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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANDREAS FINK and WOLFGANG WOERNLE

Appeal 2010-011666
Application 10/524,811
Technology Center 3600

Before JOHN C. KERINS, JOHN W. MORRISON, and
WILLIAM A. CAPP, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 9-11, 13-17 and 19-26. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and ENTER A NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b).

THE INVENTION

Appellants' invention is a fastening assembly. Spec. 1. Claim 9, reproduced below, is illustrative of the subject matter on appeal.

9. A fastening assembly, comprising:

a first component having a threaded bushing;

a second component having a keyhole shaped cut-out including a larger opening and a smaller opening; and

a self-locking bolt configured to be screwed into the threaded bushing so that the bolt can be guided with the head through the larger opening of the cut-out and the head engages behind the smaller opening of the cut-out for fastening, the bolt having engagement surfaces for a tool at an end of the shank, wherein the head has a bottom surface connecting the head to the shank and a top surface that is round and smooth.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Spurr	EP 0 747 604 A1	Dec. 11, 1996
Jakob	US 6,309,132 B1	Oct. 30, 2001

The following rejections are before us for review:

1. Claims 9-11, 13, 14, 17, 19, 22, 23 and 26 are rejected under 35 U.S.C. § 102(b) over Jakob.

2. Claims 15, 16, 20, 21, 24 and 25 are rejected under 35 U.S.C. § 103(a) over Jakob and Spurr.

OPINION

Anticipation by Jakob

Appellants argue claims 9-11, 13, 14, 17, 19, 22, 23 and 26 as a group. App. Br. 5-7. We select claim 9 as representative of the group. Claims 10, 11, 13, 14, 17, 19, 22, 23 and 26 stand or fall with claim 9. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2011).

The Examiner finds that Jakob discloses a fastening comprising a first component with a threaded bushing and a second component with a key-hole cut-out as claimed. Ans. 4. The Examiner further finds that Jakob discloses a self-locking bolt configured to be screwed into a bushing with the head guided through the larger key-hole opening and then engages behind the smaller key-hole cut-out. *Id.* The Examiner further finds that Jakob discloses a bolt with a tool engagement surface at one end of a shank and a head with a bottom surface. *Id.* Finally, the Examiner finds that the bolt head has a top surface that is round and smooth as claimed. *Id.*

Appellants essentially raise one, and only one, issue with respect to the Examiner's anticipation rejection over Jakob, namely, that the upper surface of Jakob's bolt head is not "smooth." *See* App. Br. 5-7. In essence, Appellants argues that, because the top surface of Jakob's bolt head has a three dimensional hexagonal tool engagement structure protruding from its circular base portion (radial flange), the bolt head is not "smooth" within the meaning of claim 1. *Id.* Appellants do not argue or present evidence that the upper surface of the circular bolt head radial flange portion that extends

laterally from the peripheral circumference of the bolt head to the sides of the hexagonal tool engagement structure is not “smooth.”

The issue before us is straightforward. Appellants contend that the “smooth” limitation requires the entire upper surface of the bolt head to be flat. The Examiner, on the other hand, finds that the “smooth” limitation is satisfied by the upper surface of just the radial flange 38 of the bolt head.

Ans. 8. We agree with the Examiner’s position.

The effective claim language of claim 1 refers to “... a top surface ...”. App. Br., Clms. App’x. Generally, an indefinite article, such as “a,” in patent parlance means “one or more” in open-ended claims containing the transitional phrase “comprising.” *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000). “Unless the claim is specific as to the number of elements, the article ‘a’ receives a singular interpretation only in rare circumstances when the patentee evinces a clear intent to so limit the article.” *Id.* In the instant case, Appellants identify no language in the specification that evinces a clear intent to limit the entirety of the upper surface of the bolt head to a flat, two-dimensional contour. Thus, the “smooth” limitation is satisfied by the upper surface of the radial flange 38, which is “a” top surface, of Jakob’s bolt head.

We sustain the Examiner’s anticipation rejection of claim 9. Claims 10, 11, 13, 14, 17, 19, 22, 23 and 26 fall with claim 9.

Unpatentability Over Jakob and Spurr

Appellants argue claims 15, 16, 20, 21, 24 and 25 as a group. App. Br. 7-9. We select claim 15 as representative. Claims 16, 20, 21, 24 and 25 stand or fall with claim 15. Claim 15 depends from claim 9, which is anticipated by Jakob. Claim 15 adds the limitation: “wherein the first

component includes a translation guard configured to prevent a translatory movement of the first component when fastened.” App. Br., Clms. App’x.

