

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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HALL VIRGIL JR., MERLE D. SEARS, and
MICHAEL L. BROWN

Appeal 2006-3059
Application 10/293,725
Technology Center 3600

Decided: May 14, 2007

Before MURRIEL E. CRAWFORD, JENNIFER D. BAHR, and
LINDA E. HORNER, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Hall Virgil Jr. et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-3, 6, and 7, the only pending claims. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

Appellants invented a mounting plate to which articles are secured by threaded fasteners, the mounting plate having improved impact load resistance properties (Specification [0001]). Claim 1, which is representative of the claimed invention, reads as follows:

1. Mounting apparatus for supportively mounting parts that includes:
 - a mounting plate having a flat top surface and a bottom surface and at least one hole passing through said plate;
 - a threaded fastener to be threadably received in said hole;
 - an endless depression formed in said plate that surrounds said hole, said depression protruding upwardly from the top surface of the plate; and
 - said depression having a size and a shape such that the magnitude of stresses resulting from impact loads about the at least one hole are reduced to a level below the yield strength of the plate
- wherein said plate is fabricated of sheet metal and the threaded fastener is a self tapping or thread forming screw that forms a thread in said hole upon entry therein.

Appellants seek review of the Examiner's rejection of claims 1-3, 6, and 7 under 35 U.S.C. § 102(b) as being anticipated by Hasan (US 5,908,278, issued June 1, 1999). Appellants also seek review of the Examiner's objection to the drawings and Specification. The issue of compliance with 37 C.F.R. § 1.121(d) relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002, 1002.02(c), and 1201. Accordingly, we will not review the first issue raised by Appellants on page 2 of the Appeal Brief.

The Examiner provides reasoning in support of the rejection in the Answer (mailed June 5, 2006). Appellants present opposing arguments in the Appeal Brief (filed March 16, 2006) and Reply Brief (filed June 26, 2006).

OPINION

We are presented with two issues in this appeal. The first issue is whether Appellants have demonstrated that the Examiner erred in rejecting claims 1-3 and 6 as anticipated by Hasan. As Appellants have not separately argued the patentability of claims 2, 3, and 6 apart from claim 1, these claims stand or fall with representative claim 1 (37 C.F.R.

§ 41.37(c)(1)(vii)). The second issue is whether Appellants have demonstrated that the Examiner erred in rejecting claim 7 as anticipated by Hasan. Specifically, Appellants contend that Hasan's fastener 24 does not form a thread in the hole (aperture 22) of the plate 10 upon entry therein, as required by claim 1 (Appeal Br. 3-4). Appellants further contend that "the structure of Hasan cannot reasonably be constructed as having the flat section 12 immediately adjacent a lip surrounding the hole, since the conical shaped depression 20 is disposed between the flat 12 and the lips" so as to meet the limitation in claim 7 that "said flat section is immediately adjacent a lip surrounding said at least one hole" (Appeal Br. 4-5).

We find that Hasan supports the Examiner's position that Hasan's fastener 24 is a self tapping or thread forming screw that forms a thread in the aperture 22 of Hasan's plate 10 upon entry therein (Answer 3 and 4-5). Specifically, Hasan teaches:

1. In the preferred embodiment, the fastener 24 has a thread diameter T of 0.212 inch, which is greater than the aperture 22 diameter “in the general range of 0.200 inch” (Hasan, col. 3, l. 67 to col. 4, l. 3).
2. The tip 32 of fastener 24 is of a self-tapping configuration (Hasan, col. 4, ll. 13-14).
3. The sleeve 38 circumscribing the aperture 22 depends from the underside 36 of the plate 10 a sufficient distance to receive and maintain the fastener 24 perpendicular to the plate 10 and, in particular, has a length L “dimensioned to span approximately at least one [thread] pitch of the fastener” (Hasan, col. 4, ll. 27-32 and 46-52).
4. The fastener 24 “threadably engages the aperture 22” (Hasan, col. 4, l. 59).
5. Hasan’s “plate is preferably provided to the installer as an assembly with the fastener threaded into the hole in the plate” (Hasan, col. 2, ll. 51-53).

Appellants theorize that, rather than forming threads, “when the slightly larger diameter screw passes through the hole of the relatively lightweight material of the plate 10, the diameter of the hole in the plate is expanded to accommodate the slightly larger diameter screw” (Appeal Br. 3). This theory is not supported by evidence and is expressly belied by the teachings of Hasan cited above.

Appellants additionally argue, in essence, that Hasan’s teaching that the sleeve 38 maintains the fastener 24 perpendicular to the sleeve “without shaving, penetrating or otherwise damaging the protective anti-corrosion coating of the fastener” (Hasan, col. 4, ll. 57-59) indicates that the fastener does not form a thread (Appeal Br. 3). Hasan is very clear, as discussed

above, that the thread diameter of fastener 24 is slightly larger than the aperture diameter and that the fastener threadably engages the aperture. That such engagement occurs without shaving, penetrating, or otherwise damaging the anti-corrosion coating on the fastener appears to be a consequence of providing a depending sleeve 38, which does not present the sharp edges of a hole (Hasan, col. 1, ll. 62-65), to engage the threads of the fastener (Hasan, col. 2, ll. 45-51).

In light of the above, Appellants have not demonstrated that the Examiner erred in rejecting claim 1 as anticipated by Hasan. The rejection of claim 1, and claims 2, 3, and 6 depending from claim 1, is sustained.

Turning now to claim 7, the Examiner contends that, in the illustrated embodiment of Hasan's plate, the conically-shaped depression 20 and sleeve 38 together respond to the "lip" recited in the claim and points out that the flat section of the main body 12 of the plate is immediately adjacent such lip (Answer 5). In the alternative, the Examiner refers to Hasan's teaching that, "[i]f other fasteners are used, such as those having flat heads, the flat head is preferably located on the main body 12, and the depression 20 is not required" (Hasan, col. 3, ll. 57-60), in which case the sleeve 38 would respond to the recited "lip," with the flat section of the main body 12 of the plate being immediately adjacent such lip (Answer 5-6). Both positions are well taken.

We determine the scope of the claims in patent applications "not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc)

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(quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)).

Appellants' Specification uses the term "lip" only on page 2, in paragraph [0007], describing it merely as protruding structure. Nothing in this brief mention of the term "lip" indicates that it is used in the context of Appellants' invention in any manner other than its ordinary and customary definition, namely, "anything like a lip, as in structure or in being an edge, rim, or margin" (*Webster's New World Dictionary* 824 (David B. Guralnik ed., 2nd Coll. Ed., Simon & Schuster, Inc. 1984)). Either the combination of sleeve 38 and conically-shaped depression 20, in the case of the illustrated embodiment, or the sleeve 38 alone, in the embodiment wherein depression 20 is omitted (Hasan, col. 3, ll. 57-60), meets this definition of "lip." Further, in either case, the main body 12 of the plate comprises a flat section immediately adjacent such structure responding to the "lip."

We therefore conclude that Appellants have not demonstrated the Examiner erred in rejecting claim 7 as anticipated by Hasan. The rejection is sustained.

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SUMMARY

The decision of the Examiner to reject claims 1-3, 6, and 7 as anticipated by Hasan is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

vsh:

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