

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GENERAL STAPLE, INC.

Appeal No. 97-3579
Application 90/002,797¹

REHEARING

Before MCCANDLISH, **Senior Administrative Patent Judge**, and MEISTER and STAAB, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

ON REQUEST FOR REHEARING

The patent owner requests we reconsider our decision mailed on April 30, 1998 wherein we affirmed the examiner's

¹ Reexamination proceeding for U.S. Patent No. 4,318,964 issued March 9, 1982, to General Staple, Inc., entitled Autopin Machine. According to appellants, this application is a continuation of Application Serial No. 05/877,093, filed February 13, 1978 (abandoned), which is a division of Application Serial No. 05/773,274, filed March 1, 1977 (abandoned).

Appeal No. 97-3579
Application 90/002,797

rejections of: (1) claims 6 and 7 under 35 U.S.C. § 112, first paragraph, (2) claims 1 and 6 under 35 U.S.C. § 102(b) as being anticipated by Berg '448 and (3) claims 1-7 under 35 U.S.C. § 103 as being unpatentable over (a) Ragard in view of Pierce, Berg '986 or Metscher, (b) the admitted prior art in view of Ragard and Royse, (c) Ragard in view of Royse and Fowler, (d) Ragard in view of Berg '448 and (e) the admitted prior art in view of Ragard and Berg '448. We have carefully reconsidered our decision in light of the arguments advanced; however, we decline to alter our decision in any respect.

With respect to the rejection of claims 6 and 7 under 35 U.S.C. § 112, first paragraph, the request states that we "erroneously overlooked evidence" of the acknowledged experts. Contrary to such an assertion, this evidence was treated in great detail on pages 12 through 23 of our decision.

With respect to our affirmance of claims 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Berg '448, the request states that we misapprehended the term "pointed" and urges that this limitation should be given its "normal and accustomed meaning." It is, of course, true that "when interpreting a claim, words of the claim are generally given

Appeal No. 97-3579
Application 90/002,797

their ordinary and accustomed meaning, **unless it appears from the specification or file history that they were used differently by the inventor**" (emphasis ours), **In re Paulsen**, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Here, as we carefully pointed out on pages 26 through 28 of our decision, it is readily apparent that the patent owner has used the word "pointed" in defining "pointed regions" and "pointed end portions" in other than its normal and accustomed meaning in the claims on appeal. As we specifically noted on pages 27 and 28 of our decision

it is apparent that the patent owner has used the "pointed regions" and "pointed end portions" in the sense that the strip material has been notched in such a manner so as to form interconnected notched or truncated portions of a reduced cross-sectional area relative to the remainder of the supply stock, which reduced cross-sectional area is of sufficient magnitude to provide the necessary strength to allow the strip to be coiled and thereafter fed to the insertion station. Since the reduced cross-sectional area has to be of sufficient magnitude to provide the necessary strength to hold the notched or truncated portions together when the supply stock is coiled and thereafter fed to an insertion station, these portions are of necessity "blunt" to some extent when the terminal pins are severed from the supply stock (note Figs. 6 and 7) [of the Zahn '964 patent].

Appeal No. 97-3579
Application 90/002,797

Figs. 2-4 of Berg '448 clearly show that the upper ends of the terminal pins 50 have been notched so as to provide a truncated end portion which has a significantly reduced cross-sectional area relative to the major portions of the supply stock.

Accordingly, consistent with the specification of the Zahn '964 patent, we remain of the opinion that the terminal pins 50 of Berg '448 can be considered to form "pointed regions" and "pointed end portions" as broadly set forth.

Also with respect to the rejection of claims 6 and 7 under § 102(b), the request on page 3 urges that the purpose of the end portions or regions in the strip of preformed terminal pins of the Zahn '964 patent is "to facilitate insertion into a substrate" whereas the end portions or regions in the strip of performed terminal pins of Berg '448 "allow easy insertion of the pin into an aperture [in a substrate]." We must point out, however, that independent claim 6 only broadly sets forth a coiled strip of electrically conductive material "for use in an apparatus for inserting electrical terminals in a substrate." Thus, there is no claim limitation which would

Appeal No. 97-3579
Application 90/002,797

preclude the arrangement of Berg '448 wherein the substrate has apertures and the terminal pins (which are preformed in a coiled strip) are inserted into the substrate via these apertures. It is well settled that features not claimed may not be relied upon in support of patentability. *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). Moreover, as we noted on page 29 of our decision

the particular manner in which an article or device is used cannot be relied on to distinguish structure over the prior art (*see, e.g., In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990)).

See also LaBounty Mfg. v. Int'l Trade Comm'n, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992) (in quoting with approval from *Dwight & Lloyd Sintering Co. v. Greenawalt*, 27 F.2d 823, 828 (2d Cir. 1928)):

The use for which the [anticipatory] apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent; the statute authorizes the patenting of machines, not of their uses. So far as we can see, the disclosed apparatus could be used for "sintering" without any change whatever, except to reverse the fans, a matter of operation.

Appeal No. 97-3579
Application 90/002,797

Here, in view of the truncated nature of the end portions of the terminal pins 50 of Berg '448, there is a sound basis to conclude that the terminal pins of Berg '448 are capable of being inserted into a substrate having no apertures therein. Whether the terminal pins of Berg '448 actually are or might be used in such a manner depends upon the performance or non-performance of a future act of use, rather than upon a structural distinction in the claims. Stated differently, the terminal pins of Berg '448 would not undergo a metamorphosis to new terminal pins simply because they were inserted into a substrate having no apertures therein. **See In re Pearson**, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) and **Ex parte Masham**, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

With respect to the § 103 rejections, the request states that we overlooked the testimony of the patent owner's experts who supported the position that no motivation existed to combine the teachings of Ragard and any of the secondary references. We must point out, however, that the testimony of the patent owner's experts with respect to this issue was thoroughly treated on pages 46 through 51 of our decision. As

Appeal No. 97-3579
Application 90/002,797

we noted on page 38 of our decision, this evidence is bottomed, for the most part, on the experts' assumption that the material from which the strip material is made is copper or a copper alloy (such as phosphor bronze) that is work-hardenable. As we also noted on page 38 of our decision, the evidence is therefore relevant, at the most, to claims 6 and 7 inasmuch as these are the only claims which require that the supply strip be formed of a copper alloy that is work-hardenable. Even with respect to claims 6 and 7, however, we remain of the opinion that the evidence supplied by the patent owner fails to establish

that it would have been unobvious to combine the teachings of the references in the manner proposed by the examiner because the artisan would have expected a strip of preformed terminal pins made of a copper alloy that is work hardenable to break if it was formed into a coil. In this regard, it should be noted that obviousness under § 103 does not require absolute predictability of success; instead, all that is required is there be a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). [Decision, pages 38 and 39.]

The patent owner's request is granted to the extent of reconsidering our decision, but is denied with respect to making any changes therein.

Appeal No. 97-3579
Application 90/002,797

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

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| HARRISON E. MCCANDLISH, Senior |) | |
| Administrative Patent Judge |) | |
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| JAMES M. MEISTER |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
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Appeal No. 97-3579
Application 90/002,797

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