The Examiner finds that Spurr includes mating parts that prevent rotation and translation of the first component when assembled. Ans. 6. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to modify Jakob with Spurr to include translational and rotational guards in order to secure and stabilize the assembly. *Id.*

Appellants traverse the Examiner’s rejection by first arguing that Spurr does not cure the alleged deficiency of Jakob. App. Br. 8. This argument is without merit. Figure 2 of Spurr shows that all portions of the top surface of bolt head 28 are flat and, therefore, “smooth” even according to Appellants’ aforesaid interpretation of a top surface that is smooth. Thus, we find that Spurr would, in fact, cure the alleged deficiency in Jakob regarding the “smoothness” of the bolt head.

Appellants next argue that the Examiner’s grounds of rejection are deficient for failure to define the level of ordinary skill in the art. App. Br. 8. We disagree. The absence of specific findings on the level of skill in the art does not give rise to reversible error “where the prior art itself reflects an appropriate level and a need for testimony is not shown.” *Okajima v Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). In the instant case, the Examiner’s obviousness conclusion is succinctly summarized in the following passage from the Answer.

it would have been obvious to one of ordinary skill in the art, having the teachings of Jakob and EP 604 before him at the time the invention was made, to modify Jakob as taught by EP604 to include translational and rotational guards to prevent translation of the 1st component and rotation of the 1st component in order to obtain a secure and stable assembly.

One would have been motivated to make such a combination because if the components were allowed translational and/or rotational movement, the heads could move to the larger hole of the keyhole and the assembly would come loose.

Ans. 6. By outlining what one would know from the references, the Examiner has established the level of skill in the art in the way that is typically met during examination and Appellants have failed to argue or provide a persuasive basis for a different finding. *See Ex parte Jud*, 85 USPQ2d 1280 (BPAI 2007). Here, the Examiner's discussion of the prior art references in the final Office Action and Answer is sufficient to put the Appellants on notice about what the Examiner thought one of skill in the art would have known and why. *See Jud* at 1283-1285.

In view of the foregoing, we sustain the Examiner's rejection of claim 15. Claims 16, 20, 21, 24 and 25 fall with claim 15.

*New Grounds of Rejection
Unpatentability of Claims 9-11, 13, 14, 17, 19, 22, 23 and 26
Over Jakob and Spurr*

As discussed more fully above, Appellants' sole argument to traverse the anticipation rejection was that Jakob's bolt lacked a top surface that was smooth.¹ Although we disagree with Appellants and agree with the Examiner on this point, we nevertheless find that Spurr discloses a bolt with a top surface that, in its entirety, is round, flat, and smooth. Spurr, Figure 2.

¹ We agree with the Examiner that Jakob discloses each and every limitation of claims 9-11, 13, 14, 17, 19, 22, 23 and 26. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, since anticipation is the epitome of obviousness. *See In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982); and *In re Pearson*, 494 F.2d 1399, 1402 (CCPA 1974) .

It would have been obvious for a person of ordinary skill in the art at the time of the invention to modify Jakob's bolt so that it had a round, flat, smooth top surface as disclosed in Spurr. A person of ordinary skill in the art would have been motivated to make the modification because removal of the hexagonal tool interface protrusion from the top surface of the bolt head would allow the bolt head to be more readily inserted into confined spaces behind a panel with a key-hole opening and a hexagonal tool interface would be unnecessary in product applications involving confined spaces lacking access to the top surface of the bolt head. *Application of Larson*, 340 F.2d 965, 969 (CCPA 1965) (eliminating undesired additional feature is a matter of obvious choice).

Thus, claims 9, 10, 11, 13, 14, 17, 19, 22, 23 and 26 are unpatentable under 35 U.S.C. § 103(a) over the combination of Jakob and Spurr and we hereby enter a new ground of rejection on that basis, pursuant to our authority under 37 C.F.R. § 41.50(b).

DECISION

The decision of the Examiner to reject claims 9-11, 13, 14, 17, 19, 22, 23 and 26 under 35 U.S.C. §102(b) over Jakob is affirmed.

The decision of the Examiner to reject claims 15, 16, 20, 21, 24 and 25 under 35 U.S.C. § 103(a) over Jakob and Spurr is affirmed.

We enter a new ground of rejection of claims 9, 10, 11, 13, 14, 17, 19, 22, 23 and 26 under 35 U.S.C. § 103(a) as unpatentable over Jakob and Spurr.

FINALITY OF DECISION

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellants, 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 the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. § 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless the affirmed rejections are overcome.

If Appellants elect 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 Patent Trial and Appeal Board for final action on the affirmed rejections, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)

Klh