

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

## UNITED STATES PATENT AND TRADEMARK OFFICE

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### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte PIETER MARTIN LUGT, EUSTHATIOS IOANNIDES,  
INGRID VICTORIA WIKSTROM, JOHN HOWARD TRIPP,  
MARIE-LAURE DUMONT, ANTONIO GABELLI and  
BENOIT CLEMENT JACOD

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Appeal No. 2006-0833  
Application No. 10/297,832

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ON BRIEF

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Before CRAWFORD, BAHR and LEVY, Administrative Patent Judges.  
CRAWFORD, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 to 10. Claim 2 has been cancelled and claim 11 is objected to.

The appellants' invention relates to a rolling element bearing (specification, p. 1).

A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

#### THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Akamatsu et al. (Akamatsu '947)	5,642,947	Jul. 1, 1997
Akamatsu et al. (Akamatsu '672)	5,967,672	Oct. 19, 1999

#### THE REJECTIONS

Claims 1, 3, 5, 6, 8, and 9 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Akamatsu '947.

Claims 4 and 7 stand rejected under 35 U.S.C. §102(a) as being anticipated by Akamatsu '672.

Claim 10 stands rejected under 35 U.S.C. §103 as being unpatentable over Akamatsu '947 and further in view of engineering design choice.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed August 25, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed June 6, 2005) and reply brief (filed October 25, 2005) 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.

We turn first to the examiner's rejection of claims 1, 3, 5, 6, 8 and 9 under 35 U.S.C. §102 as being unpatentable over Akamatsu '947. The examiner finds that Akamatsu '947 discloses:

"rolling element [2] bearing" with an [axially] inner [race] ring (3) and an outer [race] ring (1), the surface of each rolling element having "minute recesses" or grooves (5) randomly oriented and thus isotropic. Lubricant is employed (col. 4, lines 19-28). [Answer at page 3].

The examiner, reasons that Akamatsu '947 need not expressly disclose the displacement of the meniscus or that the lubricant meniscus forms a non-zero pressure gradient. The examiner states:

There is reason to believe, based on the similarity of structure, that the functional limitation(s) of displacement of the meniscus, non-zero pressure gradient, etc. may be inherent characteristic(s) of Akamatsu '947. . . [Answer at page 4][emphasis added].

The examiner is correct that a prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. See Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed. Cir. 1985). Rather, if a claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding

anticipation. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d at 631-33, 2 USPQ2d at 1052-54.

However, it is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (F.3d Cir. 1991); Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990). Inherency, however, can 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. Id at 1269, 20 USPQ2d at 1749 (quoting In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

In the instant case the examiner has not established that the displacement of the meniscus layer or that a non-zero pressure gradient between the meniscus and the raceway necessarily occurs in the Akamatsu '947 reference. Therefore, the examiner has not established a *prima facie* case of anticipation and thus we will not sustain this rejection.

We will likewise not sustain the examiner's rejection of claims 4 and 7 under 35 U.S.C. § 102(b) as being anticipated by Akamatsu '672. Claims 4 and 7 depend from claim 1 and thus include the subject matter related to the displacement of the

meniscus and the formation of a non-zero pressure gradient between the meniscus layer and the raceway. The examiner, as in the above discussed rejection has not established that these features of claim 1 necessarily occur in the Akamatsu '672 (see answer at page 4).

In regard to the rejection of claim 10 under 35 U.S.C. §103 as being unpatentable over Akamatsu '947 in view of engineering design choice, we note that claim 10 is dependent on claim 1 and thus includes the subject matter related to the meniscus displacement and the formation of the non-zero pressure gradient which is not disclosed, or suggested for that matter, in the Akamatsu '947 reference. As such, we will not sustain this rejection for the same reasons discussed above in regard to the rejection of claim 1 under 35 U.S.C. § 102(a).

The decision of the examiner is reversed.

REVERSED

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