

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.20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GORDON DENNIS HOBB and DAVID LLOYD HOBB

Appeal No. 2004-1057
Application 09/844,385¹

ON BRIEF

Before FLEMING, DIXON, and LEVY, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 9-13. Claims 1 and 19 have been canceled. Claims 2-8 and 15-18 are allowed. Claim 14 is objected to.

¹Application for patent filed on April 27, 2001.

INVENTION

Appellants' invention relates to an actuator device 100 for adjusting the position of an elongated member 110 relative to a component, such as, an aperture 74 in Fig. 2. See Appellants' specification, page 5, lines 1 and 2, and page 11, lines 26-29.

As shown in Figs. 3-5, Appellants' actuator device 100 comprises a track bearing member 102 having a track 114 to receive a track follower 116. See Appellants' specification, page 10, lines 21-30. The track 114 is in the form of a closed loop having first and second locating positions 121 and 122 for the follower 116 and first and second limit stops 124 and 126. See Appellants' specification, page 11, lines 1-4. An actuator member 104 in the form of a button formed in two parts: a first part 106 and a second part 108 and is connected to an end of the elongate member 110 and slidably located relative to the track bearing member 102. See Appellants' specification, page 10, lines 21-24. A biasing member 112 urges the actuator 104 outwardly with respect to the track bearing member 102 to urge the follower 116 into the first locating position 121 or the second locating position 122. See Appellants' specification, page 10, lines 24-26. The actuator 104 is pushed inwardly with

respect to the track bearing member 102 against the biasing member 112 to move the follower 116 between the first and second locating positions 121 and 122. See Appellants' specification, page 11, lines 6-24. The movement of the follower 116 from the first locating position 121 to the second locating position 122 causes no net rotation of the actuator 104 relative to the track bearing member 102. See Appellants' specification, page 12, lines 13-15.

Claim 9 is representative of the claimed invention and is reproduced as follows:

9. An actuator device for adjusting the position of an elongated member relative to a component, the device comprising:

a track bearing member adapted to be fixed relative to the component, the track bearing member having a track in the form of a closed loop, wherein the track is adapted to receive a track follower and has first and second locating positions for said track follower;

an actuator member connected to an end of the elongate member and slidably located with respect to the track bearing member, and comprising said track follower to be received in the track; and

a biasing member for urging the actuator member outwardly with respect to the track bearing member and to urge said track follower into said first or second locating positions;

wherein said actuator member is adapted to be pushed inwardly with respect to the track bearing member against said

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biasing member to move said track follower between said first and second locating positions, and movement of said track follower from said first locating position to said second locating position and back to said first locating position causes no net rotation of said actuator member relative to the track bearing member.

REFERENCE

The reference relied on by Examiner is as follows:

Gorgi et al. (Gorgi)	6,074,008	Jun. 13, 2000 (filed Jul. 7, 1998)
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REJECTIONS AT ISSUE

Claims 9-13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gorgi.

OPINION

With full consideration being given to the subject matter on appeal, Examiner's rejections and the arguments of Appellants and Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 9-13 under 35 U.S.C. § 102(e).

Anticipation of a claim under 35 U.S.C. § 102(e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) *citing Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

We now consider the arguments presented for independent claim 9. Appellants argue that the movement of Gorgi's follower acts in a like manner to that which occurs with a traditional ballpoint pen. Thus, there is a net rotation of the actuator member relative to the track bearing pen barrel. Consequently, Gorgi's follower causes a net rotation of Gorgi's actuator 44 in one cycle - from the first locating position to the second locating position and back again. See pages 4 and 5 of the brief.

The Examiner answers "[a] variety of ball point pens exist, some of which have actuators that rotate incrementally in a single direction each time the pusher is pushed and others that have an actuator that does not rotate at all Therefore, the actuator 46 disclosed by Gorgi could function in either of the two manners suggested above, depending upon the significance of the word 'traditional' to Gorgi et al." See answer, pages 4 and 5.

We find that Gorgi does not expressly teach the functional limitation "movement of said track follower from said first locating position to said second locating position and back to said first locating position causes no net rotation of said

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actuator member relative to the track bearing member" as recited in Appellants' claim 9. The Examiner has not provided any evidence to show this limitation is known. The Examiner's argument that Gorg's teaching of a "traditional ballpoint pen" reads on no net rotation actuator amounts to an argument that Gorgi inherently teaches this limitation. Therefore, the question before us is whether Gorgi inherently teaches this claimed limitation.

Our reviewing court stated "[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 49 USPQ2d 1949, 1950-1952 (Fed. Cir. 1999) **citing** *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id. citing Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

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The Examiner states that some ballpoint pens have actuators that rotate incrementally in a single direction each time the pusher is pushed and others have an actuator that does not rotate at all. Therefore, if we agree with the Examiner's statement, the actuator 46 disclosed by Gorgi could function in either of the two manners suggested. Thus, there is a probability or possibility that Gorgi's actuator may or may not rotate. Accordingly, the Examiner has failed to establish the inherency as required by our reviewing court because the limitation "no net rotation of said actuator" is not necessarily present from the given set of circumstances. Therefore, we will not sustain the Examiner's rejection of independent claim 9 and its dependent claims 10-13 based on inherency.

Furthermore, actuators of traditional ballpoint pens do rotate in order to advance or retract the ink reservoir or cartridge. See, e.g., the rotary cam 9 in U.S. Patent No. 6,698,960 B2 issued to Noguchi; the casing 7 in U.S. Patent No. 4,172,674 issued to Paroty; the cam 4 in U.S. Patent No. 5,713,680 issued to Yoshino et al.; and the cap 28 in U.S. Patent No. 2,78,337 issued to Lovejoy. However, if the Examiner finds a reference that teaches an actuator which does not rotate in order

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