The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERHARD FUCHS and RUPERT SPINDELBALKER

Appeal No. 2003-0421
Application No. 09/508,793

ON BRIEF

Before KIMLIN, GARRIS, and WALTZ, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 6, 7 and 9. Claims 10 and 11 are the only other claims pending in this application and stand allowed by the examiner (see the amendment dated Dec. 7, 2001, Paper No. 9, entered as noted in the Answer dated Apr. 4, 2002, Paper No. 13; see the Order Returning Undocketed Appeal to Examiner dated Aug. 6, 2002, Paper No. 16, and the Reply Brief dated Sep. 23, 2002, Paper No. 18). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a hinge between a side piece wire part 2 and an end piece wire part 1 of a frame of a pair of glasses, where one of the wire parts is bent in the form of a hairpin comprising two branches 4,5 connected by crosspiece 10 and bearing hinge body 6 between the two branches (Brief, pages 2-3). The hinge body 6 defines a coaxial peripheral groove 7, and the other wire part 1 has an end bent eyelet 8 having peripheral opening 12, where eyelet 8 elastically engages peripheral groove 7 and locks hinge body 6 in position, with crosspiece 10 gripping the outside of eyelet 8 (Brief, page 3).

Appellants state that "claim 6 is patentable, and claims 7 and 9 are allowable therewith." Brief, page 6. We construe this statement as meaning that the claims stand or fall together, especially since there are no specific arguments in the Brief or Reply Briefs for the separate patentability of claims 7 and 9. See 37 CFR § 1.192(c)(7)(2000). Accordingly, we select claim 6 from the grouping of claims and decide the ground of rejection in this appeal on the basis of this claim alone. *See In re McDaniel,* 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Representative independent claim 6 is reproduced below:

6. A hinge between a side piece and an end piece of a frame for a pair of glasses, the side piece and the end piece being parts made of wire, one of the wire parts being bent in the form of a hairpin comprised of two branches connected by a crosspiece and bearing a hinge body between the two branches, the hinge body having an axis about which the other wire part may be pivoted, and the hinge body defining a coaxial peripheral groove, and the other wire part has an end bent eyelet having a peripheral opening, the eyelet elastically engaging the peripheral groove and locking the hinge body in position, and the crosspiece gripping the outside of the eyelet.

The examiner has relied upon the following references as evidence of obviousness:

Nakanishi	5,570,492	Nov. 5, 1996
Teichmann (published German *Gebrauchsmuster*)[1]	9417374	Jan. 5, 1995

Claims 6, 7 and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Teichmann in view of Nakanishi (Answer, page 4).[2] We *affirm* the examiner's rejection essentially for the reasons stated in the Answer and those reasons set forth below.

OPINION

The examiner finds that Teichmann discloses a hinge between a side piece 12 and an end piece 3 of a frame for a pair of glasses, with the side and end pieces made of wire, and side piece 12 being bent in the form of a hairpin with two branches

[1]We rely upon and cite from a full English translation of this document, previously made of record.

[2]We refer to the Answer dated Sep. 6, 2002, Paper No. 17.

12, 12a connected by a crosspiece (Answer, page 4). The examiner further finds that the hinge body 8 is located between the two branches, the hinge body having an axis about which the other wire part may be pivoted, and the other wire part has an end bent eyelet 6 having a peripheral opening with the crosspiece gripping the outside of the eyelet (Answer, pages 4-5). The examiner recognizes that Teichmann fails to disclose a hinge body defining a coaxial peripheral groove and an eyelet elastically engaging the peripheral groove such as to lock the hinge body in position (Answer, page 5).

Therefore the examiner cites Nakanishi for the teaching of a hinge body 6 defining a coaxial peripheral groove 7 and an eyelet 10 elastically engaging the peripheral groove to lock the hinge body into position for the purpose of making a hinge for eyeglasses that requires no bolt (*id.*). From these findings, the examiner concludes that it would have been obvious to one having ordinary skill in this art to include a hinge body defining a coaxial peripheral groove and an eyelet elastically engaging the peripheral groove and locking the hinge body in position as taught by Nakanishi for the hinge in the eyeglass frame of Teichmann for the purpose of making a hinge for eyeglasses that requires no bolt (*id.*). We agree. Of course, if the hinge body

is composed of a smaller number of parts and is simpler in structure, the eyeglass units can be manufactured more easily and at a lower cost (Nakanishi, col. 2, l. 65-col. 3, l. 2).

