

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN J. BENDA

Appeal No. 96-0831
Application 08/191,113¹

ON BRIEF

Before ABRAMS, FRANKFORT and NASE, *Administrative Patent Judges*.
ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1 through 15, which constitute all of the claims of record in the application.

The appellant's invention is directed to a grommet for closing a hole through a panel. The subject matter before us on

¹Application for patent filed February 3, 1994.

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appeal is illustrated by reference to claim 1, which can be found in an appendix to the Brief on Appeal.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

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|-----------------------------------|-----------|---------------|
| Olmstead <i>et al.</i> (Olmstead) | 4,041,241 | Aug. 9, 1977 |
| Patel | 4,784,285 | Nov. 15, 1988 |

THE REJECTIONS

Claims 1 through 15 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 appellant regards as the invention.

Claims 1 through 7 and 9 through 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Olmstead.

Claims 8 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Olmstead in view of Patel.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief on Appeal.

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellant as set forth in the Answer and the Brief.

At the outset, we wish to confirm the examiner's opinion that the first three issues set forth on page 7 of the Brief are petitionable subject matter under 37 C.F.R. 1.181 and are not appealable.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

The examiner has set forth a number of instances of alleged indefiniteness in claims 1, 4 and 5. In evaluating these issues, we recognize that the second paragraph of Section 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). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in the light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the

pertinent art. *Id.* Having done so, we find ourselves agreeing with the examiner on only one of the several issues raised.²

Claim 4 recites that the "dimension and proportions of the elements" meet specific requirements (emphasis added). It is the examiner's position that what constitutes "the elements" is not clear. There is no antecedent basis for this phrase. The only appearances of "element" are the "peripheral sealing element" of the soft member and the "base element" of the rigid member recited in claim 1, from which claim 4 depends, to which one could assume the phrase in question is meant to refer. However, the appellant has clouded the issue by not suggesting this to be the case, but arguing on page 11 of the Brief that "[a]ny article includes elements . . . [and] the expression is a simple reference to the elements of the grommet." This buttresses the examiner's conclusion that this phrase is indefinite, in that its breadth appears to be open to interpretation, and therefore the metes and bounds of the claim cannot be determined.

²The recitation of "hold" instead of "hole" in line 13 of claim 1 clearly is an inadvertent typographical error which, although it should be corrected does not, in our view, rise to the level of a rejection under Section 112. We also note that the examiner has withdrawn the Section 112 rejection directed at language on line 23 of claim 1 (Answer, page 6).

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For this reason we will sustain the rejection of claim 4 under 35 U.S.C. § 112, second paragraph, as well as the like rejection of claims 5 and 6, which are dependent therefrom.

The Rejections Under 35 U.S.C. § 103

Claims 1 through 7 and 9 through 14 stand rejected as being unpatentable over Olmstead. The question under 35 U.S.C. § 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of the references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Olmstead discloses a grommet for closing a penetration hole through a panel. It comprises a main soft member of elastomeric material and a rigid member of non-elastomeric material which is

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of greater hardness and essentially is encapsulated in the soft member. When inserted into the hole, a sealing element 34 of the soft member engages the periphery of the hole, owing in part to the action of a plurality of spaced load resilient tangs 42 which extend from the base element of the rigid member (Figure 2). It is the examiner's position that Olmstead teaches everything recited in claim 1 except for not specifying the Shore hardness of the two components, but that the selection of relative hardness levels for the two components would have been obvious to one of ordinary skill in the art.

We are not persuaded by the appellant's arguments that the claim requires both members to be of plastic material, for while that feature is disclosed in the specification, it is not recited in the claims. As for the assertion that the mention of "Shore" values implies that the materials both are of plastic because this measure is "never" used for non-plastic materials (Brief, page 13), we first note that no evidence has been presented in support of this conclusion³. In addition, it is our view that since no criticality has been established for this limitation,

³According to its definition, Shore hardness is not limited to plastic material, i.e. "hardness of metal or other material as measured by a Shore scleroscope." Webster's Third New International Dictionary, 1971, p. 2102.

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the key factor is not that particular softness/hardness values are present, but is the relative hardness of the materials used for the two members. It is our opinion that the teachings of Olmstead would have suggested to one of ordinary skill in the art that many suitable materials can be used, so long as the outer member is soft enough to perform the task of sealing and the rigid member strong enough to stiffen the grommet to hold it in position. With regard to this, skill on the part of the artisan, rather than the lack thereof, is presumed (see *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)), and the disclosure of each reference should be considered for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom (see *In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

Finally, some of the appellant's arguments, such as those regarding the fact that the components are molded, and are molded in a particular fashion, fail from the outset because they are predicated upon limitations that are not present in the claims. See *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

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The rejection of claim 1 under 35 U.S.C. § 103 is sustained.

