

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER BINDER, LOTHAR KELLER and MICHAEL WOLF

Appeal No. 1998-3016
Application No. 08/568,344

HEARD: OCTOBER 12, 2000

Before FRANKFORT, McQUADE, and LAZARUS, Administrative Patent Judges.

LAZARUS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 4 through 15, which are all of the claims pending in this application.

We affirm-in-part.

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THE INVENTION

The appellants' invention relates to a flange for a device which separates oil from air (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.¹

Claims 1 and 11 are illustrative and read as follows:

1. An apparatus for separating an oil aerosol from air comprising:

a base member;

an annular coalescer mounted on said base member via a flange consisting of metal sheet coated with rubber; and

a housing surrounding said coalescer, said housing being mounted on said base member,

wherein said flange extends between said housing and said base member to form a seal therebetween.

11. An apparatus for separating an oil aerosol from air, comprising:

a base member including a passage for an air-oil mixture and a passage for clean air;

at least two annular coalescer elements, each said coalescer element being mounted on said base member via a respective flange, an exterior of each said coalescer element

¹ Claims 4 and 14, indicated in the examiner's advisory action (Paper No. 12, mailed September 24, 1997) as "being allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims" are not provided in appellants' appendix to the brief.

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being in communication with one of said passages, an interior of each said coalescer element being in communication with the other of said passages; and

a respective housing surrounding each said coalescer element, said respective housing being mounted on said base member,

wherein each said respective flange consists of a metal sheet with at least a portion of the metal sheet being coated with rubber, said portion of the metal sheet which is coated with rubber extending between said respective housing and said base member to form a seal therebetween.

THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Thurman	1,109,372	September 1, 1914
Briggs	3,118,837	January 21, 1964

THE REJECTIONS

Claims 1, 2, 5 and 9 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Thurman or Briggs.

Claims 1, 2, 5 through 13 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Thurman or Briggs taken in view of the general state of the art.²

² In the examiner's advisory action (Paper No. 12, mailed September 24, 1997) it is indicated that "Claims 4 and 14 are no longer rejected under 35 U.S.C.

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Reference is made to the examiner's answer (Paper No. 17, mailed March 2, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 16, filed January 14, 1998) and reply brief (Paper No. 19, filed May 4, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

112 or 35 U.S.C. 101, and would be allowable if rewritten in independent form
...."

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Grouping of Claims

In the "Grouping of Claims" section of the brief (page 4), the appellants state that, "claims 1, 2 and 5-9 stand or fall together." The remaining claims, 10 through 13 and 15, are submitted to be separately patentable.

In accordance with the appellants' grouping we have selected claim 1 as the representative claim from the appellants' grouping of claims 1, 2 and 5 through 9 and decide the appeal on the rejections under 35 U.S.C. §§ 102 and 103 on the basis of this claim alone. The 35 U.S.C. §§ 102 and 103 rejections of remaining claims 10 through 13 and 15 are decided separately.

The 35 U.S.C. § 102 rejection of claims 1, 2, 5 and 9 as being clearly anticipated by either Thurman or Briggs.

We will not sustain the examiner's rejection of appellants' claims 1, 2, 5 and 9 as anticipated by Thurman, but we will sustain the examiner's rejection of appellants' claims 1, 2, 5 and 9 as anticipated by Briggs.

We note that claim 1 on appeal requires, inter alia, a base member, a housing and a coalescer mounted on the base

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member via a flange consisting of metal sheet coated with rubber and forming a seal between the base and housing.

Turning first to Thurman, we observe that Thurman teaches a member (14) sealingly connected to a housing (10) via a bent sheet metal flange (17, 18), the flange being provided on both sides with a rubber sealing gasket or packing (19), an annular filter bag (16) being connected to the member (14) via the flange. It is the examiner's position that the flange is coated with rubber (the final rejection, Paper No. 10, page 7), whereas in this regard we are in agreement with the appellants' position that Thurman's gasket (19) is a separate member, not a coating.

As stated by appellants, the issue is "[w]hether a claim limitation calling for a flange consisting of a metal sheet coated with rubber is anticipated... by a flange assembled with a separate rubber gasket" (brief, page 3). We note that Thurman describes the flange as "provided on each side with a gasket or packing (19) of some suitable material such as rubber and which when in position lies between the top of the casing (10) and the cover (14) and serves to form an air-tight closure for the cover" (page 1, lines 97-102). In our opinion

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one of ordinary skill in the art would have viewed the gasket or packing in Thurman as being a separate member and not as a metal sheet member coated with rubber.³ Accordingly, since our review of Thurman does not disclose a flange consisting of metal sheet coated with rubber as required by claim 1, we will not sustain the examiner's rejection of claim 1 based on Thurman.

