

The opinion in support of the decision being entered today was **not** written for publication and 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 JOSEPH PACZONAY

Appeal No. 2001-0846
Application No. 08/797,960

ON BRIEF

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15, 17, 18, 21, 23, 24, 29 to 33 and 35 to 37.¹ Claim 38 has been allowed. Claims 19, 22, 27 and 28 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. Claims 1 to 14, 16, 20, 25, 26 and 34 have been canceled.

¹ Claim 15 was amended subsequent to the final rejection.

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We REVERSE.

BACKGROUND

The appellant's invention relates to the manufacture of resilient workpieces (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's original brief (Paper No. 20, filed July 20, 2000).

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

Trotter 1940	2,219,604	Oct. 29,
Lane 6, 1970	3,532,016	Oct.

Claims 15, 17, 18, 21, 23, 24, 29 to 33 and 35 to 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Trotter.

Claims 15, 17, 18, 21, 23, 24, 29 to 33 and 35 to 37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Trotter in view of Lane.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 24, mailed October 12, 2000) for the examiner's complete reasoning in support of the rejections, and to the substitute brief (Paper No. 23, filed September 8, 2000) for the appellant's arguments thereagainst.

OPINION

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

The anticipation rejection

We will not sustain the rejection of claims 15, 17, 18, 21, 23, 24, 29 to 33 and 35 to 37 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

In this case, we agree with the appellant's argument (substitute brief, pp. 10-22) that the claims under appeal are not anticipated by Trotter. While Trotter does teach (page 2, left column, lines 63-68) forming a very fine slit in member 5 while the member is stretched over a mandrel, Trotter does not teach applying both stretching and clamping forces. In that regard, there is no teaching in Trotter of applying clamping forces at an interior area of the fluid flow control valve member immediately surrounding where the cut is made in the interior area during the cutting step as recited in the claims under appeal.² In the appellant's method, as shown for

² For example, claim 15 recites including applying opposed clamping forces to said fluid flow control valve member in said interior area of said
(continued...)

example in Figures 2A-2C, the stretching forces are applied by the engagement of the housing 24 with the flange 16 while the clamping forces are applied by the resilient pad 38 and the flat end 22 of the mandrel 20.

Since all the limitations of the claims under appeal are disclosed in Trotter for the reasons set forth above, the decision of the examiner to reject claims 15, 17, 18, 21, 23, 24, 29 to 33 and 35 to 37 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

²(...continued)

fluid flow control valve member, one of said clamping forces being applied to the first fluid flow control valve member side while said first fluid flow control valve member side is stretched and another of said clamping forces being applied to the second fluid flow control member side while said second fluid flow control member side is stretched, and said clamping forces being applied substantially in the direction of said predetermined path of relative movement to the first and second fluid flow control member sides in said interior area of said fluid flow control valve member immediately surrounding where said at least one cut is made in said interior area during said cutting step.

We have reviewed the reference to Lane applied in this rejection of the claims under appeal but find nothing therein which makes up for the deficiency of Trotter discussed above. In that regard, Lane's clamps 9, which hold the tissue 16 in the stretched position, do not surround the position where the cut is formed as required by the claims under appeal. Thus, the claimed subject matter is not suggested by what the combined teachings of the applied prior art would have suggested to one of ordinary skill in the art. Accordingly, the decision of the examiner to reject claims 15, 17, 18, 21, 23, 24, 29 to 33 and 35 to 37 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 15, 17, 18, 21, 23, 24, 29 to 33 and 35 to 37 under 35 U.S.C.

§ 102(b) is reversed and the decision of the examiner to reject claims 15, 17, 18, 21, 23, 24, 29 to 33 and 35 to 37 under

35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
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