

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NATHAN FELDSTEIN

Appeal No. 95-1195
Application No. 08/102,674¹

ON BRIEF

Before KIMLIN, WEIFFENBACH and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 12-14. Claim 11, the other claim remaining in the present

¹ Application for patent filed August 9, 1993. According to appellant, this application is a continuation of Application No. 07/828,621, filed January 31, 1992, now abandoned.

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application, stands withdrawn from consideration. Claim 12 is illustrative:

12. A method of manufacturing a coated precision metal part, said method comprising preliminarily heat treating a metal part at a first temperature cycle sufficient to effect dimensional distortion thereof, conforming the preliminarily heat treated metal part to a dimension, forming a metal coating on a [sic] least a portion of the conformed metal part, and secondarily heat treating the coated conformed metal part at a second temperature cycle insufficient to effect significant dimensional distortion thereof, whereby the secondarily heat treated metal part conforms to said dimension.

The examiner relies upon the following reference as evidence of obviousness:

Lancsek	4,859,494	Aug. 22, 1989
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Appellant's claimed invention is directed to a method of making a coated precision metal part, such as a combing roll. The method entails subjecting the metal part to a preliminary heat treatment which effects dimensional distortion of the metal part, conforming the heat-treated metal part to a dimension, such as by machine, forming a metal coating on the machined metal part, and subjecting the coated metal part to second heat treatment which does not distort the dimension of the metal part. According to appellant, "by pre-heat treating the assembled or unassembled parts prior to precision

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machining, one will not only substantially eliminate the distortion which ordinarily results in the final heat treatment subsequent to coating, but one can also eliminate or substantially reduce the need for a critical or final re-machining step" (page 4 of specification).

Appealed claims 12-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lancsek. The appealed claims also stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original specification that fails to provide descriptive support for the claimed subject matter. In addition, the appealed claims stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

We have carefully considered the opposing arguments presented by appellant and the examiner. As a result, we find that the prior art applied by the examiner fails to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's § 103 rejection. In addition, we will not sustain the examiner's rejections under 35 U.S.C. § 112, first and second paragraphs.

We consider first the examiner's rejection of the appealed claims under 35 U.S.C. § 103. The examiner

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recognizes that Lancsek does not disclose the claimed preliminary heat-treating step. However, it is the examiner's position that it would have been obvious for one of ordinary skill in the art to form the metal article of Lancsek by molding, and that such molding would inherently involve the claimed preliminary heat treatment. The flaw in the examiner's reasoning is that a determination of inherency cannot be established by probabilities or possibilities, but it is incumbent upon the examiner to establish the inevitability of the inherency based upon factual evidence or persuasive scientific reasoning. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981), and In re Wilding, 535 F.2d 631, 635-36, 190 USPQ 59, 63-64 (CCPA 1976). In the present case, the examiner has not advanced the requisite factual evidence or persuasive scientific reasoning that the use of molding to form the metal part of Lancsek would inevitably include a heat treatment that is equivalent to the claimed preliminary heat treatment of a molded metal article which is thereafter conformed to a dimension. Also, the examiner has not established on this record that a molded metal article obvious from Lancsek would have the same

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microstructure as a metal article that receives the claimed preliminary heat treatment. For this reason alone, the examiner's rejection constitutes reversible error.

Furthermore, the examiner has not established the obviousness of the claimed secondary heat treatment of the coated metal article. The examiner has not factually established that it would have been obvious for one of ordinary skill in the art to dry the coated metal article with the claimed heat treatment.

We now turn to the examiner's rejection of the appealed claims under 35 U.S.C. § 112, first paragraph. According to the examiner, the claim language "whereby the secondarily heat-treated metal part conforms to said dimension" is new matter, i.e., the language does not find descriptive support in the original specification. However, as accurately stated by appellant, the proper test for determining whether claim language has original, descriptive support is "whether disclosure in the application as originally filed reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter, rather than presence or absence of literal support in specification for claimed

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language" (page 5 of principal Brief). In the present case, we concur with appellant that the criticized claim language would be understood by one of ordinary skill in the art as requiring the secondary heat treatment to not result in a change in the dimension of the metal part, which meaning is clearly described in the original specification. The examiner reasons that eliminating distortion in the final heat-treatment "is different than conforming a part to a specific dimension because the coating could be allowed to build up on a part and thus alter its dimensions without any distortion taking place" (page 8 of Answer). While it is true that the coating could alter the dimensions of the metal part, Example 3 of the original specification provides descriptive support for coating a metal part followed by a secondary heat-treatment wherein the resultant metal part conforms to the dimension of the conforming step.

Regarding the examiner's rejection under § 112, second paragraph, it is the examiner's position that the terms "precision" and "significant" of claim 12 are imprecise inasmuch as "[t]here are no guidelines given in the application to allow one skilled in the art to examine a part

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and determine if it is a precision part or a generic part. Likewise, there is no disclosure of what constitutes significant distortion and what constitutes insignificant distortion" (page 9 of Answer). Here, we also agree with appellant that when the criticized claim language is read in light of the specification by one of ordinary skill in the art, there is sufficient description in the specification to allow the skilled artisan to reasonably ascertain the metes and bounds of the claimed terms "precision" and "significant." In essence, we agree with appellant's argument stated at page 6, second paragraph, of the principal Brief.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CAMERON WEIFFENBACH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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THOMAS A. WALTZ)	
Administrative Patent Judge)	

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Nathan Feldstein
Surface Technology, Inc.
Box 8585
Trenton, NJ 08650