

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(2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKESHI HASHIMOTO,
HIROYUKI FUKUHARA, AKIYASU YONEKAWA,
and YOSHIMI YOTUTANI

Appeal No. 96-2299
Application 08/072,753¹

HEARD: Jan. 13, 1999

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS
and NASE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed June 7, 1993.

Appeal No. 96-2299
Application No. 08/072,753

This is an appeal from the decision of the examiner finally rejecting claims 7, 12, 15, 16 and 18, which are all of the claims remaining of record in the application.

The appellants' invention is directed to a profiling machine. The subject matter before us on appeal is illustrated by reference to claim 7, which has been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

McKinney	4,669,923	Jun. 2, 1987
Witt	4,844,135	Jul. 4, 1989
Dombrowski et al. (Dombrowski)	4,993,896	Feb. 19, 1991

THE REJECTION²

Claims 7, 12, 15, 16 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dombrowski in view of McKinney or Witt.

² A rejection of claim 18 under 35 U.S.C. § 102(b) has been withdrawn by the examiner in the Answer.

Appeal No. 96-2299
Application No. 08/072,753

The rejection is explained in the Examiner's Answer.

The viewpoints of the appellants are set forth in the Brief.

OPINION

We have evaluated this rejection on the basis of the following guidelines provided by our reviewing court: The examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references, rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025,

Appeal No. 96-2299
Application No. 08/072,753

226 USPQ 881, 886-87 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom (see *In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

The appellants' invention is directed to a machine for profiling a portion of a workpiece in response to following along a reference surface. As manifested in independent claim 7, the machine comprises a rotary tool having a chucked shank section, a cutter and a rotatable journal bearing provided at a tip of the cutter and having a contact surface for making direct contact with the reference surface of the workpiece. A spindle for driving the tool also is recited in the claim, the

spindle being resiliently supported to be movable perpendicular to the tool axis.

The claims stand rejected as being unpatentable over Dombrowski in view of McKinney or Witt. The examiner finds in the primary reference all of the claimed structure except that Dombrowski's contact surface is a stem-like extension of the cutter that rotates with the cutter rather than the claimed "rotatable journal bearing provided at a tip of the cutter."³ However, it is the examiner's position that it would have been obvious to replace the stem-like extension of Dombrowski with a rotatable journal bearing in view of the teachings of either of the two secondary references.

With regard to independent claims 7 and 12, the appellants have advanced only one argument, which is that it would not have been obvious to combine the references in the manner proposed by the examiner. Their reasoning is that Dombrowski is operating on precision metal parts and requires the disclosed pilot construction to assure superior strength,

³ In view of the description of the invention provided in the specification, and in keeping with the appellants' arguments in the Brief, we interpret the quoted phrase to mean that the outer race of the bearing is rotatable with respect to the cutter.

Appeal No. 96-2299
Application No. 08/072,753

long tool life and economy of manufacture, whereas McKinney and Witt disclose tools for working soft materials, and one of ordinary skill in the art would have concluded that the bearing structures of the two secondary references would not have had sufficient strength to be used in the Dombrowski setting (Brief, pages 4 and 5). It is noteworthy that the appellants do not, however, quarrel with the suggestion given by the examiner to combine the references, which is set forth on page 4 of the Answer.

The purpose of pilot portion 56 in Dombrowski, guide wheel 11 in McKinney and pilot 29 in Witt is the same, and that is to follow the contour of a reference surface on the workpiece so that a profiling tool accurately operates upon the workpiece. In our view, one of ordinary skill in the art would have recognized that the profiling tool guide elements need be of sufficient strength to tolerate being pressed against the reference finish surface without being deformed so that their accuracy is not compromised, but they need not be so strong as to be able to withstand the same level of stress as is placed upon the cutting tool. This being the case, we see no reason why the artisan would have been dissuaded from

Appeal No. 96-2299
Application No. 08/072,753

using the guides disclosed in the secondary references in the Dombrowski situation. From our perspective, Dombrowski's concern for sufficient strength is no more critical than that of McKinney and Witt, and providing the necessary level of strength in the modified Dombrowski device would have been within the purview of one of ordinary skill in the art, who is presumed to possess skill, rather than to be lacking it (see *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985)). Moreover, although the appellants argue that rotating journal bearings would not have sufficient strength to be functional in the Dombrowski machine, they have offered no evidence in support of this conclusion, and argument and conclusionary statements of counsel do not constitute evidence. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

The fact that independent claim 12 contains the additional limitation that the cutting edge of the profiling tool is at an angle to the tool axis, as is pointed out by the appellants on page 5 of the Brief, does not cause us to alter the opinion we voiced above. In this regard, we point out that such is the case in all three of the applied references.

Appeal No. 96-2299
Application No. 08/072,753

As for the argument that the details of the bearing construction recited in claims 15, 16 and 18 would not have been obvious to the artisan, we note that Witt describes the pilot as "a ball-bearing pilot 29 which rolls against the unworked portion of the edge of the workpiece" (sentence bridging columns 2 and 3), and McKinney as a "ball bearing guide wheel 11 mounted . . . in a manner well known in the art" (column 3, lines 17-19). It is our opinion that the one of ordinary skill in the art would have recognized that ball bearing guide wheels conventionally comprise one piece inner and outer sleeves within which the ball bearings are mounted, and would have found it obvious to mount the guide wheels such that the inner sleeve is attached to the tool and the outer sleeve contacts the workpiece.

It therefore is our conclusion that the teachings of the applied references establish a *prima facie* case of obviousness with regard to the subject matter of the appealed claims, and we therefore will sustain the rejection.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under

Appeal No. 96-2299
Application No. 08/072,753

37 CFR § 1.136(a).

AFFIRMED

PATENT

Harrison E. McCandlish, Senior)	
Administrative Patent Judge)	
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Neal E. Abrams)	BOARD OF
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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Appeal No. 96-2299
Application No. 08/072,753

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