

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte YOSHIHITO NAKANO

\_\_\_\_\_  
Appeal No. 1997-1332  
Application 08/217,079

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ON BRIEF  
\_\_\_\_\_

Before THOMAS, MARTIN, and FRAHM, Administrative Patent Judges.  
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 26 through 46, which constitute all the claims pending in the application.

Representative claim 26 is reproduced below:

26. An electric noise absorber for surrounding a cord of an electronic device comprising:

two bodies of a magnetic substance, each said body having a hemi-cylindrical groove for receiving the cord;

two case members for covering the cord when interlocked, each case member having two opposed end walls and containing one said body; and

means for selectively interlocking said case members with one another such that said bodies surround said cord;

means integrally formed in said case members, during manufacture of said case members, for resiliently retaining each body in its associated case member even when said case members are separated from one another; and

wherein a hemi-hole is formed on each of the opposed end walls of the case members for passage of the cord to and from the groove;

teeth are integrally formed along on edge of at least one of the hemi-holes of each opposed end of said noise absorber for directly securing the cord when the case members are closed, at least a root portion of said teeth of said at least one of the hemi-holes lies in a plane defined by one of said end walls of said case member and said teeth extend from said root portion; and

said means for resiliently retaining each body within the associated case member allows the body to move freely relative to the associated case member while preventing the body from being inadvertently removed from the associated case member when said case members are separated from one another.

The following references are relied on by the examiner:

Wahl	3,325,591	Jun. 13, 1967
Mears, Jr. (Mears)	3,846,725	Nov. 5, 1974
Heilmann et al. (Heilmann)	4,005,380	Jan. 25, 1977
Hamisch, Jr. (Hamisch)	4,049,357	Sep. 20, 1977
Nakano	4,885,559	Dec. 5, 1989
	(effective filing date	Mar. 12, 1987)
Onishi (Japan)	55-12829	Apr. 4, 1980 <sup>1</sup>
Kashiwabuchi (Japan)	56-3561	Jan. 14, 1981 <sup>1</sup>
Iritani et al. (Iritani) (Japan)	61-34705	Mar. 3, 1986 <sup>1</sup>

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<sup>1</sup> Our understanding of this reference is based upon a translation provided by the Scientific and Technical Information Center of the Patent and Trademark Office. A copy of the translation is enclosed with this decision.

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Konno et al. (Konno) (Japan) 62-14770 Apr. 15, 1987<sup>1,2</sup>

All claims on appeal, claims 26 through 46, stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 10 of the appellant's earlier patent, U.S. Patent 4,885,559, as well as provisionally rejected under the same doctrine as being unpatentable over claims 44 through 63 of copending application Serial No. 08/217,078, filed on March 24, 1994. The present application, the just noted patent, and the pending application all stem from common parent applications.

Additionally, all claims on appeal, claims 26 through 46, stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon the collective teachings of Konno, Heilmann, Mears, Wahl, Kashiwabuchi, and Onishi as to claims 26 through 29, 33, 34, 36, 37 and 39 through 46. To this basic rejection, the examiner adds Iritani as to claims 30, 35, and 38. Similarly, to the basic combination of references, the examiner adds Hamisch as to claims 31 and 32.

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<sup>2</sup> Both appellant's translation of Konno submitted on April 28, 1994 as well as the one obtained through the Patent and Trademark Office, indicate a publication date of Konno of April 15, 1987. We note further, however, that the top of page 1 of appellant's translation further indicates that the underlying application was laid-open on May 27, 1982 under [another serial number]." Therefore, appellant does not argue that this reference is not prior art to him.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and the answer for the respective details thereof.

OPINION

Turning first to the two obviousness-type double patenting rejections, we sustain both of them. As to both rejections appellant states at the top of page 21 of the brief "that the filing of any necessary terminal disclaimer(s) be held in abeyance until such time as this application otherwise recites allowable subject matter." The appellant also asserts substantially the same thing at page 23, the end of the brief.

It is thus apparent that appellant does not traverse the two of these rejections on the merits. Therefore, the examiner correctly points out at pages 8 and 9 of the answer that appellant "does not dispute this rejection," where the examiner discusses each of them separately.

