

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REXNORD INDUSTRIES, LLC

Appeal 2007-3920
Application 90/007,025
Technology Center 1600

Decided: September 14, 2007

Before JAMESON LEE, ADRIENE L. HANLON, and RICHARD TORCZON, *Administrative Patent Judges*.

TORCZON, *Administrative Patent Judge*.

DECISION ON APPEAL

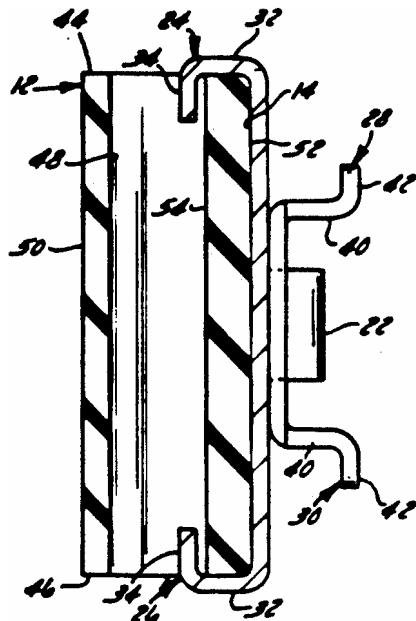
The subject matter of the claim on appeal relates to a conveyor chain for use in a product-capturing conveyor. The examiner has rejected claim 3 under the doctrine of obviousness-type double patenting. The appellant (Rexnord) seeks review. We affirm.

CLAIM 3

During reexamination, we are obligated to give a claim its broadest reasonable construction. Claim 3, the sole claim on appeal, is reproduced

below as it appears in Rexnord's claim appendix.¹ We have included numbering from FIG. 5 (below, right) a cross-sectional view from the patent on appeal for purposes of illustration only.

3. A gripper **12** adapted to be mounted on a product capturing chain including a plate having a supporting surface **14** and first and second lateral ends **32**, and the chain also including first and second lips **24**, **26** respectively projecting from the first and second ends **32** of the plate, said gripper **12** comprising a hollow, tubular, resilient member including first and second ends **44**, **46** respectively having therein first and second openings, said member being hollow along the entire length thereof and being adapted to be positioned against the supporting surface **14** of the plate with said first and second openings respectively adjacent the first and second lateral ends **32** of the plate and with the first and second lips **24**, **26** respectively projecting into said first and second openings.



THE REJECTION

Claim 3 stands rejected as having been obvious in view of the claims in two patents previously issued to the same inventors. Specifically, claims 1-3 of the 4,629,063 (063) patent and claims 1-4 of the 4,809,846 (846) patent.

¹ Appeal Brief (Br.) 8.

Res Judicata

As an initial matter, we treat the "res judicata"² argument on which the examiner and Rexnord expend most of their efforts. The term "res judicata" is ambiguous. In most contemporary legal contexts, the term is now taken to mean "claim preclusion". The alternative meaning—issue preclusion—has different considerations, so it is important to make clear which of the two doctrines is intended.³ Neither the examiner nor Rexnord provided much assistance on this critical point.

Claim preclusion is a problematic concept in the context of ex parte prosecution.⁴ Unfortunately, neither the examiner nor Rexnord discuss the considerable case law on point. Rexnord instead urges a waiver theory based on an expansive reading of a 1927 Supreme Court case⁵ that completely overlooks the significance of subsequent legislation creating a reexamination process.⁶

Most critically, neither the examiner nor Rexnord provided the earlier briefing or decision that are said to provide the basis of this argument. We

² *United Techs. Corp. v. Chromalloy Gas Turbine Corp.*, 189 F.3d 1338, 1343, 51 USPQ2d 1838, 1841 (Fed. Cir. 1999); but see *Migra v. Warren City Sch. Dist. Bd.*, 465 U.S. 75, 77 n.1 (1984)

³ *Hallco Mfg. Co. v. Foster*, 256 F.3d 1290, 1294, 59 USPQ2d 1346, 1349 (Fed. Cir. 2001).

⁴ *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974); *In re Citron*, 326 F.2d 418, 140 USPQ 220 (CCPA 1964).

⁵ Br. 3-4, citing *Overland Motor Co. v. Packard Motor Co.*, 274 U.S. 417, 421-22 (1927) and *In re Kaghen*, 387 F.2d 398, 156 USPQ 130 (CCPA 1967), which itself relies on *Overland Motor Co.*

⁶ Pub. L. 96-517, Sec. 1, Dec. 12, 1980, 94 Stat. 3015.

have only been provided with a copy of a later Board decision that is not germane to the issue on appeal.⁷

Preclusions, including res judicata, are powerful and necessary procedural tools, but they are not magic bullets. Proving a preclusion generally requires careful construction of a supporting case. The present appeal illustrates some of the many ways in which a "res judicata" theory can go awry.⁸ Since the res judicata theory has not been adequately developed in the record before us, we do not give it any weight.

Obviousness of claim 3 in view of prior claims

An obviousness-type double-patenting analysis is essentially the same as an obviousness analysis with one key exception: one of the "prior art references" is not necessarily prior art, but rather a previously issued claim. Often (as in this case) the specification underlying the claim is not prior art so the disclosure of the invention in the specification cannot be used as evidence of prior art.

