

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PATRICK A. DOLGAS, E. WAYNE ZICHT  
and ALVIN C. BANNER

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Appeal No. 97-0986  
Application 08/430,580<sup>1</sup>

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ON BRIEF

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Before MEISTER, STAAB and NASE, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 2, 9 and 12. Claims 1, 3-8, 10 and 11, the only other claims remaining in the application, have been allowed.

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<sup>1</sup> Application for patent filed April 28, 1995. According to the appellants, the application is a continuation of Application 08/234,134, filed April 28, 1994.

Appeal No. 97-0986  
Application 08/430,580

Appellants' invention pertains to a pallet for supporting an armature and maintaining it in a single angular orientation during manufacture. Claims 9 and 12, copies of which are found in Appendix A to appellants' brief, are illustrative of the appealed subject matter.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:

Smolen	2,885,165	May 5, 1959
Eckart et al. (Eckart)	4,911,606	Mar. 27, 1990
Saunders	5,061,008	Oct. 29, 1991

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Eckart in view of Smolen.

Claims 2 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eckart in view of Smolen and further in view of Saunders.

Reference is made to appellants' brief (Paper No. 22) and to the examiner's answer (Paper No. 23) for the respective positions of appellants and the examiner with respect to the merits of these rejections.

*The § 103 rejection of claim 9*

The only limitation of claim 9 argued by appellants as patentably distinguishing over the combination of Eckart in view of Smolen is the means plus function limitation calling for "means for maintaining said armature in a single angular orientation." The examiner's position is that "in Eckart et al belt 94 when not driven by the motor holds the armature in a

selected winding attachment position. This is deemed to be a ‘means for maintaining the armature in a single angular orientation’” (answer, page 5).

We appreciate the examiner’s point that Eckart’s tensioning belt 10 in conjunction with the motor 66 is capable of functioning to maintain the armature 12 in a single angular orientation (column 4, lines 39-44). However, as aptly pointed out by appellants on page 9 of the brief, and in contrast to what the examiner would apparently have us believe, this is not all that is required by claim 9. In view of *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994), the “means for maintaining” limitation of claim 9 *must* be interpreted in accordance with the sixth paragraph of 35 U.S.C. § 112, *i.e.*, “construed to cover the corresponding structure . . . described in the specification and equivalents thereof.” Thus, the circumstance that the belt and motor of Eckart, taken together, are capable of functioning in the manner called for in the means plus function limitation is not enough because the sixth paragraph of 35 U.S.C. § 112 operates to cut back on the types of means which could literally satisfy the claim language. *Johnston v. Ivac. Corp.*, 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989).

Looking to appellants’ specification, we find disclosed therein two alternative structures for performing the maintaining function set forth in the means plus function limitation in question. The first structure is illustrated in Figures 1 and 2 and comprises

two U-shaped support surfaces, namely, a smaller radius support surface 38A for engagement with the cam body 24 and a larger radius support

surface 38B for engagement with the portion of the armature shaft 16 immediately adjacent the cam body 24. By loading the armature 10 into the pallet 30 so that its cam body is supported by the smaller radius support surface 38A, the armature is held by gravity in a single angular orientation. [Specification, pages 3-4.]

The second structure is illustrated in Figure 3 and comprises

a blade 54 extending . . . [from one of the support assemblies] toward the other of the support assemblies . . . . The blade 54 is sufficiently thin and so located that it is received within the radially outermost margin of one of the armature core slots to maintain the rotary orientation of an armature. [Specification, page 5.]

Clearly, Eckart's belt 10 and motor 66 are different from and do not suggest either of appellants' disclosed structures for performing the armature maintaining function.

Further, given the structural dissimilarity of Eckart's belt and motor compared to either of the alternative constructions disclosed by appellants for performing the maintaining function, and the dissimilarity in how they function to hold an armature in a given angular orientation, it is our view that the belt and motor of Eckart cannot be fairly viewed as an equivalent in the context of the sixth paragraph of 35 U.S.C. § 112 of either the larger/smaller radius support surfaces of appellants' Figures 1 and 2 embodiment, or the blade construction of appellants' alternative Figure 3 embodiment. Accordingly, Eckart's belt and motor do not correspond to or suggest the claimed "means for maintaining."

In light of the foregoing, and in that nothing in the Smolen reference additionally applied against claim 9 makes up for the deficiencies of Eckart in this regard, we will not

sustain the standing § 103 rejection of claim 9.

