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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GEORG BOEING

Appeal 2017-009377
Application 13/361,522¹
Technology Center 3600

Before EDWARD A. BROWN, NATHAN A. ENGELS, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a non-final rejection of claims 1, 3–6, and 9–17. Claims 2, 7, 8, and 18 are canceled. This Appeal was argued in a hearing on June 13, 2019. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellant identifies Siemens Geared Motors Gesellschaft Mit Beschränkter Haftung as the real party in interest. Appeal Br. 2.

ILLUSTRATIVE CLAIM

Claim 1 is the only independent claim at issue and is reproduced below as illustrative of the claimed subject matter:

1. A clamping apparatus for fastening a hollow shaft or hub to a shaft, comprising:
 - a hollow shaft or hub having an end provided with an inner taper and a support shoulder;
 - a ring element provided with a cylindrical inner surface and having an end side which includes a plurality of axial threaded bores, said ring element being attached to the end of the hollow shaft or hub and axially fixed on the hollow shaft or hub by the support shoulder of the hollow shaft or hub and a securing ring fastened to the hollow shaft or hub; and
 - a clamping element having an end-side flange integrally formed in one piece on the clamping element, said flange having a plurality of axial passage openings receiving clamping screws, said clamping element having a portion provided with an outer taper and arranged radially between the shaft and the inner taper of the hollow shaft or hub, said clamping element being threadably engaged to the ring element, and wherein the ring element and the portion of the clamping element have substantially identical axial extents.

THE REJECTIONS

Claims 1, 3–6, and 9–14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Strang (US 3,590,652; July 6, 1971) and Müller et al. (US 5,496,127; Mar. 5, 1996).

Claims 15–17 stand rejected under 35 U.S.C. §103(a) as being unpatentable in view of Strang, Müller, and Rieser (US 2,811,861; Nov. 5, 1957).

ANALYSIS

The Examiner finds that Strang discloses each element of claim 1, including a ring element and a clamping element, but the Examiner determines that “Strang fails to disclose wherein the ring element and the portion of the clamping element have substantially identical axial extents.” Non-final Act. 6. According to the Examiner, however, changing the size of Strang’s ring element and/or clamping element to have substantially identical axial extents would have been a design consideration within the skill of a person of ordinary skill in the art, and the Examiner determines that Appellant’s Specification does not attribute any significance to the relative axial extents. Non-final Act. 6 (citing *In re Rose*, 220 F.2d 459 (CCPA 1955); *In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975)); Ans. 3–4. The Examiner additionally cites Müller as evidencing that it was known in the art to arrange a ring element and a portion of a clamping element to have substantially identical axial extents. Non-final Act. 6–8; Ans. 3–5.

Appellant argues that based on the arrangement of Stang’s housing and relevant sleeves (clamping element), Stagg’s housing counteracts expansion of the ends of the sleeves and a person of ordinary skill in the art “would therefore not have had any reason to expand the ring 112, 112' in Strang axially to a length substantially corresponding to the length of the tapered portions 96, 96' because the axial region into which the tapered portions would have to be expanded are already occupied by the housing 12.” App. Br. 4; *see* Reply Br. 2–3. Further, Appellant argues there is no problem in Strang regarding the strength of the engagement of its parts and therefore a person of ordinary skill would not have had any reason to modify the axial extent of Strang’s ring element, especially not to make the axial

extent of the ring substantially identical to the tapered portion of Strang's bushing (clamping element). Appeal Br. 2–3.

Appellant contends its arguments are based on “an objective observation of the device of Strang,” suggesting that the functions of relevant parts of Strang's device are readily apparent to a person of ordinary skill. Reply Br. 3. It similarly follows that a person of ordinary skill would have understood the functions of relevant parts of Müller's device, and we agree with the Examiner that changing the relative sizes of Strang's ring element and the tapered portion of the clamping element would have been a design consideration within the ability of a skilled artisan, with a person of ordinary skill recognizing that changes in one aspect may require changes in another aspect of the device, while still yielding predictable success. *See* Ans. 3.

We also agree with the Examiner that Appellant's Specification does not attribute any particular significance to the axial-extents limitation. Appellant's Specification describes the following functions of the ring element, each of which is described without reference to the relative lengths of the axial extents: “[t]he ring element . . . provides for an improved absorption of radial forces, because the ring element encompasses the hollow shaft or hub and the outer taper of the clamping element[,] prevents the radial widening thereof, and at the same time enables centering.” Spec. ¶ 5. Paragraph 10 of the Specification states “[a]ccording to another advantageous feature of the present invention, the ring element and the portion of the clamping element can have substantially identical axial extents,” but this passage does not explain why having substantially identical axial extents would be uniquely advantageous. Paragraph 21 also references

“substantially identical axial extents” without reference to any criticality or particular advantage.

The Federal Circuit has held that where the only difference between a claim and the prior art is a recitation of relative dimensions of the claimed device, and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device is not patentably distinct from the prior art device. *Gardner v. TEC Sys., Inc.*, 725 F.2d 1338, 1349 (Fed. Cir. 1984). We also agree with the Examiner that the claimed axial-extents limitation reflects a design choice available to a person of ordinary skill by mere rearrangement of parts with predictable results (Ans. 3–4), and we sustain the Examiner’s rejection of claim 1.

Appellant relies on the same arguments for claims 3–6, 9–14, and 15–17. We disagree with Appellant’s arguments for the same reasons, and we therefore sustain the Examiner’s rejections of claims 3–6, 9–14, and 15–17.

DECISION

We affirm the Examiner’s rejection of claims 1, 3–6, 9–14, and 15–17.

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