In analyzing obviousness, the scope and content of the prior art must be determined, the differences between the prior art and the claims

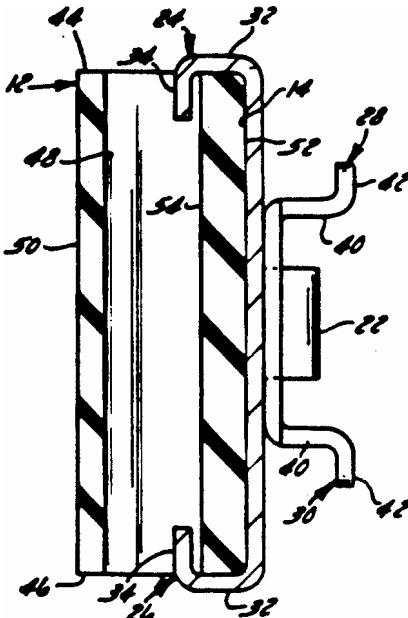
⁷ Examiner's Answer (Ans.) 6, providing a 1992 Board decision. On a procedural note, the only evidence the examiner purports to rely upon (Ans. 3) are the two patents. We also note that the initial reexamination request cited (but did not provide) the earlier and purportedly decisive 1990 Board decision.

⁸ There is an implication of serious prosecution misconduct in the res judicata argument. As with the res judicata theory, no misconduct has been established in the record before us.

ascertained, and the ordinary level of skill in the art resolved.⁹ In this case, there is no evidence of obviousness other than the claims of the cited patents. Thus, the determination of the scope and content of the prior art, as well as the ascertainment of the differences between the prior art and claim 3, calls for a comparison of claim 3 with one or more of the earlier claims.

Claim 3 and the prior claims

The claims of the 063 patent are directed to a "chain link for a product capturing chain" with "a resilient, hollow, tubular gripping member".¹⁰ The claims of the 846 patent are directed to a "carrying member for a product capturing chain" with "a hollow, tubular resilient gripping member".¹¹ Thus, some sort of resilient, hollow, tubular gripper is a necessary part of the invention in both prior patents. The following table compares the structures actually claimed in the specified claim of each patent, again with reference to FIG. 5 (right), which is present in each patent.



⁹ *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007). The record on appeal does not contain objective evidence of secondary considerations.

¹⁰ 063 patent 4:15-41 (claim 1).

¹¹ 846 patent 4:63-5:15 (claim 1).

Claim 3	063 patent claim 1	846 patent claim 1
A gripper 12	A chain link [i.e., a base link and a resilient member 12] ¹²	A carrying member [term unique to claim 1, but having a chain link, see below, which includes a gripper 12]
mounted on a product capturing chain including a plate having a supporting surface 14 and first and second lateral ends 32 , and the chain also including first and second lips 24 , 26 respectively projecting from the first and second ends 32 of the plate,	for a product capturing chain, comprising: a flat base portion having front and back surfaces 14 , first and second ends 32 , and leading and trailing edges; * * *	for a product capturing chain having a chain link, said carrying member comprising: a plate having first 14 and second surfaces and first and second lateral ends 32 ; * * *
said gripper 12 comprising a hollow, tubular, resilient member including first and second ends 44 , 46 respectively having therein first and second openings, said member being hollow along the entire length thereof and being adapted to be positioned against the supporting surface 14 of the plate with said first and second openings 44 , 46 respectively adjacent the first and second	a resilient, hollow, tubular gripping member 12 approximately the same length as said flat base portion 14 , having first and second ends 44 , 46 and said inner and outer surfaces and including a flattened outer surface portion contacting said front surface of said flattened base 14 ; first and second opposed retaining lips 24 , 26 integral with said flat base portion and projecting from	a hollow, tubular resilient gripping member 12 including first and second ends 44 , 46 respectively having therein first and second openings, said gripping member 12 being hollow along the entire length of said gripping member and being positioned against the first surface 14 of the plate with said first and second openings 44 , 46 respectively adjacent the first and second

¹² 063 patent 2:16-17.

lateral ends 32 of the plate and with the first and second lips 24, 26 respectively projecting into said first and second openings.	said first and second ends 32 , each of said lips including a first portion substantially perpendicular to said flat base and a second portion substantially parallel to said flat base opposite said front surface, the opposed retaining lips 24, 26 each being wrapped around one of the ends 44, 46 of said hollow, tubular gripping member 12 and projecting inside said gripping member for retaining it on said flat base portion.	lateral ends 32 of the plate; and retaining means extending from the plate and having first and second lips 24, 26 respectively projecting into the first and second openings for holding the gripping member 12 immobilized against the plate.
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All of the structures in claim 3 appear in each claim 1 of the prior patents, with the same functional and structural relationships. The difference between claim 3 and the other claims is that claim 3 is directed to a substructure within the structures of the other two claims. In this sense, claim 3 is broader (i.e., less limited) than the earlier claims. The claims of the 063 and 846 patents anticipate the gripper of claim 3.

Rexnord argues that the rejection is improper because one could make and use the gripper separately from the combinations including the gripper that are claimed in the 063 and 846 patents. According to Rexnord, no one is thus excluded from using the inventions claimed in those earlier patents.¹³

¹³ Br. 6.

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Rexnord offers no evidence other than the argument of counsel to support its contention. In any case, the contention is not credible.

It may well be that the gripper of claim 3 has other uses, but claim 3 is directed to the gripper itself, not a method of using the gripper. The gripper is integral to the chain link and carrying member of the 063 and 846 patents, respectively. One cannot practice the inventions of those now-expired patents without using the gripper of claim 3.

CONCLUSION

The double-patenting rejection of claim 3 is—

AFFIRMED

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