

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(2) is not binding precedent of the Board.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 HUGH B. GLOVER

Appeal No. 1998-2482
Application No. 08/533,429

ON BRIEF

Before KRASS, BARRETT and GROSS, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 22, all of the claims pending in the application.

The invention is directed to providing electromagnetic interference isolation of sensitive circuit areas on a circuit board. More particularly, a gasket provides the isolation by substantially attenuating the electromagnetic interference.

Representative independent claim 1 is reproduced as follows:

1. A gasket system for attenuating the propagation of electromagnetic interference, comprising:

a pair of deflectable leg members disposed relative to each other to cause said leg members to deflect away from each other when said gasket system is positioned between two opposing substrates and the substrates are drawn together so that said leg members provide dual contact with one of the substrates to substantially attenuate electromagnetic interference across said gasket system.

The examiner relies on the following references:

Hadley et al. (Hadley)	3,304,360	Feb. 14, 1967
Bogner	4,396,795	Aug. 02, 1983
Cantrell et al. (Cantrell)	5,252,782	Oct. 12, 1993

Claims 1-22 stand rejected under 35 U.S.C. § 112, first paragraph, as relying on a specification which lacks an adequate written description.

Claims 1, 2, 6, 7, 9, 10, 14, 15, 17 and 19 stand further rejected under 35 U.S.C. § 102(b) as anticipated by Hadley.

Claims 3-5, 11-13, 18 and 20-22 stand further rejected under 35 U.S.C. § 103 as unpatentable over Hadley in view of Cantrell.

Claims 8 and 16 stand further rejected under 35 U.S.C. § 103 as unpatentable over Hadley in view of Bogner.

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

OPINION

Turning first to the rejection under 35 U.S.C. § 112, first paragraph, the examiner contends that there is no support in the original disclosure for “the leg members are deflected away from each other.” [answer-page 3].

We will not sustain this rejection because there is clear evidence in the originally filed disclosure that appellant had possession of the invention now claimed. Although the original disclosure recited that the deflectable leg members were disposed to “deflect horizontally and vertically...” [pages 4 and 9 and original claim 1, for example], in our view, this recitation, taken together with the original drawings Figures 2A and 2B, makes it clear that, at the time of originally filing the application, appellant had in his possession the invention whereby the leg members are caused to “deflect away from each other” when the gasket is placed between two opposing substrates and the substrates are drawn together. Fig. 2A shows the gasket 48 prior to the substrates being drawn together and Fig. 2B shows the gasket 48 after the substrates are drawn together via fastener 80. Clearly, as shown in Fig. 2B, the leg members 50 and 52 have been deflected away from each other, as claimed. Accordingly, there is clear support in the original disclosure for the leg members being caused “to deflect away from each other.”

We now turn to the rejection under 35 U.S.C. § 102(b). We will sustain this rejection.

Anticipation, under 35 U.S.C. § 102, requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983).

The examiner contends that Hadley's gasket 3 has a pair of leg members and that if the groove had straight sides rather than the inclined sides, a modification suggested by Hadley itself, then the leg members would deflect away from each other "because the straight sides of the groove will not retain the leg members in a secure position as the slanted sides of the groove" [answer-page 7]. However, the flexible conductive strip 3 of Hadley is shown in various Figures and in each Figure, it appears to us that if the strip is compressed, the legs of that strip will either stay in position, held by the slanted edges of the groove, with only the main body of the strip being compressed or, in the case of a straight sided groove, the legs will deflect inward, toward each other, as opposed to the claimed direction. In any event, it would be a matter of speculation, at best, to say that the legs of strip 3 in Hadley would be deflected away from each other when the strip is under compression and a rejection under 35 U.S.C. § 102(b) cannot be based on speculation.

