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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARNO HAMAEKERS

Appeal No. 97-0996
Application 08/287,432[1]

ON BRIEF

Before ABRAMS, STAAB and NASE, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-9, all the claims in the application.

Appellant's invention pertains to a method of manufacturing a metal ring element for use in a hydraulically dampened machine support. Independent claims 1 and 5 are illustrative of the

[1] Application for patent filed August 8, 1994.

appealed subject matter and read as follows:

1. A method for manufacturing a bearing comprising an elastic spring element made of rubber that is affixed to a ring element made of an elastically deformable material, comprising the steps of:

bending a lamellar section of sheet metal into a cylindrical shape; and

deforming the sheet metal into the shape of a ring element having a uniform thickness.

5. A method for manufacturing a metal ring element for use in a bearing, comprising the steps of:

bending a lamellar section of sheet metal into a cylindrical shape; and

deforming the sheet metal into a shape comprising a conical portion and a contiguous disk-like portion that is set at an angle with respect to the conical portion so that the ring element is of uniform thickness.

The following reference of record is relied upon by the examiner in support of the rejections:

Ingersoll 2,382,485 Aug. 14, 1945

In addition, the examiner relies upon appellant's admitted prior art (AAPA) as set forth on pages 1 and 2 of the specification.

Claims 1-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ingersoll.

Claims 1-9 stand further rejected under 35 U.S.C. § 103 as being unpatentable over AAPA in view of Ingersoll.

Independent claim 1 calls for the step of deforming the sheet metal into the shape of a ring element *having a uniform thickness.* Independent claim 5 contains similar language.

Ingersoll pertains to a method of manufacturing conical disks suitable for heavy load purposes such as in the construction of wheels for tractors and other vehicles. In order to combine maximum strength with economy of material, the disk "is desirably tapered in thickness from center to periphery" (column 1, lines 7-9). Several methods of manufacturing the disk are disclosed. In each instance, the thickness of the side wall of the disk is tapered so as to gradually decrease in thickness toward the smaller end of the conical shape of the finished product. See, for example, column 2, lines 33-46; column 2, line 55 through column 3, line 5; and column 3, lines 2-4. Also see Figures 2, 4, 6, 8, 12 and 13, wherein the tapering of the side wall of the conical disk is clearly seen.

AAPA, pages 1-2 of appellant's specification, states that in hitherto known methods of making the ring element of the support, an annular disc was punched out of a piece of flat sheet metal,

and thereafter, the annular disc "reshaped" into a finished ring element. According to the specification, page 2,

> the reshaping operation results in the ready-to-fit ring element having sections of varying material strength along its axial extent, the lowest material strengths occurring, depending upon the particular manufacturing method employed, in the area of the lateral edges of the ring element, where the elastic spring element and the bearing support are affixed. This weakening of the material is caused by the plastic stretching it undergoes during reshaping and the resultant loss of thickness in these regions.

It is the examiner's foundation position that the thickness of the Ingersoll ring element, or the ring element of AAPA made in accordance with the teachings of Ingersoll, "is uniform in thickness around the circumference at either terminal end, or at any point along the length thereof, thus the limitation of the ring 'having a uniform thickness' or 'of a uniform thickness' as required by the claims is met by Ingersoll" (answer, page 3).

In responding to appellant's argument, the examiner further explains his position as follows:

> Appellant's threshold argument is that Ingersoll fails to teach a ring element having a uniform thickness. In fact, according to Appellant, Ingersoll teaches a tapered thickness, which teaches away from the present invention. The Examiner agrees with Appellant's interpretation of Ingersoll in that the element formed by the process disclosed in Ingersoll does indeed have a tapered form, when viewed along the longitudinal axis of the element as seen in, for instance, figure 12 of Ingersoll. The tapered ring element in Ingersoll is

> indeed not uniform in thickness along this axis. However, the claims only require forming a ring element having a uniform thickness. As stated in the above rejections, which were repeated from the final rejection, the ring element of Ingersoll does indeed have a uniform thickness around the circumference at either terminal end, or at any point along the length thereof. Therefore, the limitation of the ring "having a uniform thickness" or "of a uniform thickness"[2] as required by the claims is met by Ingersoll. This interpretation of the limitation of a "uniform" thickness not only conforms with the well accepted definition of the word "uniform" but also conforms with it's [sic, its] broadest reasonable interpretation. [answer, pages 4-5]

We appreciate the point the examiner is trying to make. We agree with appellant, however, that the examiner's position "is simply not a reasonable interpretation of the plain meaning of the words employed in the claims or of the structure and method shown in Ingersoll" (brief, page 5). More particularly, while it is true that terms in a claim are to be given their broadest reasonable interpretation in proceedings before the PTO, this interpretation must be consistent with the specification and the 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 Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990);

[2] To the extent this quote is intended to reflect the terminology of independent claim 5, it is inaccurate. Claim 5 does not include the word "a."

In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Here, appellant's specification as a whole makes it clear that the ring element does not merely include end and/or cross sectional portions of what may be termed uniform thickness, but rather that the ring element itself is of uniform thickness. We can think of no circumstances under which the artisan, consistent with appellant's specification, would construe the conical elements of Ingersoll, with its progressively thinning side wall, as corresponding to the claimed ring element of uniform thickness. This being the case, we will not sustain the examiner's rejections of the appealed claims under either 35 U.S.C. § 102(b) or 35 U.S.C. § 103.

The decision of the examiner is reversed.

REVERSED

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

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