

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL G. WEBSTER and JEFF J. ADAMS

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Appeal No. 2003-1336  
Application No. 09/642,398

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ON BRIEF

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Before ABRAMS, STAAB, and McQUADE, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 18-30, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

### BACKGROUND

The appellants' invention relates to a block system for holding a workpiece in a clamp. An understanding of the invention can be derived from a reading of exemplary claim 18, which has been reproduced below.

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

Hennessey	3,463,478	Aug. 26, 1969
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Claims 18-30 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 18-30 further stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hennessey.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 15) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 14) and the Reply Brief (Paper No. 16) 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 references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

*Claim 18*

18. A block system for a workpiece configured to fit inside a clamp, comprising:

a first block configured to contact and interpose between said clamp and said workpiece and having a first hole pattern, wherein said first hole pattern comprises at least one hole that is clear of said clamp when said first block is interposed between said clamp and said workpiece; and

a second block configured to contact and interpose between said clamp and said workpiece and having a second hole pattern differing from said first hole pattern by at least one hole.

*The Examiner's Rejection Under Section 112, Second Paragraph*

The second paragraph of 35 U.S.C. § 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 making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in 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.

On pages 3 and 4 of the Answer, the examiner has pointed out nine phrases in the claims which are considered to be indefinite for the reasons set forth therein. The appellants have argued that these phrases can be understood by one of ordinary skill in the art when considered in view of the specification, and have provided a detailed explanation in support of this conclusion for each of the phrases. We agree with the appellants' conclusions and with their reasoning on this issue. Several of the phrases found by the examiner to be indefinite have to do with the patterns of holes in the blocks and paths defined by the holes in the blocks. Others refer to relationships between the blocks and a workpiece when interposed between the clamp and the workpiece, and between the paths and features of the workpiece when so arranged. From our perspective, however, what is meant by each of the disputed phrases would be determinable by one of ordinary skill in the art from a review of the specification and drawings. The examiner seems to be suggesting that the disputed language is too broad, and therefore is indefinite. However, just because a claim is broad does not mean that it is indefinite. See for example, In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

The rejection under Section 112, second paragraph, is not sustained.

*The Examiner's Rejection Under Section 102*

Claims 18-30 stand rejected as being anticipated by Hennessey. Anticipation is established only when a single prior art reference discloses, either expressly or under

the principles of inherency, each and every element of the claimed invention. See, for example, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does it require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the 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).

Like the appellants' invention, Hennessey is directed to a block system configured for installation between a clamping device and a workpiece (Figure 4). Using the language of claim 18 as a guide, Hennessey discloses a first block 20 (Figure 1) configured for contacting and being interposed between a clamp J2 and a workpiece W. First block 20 has a first hole pattern 26, 27, 28 that comprises at least one hole capable of being positioned clear of a clamp when interposed between a clamp and a workpiece, for example, when used with a clamp having a height or length less than that of the block. Hennessey further discloses a second block (Figure 11) configured to contact and interpose between a clamp and a workpiece, the second block having a

hole pattern different than the first block. Thus, it is our opinion that all of the structural limitations of the blocks read on Hennessey. Claim 18 therefore is anticipated by the reference and we will sustain this rejection.

We are not persuaded that this decision is incorrect by the appellants' arguments, which are directed to the relationship between the blocks and the clamp and workpiece, whereas the claim is directed only to a system of blocks and not to the combination of blocks and a clamp, or to blocks, a clamp and a workpiece. Arguments predicated upon limitations that are not present in the claims are not persuasive. See In re Self, 671 F.2d 1344, 1350, 213 USPQ 1, 5 (CCPA 1982).

Since the appellants have not argued the separate patentability of claims 19-22, they fall with claim 18, from which they depend. See 37 C.F.R. 1.192(c)(7) and Section 1206 of the Manual of Patent Examining Procedure.

Independent claim 23 recites the invention in terms of the first block defining a first hole pattern "that is configured to define at least one unobstructed path from said workpiece, through said first block, to a point away from said clamp." It is our opinion that the blocks disclosed in Hennessey are capable of being aligned in such a fashion with respect to a clamp and a workpiece as to meet this requirement, and we therefore will sustain this rejection.

In view of the fact that the separate patentability of claim 24, which depends from claim 23, has not been argued, the rejection of claim 24 also is sustained.

Independent claim 25 recites that the hole pattern is configured to define “a clear path from beyond said clamp to said workpiece.” On the basis of the reasoning we applied above with regard to claim 23, the Section 102 rejection of claim 25 also is sustained.

Claim 26 requires that the hole pattern in the first block include “at least one channel in a surface of said first block.” We agree with the appellants that this feature is not disclosed in Hennessey. This being the case, Hennessey does not anticipate the subject matter of claim 26, and the rejection of claim 26 and dependent claim 27 cannot be sustained.

As for independent claim 28, it is our view that the hole pattern of Hennessey’s blocks are configured in such a fashion as to be capable of receiving a portion of a workpiece therein. The only argument advanced by the appellants concerns this feature, and we are not persuaded by it that the rejection shouldn’t be sustained.

Independent claim 29 requires that the first hole pattern include at least one hole “configured to align with a fastening feature of the workpiece,” and independent claim 30 that it align with “a sealing feature of a workpiece.” Again, we are of the opinion that the blocks disclosed by Hennessey have the capability to be so aligned, and we thus will sustain the Section 102 rejection of both of these claims.

In arriving at the foregoing conclusions, we have carefully considered all of the appellants’ arguments as they might apply to the claims the rejections of which we have

sustained. However, we remain unconvinced that these rejections should not be sustained. Our position with respect to these arguments should be apparent from the foregoing explanations.

CONCLUSION

The rejection of claims 18-30 under 35 U.S.C. § 112, second paragraph, is not sustained.

The rejection of claims 18-25 and 28-30 under 35 U.S.C. § 102(b) as being anticipated by Hennessey is sustained.

The rejection of claims 26 and 27 under 35 U.S.C. § 102(b) as being anticipated by Hennessey 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

NEAL E. ABRAMS  
Administrative Patent Judge

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) BOARD OF PATENT

LAWRENCE J. STAAB  
Administrative Patent Judge

) APPEALS  
) AND  
) INTERFERENCES

JOHN P. McQUADE  
Administrative Patent Judge

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