particular area with a reasonable degree of precision and particularity and therefore are in compliance with the second paragraph of 35 U.S.C. § 112. It is clear to us that claim 6 requires that the fluid tight damping chamber be sealed prior to its assembly in position adjacent one of the compliance members. It is equally clear to us that claim 12 requires that the fluid-tight module be sealed prior to its assembly against the resiliently deformable member.²

² We have interpreted the phrase "the fluid-tight module being sealed prior to assembly against the resiliently deformable members" to be "the fluid-tight module being sealed prior to assembly against the resiliently deformable member" since claim 12 recites only one resiliently deformable member (i.e., at least one resiliently deformable member).

The anticipation issue

We will not sustain the examiner's rejection of claim 6 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 6 is drawn to an elastomeric vehicle mount comprising, inter alia, a top resiliently deformable compliance member, a bottom resiliently deformable compliance member, and an integral fluid tight damping chamber which is sealed prior to its assembly in position adjacent one of the compliance members.

Kato discloses an engine mount. As shown in Figure 1, the engine mount includes an annular elastic body 14, a metal member 20, a flexible rubber diaphragm 28, and a protective rubber layer 31. Between the protective rubber layer 31 of the elastic body

14 and the flexible rubber diaphragm 28, there is formed a fluid-tight space filled with a suitable electro-viscous fluid 30.

The appellants argue (brief, pp. 8-10) that claim 6 is not anticipated by Kato. We agree. Kato does not disclose each element of claim 6. Kato does not disclose an integral fluid tight damping chamber which is sealed prior to its assembly in position adjacent Kato's elastic body 14. Kato also does not disclose a bottom resiliently deformable compliance member. Contrary to the position of the examiner (answer, p. 4), it is our opinion that claimed bottom resiliently deformable compliance member is not readable on Kato's metal member 20.

The obviousness issues

We will not sustain the examiner's rejections of claims 7 through 12 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The examiner rejected dependent claims 7, 8 and 11 based upon the combined teachings of Kato and Hoying. The examiner rejected dependent claims 9 and 10 based upon the combined teachings of Kato, Hoying and Schubert.

We have reviewed the references to Hoying and Schubert but find nothing therein which makes up for the deficiencies of Kato discussed above regarding claim 6. Accordingly, we cannot sustain the examiner's rejection of appealed claims 7 through 11 under 35 U.S.C. § 103.

The examiner rejected independent claim 12 based upon the combined teachings of Kato and Hoying.

Claim 12 is drawn to a fluid-damped resilient mounting device comprising, inter alia, at least one resiliently deformable member and a fluid-tight module which is sealed prior to its assembly against the resiliently deformable member.

The appellants argue (brief, p. 11) that claim 12 is patentable since neither Kato nor Hoying discloses a fluid-tight module which is sealed prior to its assembly against the

resiliently deformable member. We agree. Kato does not disclose a fluid-tight module which is sealed prior to its assembly against Kato's elastic body 14. Hoying does not disclose a fluid-tight module which is sealed prior to its assembly against a resiliently deformable member. Thus, the combined teachings of Kato and Hoying would not have suggested a fluid-tight module which is sealed prior to its assembly against the resiliently deformable member. Accordingly, we cannot sustain the examiner's rejection of appealed claim 12 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 6 through 12 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claim 6 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 7 through 12 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 95-4486
Application No. 08/158,713

Page 11

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APPEAL NO. 95-4486 - JUDGE NASE
APPLICATION NO. 08/158,713

APJ NASE

APJ MEISTER

APJ McQUADE

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 04 Jun 98

FINAL TYPED: