

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN L. BECK, THOMAS A. GREGORY
and CHRISTOPHER G. KELLER

Appeal No. 1996-3903
Application No. 08/305,225¹

ON BRIEF

Before STAAB, JERRY SMITH, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 33-52, which are all of the claims pending in this application.

¹ Application for patent filed November 13, 1994. According to appellants, this application is a continuation of 07/922,920 filed July 30, 1992. We note that this application may not be a proper continuation under Rule 60 since the drawing in this application are not a true copy of those filed in the parent application 07/922,920 filed July 30, 1992.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a member seal secured to inner and outer oscillating bearing members for small angle oscillations within a confined axial space. An understanding of the invention can be derived from a reading of exemplary claim 33, which is reproduced below.

33. A bearing seal assembly adapted for fitting within a confined axial space of not more than one tenth the outer radius thereof for enabling small angle oscillations of an oscillating arm, said seal assembly comprising:

an outer bearing raceway defining one boundary of said confined space;

an inner bearing raceway mounted concentric with said outer raceway;

an annular elastic membrane having structure and configuration excluding bellows structure and configuration, said membrane having an inner peripheral edge sealingly secured to said inner raceway, and an outer peripheral edge sealingly secured to said outer raceway, said membrane having a maximum axial length to occupy an axial space of not more than one tenth the outer radius thereof, said membrane having no torsional strain at a neutral position of said inner raceway and said outer raceway, and said membrane having a structure and configuration for enabling predetermined limited relative oscillation between said inner raceway and said outer raceway with minimum torque and with minimum axial distortion of said membrane within said axial space.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Comery	2,946,609	July 26, 1960
Fickenwirth et al. (Fickenwirth) ²	3,700,297	Oct. 24, 1972
Bender	4,426,090	Jan. 17, 1984
Lederman	4,722,616	Feb. 2, 1988
Albert	5,046,868	Sept. 10, 1991

Claims 33-42 stand rejected under 35 U.S.C. § 112³ as being unpatentable as failing to particularly pointing out and distinctly claiming the invention. Claims 33-52 stand rejected under judicially created doctrine of obvious-type double patenting over serial number 07/922,290.⁴ Claims 33, 35-38, 41 and 50-51 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fickenwirth. Claims 34, 42- 44 and 46-47 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fickenwirth in view of Lederman. Claim 36 stands rejected under 35 U.S.C. § 103 as being unpatentable over Fickenwirth in view of Comery. Claim 39 stands rejected under 35 U.S.C. § 103 as being unpatentable over Fickenwirth in view of Bender. Claims 40 and 52 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fickenwirth in view of Albert. Claim 45

² We note that Fickenwirth has been referenced throughout the briefs and answers as "Fickenworth," but we refer to this reference as "Fickenwirth."

³ We note that claims 37, 44 and 51 refer to "said annual elastic member," but we understand this limitation to refer to "said **annular** elastic member" for proper antecedent basis.

⁴ Serial Number 07/922,290 matured into US Patent 5,416,657 and we evaluate the double patenting based upon the claims as issued therein.

stands rejected under 35 U.S.C. § 103 as being unpatentable over Fickenwirth in view of Lederman and Bender. Claims 48 and 49 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fickenwirth in view of Lederman and Albert.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14, mailed Jan. 3, 1996) and the supplemental examiner's answer (Paper No. 16, mailed May 3, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 13, filed Dec. 14, 1995), reply brief (Paper No. 15, filed Feb. 26, 1996) and replacement brief (Paper No. 22, filed May 28, 1999)⁵ for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

⁵ We reference the replacement brief, which corrected formal matters, when citing to appellants' brief.

35 U.S.C. § 112, SECOND PARAGRAPH

With respect to claim 33, the examiner argues that the limitation “having a structure and configuration excluding bellows structure and configuration” is unclear and misdescriptive of the invention. (See answer at page 4.) We agree with the examiner that this limitation does not define appellants’ invention with sufficient detail to enable skilled artisans to determine the metes and bounds of the claimed invention. Furthermore, we have reviewed the specification to further define the interpretation of the recited claim limitations. We find not disclosure in the specification as originally filed which further aids in the determination of the metes and bounds of this claim limitation.⁶ Moreover, the examiner argues that the various embodiments of the elastic membrane would appear to have a “bellows structure and configuration” as defined in the dictionary definition set forth by the examiner. We agree, but appellants argue that these embodiments are not “bellows structure and configuration.” In light of the conflicting possible interpretations, we find that the claim does not particularly point out and distinctly claim the invention. Since the limitations cannot be determined without speculation, we will sustain the rejection of claims 33-42 under 35 U.S.C. § 112, second paragraph.

⁶ We find no clear support in the specification as originally filed for this negative limitation, but a rejection under 35 U.S.C. § 112, first paragraph has not been applied by the examiner.

35 U.S.C. § 103

CLAIMS 33-42

Considering now the rejections of claims 33-42 under 35 U.S.C. § 103, we have carefully considered the subject matter defined by these claims. However, for reasons stated *supra* with respect to the rejection under the second paragraph of Section 112, no reasonably definite meaning can be ascribed to certain language appearing in the claims. As the court in **In re Wilson**, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) stated:

All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious --the claim becomes indefinite.

In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and assumptions, **see In re Steele**, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962), we are constrained to reverse, *pro forma*, the examiner's rejections of claims 33-42 under 35 U.S.C. § 103. While we might speculate as to what is meant by the claim language, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art as

we are obliged to do. We hasten to add that this is a procedural reversal rather than one based upon the merits of the section 103 rejections.

CLAIMS 43-52

With respect to claim 43, appellants argue that the prior art does not teach or suggest the invention as claimed in claim 43. (See brief at pages 11-12.) We agree, we find that neither Fickenwirth nor Lederman teaches the claim limitation wherein the “membrane being pre-stretched isotopically throughout the entire membrane between said first means and said second means.” Furthermore, the examiner has not provided a convincing line of reasoning as to why it would have been obvious to skilled artisans to combine the teachings of Fickenwirth and Lederman.

With respect to claim 50, appellants argue that Fickenwirth does not teach or suggest the invention as set forth in the language of claim 50. We agree. It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. **In re Sneed**, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). When the skilled artisan reads the limitations recited in claim 50 in light of the disclosure, it is clear that the claim language regarding the “orthogonal sinusoidal dimples extending in line both radially and circumferentially” is not the same as structure disclosed

or suggested in Fickenwirth. Therefore, Fickenwirth does not disclose or fairly suggest the first alternative limitation in claim 50. Furthermore, we find that Fickenwirth does not teach or fairly suggest the second alternative limitation in claim 50 directed to the “planar configuration stretched in plane isotropically in tension throughout said membrane before being attached.” Therefore, we will not sustain the rejection of claims 43-52 under 35 U.S.C. § 103.

DOUBLE PATENTING

With respect to claims 33-42, in comparing the claimed subject matter with the claims of the prior patent, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on a comparison of appellants' claims with the claims of a prior patent cannot be based on speculations and assumptions, as discussed above, we are constrained to reverse, *pro forma*, the examiner's rejections of claims 33-42 through under obvious-type double patenting. We hasten to add that this is a procedural reversal rather than one based upon the merits.

With respect to claims 43 and 50, appellants argue that the instant claims would not be obvious in view of the claims of U.S. Patent 5,416,657. We agree with appellants that the swirl pattern is not an obvious variation of the instant claimed invention. Furthermore, the pre-stretched limitation of claim 43 as discussed above is further not included or

obvious. Nor are the alternative limitations of claim 50 of the present application deemed obvious in view U.S. Patent 5,416,657. Therefore, we will not sustain the rejection of claims 43-52 under obvious-type double patenting.

CONCLUSION

To summarize, the decision of the examiner to reject claims 33-52 under 35 U.S.C. § 103 is reversed **pro forma** with respect to claims 33-44 and on the merits with respect to claims 43-52; the decision of the examiner to reject claims 33-52 under obvious-type double patenting is reversed **pro forma** with respect to claims 33-42 and on the merits with respect to claims 43-52; and the decision of the examiner to reject claims 33-42 under 35 U.S.C. § 112, second paragraph, is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
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JOSEPH L. DIXON)	
Administrative Patent Judge)	

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