Accordingly, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) as clearly anticipated by Thurman is reversed. It also follows that the examiner's rejection of claims 2, 5 and 9, which are dependent on claim 1, under 35 U.S.C. § 102(b) as clearly anticipated by Thurman is also reversed.

Turning next to the examiner's rejection of claim 1 as clearly anticipated by Briggs, it is the examiner's position that "Briggs teaches a base member (18,62) sealingly connected to a housing (38,48) via a bent sheet metal flange (54,56,58),

³ Enclosed with this decision is a copy of The Condensed Chemical Dictionary, ninth edition, page 215, which defines "coating" as a film or layer applied to a base by, for example, electrolysis, painting, etc. In our view the gasket or packing of Thurman is not a film or layer applied in a manner so as to be a coating on the metal flange (17, 18).

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the flange being coated in operative position by rubber sealing material (60) on both sides, an annular filter media (34) being connected to the base via the flange" (the final rejection, Paper No. 10, page 7).

The appellants' argument is the same as that with respect to Thurman. That is, Briggs' body (60) of elastomeric material is a separate part rather than the coating as required by claim 1. Further, the appellants argue that "the Examiner's attempt to read the instant claim language on the structure of Briggs is untenable... Briggs does not disclose or suggest a rubber coated flange extending between a housing and a base member to form a seal therebetween, as set forth in instant claim[s] 1" (reply brief, page 2).

We do not agree with the appellants' position that Briggs does not teach the features of claim 1 on appeal. In our view Briggs' members (36, 42) and (48) provide a housing for the pleated filter medium, or coalescer (34), which is mounted via rubber covered flange (58) on base (18, 62) so as to provide a seal between the housing and base as prescribed by appellants' claim 1 on appeal. Flange (58) is described by Briggs as "embedded in a body of elastomeric material 60" (col. 2, lines

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31-32) and in our view one of ordinary skill in the art would have understood this to mean that Briggs' flange is coated with the material (60). The term "embed" is defined as to make an integral part of, or to fix firmly in a surrounding mass.⁴ In our view to make an integral part of, or fix firmly, would convey to one of ordinary skill in the art that this is a coating. For this reason we will sustain the examiner's rejection of claim 1 as anticipated by Briggs.

Accordingly, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) as clearly anticipated by Briggs is affirmed. As noted above, the appellants have grouped claims 1, 2 and 5 through 9 as standing or falling together. Thus, it follows that the decision of the examiner to reject claims 2, 5 and 9 under 35 U.S.C. § 102(b) over Briggs is also affirmed.

The 35 U.S.C. § 103 rejection of claims 1, 2, 5 through 13 and 15 as being unpatentable over either Thurman or Briggs taken in view of the general state of the art.

⁴ The American Heritage Dictionary, second college edition, page 447 (copy enclosed with this decision).

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As noted above, Briggs does teach all the limitations of claim 1. A disclosure that anticipates under 35 U.S.C. ' 102 also renders the claim unpatentable under 35 U.S.C. ' 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, we sustain the examiner's rejection of appealed claim 1 under 35 U.S.C. ' 103 over Briggs taken in view of the general state of the art.

As noted above, the appellants have grouped claims 2 and 5 through 9 as standing or falling together with independent claim 1. Thus, it follows that the decision of the examiner to reject claims 1, 2, and 5 through 9 under 35 U.S.C. § 103 as being unpatentable over Briggs taken in view of the general state of the art is affirmed.

Turning now to claims 10 and 11, we note that both claims 10 and 11 include substantially the same limitations as claim 1 with additional structure not recited in claim 1, e.g. the base member including a passage for an air-oil mixture and a passage for clean air, with the exterior of the coalescer

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element being in communication with each of these passages.

The examiner's position is that Briggs is applied as in the rejection of claim 1 and further that "applicant's disclosure makes it clear that the instant invention lies within the use of a rubber coated metal flange within a separator apparatus and not specifically with the structure of the base member (10), which is notoriously well known within the art" (the final rejection, Paper No. 10, page 6).

The examiner's rejection with regard to claims 10 and 11 as being unpatentable over Briggs taken in view of the general state of the art, will not be sustained because, in our view, the combined teachings of Briggs and the general state of the art fail to disclose or suggest a base member with two passages in communication with the coalescer element as recited in claims 10 and 11.

With respect to the examiner's comments regarding the general state of the art, we note appellants' statement that,

[I]n the Amendment filed March 18, 1997 Appellant added claims 10 and 11, including recitations specifically directed to the structure of the base member. At that time, the Examiner was clearly put on notice that Appellant considered the structure of the base

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member to be part of the claimed invention, in combination with the rubber coated flange. As pointed out in the Appeal Brief, that claimed structure of the base member distinguishes over Thurman and Briggs [reply brief, pages 2-3].