However, that being said, a reference is good for all that it teaches and in Figure 3B, Hadley shows the flexible gasket strip, per se, without any application in a groove. Independent claim 1 merely requires a “gasket system,” of which the flexible gasket of Hadley is one, and that gasket system must have “a pair of deflectable leg members disposed relative to each other to cause said leg members to deflect away from each other.” The flexible gasket member shown in Figure 3B of Hadley clearly meets that limitation. Without a groove to impede the movement, from the shape of Hadley’s gasket, it is clear that pressure from the top down on the gasket will cause the legs of the gasket to “deflect away from each other,” as claimed. The remainder of claim 1 merely recites that the legs are deflected away from each other “when said gasket system is positioned between two opposing substrates and the substrates are drawn together so that said leg members provide dual contact with one of the substrates to substantially attenuate electromagnetic interference across said gasket system.” Accordingly, this remaining language sets forth no positive defining structure. The gasket of Hadley is clearly for the purpose of shielding components from electromagnetic interference. Since the claim recites what will happen “when” the gasket is positioned between two substrates, but does not recite the specifics of the intended structure, it is clear that Hadley’s gasket will also act in the same way “when” it is placed between two substrates and those substrates are drawn together.

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With regard to independent claim 9, the top of Hadley's flexible gasket, shown as element 33 in Figure 3B, is "a main body member" of the gasket system, as claimed.

Claims 2, 6, 7, 10, 14, 15, 17 and 19 will fall with independent claims 1 and 9 since appellant does not argue the merits of these claims separately.

Finally, we turn to the rejections under 35 U.S.C. § 103. We will not sustain these rejections.

With regard to claims 3-5, 11-13, 18 and 20-22, the examiner relies on Cantrell for a teaching of a threaded receptacle having a threaded fastener and a boss. Without even reaching a decision on whether Cantrell, in fact, discloses a limiting means and a boss, as claimed, we will not sustain the rejection under 35 U.S.C. § 103 because we find nothing that would have led the artisan to combine Hadley and Cantrell. The examiner has provided no convincing line of reasoning as to why the skilled artisan would have applied the flexible gasket of Hadley in the device of Cantrell, in place of gasket 144 taught by Cantrell. Moreover, if the gasket of Hadley were to be applied in place of gasket 144 of Cantrell, it is unclear how such a gasket would be placed to ensure that the leg members of the gasket would deflect away from each other when the opposing substrates in Cantrell are drawn together. It may be that in conforming to the shape of the peripheral walls 134 and interior walls [Cantrell-

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column 5, lines 17-19], the legs of the Hadley gasket would be impeded from deflecting away from each other. Accordingly, we will not sustain the rejection of claims 3-5, 11-13, 18 and 20-22 under 35 U.S.C. § 103.

With regard to claims 8 and 16, these claims stand rejected under 35 U.S.C. § 103, with the examiner relying on a teaching by Bogner of applying an adhesive to a gasket. Appellant does not argue the unobviousness of applying an adhesive to a gasket but relies on the arguments relative to Hadley and the fact that Bogner does not remedy the deficiency of Hadley. While we, too, do not doubt the obviousness of applying an adhesive to a gasket, claim 8 includes limitations of claims 1, 2 and 6 while claim 16 includes limitations of claims 9 and 14. Since there is no evidence provided by Hadley and/or Bogner of the obviousness of limiting the deflection of the leg members or of retaining the gasket in a predetermined position on one of the substrates during assembly of the substrates, we will not sustain the rejection of claims 8 and 16 under 35 U.S.C. § 103.

We also note that the examiner states, at the bottom of page 5 of the answer, that the "limitation of the leg members deflecting away from each other has not been considered due to the new matter rejection." As noted supra, with regard to the rejection under 35 U.S.C. § 112, first paragraph, we do not view the limitation of the leg

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members deflecting away from each other as being new matter. In any event, it is improper for the examiner to ignore claim limitations when applying prior art against the claims under 35 U.S.C. § 102 and/or 103.

We have sustained the rejection of claims 1, 2, 6, 7, 9, 10, 14, 15, 17 and 19 under 35 U.S.C. § 102(b) but we have not sustained the rejection of claims 1-22 under 35 U.S.C. § 112 or the rejection of claims 3-5, 8, 11-13, 16, 18 and 20-22 under 103. Accordingly, the examiner's decision is affirmed-in-part.

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

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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