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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARIO MEGGIOLAN

Appeal 2010-011962
Application 10/193,008
Technology Center 3600

Before STEFAN STAICOVICI, BRETT C. MARTIN, and PATRICK R. SCANLON, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Mario Meggiolan (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 3-8 and 13-17. Claims 1, 2 and 9-12 have been cancelled. Appellant presents additional evidence in the Declaration of Mario Meggiolan pursuant to 37 C.F.R. § 1.132, filed November 24, 2006 (hereafter referred to as the "Inventor's Declaration"). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and denominate our affirmance as a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

THE INVENTION

The claimed subject matter relates to "a device for closing a chain, particularly a bicycle chain." Spec., para. [0003]. Claim 3, reproduced below, is illustrative of the subject matter on appeal.

> 3. Device for reclosing a chain, the device comprising:
>
> a pair of inner plates connected to a first and a second pair of end outer plates; and
>
> a pair of rivets for connecting a pair of end holes of the first and of the second pair of end outer plates to the corresponding holes of a pair of end inner plates of a chain to be closed.

THE REJECTIONS

Appellant seeks review of the following rejections:

The rejection of claims 3-8 under 35 U.S.C. § 102(b) as being anticipated by Lin (US 5,178,585, iss. Jan. 12, 1993).[1]

The rejection of claims 13-17 under 35 U.S.C. § 103(a) as being unpatentable over Lin.

ANALYSIS

Anticipation based on Lin

Claims 3 and 4

Regarding independent claim 3, the Examiner finds that Lin discloses a chain with an adjustable number of links that inherently includes a closure device. Final Rej. 2.[2] The Examiner further finds that Lin discloses a "closure linkage comprising one pair of inner plate [sic] and two pairs of outer plates." Final Rej. 4; Ans. 3.

Appellant argues that "[a] distinction exists between a chain closing device[3] and the chain itself," pointing to the Inventor's Declaration as

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[1] There appears to be some question as to whether claims 5-8 are also rejected under 35 U.S.C. § 102(b) as being anticipated by Nakamura (US 6,176,798 B1, iss. Jan. 23, 2001). *See* Reply Br. 3. For the reasons discussed below, we determine that the Examiner is not maintaining a rejection based on Nakamura.

[2] As used herein, "Final Rej." refers to the Office Action mailed Aug. 7, 2007.

[3] We note that Appellant's claims do not actually recite a "chain closing device" but instead use a variety of other phrases (i.e., "device for reclosing a chain," "closing device for closing an opened chain," "coupling for reconnecting the end of an opened chain," and "connector for reconnecting the ends of an opened chain"). Appellant uses the phrase chain closing device (or chain *closure* device) extensively throughout the Appeal Brief

presenting evidence that one of ordinary skill in the art would recognize such a distinction. App. Br. 11-12[4] (footnote added). Appellant then argues that Lin discloses a chain and thus fails to disclose a chain closing device. App. Br. 12; Reply Br. 6-7.

We are not persuaded by these arguments. The assertion that a chain closing device is distinct from a chain has little bearing whether Lin anticipates claim 3 because Appellant has not established that a chain closing device and a chain are mutually exclusive. In other words, the fact that Lin discloses a chain does not necessarily mean that Lin cannot disclose a chain closing device.

To determine whether Lin discloses a chain closing device, we first must interpret the claim language at issue. During examination, patent claims are given their broadest reasonable interpretation in light of the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*). Appellant's Specification refers to a "chain closing device" as being used to "reciprocally connect the two ends [of a bicycle chain]." Spec., para. [0017]. In addition, the terms "closing" or "closed" are referred to as the reciprocal connection of the two ends of a chain to produce an endless chain configuration. Spec., paras. [0003], [0016]. Accordingly, we determine that the broadest reasonable interpretation of "chain closing

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and Reply Brief to refer to the claimed invention and does not argue that any of the actual claim phrases have a distinct meaning. *See e.g.*, App. Br. 7 (the claims at issue "are directed to a chain closure device"). Accordingly, we adopt this convention herein and use the phrase "chain closing device" to inclusively refer to all of the claimed devices.

[4] As used herein, "App. Br." refers to the Third Amended Appeal Brief filed July 29, 2009.

device" means any structure that connects two ends of a chain to produce an endless chain configuration.

Applying this interpretation, we determine that any subset of contiguous links in a closed chain would connect the ends of the remainder of the chain and thus be a chain closing device. We thus agree with the Examiner that Lin discloses a chain closing device. In particular, Figure 1 of Lin[5] shows a subset of contiguous links comprising a first pair of outer plates (plates 6 and 10), a pair of inner plates (unnumbered but shown to the left of outer plates 6 and 10 in Figure 1), and a second pair of outer plates (unnumbered but shown to the left of the above-mentioned pair of inner plates). This subset of links forms a chain closing device that connects the ends of the remainder of Lin's chain. Furthermore, the similarity between this subset of links and the rest of Lin's chain links does not prevent the subset from being a chain closing device. As noted by the Examiner, Appellant's claims do not differentiate the links of the chain closing device from the other links of the chain. Ans. 4. Unlike the two patents cited in the Inventor's Declaration[6] (which involve a "master chain link" and a "special quick-connection link," respectively, that are described as having clear structural differences from the rest of the chain links), the chain closing device of the present invention is not described as being structurally different from the rest of the chain links.

