

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAPHAEL SCHLANGER

Appeal No. 1999-1821
Application No. 08/725,335¹

ON BRIEF²

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

¹ Application for patent filed October 1, 1996.

² We note that the appellant has requested an oral hearing on page 19 of the brief (Paper No. 11, filed October 29, 1998), but under the circumstances a hearing is not considered necessary. See 37 CFR § 1.194(c), last sentence, as amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, (Oct. 21, 1997).

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DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 3-8, 10, 11, 23-27, 32-37 and 39-43, as amended subsequent to the final rejection. Claims 9, 12-22 and 28-31 have been withdrawn from consideration under 37 CFR § 1.142(b) as being

drawn to a nonelected invention. Claims 1, 2 and 38 have been canceled.³

We REVERSE.

BACKGROUND

The appellant's invention relates to a device for forming a connection between connectable elements. An understanding of the invention can be derived from a reading of exemplary claim 32, which appears in the appendix to the appellant's brief.

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

Johnston	443,855	Dec. 30, 1890
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Claims 25, 26, 34 and 39 stand rejected under 35 U.S.C.

³ Claim 2 was canceled by the appellant's entered amendment after final rejection (Paper No. 8, filed July 27, 1998). However, both the appellant in the brief and the examiner in the answer (Paper No. 12, mailed January 21, 1999) have mistakenly treated claim 2 as pending.

§ 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 3, 6, 8, 10, 11, 23, 27, 32-36 and 39-43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Johnston.

Claims 4, 5, 7, 24-26 and 37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnston.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer for the examiner's complete reasoning in support of the rejections, and to the brief for the appellant's arguments thereagainst.

OPINION

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

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respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 25, 26, 34 and 39 under 35 U.S.C. § 112, second paragraph.

The examiner determined (answer, p. 3) that claims 25 and 26 were indefinite since "said tapered means" lacks positive antecedent basis in the claims. The examiner also determined (answer, p. 4) that claims 34 and 39 were indefinite since it is unclear how the inner surface of the first member circumscribes the first member.

We agree with the appellant's position (brief, p. 6) that the entered amendment after final obviated this rejection. In that regard, we note that the phrase "said tapered means" in claims 25 and 26 was amended to "said tapered element." In addition, the phrase "the inner surface of the first member substantially circumscribes the outer surface of said first member" in claim 34 was amended to read "the inner surface of the first member substantially circumscribes the outer surface of said second member."

For the reasons stated above we see no basis for the examiner maintaining this rejection following entry of the amendment after final. Accordingly, the decision of the examiner to reject claims 25, 26, 34 and 39 under 35 U.S.C. § 112, second paragraph, is reversed.

The anticipation rejection

We will not sustain the rejection of claims 3, 6, 8, 10, 11, 23, 27, 32-36 and 39-43 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 32 (the only independent claim on appeal) recites a device for forming a connection between connectable elements, comprising, inter alia, a first connectable member means; a second connectable member means; and at least one tapered

element for either compressing the first connectable member means into engagement with the second connectable member means or expanding the second connectable member means into engagement with the first connectable member means. In addition, claim 32 recites that

at least one of said first connectable member means and said second connectable member means includes a tapered opening having means for securely engaging said tapered element, and wherein said engagement provides a substantially uniform force distribution between the first and second connectable member [means].

Johnston discloses a handle for a lawn-mower. As shown in Figures 1-3, the handle includes a cross-bar A having an oblong mortise a; a push-bar B having a tenon b, which corresponds to and fits into the mortise a; an axial opening b' in the tenon b; a metal plate C provided with a central opening c; and a tapered screw D. Johnston teaches (page 1, lines 64-69) that the tapered screw D causes the tenon b to expand so that the sides of the tenon press closely against the walls of the mortise a, thereby materially aiding in holding the parts tightly together.

We agree with the appellant's argument (brief, pp. 11-12) that the standing 35 U.S.C. § 102(b) rejection of the sole independent claim on appeal (i.e., claim 32) is unsound because Johnston does not provide a substantially uniform force distribution between his first and second connectable member means (i.e., the mortise a and the tenon b).

The examiner's contention that Johnston's device would provide, presumably under principles of inherency, a substantially uniform force distribution between the mortise a and the tenon b (answer, pp. 8-9) is not well founded. Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of

circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Here, the examiner's determination that Johnston's device would provide a substantially uniform force distribution between the mortise a and the tenon b is simply speculative.

Thus, Johnston does not meet the particular limitation in claim 32 requiring a substantially uniform force distribution between the first and second connectable member means. In light of the foregoing, the decision of the examiner to reject claim 32, as well as claims 3, 6, 8, 10, 11, 23, 27, 33-36 and 39-43 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

The decision of the examiner to reject claims 4, 5, 7, 24-26 and 37 under 35 U.S.C. § 103 is reversed since the above-noted limitation of parent claim 32 is neither taught by Johnston for the reasons set forth above, nor would it have

been obvious to one of ordinary skill in the art from the teachings of Johnston.

CONCLUSION

To summarize, the decision of the examiner to reject claims 25, 26, 34 and 39 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 3, 6, 8, 10, 11, 23, 27, 32-36 and 39-43 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 4, 5, 7, 24-26 and 37 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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APPLICATION NO. 08/725,335

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APJ BAHR

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 29 Sep 99

FINAL TYPED: