

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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Appeal No. 2006-1294  
Application No. 10/430,963

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ON BRIEF

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Before PATE, HORNER and FETTING, Administrative Patent Judges.  
PATE, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-3, 27, 28 and 31-35 and the examiner's refusal to allow claims 29 and 39 amended after final rejection. Claims 6-8 and 30 are allowed. These are all the claims remaining in the application.

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The claimed invention is a protective guard for a coupling between a pair of rotating shaft components. The guard has first and second halves that are connected with a hinge. Extending from both sides of the protective housing are sleeves with cut lines so that they may be trimmed to provide the length necessary to surround the rotating shaft. The claimed invention may be further understood with reference to the appealed claims appended to appellant's brief.

The references of record relied upon by the examiner as evidence of anticipation and obviousness are:

Pelton	1,192,342	Jul. 25, 1916
Hogan	4,211,519	Jul. 8, 1980
Powell	6,190,261	Feb. 20, 2001

Claims 1 through 3, 29, 31, 35 and 39 stand rejected under 35 U.S.C. § 102 as anticipated by Pelton.

Claims 1 through 3, 27, 29, 31 through 35 and 39 stand rejected under 35 U.S.C. § 102 as anticipated by Hogan.

Claims 31 through 35 and 39 stand rejected under 35 U.S.C. § 102 as anticipated by Powell.

Claim 28 stands rejected under 35 U.S.C. § 103 as unpatentable over Pelton in view of Powell.

Claims 29, 33 and 39 stand rejected under 35 U.S.C. § 112 second paragraph as indefinite.

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## ISSUES

Appellant argues that Pelton does not disclose appellant's claimed sleeve portions that can be trimmed. With respect to Hogan, appellant argues that Hogan does not show a coupling connection because Hogan does not have a pair of rotating shafts. With respect to Powell, appellant argues that Powell does not show a pivotal or hinge connection joining the two first and second guard portions. With respect to the obviousness rejection of claim 28 appellant argues that the claimed features are not found in Pelton and Powell, and additionally argues that there is no motivation to modify Pelton in the manner suggested by the examiner. With respect to the rejections under § 112, second paragraph, appellant argues that the term "trim line" does not render the claims indefinite. The appellant further argues that claim 33 is not indefinite as to whether the base member is part of the claimed combination or not.

Therefore, the issues for our decision on appeal are: whether Pelton anticipates claims 1 through 3, 29, 31, 35 and 39; whether Hogan anticipates claims 1 through 3, 27, 29, 31 though 35 and 39; whether Powell anticipates claims 31 through 35 and 39; whether Pelton and Powell render unpatentable claim 28; and whether claims 29, 33 and 39 are indefinite under the purview of 35 U.S.C. § 112 second paragraph.

## FINDINGS OF FACT

Pelton discloses a safety device to be used on revolving shafts or machinery to prevent contact by workers and to protect the coupling joint. Pelton has a first guard half 1 and a second guard half 2 pivotally connected by hinge connector 5 and 6. The first guard half and the second guard half have

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sleeve portions, bushings 18, that extend outwardly in opposite directions from the first central body. The bushings 18 fit on the rotating shaft and the guard assembly of Pelton is designed to rotate with the shafts and coupling. We further note that the half bushings are interchangeable to fit any size of shafts. See Pelton at line 74-76.

Hogan discloses a pair of peristaltic pumps for dispensing condiments. The pump housing 20 is formed of two identical halves 20a and 20b integrally connected to each other through a connecting hinge bolt 24. The first and second parts 20a and 20b have outwardly extending sleeve portions 66a and 66b. It is further noted that shaft 50 on which roller 56 is mounted includes transverse drive slot 204 which is adapted to receive a drive key of an additional peristaltic pump. See Figure 8.

Powell discloses a pump assembly shaft guard for a coupling 18 between a motor 12 and pump 14. The first and second guard halves of Powell are not hinged but are fastened with conventional fasteners at horizontal flanges. Powell discloses ventilation port 28 and support legs 50 that fasten the assembled guard assembly to a base member 60. Powell further discloses that stepped-down sleeves 26 may be trimmed down to fit the length of the drive shaft 16 and match the spacing between the motor 12 and the pump mechanism 14. See col. 4, lines 5-8.

#### PRINCIPLES OF LAW

The prior art may anticipate a claimed invention, and thereby render it non-novel, either expressly or inherently. In re Cruciferous Sprout Litig., 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002), cert. denied, 538 U.S.

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907(2003). Express anticipation occurs when the prior art expressly discloses each limitation (i.e., each element) of a claim. *Id.* In addition, it is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. @ *Id.*

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the pertinent art. In re Kahn, 441 F.3d 977, 985, 78 USPQ2d 1329, 1334-35 (Fed. Cir. 2006)(citing 35 U.S.C. § 103(a) (2000)); Graham v. John Deere Co., 383 U.S. 1, 13-14 ,148 USPQ 459, 467 (1966). The ultimate determination of whether an invention would have been obvious is a legal conclusion based on underlying findings of fact. *Id.* (citing In re Dembiczak, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999)).

In assessing whether subject matter would have been non-obvious under §103, the Board follows the guidance of the Supreme Court in Graham v. John Deere Co. Kahn 441 F.3d at 985, 78 USPQ2d at 1335. The Board determines ““the scope and content of the prior art,”” ascertains ““the differences between the prior art and the claims at issue,”” and resolves ““the level of ordinary skill in the pertinent art.”” *Id.* (citing Dann v. Johnston, 425 U.S. 219, 226, 189 USPQ 257, 261 (1976)) (quoting Graham, 383 U.S. at 17, 148 USPQ at 467). Against this background, the Board determines whether the subject matter would have been obvious to a person of ordinary skill in the art at the time of the asserted invention. *Id.* (citing Graham, 383 U.S. at 17, 148 USPQ 467). In making this determination,

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the Board can assess evidence related to secondary indicia of non-obviousness like "commercial success, long felt but unresolved needs, failure of others, etc." *Id.*, 383 U.S. at 17-18, 148 USPQ at 1335; *accord In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). "We have explained that '[t]o reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness.... On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.' " *Id.* (quoting *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456).

Section 112, second paragraph, is satisfied if a person skilled in the field of the invention would reasonably understand the claim when read in the context of the specification. *Marley Mouldings Ltd. v Mikron Industries, Inc.*, 417 F.3d 1356, 1359, 75 USPQ2d 1954, 1956 (Fed. Cir. 2005) (*citing Union Pac. Res. Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692, 57 USPQ2d 1293, 1297 (Fed. Cir. 2001) (the definiteness requirement set forth in '112, & 2 "focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification")); *Miles Labs., Inc. v. Shandon*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993) (if the claims "reasonably apprise those skilled in the art of the scope of the invention, ' 112 demands no more"); *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971) (the indefiniteness inquiry asks whether the claims "circumscribe a particular area with a reasonable degree of precision and particularity").

## ANALYSIS

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With respect to the anticipation rejection based on Pelton these rejections are not sustained. Although Pelton does state that the bushings 18 are interchangeable, we agree with appellant that this does not necessarily mean that they are adjustable in length. We deem it far more likely that the adjustability is to fit shafts of different diameters. With respect to claim 31 we note that Pelton is designed to rotate with the shafts and the coupling. Therefore there is no base mounting member disclosed in Pelton.

Turning to the anticipation rejection with respect to Hogan we agree with the appellant that the sleeves 66a and 66b of Hogan do not appear to be adjustable. Claims 1 through 3, 27 and 29 do not lack novelty over Hogan. With respect to claim 31 we note that the two halves of Hogan are connected to base member 14 via base mount portion 60 on the two upper quadrants of the housings of Hogan. Appellant argues that Hogan is not a coupling. As noted above, however, as clearly illustrated in Figure 8, one pump of Hogan can be used to couple the motor of Hogan to a second pump installed outboard of first pump 12. Therefore it is our finding that claim 31 lacks novelty over the Hogan reference. For claims 32-34 note base mount portion 60 is integrally molded to the housing structure. Accordingly, it is our finding that claims 31-34 lack novelty over the Hogan reference. With respect to claim 35 Hogan does not disclose an elongated opening, and therefore claims 35 and 39 do not lack novelty over Hogan.

We also do not affirm the anticipation rejection of claims 31-35 and 39 as anticipated by Powell. Claim 31 requires a pivotal connection between a first guard portion and second portion. The examiner points to slots 38, 48 which provide an opening for the tab on leg 50. However this is not a pivotal connection

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between the two halves of the guard assembly. Claims 31-35 and 39 do not lack novelty over Powell.

We will affirm the rejection of claim 28 as unpatentable over Pelton in view of Powell. As noted above Pelton discloses two pivoting guard portions surrounding a coupling. Powell discloses sleeve 26 which can be trimmed to fit the length of the shaft and also discloses ventilation port 28. It would have been obvious at the time the invention was made to provide Powell with a pivoting coupling in the nature of a hinge as taught by Pelton. The motivation for combining the disclosures is found in the convenience the hinge connection provides with respect to access and servicing the protected coupling.

Turning to the rejections under 35 U.S.C. § 112 second paragraph we will not affirm the rejection of claim 29 and 39. In our view, appellant's claim language referring to "trim lines" would be clear and understandable to one of ordinary skill. We will, however, affirm the § 112 second paragraph rejection of claim 33, for the reasons given by the examiner. It is not clear to us whether the base member claimed in claim 33 is part of the claimed guard assembly of the independent claim 31.

#### CONCLUSIONS

The examiner has not sustained his burden of showing that claims 1-3, 29, 31 through 35 and 39 are anticipated by Pelton.

The examiner has not sustained his burden of showing that claims 1-3, 27, 29, 35 and 39 are anticipated by Hogan. The examiner has sustained his burden of showing that claims 31 through 34 are anticipated by Hogan.

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The examiner has not sustained his burden of showing that claims 31-35 and 39 are anticipated by Powell.

The examiner has sustained his burden of showing that claim 28 is unpatentable over Pelton and Powell.

The examiner has not sustained his burden of showing that claims 29 and 39 are indefinite. Examiner has sustained his burden of showing that claim 33 is indefinite.

ORDER

The rejections of claims 1-3, 27, 29, 35 and 39 on the ground of lack of novelty are not sustained.

The rejections of claim 31 through 34 under § 102 and claim 28 under § 103 are sustained.

The rejections of claims 29 and 39 under 35 U.S.C. § 112 second paragraph are not sustained.

The rejection of claim 33 under 35 U.S.C. § 112 second paragraph is sustained.

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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)(1)(vii).

AFFIRMED-IN-PART

WILLIAM F. PATE, III Administrative Patent Judge	) ) ) ) ) )	) BOARD OF PATENT
LINDA E. HORNER Administrative Patent Judge	) ) )	APPEALS AND INTERFERENCES
ANTON W. FETTING Administrative Patent Judge	) )	

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