

***THIS OPINION WAS NOT WRITTEN FOR PUBLICATION***

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* BRUCE G. BARTON, JR.

---

Appeal No. 1996-1266  
Application 08/246,804<sup>1</sup>

---

HEARD: September 13, 1999

---

Before GARRIS, WARREN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 17 through 30, all of the claims in the application.<sup>2</sup>

We have carefully considered the record before us, and based thereon, find that we cannot

---

<sup>1</sup> Application for patent filed May 20, 1994. According to appellant, this application is a continuation of application 08/119,954, filed September 10, 1993, now abandoned, which application is a division of application 07/745,548 ('548 application), filed August 15, 1991, now abandoned. A prior panel of this board issued a decision in Appeal No. 93-1853 on August 23, 1993, in the '548 application (Paper No. 17).

<sup>2</sup> See specification, pages 34-40, and the amendment of May 20, 1994 (Paper No. 3).

sustain the rejection of claims 17 and 19 through 30 under 35 U.S.C. § 103 over Stolz or the rejection of claim 18 under 35 U.S.C. § 103 over Stolz as applied to claims 17 and 18 through 30, and further in view of Barton.<sup>3</sup>

The dispositive issue in this appeal is the construction to be made of the phrase “*modular, one piece, passage unit*” in the preamble of claim 17, and the last clause thereof: “the main shell, the front unit closure wall, the mounting means, the rear unit closure wall, and the interlocking means all constituting a *single, one piece integral unit*” (emphasis supplied). Similar language appears in claim 26. The examiner has focused on the term “integral” and has taken the position that the term “‘integral’ may be construed broadly to encompass parts rigidly secured together” citing, *inter alia*, *In re Larson*, 340 F.2d 965, 967-68, 144 USPQ 347, 349 (CCPA 1965), *In re Hotte*, 475 F.2d 644, 647, 177 USPQ 326, 328 (CCPA 1973), *In re Kohno*, 391 F.2d 959, 157 USPQ 275 (CCPA 1968) (answer, pages 5 and 6). Appellant submits that the authority relied on by the examiner “expressly distinguishes ‘integral’ from the far more restrictive ‘one piece’ requirement of the claims on appeal” (reply brief, paragraph bridging pages 1-2). Based on the record before us, we agree with appellant.

It is well settled that the terms of the appealed claims must be given the broadest reasonable interpretation consistent with appellant's specification as it would be interpreted by one of ordinary skill in this art. *In re Morris*, 127 F.3d 1048, 1053-56, 44 USPQ2d 1023, 1027-30 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). We find that one of ordinary skill in this art would have reasonably determined from appellant's specification (e.g., page 6, lines 12-14, and Figs. 2 and 6) that that the *phrases* “modular, one piece, passage unit” and “single, one piece integral unit” should be reasonably interpreted as denoting a “one piece” unit and not a number of individual pieces integrated into a “unit.” *Morris*, 127 F.3d at 1055-56, 44 USPQ2d at 1029; *compare Hotte, supra*.

Accordingly, in comparing the appealed claims as we have construed them above with Stolz,

---

<sup>3</sup> The references relied on by the examiner with respect to the grounds of rejection are listed at page 2 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

we are in further agreement with appellant that the claimed “modular, one piece, passage unit” does “not ‘integrate’ the complex parts of the substantially different device of Stolz” as was the case with the rigid construction in *Larson, supra*, and *In re Fridolph*, 309 F.2d 509, 135 USPQ 319 (CCPA 1962) (reply brief, page 2; see also principal brief, pages 7-8). Indeed, the difficulty that we have with the examiner’s contention that “it would have been obvious . . . to have provided the integral parts in a one-piece construction . . . by conventional blow molding,” apparently of “plates 13, 18 [that] are integral with cylinder 11” (answer, pages 6-7; see also page 5), is that such a modification would violate the requirement in Stolz that “sleeve **11** . . . may be made of any *elastic* material such as rubber or a composition product” so that the “sleeve” can be removed after the concrete has set (page 1, second col., lines 33-35, and page 2; emphasis supplied). Thus, it is inescapable that the motivation relied upon by the examiner to modify the device of Stolz in order to arrive at the “modular, one piece, passage unit” of the appealed claims arises solely from the description of appellant’s invention in his specification and not from some teaching or suggestion that Stolz would have conveyed to one of ordinary skill in this art. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

The examiner’s decision is reversed.

*Reversed*

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
CHARLES F. WARREN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	

Appeal No. 1996-1266  
Application 08/246,804

PETER F. KRATZ )  
Administrative Patent Judge )

Mr. Bruce G. Barton, Jr.  
Three 60 Corporation  
1201 Fendt Drive  
Howello, MI 48843