

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(2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID N. SCHUH

Appeal No. 97-1033
Application 08/190,485¹

ON BRIEF

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

¹ Application for patent filed February 2, 1994.

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DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 5. These claims constitute all of the claims in the application.

Appellant's invention pertains to a bearing clearance detector and method of applying a vacuum or air pressure thereto. An understanding of the invention can be derived from a reading of exemplary claims 1 and 4, copies of which appear in the amendment dated July 10, 1995 (Paper No. 7).²

As evidence of anticipation, the examiner has applied the document listed below:

Schuh	4,928,400	May 29, 1990
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The following rejections are before us for review.

Claims 1 through 3 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.³

² The copy of claim 4 in the brief includes a typographical error in reciting "air or air pressure" (line 6).

³ Particularly in light of appellant's concession that the rejection is proper (brief, page 3) and the circumstance that the examiner has not expressly stated that the rejection is withdrawn, we view the omission of the rejection under 35 U.S.C. § 112, second paragraph, in section (9) of the answer (page 3) as simply inadvertent.

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Claims 1 through 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schuh.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the final rejection and answer (Paper Nos. 9 and 16), while the complete statement of appellant's argument can be found in the brief (Paper No. 15).⁴

As indicated by the examiner (answer, page 2), appellant has not included a statement that the claims do not stand or fall together. Thus, pursuant to 37 CFR § 1.192(c)(7), we select single claim 4 and shall decide the appeal on the basis thereof relative to the anticipation rejection.

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification and method claim 4, the applied patent, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

⁴ A supplemental brief was filed (Paper No. 20) to provide information omitted from the original brief.

The indefiniteness issue

We are constrained to affirm the rejection of appellant's claims 1 through 3 under 35 U.S.C. § 112, second paragraph, in light of appellant's concession regarding the propriety thereof (brief, page 3).

The anticipation issue

We reverse the rejection of appellant's claims under 35 U.S.C. § 102(b).

Selected method claim 4 requires, inter alia, a single operator performing the applying of vacuum or air pressure, with said (single) operator also observing distance indicated on a measurement device.⁵

A reading of the Schuh document reveals to us an absence of any indication whatsoever by the patentee as to the number of operators that operate the bearing clearance detector with the specified equipment on the auxiliary cart (column 3, lines 1 through 4). There clearly is uncertainty from the

⁵ Akin to the noted limitation in selected claim 4, we particularly make reference to a comparable single operator limitation in indefinite claim 1, i.e., the operator of incremental application means also observes the distance measuring device connected to the detector.

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disclosure of the Schuh patent as to the number of operators of the detector. Anticipation cannot be based upon a reference that is ambiguous. See In re Turlay, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962). For this reason, the rejection must be reversed.

NEW GROUND OF REJECTION

Under the authority of 37 CFR § 1.196(b), this panel of the board introduces the following new ground of rejection.

Claims 1 through 5 are rejected under 35 U.S.C. § 103 as being unpatentable over Schuh.⁶

The Schuh patent, considered in its entirety, instructs those of ordinary skill in the art as to a bearing clearance detector, including a measuring device with a micrometer gauge 38, wherein the device is connected by hoses to an auxiliary cart which provides the required vacuum, air pressure, flow measurement, oil source and filters to operate the device.

The Schuh patent cannot, however, be viewed as an isolated disclosure. More specifically, an obviousness question

⁶ We understand claim 1 as being drawn to a combination, consistent with the view of the examiner as expressed on page 2 of the final rejection (Paper No. 9).

cannot be approached on the basis that an artisan having ordinary skill would have known only what they read in a reference, because such artisan must be presumed to know something about an art apart from what a reference discloses. See In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). Further, a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

With the above in mind, we are of the opinion that the overall teaching of Schuh would have suggested to one having ordinary skill in the art a single operator, with the auxiliary cart moved to a location in proximity to the measuring device (with micrometer) for operation of the device. From our perspective, the incentive on the part of one having ordinary skill in the art for carrying out the preceding equipment arrangement would have simply been to gain the self-evident advantage of having all equipment at one location (workstation),⁷ thereby

⁷ In our opinion, one of ordinary skill in the art would have understood the micrometer gauge as being suggestive of a dial indicator, and have expected conventional air and vacuum controls to be present on the cart, e.g., handle operated valving.

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permitting one operator to operate the device; minimizing the number of personnel to a single operator would have clearly been a desirable and expected objective based upon the traditional goal of maximizing the efficient utilization of personnel in a workplace. Our latter assessment presumes skill on the part of those practicing this art, not the converse. See In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985). For the above reasons, we determine that the content of each of claims 1 through 5 is unpatentable under 35 U.S.C. § 103.

In summary, this panel of the board has:

affirmed the rejection of claims 1 through 3 under 35 U.S.C. § 112, second paragraph, as being indefinite; and reversed the rejection of claims 1 through 5 under 35 U.S.C. § 102(b) as being anticipated by Schuh.

Additionally, we have introduced a new rejection in accordance with 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new

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ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision. . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution

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before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART 37 CFR § 1.196

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
WILLIAM F. PATE, III)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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