

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS SALCICCIOLI
and
HAROLD L. CHAMBERS

Appeal No. 97-1882
Application No. 08/316,957¹

ON BRIEF

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

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 to 3, 5, 11, 12, 14 and 20, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

¹ Application for patent filed October 3, 1994.

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We REVERSE.

BACKGROUND

The appellants' invention relates to an unitary axle seal. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

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

Heinzen

5,201,529

April 13, 1993

Claims 1 to 3, 5, 11, 12, 14 and 20 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.

Claims 1 to 3, 5, 11, 12, 14 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Heinzen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 6, mailed April 2, 1996) and the examiner's answer (Paper No. 13,

mailed November 29, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 12, filed November 18, 1996) 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 reference, 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 1 to 3, 5, 11, 12, 14 and 20 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.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes

and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

In this case, the examiner determined (final rejection, p. 2) that the meaning of the term "operative" is unclear. Subsequent to the final rejection, claims 1 to 3, 5, 11, 12, 14 and 20 were amended to replace the term "operative" with the term "adapted." Nevertheless, in the answer (pp. 2-4) the examiner maintained this rejection and stated that the scope of the claims cannot be determined since the claims include recitations that appear to positively recite the axle/knuckle.

After reviewing the claims under appeal, it is our opinion that they define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity. In that regard, it is our view that the claims under appeal are directed to a unitary axle seal adapted for use with a knuckle and an axle as set forth in the claims. Accordingly, the decision of the examiner to reject claims 1 to 3, 5, 11, 12, 14 and 20 under 35 U.S.C. § 112, second paragraph, is reversed.

The anticipation issue

We will not sustain the examiner's rejection of claims 1 to 3, 5, 11, 12, 14 and 20 under 35 U.S.C. § 102(b) as being anticipated by Heinzen.

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). The prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. See Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed. Cir. 1985). Rather, if a claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding anticipation. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d at 631-33, 2 USPQ2d at 1052-54.

The examiner determined (final rejection, p. 2) that

[i]n Figure 1, Heinzen discloses a seal as claimed. The seal has a knuckle mating portion 13, a deflector portion

16, an axial lip, a radial lip and a radial pad (not labelled [sic, labeled]).

The appellants argue (brief, pp. 5-7) that

Heinzen does not disclose, teach or suggest a seal as claimed in the present invention. Specifically, Heinzen does not teach or suggestion a unitary seal having a reinforcing member and sealing member designed to cooperate with the axle and knuckle as in the present invention.

The examiner responded to the appellants' argument (answer, pp. 4-6) by concluding that Heinzen's structure is capable of performing the intended uses set forth in the claims and according Heinzen does anticipate the claims under appeal.

Thus, the real issue presented to us for review is whether Heinzen's structure is capable of performing the intended uses set forth in the claims (i.e., does Heinzen disclose a unitary seal having a reinforcing member and sealing member adapted to cooperate with the axle and knuckle as set forth in the claims under appeal).

After reviewing the disclosure of Heinzen, we conclude that Heinzen's structure is not capable of performing the intended uses set forth in the claims. In our opinion, the claims under appeal require that the unitary axle seal be configured so that

it can be placed between an axle and a knuckle in such a manner that (1) the knuckle mating portion of the annular reinforcing member engages the internal bore of the knuckle; (2) the axial lip of the sealing member engages the axle; (3) the radial lip of the sealing member engages the axle; and (4) the radial pad of the sealing member engages the axle. As clearly shown in Figure 1 of Heinzen, the knuckle mating portion (i.e., cylindrical portion 13 of metal case 11) is not capable of engaging the internal bore of the knuckle (i.e., axle hole 4 of housing 2) due to the presence of the outer peripheral seal portion 14.

Furthermore, even if the knuckle mating portion of Heinzen is modified to somehow engage the internal bore of the knuckle, it is clear from Figure 1 of Heinzen that Heinzen's unitary seal (i.e., first seal member 10 composed of metal case 11 and rubber-like portions 12, 14 and 15) would still not be configured so that it can be placed between an axle and a knuckle in such a manner that the axial lip, the radial lip and the radial pad all engage the axle.

Since all the limitations of the appealed claims are not disclosed in Heinzen, the decision of the examiner to reject

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claims 1 to 3, 5, 11, 12, 14 and 20 under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 5, 11, 12, 14 and 20 is reversed.

REVERSED

JOHN P. McQUADE)	
Administrative Patent Judge)	
)	
)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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APJ CRAWFORD

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 08 Sep 98

FINAL TYPED: