Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY M. WILL

Appeal No. 96-0561
Application 08/055,584[1]

ON BRIEF

Before FRANKFORT, McQUADE and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

[1] Application for patent filed May 3, 1993.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 7 and 9 through 21. Claims 22 through 33, the only other claims remaining in the application, stand withdrawn from further consideration under 37 CFR § 1.142(b). Claim 8 has been canceled.

Appellant's invention relates to a mandrel assembly that, as disclosed, is used for enlarging the cross-sectional area of a passage formed in an elastomeric work piece such as a seal, sleeve, or grommet. Claim 1 is representative of the subject matter on appeal and a copy thereof, as it appears in the Appendix to appellant's brief, is attached to this decision.

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

Rossmann	2,321,518	June 8, 1943
Hirmer (German Patent)[2]	680,232	Aug. 3, 1939

[2] A translation of this German language document prepared for the U.S. Patent and Trademark Office is attached to this decision.

Claims 1, 4, 7 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hirmer.

Claims 2, 3, 5, 6 and 10 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hirmer in view of Rossmann.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 14, mailed August 14, 1995) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 13, filed June 9, 1995) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to

the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's

rejection of claims 1, 4, 7 and 9 under § 102 is well founded and will be sustained. However, the examiner's rejection under 35 U.S.C. § 103 of claims 2, 3, 5, 6 and 10 through 21 is not well founded and will therefore not be sustained. Our reasoning in support of these determinations follows.

Looking first at the examiner's rejection of claims 1, 4, 7 and 9 under § 102(b), we are in agreement with the examiner that the mandrel assembly of Hirmer is fully responsive to that set forth in the claims so rejected, and that the mandrel assembly of Hirmer is fully capable of being used for enlarging the cross-sectional area of a passage formed in an elastomeric work piece such as a seal, sleeve, or grommet, notwithstanding that the mandrel assembly therein is not specifically disclosed for such use. In this regard, we note that the mandrel assembly of Hirmer includes first and second generally axially elongated resiliently deflectable members (3), described on page 3 of the translation as "[t]wo projections 3," that are positioned

relative to one another in the manner set forth in appellant's claim 1 on appeal and also are capable of operation in the manner set forth in claim 1. In addition, Hirmer discloses an axially extending expander member (9) slidable between and against the inner surfaces of the deflectable members (3) and effective to move the second ends of the deflectable members away from one another so that the outer surfaces of the deflectable members are forced against the surface defining a passage in a work piece through which the members (3) extend. As to claim 7, the deflectable members (3) of Hirmer are connected to a threaded body portion (1) of the expansion body, and that body portion includes a guide passage means therethrough for guiding the expander member (9) in relation to the first and second members (3) when the expander member slidably moves in said guide passage means. Contrary to appellant's arguments, we consider that the conically tapered tip portion (10) of the expander member in Hirmer would have been viewed by one of ordinary skill in the art as having a "wedge-like configuration."

With respect to the above determinations, we observe that the law of anticipation does not require that the reference

specifically teach what the appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the 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). In the present case, all the limitations of claims 1, 4, 7 and 9 are found in Hirmer, either expressly or under principles of inherency, and those claims are clearly anticipated thereby.

Turning to the examiner's rejection of claims 2, 3, 5, 6 and 10 through 21 under 35 U.S.C. § 103 as being unpatentable over Hirmer in view of Rossmann, the examiner has taken the position that because the semi-circular elements (11, 12) of Rossmann have a flat face (e.g., as seen in Fig. 3), it is a reasonable interpretation to say that these elements are made from "thin flat-stock spring steel," as set forth in appellant's above-noted claims on appeal. We do not agree. The elements (11, 12) in Rossmann are shown in the drawings and expressly described therein as being "semi-circular" in cross section with flat faces facing each other as seen in Figure 3. Thus, in

contrast to the examiner's position, it does not appear to us that this reference would have fairly taught or motivated one of ordinary skill in the art to use flat-stock spring steel to make the elements (3) in Hirmer. As for the examiner's assertion (answer, page 4) that one skilled in the art would have been motivated to use flat stock "in order to advantageously provide

smooth guiding surfaces," we find such reasoning to be at best hollow and self-deceptive. Since we have determined that the examiner's conclusion of obviousness is based on a hindsight reconstruction using appellant's own disclosure as a blueprint to arrive at the claimed subject matter, it follows that we will not sustain the examiner's rejection of claims 2, 3, 5, 6 and 10 through 21 under 35 U.S.C. § 103 based on Hirmer and Rossmann.

To summarize:

We have affirmed the examiner's rejection of claims 1, 4, 7 and 9 under 35 U.S.C. § 102(b) as being anticipated by Hirmer.

We have reversed the examiner's rejection of claims 2, 3, 5, 6 and 10 through 21 under 35 U.S.C. § 103 as being unpatentable over Hirmer in view of Rossmann.

The decision of the examiner is accordingly affirmed-in-part.

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

CHARLES E. FRANKFORT Administrative Patent Judge	)	
JOHN P. McQUADE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES

MURRIEL E. CRAWFORD)
Administrative Patent Judge)

Lon H. Romanski
Suite-B
101 E. Harris Street
Cadillac, MI 49601

APPENDIX

1. A mandrel assembly for enlarging the cross-sectional area of a passage formed in a work-piece comprised of elastomeric material; said mandrel assembly comprising a first generally axially elongated resiliently deflectable mounting member; a second generally axially elongated resiliently deflectable mounting member; wherein said first mounting member comprises first and second ends; wherein said second mounting member comprises first and second ends; wherein said first and second mounting members are juxtaposed to each other as to have said first ends juxtaposed to each other and as to have said second ends juxtaposed to each other; wherein said first ends of said first and second mounting members are spaced a preselected distance from each other and wherein said second ends are resiliently deflectable toward and away from each other; wherein said first mounting member comprises an inner disposed surface; wherein said second mounting member comprises an inner disposed surface; wherein said inner disposed surfaces of said first and second mounting members generally face each other; wherein said first mounting member comprises an outer disposed surface carried by said first mounting member as to be disposed thereon generally oppositely to said inner disposed surface of said first mounting member; wherein said second mounting member comprises an outer disposed surface carried by said second mounting member as to be disposed thereon generally oppositely to said inner disposed surface of said second mounting member; wherein when said second ends are resiliently deflected toward each other said work-piece may be placed onto said first and second mounting members by having said resiliently deflected second ends inserted into said passage of said work-piece in a manner whereby at least portions of said outer disposed surfaces of said first and second mounting members are juxtaposed to the elastomeric material of said work-piece defining the surface of said passage; and further comprising an axially extending expander member; said expander member being slidable against said inner disposed surfaces of said first and second mounting members when said first and second mounting members are held axially stationary; said expander member when slid axially along said inner disposed surfaces, while said mounting members are held against axial movement, a distance sufficient to become between said second ends of said first and second mounting members being effective to move said second ends away from each other whereby said at least portions

of said outer disposed surfaces are forced against said surface defining said passage and thereby expand said cross-sectional area of said passage.