In our view the examiner has not provided evidence supporting his contention that the base member structure is notoriously well known in the art. It is apparent to us that the examiner is dismissing the structural features of appellants' claims 10 and 11 because of appellants' assertion that the coating is the inventive aspect. Our review of appellants' prior art disclosure reveals nothing therein which describes the above quoted structural features recited in appellants' claims 10 and 11 as being part of the prior art. Specifically, we do not find evidence that the nebulous "general state of the art" relied upon by the examiner teaches or suggests a base member with two passages in communication with a coalescer element as recited in claims 10 and 11.

Accordingly, the decision of the examiner to reject claims 10 and 11 under 35 U.S.C. § 103 as being unpatentable over Briggs taken in view of the general state of the art is reversed. It also follows that the examiner's rejection of claims 12, 13 and 15, which are dependent on claim 11, as

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being unpatentable under 35 U.S.C. § 103 over Briggs taken in view of the general state of the art is also reversed.

We will not sustain the examiner's 35 U.S.C. § 103 rejection of claims 1, 2, 5 through 13 and 15 as being unpatentable over Thurman taken in view of the general state of the art.

With regard to the examiner's rejection of claim 1 as being unpatentable over Thurman taken in view of the general state of the art, we again note that the examiner relies on the nebulous "general state of the art" for the teaching of the structure of the claimed base member or base members. The general state of the art is not relied on for teaching a flange consisting of metal sheet coated with rubber as required by claim 1 and, as discussed above, this feature is not disclosed by Thurman. Accordingly, the examiner's rejection with regard to claim 1 as being unpatentable over Thurman taken in view of the general state of the art, will not be sustained because, in our view, the combined teachings of Thurman and the general state of the art fail to disclose or suggest a flange consisting of metal sheet coated with rubber as required by claim 1.

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Claims 2 and 5 through 10 are dependent on claim 1. Thus, it follows that the decision of the examiner to reject claims 1, 2, and 5 through 10 under 35 U.S.C. § 103 as being unpatentable over Thurman taken in view of the general state of the art is reversed.

The examiner's rejection with regard to claim 11 as being unpatentable over Thurman taken in view of the general state of the art, will not be sustained.

Claim 11 includes two flanges, each of which, like claim 1, consists of a metal sheet with at least a portion of the metal sheet being coated with rubber. As discussed above, we do not find this feature to be taught or suggested by Thurman.

Again, we see no evidence with respect to the general state of the art which teaches or suggests this feature. The examiner's rejection of claim 11 as being unpatentable over Thurman taken in view of the general state of the art, will not be sustained because, in our view, the combined teachings of Thurman and the general state of the art fail to disclose or suggest flanges, each of which consists of a metal sheet with at least a portion of the metal sheet being coated with rubber, as recited in claim 11.

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Additionally, we note that claim 11 requires a base member including a passage for an air-oil mixture and a passage for clean air, both passages being in communication with the coalescer element. From our perspective there is no evidence with respect to the general state of the art which discloses or suggests a base member with two passages in communication with the coalescer element as recited in claim 11. Our review of Thurman also reveals nothing therein which teaches or suggests this feature. The examiner's rejection of claim 11 as being unpatentable over Thurman taken in view of the general state of the art, will not be sustained because, in our view, the combined teachings of Thurman and the general state of the art fail to disclose or suggest a base member including a passage for an air-oil mixture and a passage for clean air, both passages being in communication with the coalescer element, as recited in claim 11.

Claims 12, 13 and 15 are dependent on claim 11. Thus, it follows that the decision of the examiner to reject claims 11 through 13 and 15 under 35 U.S.C. § 103 as being unpatentable over Thurman taken in view of the general state of the art is reversed.

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CONCLUSION

To summarize,

the decision of the examiner to reject claims 1, 2, 5 and 9 under 35 U.S.C. § 102 over Thurman is reversed,

the decision of the examiner to reject claims 1, 2, 5 and 9 under 35 U.S.C. § 102 over Briggs is affirmed,

the decision of the examiner to reject claims 1, 2, and 5 through 9 under 35 U.S.C. § 103 over Briggs in view of the general state is affirmed,

the decision of the examiner to reject claims 10 through 13 and 15 under 35 U.S.C. § 103 over Briggs in view of the general state is reversed, and

the decision of the examiner to reject claims 1, 2, 5 through 13 and 15 under 35 U.S.C. § 103 as being unpatentable over Thurman taken in view of the general state of the art is also reversed.

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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

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
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RICHARD B. LAZARUS)	
Administrative Patent Judge)	

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APPLICATION NO. 08/568,344

APJ LAZARUS

APJ FRANKFORT

APJ McQUADE

DECISION: **AFFIRMED-IN-PART**

Prepared By:

DRAFT TYPED: 24 Sep 01

FINAL TYPED: