

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LORONZO H. THOMSON, BRIAN THOMSON,
And MARK P. MCJUNKIN

Appeal No. 2004-1383
Application No. 09/658,389

ON BRIEF

Before GARRIS, WARREN, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 1 through 6, 10, 12, 13, 15, 17, 18, 20 through 22, 24 through 27, and 29 through 31 (final Office action mailed May 1, 2003, paper 20) in

the above-identified application.¹ Claims 7, 11, 14, 16, 23, 32, and 39 through 76 are also pending but remain withdrawn from further consideration pursuant to 37 CFR § 1.142(b)(2003) (effective Dec. 22, 1959).

The subject matter on appeal relates to a bicycle stem for connecting a bicycle handlebar to a bicycle steering tube. According to the present specification (page 4, line 4 to page 5, line 9), the present invention includes a fastener receiving passageway that is offset in relation to the axis of an imaginary cylinder defined by certain portions of steering tube clamp members and that this offset relation "allows the clamp to be more effective and rugged" (e.g., "a greater extent of the steering tube can be engaged"). Further details of this appealed subject matter are recited in representative claims 1, 4, and 15 reproduced below:

1. A bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising:
 - a body portion having opposing first and second ends;

¹ The examiner states that the final rejection under 35 U.S.C. § 112, ¶1, of claims 8, 9, 19, 28, and 33 through 38 as set forth in the final Office action has been withdrawn. (Substitute examiner's answer mailed Apr. 2, 2004, paper 25, hereinafter "answer," p. 3.) Accordingly, this issue is not before us.

a handlebar clamping portion connected to the first end of said body portion;

a steering tube clamping portion connected to the second end of said body portion and having a tubular shape defining a steering tube receiving passageway therethrough, said steering tube clamping portion also having a clamp receiving passageway therein transverse to the steering tube receiving passageway and in communication therewith;

a steering tube clamp in the clamp receiving passageway and comprising

a pair of cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube, each clamp member also having at least one fastener receiving passageway therein offset a predetermined distance from an axis defined by the imaginary cylinder, and

at least one fastener extending between corresponding fastener receiving passageways of said pair of clamp members for urging said clamp members together to engage the steering tube and thereby secure the bicycle stem to the steering tube.

4. A bicycle stem according to Claim 1 wherein said at least one fastener comprises a plurality of fasteners.

15. A bicycle stem according to Claim 1 further comprising a handlebar clamping member cooperating with said handlebar clamping portion to clamp the bicycle handlebar therebetween.

The examiner relies on the following prior art references as evidence of unpatentability:

Cheng	5,477,747	Dec. 26, 1995
Lai	5,509,328	Apr. 23, 1996
Roddy	5,881,606	Mar. 16, 1999 (filed Feb. 26, 1997)

The claims on appeal stand rejected as follows:

- I. claims 1 through 3, 10, 12, 13, 17, 20, and 21 under 35 U.S.C. § 102(b) as anticipated by Cheng (answer, page 3; final Office action, pages 5-6);
- II. claims 4 through 6, 18, 24 through 27, and 29 through 31 under 35 U.S.C. § 103(a) as unpatentable over Cheng in view of Roddy (answer, page 3; final Office action, page 7);
- III. claims 15 and 22 under 35 U.S.C. § 103(a) as unpatentable over Cheng in view of Lai (answer, page 3; final Office action, pages 7-8); and
- IV. provisionally, claims 1 through 3, 10, 12, 13, 15, 17, and 20 through 22 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 through 27 of copending application 09/658,509 in view of Cheng (answer, page 3; final Office action, pages 3 through 5).

We affirm all four rejections. Because we are in substantial agreement with the examiner's factual findings and

legal conclusions, we adopt them as our own and add the following comments for emphasis.²

I. 35 U.S.C. § 102(b): Claims 1-3, 10, 12, 13, 17, 20, & 21

To aid us in determining whether the examiner applied the prior art correctly against the appealed claims, we must first consider the scope and meaning of certain terms that appear in representative claim 1. Gechter v. Davidson, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). It is well settled that, in proceedings before the United States Patent and Trademark Office (PTO), claims in an application are to be given their broadest reasonable interpretation, taking into account the written description found in the specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d

² The appellants submit: "For the purposes of addressing the rejections under 35 U.S.C. §103 and obviousness-type double patenting, the grouping of the claims is: Claims 1-6, 8-10, 12, 13, 15, 17-22, 24-31 and 33-38 stand or fall together as a group." (Appeal brief filed Oct. 7, 2003, paper 22, p. 5.) Accordingly, for rejection II, we select claim 4 as representative; for rejection III, we select claim 15 as representative; and for rejection IV, we select claim 1 as representative. As to rejection I, the appellants do not identify any claim grouping. Nor do they argue any particular claim. We therefore confine our discussion of rejection I to claim 1. 37 CFR § 1.192(c)(7)(2003)(effective Apr. 21, 1995).

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319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow."); In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984)("The PTO broadly interprets claims during examination of a patent application since the applicant may 'amend his claim to obtain protection commensurate with his actual contribution to the art.'")(quoting In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)).

In this case, the examiner found that the specification does not contain any special definitions for the terms "imaginary cylinder" and "axis" recited in appealed claim 1. Absent any special definitions, the examiner concluded that these terms should be given their broadest reasonable meanings as they would be understood by one skilled in the relevant art. (Answer, page 4.) Relying on a dictionary definition, the examiner determined that the term "cylinder" is not limited to a right circular cylinder (i.e., a cylinder with two circular bases) but instead reads on any "surface traced by a straight line moving parallel to a fixed straight line and intersecting a

fixed planar closed curve.'"³ (Id.) Regarding the term "axis," the examiner determined that this term must be broadly interpreted to mean any axis. (Id.)