Finally, as to these rejections, we note that "[c]laims may be provisionally rejected for obviousness-type double patenting over claims in a commonly assigned, copending patent application. In re Wetterau, 356 F.2d 556, 557-58, 148 USPQ 499, 501 (CCPA 1966). This is true even if the claims in the copending application stand rejected. Ex parte Karol, 8 USPQ2d 1771, 1773 (Bd. Pat. App. & Int. 1988).

We now turn to the rejection of the claims under 35 U.S.C. § 103. Firstly, we address the rejection of claims 26 through 29, 33, 34, 36, 37 and 39 through 46 in light of the collective teachings and showings of Konno, Heilmann, Mears, Wahl, Kashiwabuchi, and Onishi. Included within this claim grouping are independent claims 26, 40, and 43.

We reverse this rejection.

Each of independent claims 26, 40, and 43 on appeal recite in part the following:

means integrally formed in said case members, during manufacture of said case members, for resiliently retaining each body in its associated case member even when said case members are separated from one another;

. . .

said means for resiliently retaining each body within the associated case member allows the body to move freely relative to the associated case member while preventing the body from being inadvertently removed from the associated case member when said case members are separated from one another.

The principal argument presented by appellant relates to these features recited in the above noted quoted material. Two characteristics of this quoted material are that the magnetic bodies are freely movable relative to the case members and that the magnetic bodies are not disconnected from the case member once assembled therewith as noted by the examiner at the middle of page 5 of the answer. To these we add that each body is

resiliently retained in each case member even when the case members are separated from one another.

The combined teachings and suggestions of the six references relied upon by the examiner in the initially stated rejection would not have led the artisan to the claimed subject matter. The examiner has provided little reasoning to persuade us that the artisan would have found it obvious to have combined the teachings of the references to yield the features of the above quoted material of each independent claim on appeal.

The principal references to Konno and Heilmann appear to be presumptively combined by the examiner. From our study of each of them, we find first that Konno's ferrite members 4 and 5 appear to be fixedly retained within their respective cover portions 13, 14 with no free movability therewithin. On the other hand, Heilmann's inductive clip-on pulse pick-up device permits the assembled ferrite members 18 and 19, which are adhesively attached to their respective synthetic resin holders 20 and 21, to move freely within each of the handle portions of the device in Figure 1 by means of the bias spring means 24, 25 and the projections 22 which allow the assembled holders 20, 21 to move somewhat freely within the jaw shells 10 and 11. We are unpersuaded by the examiner's reasons for utilizing the teachings of Heilmann in the device of Konno and we can find none of our own from the teachings and suggestions of both references.

Similarly, the teaching value of Kashiwabuchi and Onishi, both of which indicate various manners in which ferrite magnets may be retained within a small motor housing, also do not persuade us of the obviousness of the requirements of each independent claim that the two bodies of magnetic material be both resiliently retained within each claimed case member but also do so in such a manner that the magnetic bodies are allowed to move freely relative to their respective case members at the same time as not being inadvertently removed when the case members are separated from one another as required by the claims on appeal. These features would be highly undersirable in small DC motors. Neither Wahl nor Mears bear on the noted features because they appear to be relied upon and contain teachings only relative to the location and the shape of the claimed teeth members.

In view of the foregoing, we have reversed the examiner's basic rejection of each independent claim 26, 40, and 43 on appeal and some of the dependent claims therefrom. As such, we also must reverse the rejection of the remaining dependent claims utilizing the additional references to Iritani and Hamisch as well.

Although we reverse the three stated rejections of all the claims on appeal under 35 U.S.C. § 103, the decision of the examiner is affirmed because we have sustained both obviousness-

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type double patenting rejections of all the claims on appeal.  
Therefore, the decision of the examiner is affirmed.

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR §  
1.136(a).

AFFIRMED

JAMES D. THOMAS )  
Administrative Patent Judge )  
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 )  
 ) BOARD OF PATENT  
JOHN C. MARTIN )  
Administrative Patent Judge ) APPEALS AND  
 )  
 ) INTERFERENCES  
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ERIC FRAHM )  
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