Appellant also argues that Lin fails to teach a chain closing device terminating in outer plates at both ends. Reply Br. 4. We do not find this

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[5] Contrary to Appellant's assertion (Reply Br. 4), Figure 1 of Lin does not depict an entire chain that terminates in two pairs of inner plates; instead this figure depicts a *segment* of a chain. Lin, col. 2, ll. 10-12.
[6] U.S. Patent Nos. 5,362,282 and 6,364,799 (Inventor's Decl., para. 16).

argument convincing because Lin teaches a subset of links that defines a chain closing device terminating in outer plates at each end as discussed *supra*.

Lastly, Appellant argues that Lin teaches away from Appellant's configuration. Reply Br. 5. However, "[t]he question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis." *Manual of Patent Examining Procedure* (MPEP) § 2131.05 (8th ed., Rev. 9, August 2012) (quoting, *Celeritas Technologies, Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, (Fed. Cir. 1998)).

For the above reasons, we sustain the rejection of independent claim 3. We also sustain the rejection of claim 4, which depends from claim 3 and for which Appellant does not advance any separate arguments.

Claims 5-8

In rejecting claims 5-8 as being anticipated by Lin, the Examiner contends that these claims are product-by-process claims, and because the patentability of a product-by-process claim is based on the product only (i.e., not the recited process steps), the Examiner finds that Nakamura fully meets the claimed chain. Final Rej. 2-3.

As an initial point, Appellant notes the apparent incongruity of stating that *Nakamura* meets the claimed device where the claims are rejected based on *Lin*. App. Br. 13. In response, the Examiner states that Nakamura was used as an "example" and is not "a form of rejection." Ans. 4. This does not appear to be consistent with the statement that Nakamura fully meets the claim. The statement instead appears to be a typographically error, perhaps as a result of the use of Nakamura in rejecting the claims in earlier Office

Actions. In any event, we determine that the Examiner's intent was to reject claims 5-8 as being anticipated by Lin only, not by Nakamura.

Appellant argues that claims 5-8 are not product-by-process claims because they apply to a process of *using* the claimed device rather than a process of *making* the claimed device. App. Br. 13-14. We agree with Appellant that claims 5-8 do not define the claimed device in terms of the process by which the device is made and are thus not product-by-process claims. However, "a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham,* 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (citation omitted); *see also*, MPEP § 2114, II.

Appellant concedes that claims 5-8 relate to processes of using the chain closing device. App. Br. 14. In fact, claims 5-7 recite only process steps and do not include any structural limitations in addition to those recited in independent claim 3. The chain closing device disclosed by Lin thus comprises the same structural features as claims 5-7. Accordingly, we sustain the rejection of claims 5-7 but because our reasoning differs from the Examiner's, we denominate our affirmance of the rejection of claims 5-7 as a new ground of rejection.

Claim 8 recites that each rivet "is associated with a guide element." As such, claim 8 recites structure—the guide elements—that is not disclosed by Lin. Because Lin does not disclose all of the recited structure, we do not sustain the rejection of claim 8 under 35 U.S.C. § 102(b) as being anticipated by Lin.

Obviousness based on Lin

The Examiner finds that Lin is not limited to a particular number of links and thus does not disclose a particular number of inner plates, outer plates and rivets but concludes one of ordinary skill in the art would have known to include the claimed number of plates and rivets. Ans. 3. Appellant argues that the Examiner's rationale that Lin shows "it is known to one of ordinary skill in the art to adjust the closure device to obtain the desired *length*" is irrelevant. App. Br. 15-16 (quoting Final Rej. 4). However, the Examiner disagrees, noting that "to decide the end of the closure device one would have to also consider the end of the actual chain to mesh with the end of the closure device." Ans. 5. We agree with this statement because, as discussed *supra*, any subset of contiguous links in the chain of Lin can be considered to be a chain closing device that connects the ends of the remainder of the chain.

Moreover, because we agree with the Examiner's finding that Lin discloses a chain closing device comprising one pair of inner plates and two pairs of outer plates (*see* Final Rej. 4; Ans. 3), we determine that Lin discloses a chain closing device having four outer plates, two inner plates, and two rivets as called for in each of claims 13-17. We thus sustain the Examiner's rejection of claims 13-17 under 35 U.S.C. § 103(a) as being unpatentable over Lin given that "a complete description [is] but the ultimate or epitome of obviousness." *In re Kalm*, 378 F.2d 959, 962 (C.C.P.A. 1967).

The Inventor's Declaration

We disagree with Appellant's contention that the Examiner failed to accord due weight to the Inventor's Declaration. App. Br. 8-11; Reply Br.

7-8. The Examiner did consider the Inventor's Declaration and found it not sufficient or persuasive to overcome the prior art rejection. Final Rej. 4; Ans. 5. Furthermore, we note that the Inventor's Declaration refers to the Examiner's previous reliance on admitted prior art and Nakamura (Inventor's Decl., paras. 14, 15) but makes no mention of the Lin reference. The Inventor's Declaration is thus not commensurate in scope with the appealed grounds of rejection.

In addition, the Inventor's Declaration primarily consists of argument and opinion and presents little factual evidence supporting patentability of the claims. The evidence showing that a chain closing device is distinct from a chain (Inventor's Decl., para. 16) is not persuasive for the reasons discussed *supra*. We thus find the Inventor's Declaration insufficient to overcome the prior art rejections.

DECISION

We affirm the decision of the Examiner rejecting claims 3-7 and 13-17 and denominate our affirmance of the rejection of claims 5-7 as a NEW GROUND OF REJECTION.

We reverse the decision of the Examiner rejecting claim 8.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2011). 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 Appellant, <u>WITHIN TWO MONTHS FROM THE DATE OF THE DECISION</u>, 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 Appellant 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 rejection[7], the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome. If 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 Patent Trial and Appeal Board 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 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

llw

[7] 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."