Appellants do not contest the examiner's findings from Teichmann (Brief, page 8, first sentence). However, appellants argue that there is nothing in either reference to make it obvious to combine their teachings (Brief, page 7). Appellants argue that there is no reason for providing a peripheral groove in the bolt to secure the eyelet axially, but that such a peripheral groove would only complicate the insertion of bolt 8 in the eyelet because the diameter of the bolt would have to exceed the inner diameter of the eyelet (Brief, pages 7 and 9-10).

These arguments are not persuasive. As correctly stated by the examiner (Answer, pages 9-10), motivation for the combination of references has been identified as providing a hinge for eyeglasses which does not need any hinge bolts (see Nakanishi, abstract; col. 1, ll. 5-26; and col. 2, l. 65-col. 3, l. 2). Furthermore, as explained by the examiner (Answer, page 10), adding a peripheral groove to the hinge body of Teichmann would not affect or complicate the insertion of the hinge body into the eyelet.

Appellants argue that Nakanishi fails to teach an eyelet that “elastically engages” the peripheral groove as required by claim 6 on appeal (Brief, pages 6, 7, 8 and 9; Reply Brief, pages 1-2).[3] Appellants specifically argue that if temple 5 of Nakanishi were elastic, endpiece 8 would also be elastic which would make no sense (Brief, page 6). Appellants further argue that, if the arcuate member 10 elastically engages groove 7, such engagement would produce an undesired detachment when member 10 comes into contact with a stop (Brief, pages 7-8). Appellants argue that, if eyelet 10 were elastic, it would be forced out of groove 7 when its end 10a hits the stop formed by recess 12 (Brief, page 9, citing Figures 6 and 7 of Nakanishi). Finally, appellants argue that thin wire 10 of Nakanishi is “plastically deformed” but not elastic, according to the examiner’s own dictionary definition (Reply Brief, page 2).

Appellants’ arguments are not persuasive. During prosecution before the examiner, we must give the words of the claims the broadest reasonable meaning as they are ordinarily used, as understood by one of ordinary skill in the art taking into account any definitions or enlightenment from the

[3]We refer to and cite from the Reply Brief dated Sep. 23, 2002, Paper No. 18 (which is similar in substance to the Reply Brief dated June 11, 2002, Paper No. 14).

specification. *See In re Morris,* 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Appellants have not identified, and we do not find, any definition of "elastically engaging" in the original disclosure.[4] The term "elastic" is defined by the examiner as "easily resuming original shape after being stretched or expanded" or "flexible" (Answer, page 7, citing *The American Heritage Dictionary of the English Language,* 3rd ed., 1992). Appellants have not submitted any other definition of "elastic" but apparently accept the examiner's first definition (Reply Brief, page 2). We note that Nakanishi teaches that the material of the eyelet (or arcuate member 10) is made from a length of "thin wire" (Nakanishi, col. 2, ll. 18-21), which is the same as appellants' disclosure of "thin wire" (specification, page 6, l. 15-page 7, l. 3). Accordingly, to the extent that appellants' "thin wire" eyelet "elastically engages" the peripheral groove, we determine that the examiner has established a reasonable belief that the "thin wire" eyelet of Nakanishi has the same or similar "elastic engagement" with a peripheral groove, especially since the broadest reasonable interpretation of "elastically engaging" includes merely the *flexible* engagement of the eyelet

[4]We note that the term "elastically engage," or variations thereof, can be found in the specification at page 1, l. 8; page 7, l. 1 and l. 21; page 8, ll. 1-2; and page 9, ll. 12-13.

and the groove. *See In re Spada,* 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)(when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not); *and In re Best,* 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977)(where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty may, in fact, be an inherent characteristic of the prior art, it possesses authority to require applicant to prove that prior art does not possess this characteristic). We note that appellants have not disclosed any criticality to the type of "thin wire" used in their hinge, nor have they disclosed any treatment to produce a "thin wire" different than that of the prior art.

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness. Accordingly, we affirm the examiner's rejection of claim 6, and

claims 7 and 9 which stand or fall with claim 6, under section 103(a) over Teichmann in view of Nakanishi.

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

AFFIRMED

Edward C. Kimlin Administrative Patent Judge	)	
Bradley R. Garris Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Thomas A. Waltz Administrative Patent Judge	)	

TAW/tdl

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