

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUYA UDA

Appeal No. 96-1191
Application 08/344,624¹

ON BRIEF

Before JERRY SMITH, BARRETT and TORCZON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

¹ Application for patent filed November 17, 1994. According to the appellant, this application is a continuation of Application 08/025,462, filed March 3, 1993, now abandoned.

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Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer 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 and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Kadowaki neither anticipates nor renders obvious the invention as set forth in claims 1-11. Accordingly, we reverse.

We consider first the rejection of claims 1-11 under 35 U.S.C. § 102 as anticipated by the disclosure of Kadowaki. Anticipation is established only when a single prior art

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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. 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 independent claims 1 and 3, the anticipation question basically reduces to a consideration of the oscillator in claims 1 and 3. Appellant argues that there are three oscillator recitations in these claims which are not present in Kadowaki. Specifically, appellant argues that Kadowaki does not disclose the following:

- (1) terminals/electrodes connected to an oscillator;
- (2) a ground potential terminal positioned between the oscillator input and output terminals/electrodes; and wherein
- (3) the ground potential extends from a metal plate, while the oscillator input and output terminals/electrodes

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do not extend from the metal plate
[brief, pages 5-6].

The examiner asserts that the oscillator is not part of the invention and is merely a functional use of the invention which is not given any patentable weight [answer, pages 3-5].

The examiner's position is without merit. Independent claims 1 and 3 clearly recite that the integrated circuit/chip is connected to an oscillator, and these claims also clearly recite specific connections involving the input and output terminals/electrodes of the oscillator. We fail to see how the device of Kadowaki, which discloses no oscillator, can fully meet the recitations of claims 1 and 3. It was an error for the examiner to treat the oscillator recitations as nondistinguishing limitations in the claim. Therefore, we do not sustain the examiner's rejection of independent claims 1 and 3 as anticipated by Kadowaki. It necessarily follows that we also do not sustain this rejection of any of the dependent claims as well.

We now consider the rejection of claims 1-11 under 35 U.S.C. § 103 as unpatentable over the teachings of Kadowaki.

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As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to independent claims 1 and 3, appellant argues that (1) the examiner has failed to establish a prima facie case of obviousness; (2) the examiner has not made appropriate factual findings; and (3) the examiner has provided no motivation to modify Kadowaki so as to arrive at the claimed invention [brief, pages 7-11]. Since the examiner has alternatively rejected the claims under Sections 102 and 103, there is little discussion on the question of obviousness. The examiner's only comment is that it would

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have been an obvious design choice to connect an oscillator to the Kadowaki device [answer, pages 3-4].

We will not concern ourselves with whether the examiner's rejection meets the legal threshold for a prima facie case of obviousness because the rejection would fail on the merits in any case. The examiner's bald conclusion that it would have been obvious to connect an oscillator to the Kadowaki device lacks any support on this record. We agree with appellant that the teachings of Kadowaki are not automatically applicable to an oscillator connection, and even if an oscillator were connected to the leads in Kadowaki, the invention of claims 1 and 3 would not necessarily result. Kadowaki is concerned with creating a coplanar high frequency transmission path between a pair of ground leads and a single signal lead. The signal leads in Kadowaki are not distinguished as being input or output leads so that it is not clear that the connections of the input and output terminals/electrodes of claims 1 and 3 would have been obvious in view of the Kadowaki teachings. Therefore, we do not sustain the rejection of independent claims 1 and 3 under 35 U.S.C. § 103 as unpatentable over the teachings of Kadowaki.

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It necessarily follows that we also do not sustain the rejection of any of the dependent claims as well.

In summary, we have not sustained either of the examiner's alternative rejections under 35 U.S.C. §§ 102 and 103. Accordingly, the decision of the examiner rejecting claims 1-11 is reversed.

REVERSED

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JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT))
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
RICHARD TORCZON)	
Administrative Patent Judge)	

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