

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PAUL A. HUMMEL

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Appeal No. 96-2653  
Application No. 08/395,681<sup>1</sup>

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HEARD: October 17, 1997

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Before COHEN, NASE, and CRAWFORD, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 2, which are all of the claims pending in this application.

We REVERSE.

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<sup>1</sup> Application for patent filed February 28, 1995. According to the appellant, the application is a continuation-in-part of Application No. 08/199,559, filed February 22, 1994, which is now abandoned.

Appeal No. 96-2653  
Application No. 08/395,681

BACKGROUND

The appellant's invention relates to a vibration isolation grommet. Claim 1 is representative of the subject matter on appeal and a copy thereof is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Schmitt	3,128,999	Apr. 14, 1964
Stewart et al. (Stewart)	3,350,042	Oct. 31, 1967

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schmitt in view of Stewart.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 rejection, we make reference to the examiner's answer (Paper No. 8, remailed March 5, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 7, filed January 22, 1996) for the appellant's arguments thereagainst.

Appeal No. 96-2653  
Application No. 08/395,681

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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness<sup>2</sup> with respect to claims 1 and 2. Accordingly, we will not sustain the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103. Our reasoning for this determination follows.

Before addressing the examiner's rejection based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim

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<sup>2</sup> In rejecting claims under 35 U.S.C. § 103, 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).

Appeal No. 96-2653  
Application No. 08/395,681

itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988).

Our review of independent claim 1 reveals that it is drawn to a vibration isolator grommet **capable of** preassembly with a workpiece and cooperative with a workpiece supporting structure to limit compression of an elastomeric element of the grommet and requires, inter alia, a compression limiting metal sleeve having a cylindrical portion with a radially outwardly extending flange at one end thereof, and an annular elastomeric element having a radially outwardly extending flange portion at one end thereof underlying the flange on the sleeve and a cylindrical portion with an inside diameter complementary to the outside diameter of the cylindrical portion of the sleeve **so as to be acceptable thereover in a slidable frictional fit**, the elastomeric element having a radially inwardly extending portion at the opposite end of the cylindrical portion thereof from the flange portion thereon **initially underlying** the cylindrical portion of said sleeve **but movable radially outwardly upon axial advancement of the sleeve** relative to the elastomeric element to lock the grommet in the aperture in a workpiece. The length of the cylindrical portion of the metal sleeve is related to the length

Appeal No. 96-2653  
Application No. 08/395,681

of the cylindrical portion of the elastomeric element **so as to be engageable with** the supporting structure to limit compression of the flange of the elastomeric element.

We view the claims on appeal as precisely defining a grommet of interrelated parts (i.e., metal sleeve 12 and elastomeric element 14). From the language of claim 1 highlighted above, it is our opinion that these interrelated parts are recited in their disassembled condition to be later assembled to form an installed grommet. Thus, we view the claims on appeal, as reciting a grommet "kit" (as shown in Figure 1), not an assembled grommet (as shown in Figures 2-4). See In re Venezia, 530 F.2d 956, 958-59, 189 USPQ 149, 151-52 (CCPA 1976). As with the kit in the Venezia case, each part of the grommet herein is interrelated with the other.

With regard to the 35 U.S.C. § 103 rejection of claims 1 and 2 as being unpatentable over Schmitt in view of Stewart (answer, p. 4), the examiner found that

Schmitt discloses a grommet comprising a sleeve 12 and an elastomeric element 9 having an inwardly extending flange 11 which moves outwardly as the sleeve is moved relative to the flange. The outer diameter of the cylindrical portion 10 of the elastomeric body 9 of Schmitt must be less than the

Appeal No. 96-2653  
Application No. 08/395,681

inner diameter of hole 3 at least when the cylindrical portion 10 is inserted into hole 3. Schmitt states, in column 1 lines 34-35, that cylindrical portion 10 fits easily in hole 3.

The examiner then determined that "Schmitt fails to teach a flange on the sleeve." The examiner then found that Stewart teaches "a grommet having a sleeve with and without a flange (generally at 36)." The examiner concluded that

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the grommet of Schmitt with a flange on the sleeve, as taught by Stewart et al, as to distribute the compressive load more evenly over the flange portion of the elastomeric body and achieve the desired compression limits of the elastomeric body.

We agree with the examiner that it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the grommet of Schmitt with a flange on the sleeve, as taught by Stewart. However, we agree with the appellant's argument (brief, p. 4) that the modified grommet (resulting from the combination of Schmitt and Stewart) would not teach all the limitations of independent claim 1. Specifically, the recitation in claim 1 that the elastomeric element has a radially inwardly extending portion at the opposite end of the cylindrical portion thereof from the flange portion thereon

Appeal No. 96-2653  
Application No. 08/395,681

initially underlying the cylindrical portion of the sleeve but movable radially outwardly upon axial advancement of the sleeve relative to the elastomeric element to lock the grommet in the aperture in the workpiece is not met by either Stewart's grommet or the modified grommet. While both Stewart's grommet and the modified grommet would have an inwardly extending flange (see skirt 11 shown in Schmitt's Figure 1), the inwardly extending flange is movable outwardly to the position shown in Schmitt's Figure 2 only when the bolt 14 is tightened thereby forcing washer 15 to engage the outer end of the skirt 11 and compress it axially toward surface 7. Thus, the inwardly extending flange is not movable radially outwardly upon axial advancement of the sleeve relative to the elastomeric element.

Since all the limitations of independent claim 1 are not taught or suggested by the applied prior art, the examiner has failed to meet the initial burden of presenting a prima facie case of obviousness. Thus, we cannot sustain the examiner's rejection of appealed claim 1, and dependent claim 2, under 35 U.S.C. § 103 as being unpatentable over Schmitt in view of Stewart.

Appeal No. 96-2653  
Application No. 08/395,681

Appeal No. 96-2653  
Application No. 08/395,681

CONCLUSION

To summarize, the decision of the examiner to reject claims  
1 and 2 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

Appeal No. 96-2653  
Application No. 08/395,681

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APPENDIX

1. A vibration isolator grommet capable of preassembly with a workpiece and cooperative with a workpiece supporting structure to limit compression of an elastomeric element of the grommet, said grommet comprising:

a compression limiting metal sleeve having a cylindrical portion with a radially outwardly extending flange at one end thereof, and

an annular elastomeric element having a radially outwardly extending flange portion at one end thereof underlying the flange on said sleeve and a cylindrical portion with an inside diameter complementary to the outside diameter of the cylindrical portion of said sleeve so as to be acceptable thereover in a slidable frictional fit, the cylindrical portion of said elastomeric element having an outside diameter less than the diameter of a grommet accepting aperture in said workpiece whereby said grommet is readily accepted therein, said element having a radially inwardly extending portion at the opposite end of the cylindrical portion thereof from the flange portion thereon initially underlying the cylindrical portion of said sleeve but movable radially outwardly upon axial advancement of said sleeve relative to said elastomeric element to lock said grommet in the aperture in said workpiece, the length of the cylindrical portion of said metal sleeve being related to the length of the cylindrical portion of said elastomeric element so as to be engageable with the supporting structure

Appeal No. 96-2653  
Application No. 08/395,681

to limit compression of the flange of said elastomeric  
element.

APPEAL NO. 96-2653 - JUDGE NASE  
APPLICATION NO. 08/395,681

APJ NASE

APJ COHEN

APJ CRAWFORD

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

**DRAFT TYPED:** 17 Oct 97  
1st Rev. 24 Nov 97

**FINAL TYPED:**

HEARD: 17 Oct 97