With regard to claim 2, the appellant argues that Olmstead does not show the required load pads, but utilizes "load prongs" (Brief, page 16). We agree with the examiner that the ends of Olmstead's members 42 constitute load pads inasmuch as their ends are exposed to the extent necessary to engage the panel into which the grommet is inserted (see column 4, lines 7 through 9 and column 2, lines 35 through 41). We add that Olmstead also discloses a variation on this theme, for as seen in Figure 5 the locking function also can be performed by an offset portion 74 of the locking ring 72. This rejection of claim 2 is sustained.

Above, we have sustained the rejection of claim 4 under Section 112, second paragraph, on the basis that the term "the elements" in line 5 is indefinite. However, it is our view that this problem is not of such magnitude as to cause us not to be able to evaluate the claim from the standpoint of patentability over the prior art relied upon. On the basis that the indefiniteness problem will be overcome by way of acceptable amendment, it is our conclusion that Olmstead does not disclose the required peripheral sealing element "having a normal curved position" and curving in the direction of the inner surface of the grommet. We therefore will not sustain the Section 103

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rejection with regard to this claim or claims 5 and 6, which depend therefrom.

Claim 7 adds to claim 1 the limitation that the base element has slits located between the load pads, which slits extend partially through the base element. We agree with the appellant that this is not taught or suggested by Olmstead, and therefore we will not sustain the Section 103 rejection of claim 7 or, it follows, of claims 9 through 11, which are dependent therefrom.

Claim 12 adds to claim 2 the limitation that the axially outer surfaces of the load pads have exposed camming surfaces 61 for engaging the marginal edge surface of the hole into which the grommet is installed. While Olmstead teaches that a portion of the locking members be exposed, in our view these portions do not "extend inwardly ... beyond said skin of the rib," as required by claim 12. The rejection of this claim under 35 U.S.C. § 103 is not sustained.

Claims 13 and 14 are directed to the manner in which the soft member and the rigid member are connected together. Claim 13 requires that they be "only mechanically" connected and claim 14 adds that there be no chemical or thermal bonding. Olmstead is silent as to the use of any adhesive or the like in the connection of the rigid member to the soft member, stating only

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that the former is embedded in the latter (column 3, line 67 *et seq.*). From our perspective, therefore, one of ordinary skill in the art would have understood that the two elements of the Olmstead grommet are mechanically attached together, only, and thus the limitations added by claims 13 and 14 inherently are present in Olmstead. The Section 103 rejection of these two claims is sustained.

Claims 8 and 15 stand rejected as being unpatentable over Olmstead in view of Patel, the latter being cited by the examiner for its showing of a grommet having an oblong shape. Be that as it may, claim 8 requires the presence of slits extending partially through the base element, as did claim 7, and this is not taught by Patel or, as we stated above, by Olmstead. Therefore, this rejection of claim 8 is not sustained.

Claim 15 has no such requirement; its purpose is to add to claim 1 the limitation that both the soft member and the rigid member are made of "plastic materials." Patel discloses a self locking plug for insertion in a hole in a panel, with both the soft member (22) and the rigid member (20) being formed of plastic material (column 5, lines 30 through 37). As admitted by the appellant on page 19 of the Brief, the two elements of the Patel device are mechanically interlocked. It is the examiner's

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position, with which we agree, that one of ordinary skill in the art would have found it obvious to make the rigid member of Olmstead from plastic, in view of the teachings of Patel. Suggestion for such a modification is found in the self-evident advantages of the use of plastic materials, which would have been known to the artisan, such as lighter weight and ease of manufacture. In this regard, we observe that Patel has listed several advantages in column 1. Furthermore, and quite interestingly, Patel has described the method of manufacturing the device as comprising the steps of "injecting material having metal-like properties to form the hole filling and locking portions," that is, the rigid member, and then injecting the "resilient, softer material into the same mold" to thus "form the unitary dual durometer plug" (column 2, lines 1 through 7, emphasis added). This, in our view, explicitly establishes the *prima facie* obviousness of utilizing a suitable plastic material instead of metal.

This rejection of claim 15 is sustained.

SUMMARY

The rejection of claims 1 through 3 and 7 through 15 under 35 U.S.C. § 112, second paragraph, is not sustained.

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The rejection of claims 4, 5 and 6 under 35 U.S.C. § 112, second paragraph, is sustained.

The rejection of claims 1 through 3 and 13 through 15 under 35 U.S.C. § 103 is sustained.

The rejection of claims 4 through 12 under 35 U.S.C. § 103 is not sustained.

The decision of the examiner is 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

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| NEAL E. ABRAMS |) | |
| Administrative Patent Judge) |) | |
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| CHARLES E. FRANKFORT |) | BOARD OF PATENT |
| Administrative Patent Judge) |) | APPEALS AND |
| |) | INTERFERENCES |
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