Cheng describes a bicycle pivot arm assembly (i.e., a bicycle stem) for securing a handlebar to a steering tube. (Column 1, lines 29-31; Figure 1.) Cheng teaches that the pivot arm assembly comprises a shank 20 (i.e., a body portion) having opposing first and second ends, a connector 21 formed on one end of the pivot arm assembly for engaging and supporting a handlebar (i.e., a handlebar clamping portion), and, on the other end of the pivot arm assembly, a sleeve 22 having a cylindrical opening 23 for engaging a steering tube (i.e., a steering tube clamping portion). (Column 2, lines 24-34.) As seen in Cheng's Figures 1 and 2, the reference teaches that the sleeve 22 and the shank 20 include an aperture 24 transverse to the steering tube for receiving two recessed clamping members 28, which the examiner determined to be in "side-by-side" relation to each other, and a fastener 32. (Column 2, lines 36-67.) Cheng's Figure 2 further shows that the clamping members 28 include a threaded hole 30 and an enlarged recess 300,

³ See also Webster's New World College Dictionary 360 (1999), copy attached.

respectively. Additionally, the examiner found that the outer surface portions of Cheng's clamping members 28 define imaginary cylinders having cross-sections depicted at page 6 of the answer.

Given the shapes of the imaginary cylinders defined by the outer surface portions of Cheng's clamping members 28, we determine that Cheng's threaded hole 30 or enlarged recess 300 is necessarily offset with respect to the symmetrical axis of the imaginary cylinders. Thus, Cheng describes, either expressly or inherently, each and every limitation of the invention recited in appealed claim 1. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

The appellants urge that Cheng's clamping members 28 include shoulders 31 for accommodating partition member 26 with stop members 27 and thus, in reality, threaded hole 30 as shown in Figure 2 is not offset with respect to an axis of an imaginary cylinder defined by either the large diameter portion or the reduced diameter portion of clamping members 28. (Appeal brief, pages 10-12.) This argument is unpersuasive for reasons already discussed above. Specifically, the recited term "imaginary cylinder" defined by "outer surface portions" reads

on imaginary cylinders having the cross-sections depicted on page 6 of the answer.

For these reasons, we uphold the examiner's rejection on this ground.

II. 35 U.S.C. § 103(a): Claims 4-6, 18, 24-27, & 29-31

The appellants do not dispute the examiner's determination that there is some motivation or suggestion to combine Cheng and Roddy. Rather, the appellants contend that "nothing in the Roddy patent makes up for the deficiencies pointed out above with respect to the Cheng patent." (Appeal brief, page 12.) It is clear, therefore, that the appellants are relying on the same arguments as they did for appealed claim 1.

As we discussed above, the appellants' arguments regarding Cheng have no merit relative to the broad language recited in appealed claim 1. Accordingly, we affirm this rejection.

III. 35 U.S.C. § 103(a): Claims 15 and 22

Again, the appellants rely on the same arguments as they did for appealed claim 1. Accordingly, we affirm for the same reasons stated above.

IV. Provisional Obviousness-Type Double Patenting

The judicially-created doctrine of obviousness-type double patenting prohibits a party from obtaining an extension of the

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right to exclude granted through claims in a later patent that are not patentably distinct from claims in a commonly-owned earlier patent. Eli Lilly & Co. v. Barr Laboratories, Inc., 251 F.3d 955, 967, 58 USPQ2d 1869, 1877-78 (Fed. Cir. 2001)(citing In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985)). According to our reviewing court, "a double patenting rejection of the obviousness type rejection is 'analogous to a [failure to meet] the nonobviousness requirement of 35 U.S.C. § 103,' except that the patent document underlying the double patenting rejection is not considered prior art." In re Longi, 759 F.2d at 892 n.4, 225 USPQ at 648 n.4.

The claims of copending application 09/658,509 do not disclose the clamp members having at least one offset fastener receiving passageway as recited in the appealed claims. To account for this difference, the examiner relies on Cheng. (Final Office action, pages 4-5.) According to the examiner (id. at page 5), "[i]t would have been obvious to a person of ordinary skill in the art . . . to modify the clamping device of . . . copending Application No. 09/658,509 with the pair clamp device of Cheng in order to provide a tighter and more versatile clamping device so that the operation of the bicycle is not compromised."

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The appellants argue that Cheng does not disclose the offset fastener receiving passageway limitation of the appealed claims. This argument is incorrect, because Cheng does disclose each and every limitation of appealed claim 1, as we discussed above.

Accordingly, we affirm this rejection as well.

Summary

In summary, we affirm the examiner's rejections under: (i) 35 U.S.C. § 102(b) of appealed claims 1 through 3, 10, 12, 13, 17, 20, and 21 as anticipated by Cheng; (ii) 35 U.S.C. § 103(a) of appealed claims 4 through 6, 18, 24 through 27, and 29 through 31 as unpatentable over Cheng in view of Roddy; (iii) 35 U.S.C. § 103(a) of appealed claims 15 and 22 as unpatentable over Cheng in view of Lai; and (iv) the judicially created doctrine of obviousness-type double patenting of appealed claims 1 through 3, 10, 12, 13, 15, 17, and 20 through 22 as unpatentable over claims 1 through 27 of copending application 09/658,509 in view of Cheng.

The decision of the examiner is affirmed.

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

AFFIRMED

Bradley R. Garris)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Charles F. Warren)	
Administrative Patent Judge)	APPEALS AND
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Romulo H. Delmendo)	
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