

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(2) is not binding precedent of the Board.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 THOMAS J. SMITH

Appeal No. 1997-2878
Application 08/287,505

ON BRIEF

Before THOMAS, KRASS, and LALL, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of
claims 1 through 30, all of the pending claims.

The invention is directed to a telephone network
interface best understood from reference to Figures 1-4 and to

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representative independent claims 1 and 29, reproduced as follows:

1. A telephone network interface apparatus comprising:
 - (a) a base member means for receiving electrical components in the interior thereof, said base member means having an open top; and
 - (b) a hinged cover member means for covering said open top of said base member means, said cover member being free from apertures communicating with the interior of said base member means.

29. In a telephone network interface apparatus having a base member for receiving electrical components in the interior thereof, said base member having an open top and a hinged cover member for covering said open top of said base member, the improvement wherein said hinged cover member is free from apertures communicating with the interior of said base member.

The examiner relies on the following references:

Dellinger et al. (Dellinger)	4,488,008	Dec. 11, 1984 (filed Jun. 24, 1983)
Berkman	4,518,084	May 21, 1985 (filed Sep. 13, 1983)
Tuohy, III (Tuohy)	4,522,326	Jun. 11, 1985 (filed Apr. 10, 1984)
Whatley	4,531,774	Jul. 30, 1985 (filed Mar. 4, 1983)
Dola	4,562,311	Dec. 31, 1985 (filed Jul. 29, 1983)
Hampton	4,741,032	Apr. 26, 1988

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(filed Mar. 17, 1986)

In accordance with the examiner's answer, the only rejections before us are as follows:

Claims 1 and 29 stand rejected under 35 U.S.C. § 103 as unpatentable over Dola.

Claims 1 and 29 stand further rejected under 35 U.S.C. § 103 as unpatentable over Dellinger.

Claims 1 and 29 stand still further rejected under 35 U.S.C. § 103 as unpatentable over Dellinger in view of Dola.

Claims 1 and 29 are even further rejected as anticipated (presumably under 35 U.S.C. § 102) by "many apparatuses." The examiner cites Berkman, Whatley and Tuohy as examples of such "apparatuses."

Claims 2 through 28 and 30 stand rejected under 35 U.S.C. § 103 as unpatentable over Hampton.

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

OPINION

Turning first to the rejections of claims 1 and 29 under 35 U.S.C. § 103, we will not sustain these rejections as, in

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our view, neither Dola nor Dellinger, or the combination thereof, discloses or suggests certain claim limitations.

Both claims 1 and 29 require a *hinged* cover member and that this cover member be "free from apertures communicating with the interior of said base member." The cover of Dola has an aperture, viz., keyhole 95, and the cover member of Dellinger has an aperture through which screw 22 is inserted. Thus, neither of these references has a cover member "free from apertures..." The examiner indicates that once key 97 in Dola or screw 22 in Dellinger is inserted into the respective apertures, there is no longer an aperture for the aperture in each case is sealed. The examiner's approach is certainly creative and has a certain logic to it but, after careful consideration, we simply cannot agree with the examiner. If the claims had merely stated that the cover was weathertight or completely sealed, the examiner's case may have been stronger. But, the claims call for the cover to be "free from apertures..." No matter that the apertures are covered over in Dola and Dellinger, the fact remains that the cover members of these prior art devices still contain apertures, albeit covered, and, accordingly, they are not "free from apertures,"

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as claimed. Since neither Dola nor Dellinger discloses or suggests a cover member that is free from apertures, the combination of these references clearly cannot suggest such a feature.

Moreover, the claims require a *hinged* cover member. While Dellinger appears to show such a cover, Dola clearly does not as the cover in Dola is merely slid into place via slots on the sides of the device and so there would be no suggestion in Dola of providing a *hinged* cover member. Thus, Dola is an improper reference on two grounds: no hinged cover member and no cover member that is free from apertures. Dellinger merely lacks a cover member free from apertures.

Accordingly, the rejections of claims 1 and 29 under 35 U.S.C. § 103 based on Dola and/or Dellinger are reversed.

We turn now to the rejection of claims 2 through 28 and 30 under 35 U.S.C. § 103 over Hampton. The propriety of this rejection will depend on whether Hampton is a viable reference with regard to the effective filing date of the instant application.

The instant application, filed August 8, 1994, is a continuation of an application filed October 25, 1993 which is

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a continuation of an application filed February 4, 1991 which is a continuation of an application filed August 4, 1989 which is a continuation-in-part of a design application filed July 5, 1984, under 35 U.S.C. § 120. The examiner contends that appellant may not rely on this priority date since the design application does not disclose the invention, as claimed. If appellant is correct, appellant contends that such a priority date will effectively remove Hampton as a viable reference and the examiner's rejection must be reversed.¹

No distinction between types of applications is made in 35 U.S.C. § 120. Thus, either design or utility applications may serve as a priority application for the other as long as all requirements of 35 U.S.C. § 120 are met. Racing Strollers, Inc. v. TRI Indus., Inc., 878 F.2d 1418, 1421-22, 11 USPQ2d 1300, 1303 (Fed. Cir. 1989). In order for priority

¹We note that although the design application does not have the same inventive entity as the instant application, the former including Mr. Smith as one of two co-inventors and the latter having Mr. Smith as the sole inventor, in accordance with the declaration of Mr. