

File

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte THOMAS P. ROGERS

NOV 20 1996

PAT & TMA OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 95-5078
Application 07/902,715¹

HEARD: November 12, 1996

Before LYDDANE, MCQUADE and CRAWFORD, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 through 6, 8, 10 through 12, 14 and 16 through 20. Claims 7, 9, 13 and 15, which are the only other claims remaining in the application, are no longer under any rejection², and

¹ Application for patent filed June 23, 1992.

² Note that the rejection of these claims was withdrawn on page 1 of the examiner's answer dated February 6, 1995.

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presumably would be allowable once properly rewritten in independent form, although the examiner did not make clear the status thereof.

The subject matter on appeal is directed to a damped device having a vibratable surface and a damping gel patch external of and attached to the vibratable surface. Claims 1 and 19 are exemplary of the invention and read as follows:

1. A damped device comprising:
a vibratable surface, and
a damping gel patch external of and attached to said vibratable surface.
19. A damped device comprising:
a vibratable surface, and
a damping gel patch attached to said vibratable surface, wherein said vibratable surface comprises a practice pad with a drum head.

The references of record relied upon by the examiner in rejections of the claims under 35 USC 102(b) and under 35 USC 103 are:

Kobayashi	4,154,137	May 15, 1979
Hoshino	4,581,973	Apr. 15, 1986
Nakashiba et al. (Nakashiba)	5,375,889	Dec. 27, 1994
Remold-O'Donnell	5,370,991	Dec. 6, 1994

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Claims 1 through 6, 8, 10, 16 and 20 stand rejected under 35 USC 102(b) as being anticipated by Kobayashi.

Claims 11, 12, 14, 17 and 18 stand rejected under 35 USC 103 as being unpatentable over Kobayashi.

Claim 19 stands rejected under 35 USC 103 as being unpatentable over Hoshino in view of Kobayashi.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellant, we refer to pages 3 through 7 of the examiner's answer, to the supplemental answer, to pages 4 through 19 of the appellant's amended brief filed December 1, 1994 and to the reply brief for the full exposition thereof.

OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art, and to the respective positions advanced by the appellant and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish either an anticipation under 35 USC 102(b) or a prima facie case of

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obviousness under 35 USC 103 with respect to any of the claims on appeal. Our reasoning for this determination follows.

We initially observe that an anticipation under 35 USC 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984), cert. dismissed sub nom., Hazeltine Corp. v. RCA Corp., 468 U.S. 1228 (1984). Additionally, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983) cert. denied, 465 U.S. 1026 (1984) (and overruled in part on another issue) 775 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1985). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of properties that are inherently possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987).

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Central to the rejection of claims 1 through 6, 8, 10, 16 and 20 under 35 USC 102(b), as well as to the rejections of the other claims on appeal under 35 USC 103, is whether or not the mute assembly disclosed in the patent to Kobayashi discloses a "gel patch" as required by each of the claims on appeal. Our conclusion, like that of the appellant, is that it does not. The mute assemblies depicted in the drawing figures of Kobayashi include a number of different mute elements 33, 53, 73 which are disclosed as made of "an elastically deformable material such as felt, urethane rubber and foamed resin" (note column 4, lines 22-24; column 4, line 67 through column 5, line 1; and column 7, lines 19-21). The examiner has made the factual findings that the elastically deformable resin material 73 can be "read as a gel patch" (answer, page 3) and that "the broad use of the term gel can be read as a resin, since resins are often seen in the form of a colloidal substance that is deformable" (answer, page 6).

While we would not disagree that a resin could be a gel, we find nothing in the four corners of the patent to Kobayashi that would indicate that the resin disclosed therein would be, or even could be, a gel as understood in the usual meaning of the term, as exemplified by the definition supplied by the appellant from

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the MCGRAW-HILL DICTIONARY OF SCIENTIFIC AND TECHNICAL TERMS of a "two-phase colloidal system consisting of a solid and a liquid in more solid form than a sol" (brief, page 7). Although the examiner has provided evidence (the patents to Remold-O'Donnell and Nakashiba³) to indicate that resins can be gels, it is readily apparent that not all resins are gels. Moreover, Kobayashi does not simply disclose the material of the mute element to be a "resin." Rather, it is disclosed as being, among other materials, a "foamed resin" (emphasis added) which would clearly have led the artisan of ordinary skill away from any suggestion that the mute element of Kobayashi should be, or even could be, formed from a gel. Absent a disclosure that the mute element of Kobayashi is formed of gel, or as a gel patch, the damped device disclosed therein fails to include every element recited in appealed claims 1 through 6, 8, 10, 16 and 20, and the rejection of these claims under 35 USC 102(b) cannot be sustained.

Furthermore, since the rejections of claims 11, 12, 14, and 17 through 19 under 35 USC 103 are based on the examiner's faulty

³The examiner's reliance on these references for the first time in the answer, although they were previously of record, as evidence that resin can be in gel form is improper since the references were not included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970).

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