*The § 103 rejection of claim 2 and 12*

Turning to the standing § 103 rejection of claim 2 and 12, each of these claims calls for a blade extending from one of the support assemblies toward the other support assembly, with the blade being sufficiently thin and so located that it is received within an armature core slot to maintain angular orientation of an armature loaded onto the pallet. The examiner has taken the position (answer, page 5) that it would have been obvious to employ a blade on one of the support assemblies of Eckart in view of Saunders' teaching at blade 56 in order to locate the armature at a desired annular position, and that the Eckart device, as modified, would correspond to the subject matter of claims 2 and 12.

As a threshold issue, appellants argue that Saunders is nonanalogous art. This argument is well taken. Saunders pertains to a fixture for selectively and reproducibly positioning and orienting a nock with respect to the lead feather of an arrow. Notwithstanding the examiner's view to the contrary, we agree with appellants that Saunders is not in the same field of endeavor as appellants' invention, and is not reasonably pertinent to the problem with which appellants were involved, namely, the problem of maintaining the angular orientation of an armature supported on a pallet during manufacture. This constitutes a first reason necessitating reversal of the examiner's rejection of claims 2 and 12.

Further, assuming that Saunders is analogous art, it would not have been obvious to one of ordinary skill in the art to modify Eckart in the manner proposed in view of Saunders. We fail to perceive any teaching, suggestion or incentive in either Eckart or Saunders which would have led one of ordinary skill in the art to modify the Eckart apparatus by adding a blade located to be received within an armature core slot, other than the hindsight provided to one who first views appellants' disclosure. Hindsight reconstruction, however, is not a proper basis for establishing the obviousness of the subject matter of claims. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Simply put, there is no suggestion in either Eckart or Saunders, or need in view of their divergent objectives, for their combination. Smolen, additionally relied upon by the examiner, does not make up for the deficiencies of Eckart and Saunders in this regard. This constitutes a second reason necessitating reversal of the examiner's rejection of claims 2 and 12.

Finally, even if we were to consider that it would have been obvious to provide a "blade" of the type disclosed by Saunders at element 56 in Eckart, the claimed subject matter would not ensue. This is so because neither Eckart nor Saunders teach locating a blade on one of the support assemblies "extending therefrom toward the other of said support assemblies," much less locating the blade such that "it is received within . . . one of the armature core slots . . . so that the rotary orientation of said armature shaft is

maintained,” as required by the claims. The “blade” 56 of Saunders is not disclosed as “maintaining” the angular orientation of either the arrow or the nock. Instead, element 56 is merely an alignment device. This constitutes a third reason necessitating reversal of the examiner’s rejection of claims 2 and 12.

*Remand*

This application is *remanded* to the examiner for consideration of the following matter.

As earlier mentioned, the *Donaldson* case makes it clear that appellants’ claimed “means for maintaining” is construed to cover corresponding structure, e.g., the smaller radius support surface 38A and the larger radius support surface 38B, described in the specification (pages 3-4) and “equivalents thereof.”

We note that in the Eckart patent applied by the examiner against the appealed claims, “[e]ach plate support 58 includes an arcuate shaped support surface 64 which is radially open in an upward direction for retaining the ends of the shaft” (column 3, lines 29-32), and that the plate support 58 is made of a suitable soft material such that it “provides some friction with the shaft to prevent rotation of the rotor 12 when it is not being driven by the drive means 8” (column 3, lines 39-41). In addition, upon inspection of the drawing figures, the support 56 to which the plate support 58 is secured also appears to include an arcuate surface radially opening in an upward direction.

Appeal No. 97-0986  
Application 08/430,580

Consistent with the *Donaldson* case, it is appropriate, in the first instance, for the examiner to make findings as to whether or not the aforementioned structure of Eckart is an equivalent of the claimed “means for maintaining.” We therefore remand this application to the examiner to determine, on the record, if the aforementioned arcuate shaped surfaces of elements 56 and/or 58 of Eckart are an equivalent of the smaller and larger radius support surfaces described in appellants’ specification, and to take any suitable action thereafter.

#### *Summary*

The standing § 103 rejection of claim 9 as being unpatentable over Eckart in view of Smolen is reversed.

The standing § 103 rejection of claims 2 and 12 as being unpatentable over Eckart in view of Smolen and further in view of Saunders is also reversed.

Additionally, we have *remanded* the application to the examiner to consider the matter of equivalency (sixth paragraph of 35 U.S.C. § 112) of the arcuate shaped surfaces of Eckart’s elements 56 and/or 58 vis-à-vis the claimed “means for maintaining.”

The decision of the examiner is reversed.

This application, by virtue of its “special” status, requires an immediate action. See Section 708.01(d) of the *Manual of Patent Examining Procedure*, 6th Edition, Rev. 3, July 1997.

Appeal No. 97-0986  
Application 08/430,580

*REVERSED AND REMANDED*

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

Appeal No. 97-0986  
Application 08/430,580

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