

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

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS PFAB, MANFRED SCHMIDT, NORBERT ZIMMERMANN,
NORBERT SORGEL and PETER DONHAUSER

Appeal No. 2001-1077
Application No. 09/051,506

ON BRIEF

Before JERRY SMITH, RUGGIERO, and DIXON, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 9-17, which are all of the claims pending in the present application. Claims 1-8 have been canceled.

The claimed invention relates to a switchgear housing for an electromagnetic switching device having a magnetic chamber. The magnetic chamber includes a magnet yoke, a magnet armature, and two magnet supporting areas. According to Appellants (specification, pages 1 and 2), the two magnet supporting areas have different

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elastic resiliency, thereby acting to reduce the rebound of the magnet armature due to impact vibrations.

Claim 9 is illustrative of the invention and reads as follows:

9. A switchgear housing for an electromagnetic switching device including a magnet yoke and a magnet armature, comprising:

a magnetic chamber including a vibratable magnetic-chamber base, the magnetic-chamber base having a surface including a supporting strip, the surface facing an interior space of the switchgear housing, the supporting strip including a first end configured as a first magnet-supporting area and a second end configured as a second magnet-supporting area, the first magnet-supporting area having a first elastic resiliency and the second magnet-supporting area having a second elastic resiliency, the first elastic resiliency being different from the second elastic resiliency, the first magnet-supporting area being retained at the first end only by the magnetic-chamber base;

wherein the first magnet-supporting area and the second magnet-supporting area support the magnet yoke, and the magnet armature is positionable in the magnetic chamber.

The Examiner relies on the following prior art:

Lemmer	4,229,719	Oct. 21, 1980
Schmiedel et al. (Schmiedel)	4,647,886	Mar. 03, 1987
Sitar	5,623,239	Apr. 22, 1997
		(filed Jan. 17, 1996)

Claims 9-17 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by each one of Schmiedel and Lemmer. Claims 9-11 and 13-17 also stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Sitar.

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Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief (Paper No. 10) and the Answer (Paper No. 11) for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of anticipation relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that none of the applied Schmiedel, Lemmer, and Sitar references fully meets the invention as set forth in the claims on appeal. Accordingly, we reverse.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert.

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dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to claim 9, the sole independent claim on appeal, the Examiner initially attempts to read the various limitations on the disclosure of Schmiedel. In particular, the Examiner (Answer, pages 2 and 3) points to the structure illustrated in Figures 23, 28, and 29 of Schmiedel along with the accompanying description beginning at column 7, line 58.

Appellants' arguments in response assert a failure of Schmiedel to disclose every limitation in independent claim 9 as is required to support a rejection based on anticipation. At page 7 of the Brief, Appellants' arguments focus on the contention that the magnet supporting surface of Schmiedel, identified by the Examiner as the region below rubber blanket 614, does not correspond to a supporting strip, let alone one having first and second supporting areas with differing elastic resiliency as claimed.

After reviewing the Schmiedel reference in light of the arguments of record, we are in general agreement with Appellants' position as expressed in the Brief. As pointed out by Appellants (Brief, pages 6 and 7) the magnetic chamber region below element

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614 in Schmiedel is illustrated, for example in Figure 23, as a plurality of composite parts, the structural nature of which is not described in the disclosure of Schmiedel. Given this deficiency in the disclosure of Schmiedel, it is our view that any conclusions drawn as to the structure of Schmiedel's magnet supporting region below rubber blanket element 614 can only be based on unwarranted speculation.

As to the Examiner's position that the asserted first and second magnet supporting areas in Schmiedel have differing elastic resiliency as claimed "...due to the left-right symmetry of the magnetic chamber base" (Answer, page 2), we find the record totally devoid of any evidentiary support for such a position. "[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "common knowledge" and "common sense" may only be applied to analysis of evidence, rather than be a substitute for

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evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

In view of the above discussion, since all of the claim limitations are not present in the disclosure of the applied prior art reference, we do not sustain the Examiner's 35 U.S.C. § 102(b) rejection of independent claim 9, nor of claims 10-17 dependent thereon, based on Schmiedel.

Turning to the Examiner's separate 35 U.S.C. § 102(b) rejection of independent claim 9, and claims 10-17 dependent thereon, based on Lemmer, we do not sustain this rejection as well. In addressing the magnet supporting strip feature of appealed independent claim 9, the Examiner (Answer, page 5) directs attention to the mounting plate 31 in Lemmer. As with the rejection based on Schmiedel, the Examiner invokes the left-right asymmetry of Lemmer's magnetic chamber base as a basis for concluding that the first and second magnet supporting areas have differing elastic resiliency. For all of the reasons discussed supra with respect to Schmiedel, however, we find no evidence presented by the Examiner that would support any such conclusion with respect to the disclosure of Lemmer.

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Lastly, and for similar reasons, we also do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of independent claim 9 and dependent claims 10, 11, and 13-17 as being anticipated by Sitar. The Examiner has not provided any evidence to support the conclusion that the asymmetrical structure of Sitar's magnetic chamber base 22 results in the magnet supporting strip (identified by the Examiner as spring member 36) as having first and second magnet supporting areas with differing elastic resiliency.

In summary, we have not sustained any of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 9-17 is 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).

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOSEPH L. DIXON)	
Administrative Patent Judge)	

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