

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE A. BACON

Appeal No. 97-3998
Application 08/302,168¹

ON BRIEF

Before PATE, McQUADE and CRAWFORD, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Bruce A. Bacon appeals from the final rejection of claims 16 through 18 and 21 through 29, all of the claims pending in

¹ Application for patent filed September 8, 1994. According to appellant, the application is a continuation of Application 08/096,704, filed July 23, 1993, now abandoned.

Appeal No. 97-3998
Application 08/302,168

the application.

The invention relates to a method for marking a longitudinal identification stripe on the external surface of a strand of material such as tubing, wire or rope. Claim 16 is illustrative and reads as follows:

16. A method for marking a longitudinal stripe on an external surface of a flexible strand of material, said method comprising the steps of:

providing a reservoir;

providing said reservoir with a marking medium;

providing a nib which receives said marking medium from said reservoir;

providing a guide and locating said guide in association with said nib so as to position the external surface of said flexible strand of material to be marked in a select orientation against said nib when said flexible strand of material is positioned against said nib;

positioning said flexible strand of material against said guide with the external surface of said flexible strand of material being in said select orientation against said nib;
and

drawing said flexible strand of material through said guide while positioning said flexible strand of material against said guide, thereby marking the external surface of said flexible strand of material with a longitudinal stripe of said marking medium.

The reference relied upon by the examiner as evidence of

inserted within opening 108, and slid within slit 106. The opposing side walls of slit 106 are in mutual contact, whereby these side walls press against both sides of the sheet when inserted. As the sheet is inserted fully into 106, the sheet edge will be marked. Drawing the sheet in either direction produces continuous lengthwise markings.

An alternative embodiment of the invention can be seen in FIG. 2. Marker 200 includes a barrel 252 which

houses four fibrous, porous members 254(a-d). Openings 256(a-d) are disposed to expose slits 258(a-d), which are disposed proximate the end of barrel 252. In a preferred embodiment, fibrous, porous members 254(a-d) are of different colors. While four fibrous, porous members are shown, it should be understood that any number of such members may be used. Openings 256(a-d) and slits 258(a-d) may be disposed at different positions relative to the end of barrel 252. This facilitates the insertion of a sheet within the desired opening. To easily distinguish between different colors or types of marking material exposed by each of the openings 256(a-d), the outer covering of the barrel 252 may be appropriately marked, as by color coding. Marker 200 is shown as a sealed container with a closure 260 disposed at the end closest to openings 256(a-d). In this embodiment there may additionally be a nib such as is shown in FIG. 1. Moreover, a cap such as 112, may be appropriately shaped to cover openings 256(a-d).

As can be seen in FIG. 1, nib 110 is provided with a slit extending transverse to the axis of the marker barrel 102. A sheet may be drawn through this slit to mark in a similar manner as slit 106, or 258(a-d) [column 2, lines 9 through 48].

Anticipation is established only when a single prior art reference discloses, expressly or under principles of

Appeal No. 97-3998
Application 08/302,168

inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or

fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellant's position on appeal is that the standing 35 U.S.C. § 102(b) rejection of claims 16 through 18 and 21 through 29 is unsound because Pitts does not meet the limitations in independent claims 16 and 24 relating to the steps of providing a guide, positioning a strand of material against the guide and drawing the strand through the guide while positioning the strand against the guide (see pages 4 through 12 in the brief). This argument is persuasive with respect to claim 24, but not with respect to claim 16.

Appeal No. 97-3998
Application 08/302,168

More particularly, Pitts' provision of slits 106 or 258(a-d) meets the relatively broad guide-providing step recited in claim 16. In this regard, Pitts' slits constitute guides to the same extent that the appellant's notch 240 in nib 230 constitutes a guide (see page 7 and Figure 2 of the appellant's disclosure). This being the case, Pitts' steps of inserting the edge of a sheet into the slit (wherein it engages the slit side walls) and drawing it therethrough meet the strand positioning and drawing steps recited in claim 16. Thus, the appellant's contention that the subject matter recited in claim 16 is not anticipated by Pitts is not well taken.

Claim 24, on the other hand, requires the guide to be in a housing partially enclosing the marking element. The only structures disclosed by Pitts which arguably correspond to such a guide are the openings 108, 256(a-d) in barrel/housing 102, 252. There is no teaching in Pitts, however, that the sheet being marked is ever positioned against these openings.

The examiner's contention that the use of the Pitts device would include, presumably under principles of inherency, some contact between the sheet and the openings in

Appeal No. 97-3998
Application 08/302,168

the barrel/housing (see page 5 in the answer) is not well founded. Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be 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.

Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

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. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Here, the examiner's determination that the use of the Pitts device would include contact between the sheet and the openings in the housing is unduly speculative.

Thus, Pitts does not meet the particular limitations in

Appeal No. 97-3998
Application 08/302,168

claim 24 requiring the steps of providing a housing having a guide, positioning a strand of material against the guide and drawing the strand through the guide while positioning the strand against the guide.

In light of the foregoing, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claim 16 as being anticipated by Pitts. We also shall sustain the standing 35 U.S.C. § 102(b) rejection of dependent claims 17, 18 and 21 through 23 since the appellant has not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 16 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)). We shall not sustain, however, the standing 35 U.S.C. § 102(b) rejection of claim 24, or of claims

25 through 29 which depend therefrom, as being anticipated by Pitts.

Thus, the decision of the examiner to reject claims 16 through 18 and 21 through 29 is affirmed with respect to claims 16 through 18 and 21 through 23, and reversed with

Appeal No. 97-3998
Application 08/302,168

respect to claims 24 through 29.

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

AFFIRMED-IN-PART

WILLIAM F. PATE, III)	
Administrative Patent Judge)	
)	
)	
)	
JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
MURRIEL E. CRAWFORD))
Administrative Patent Judge)	

Appeal No. 97-3998
Application 08/302,168

Bruce Allen Bacon
9263 Sagebrush Trail
Littleton, CO 80124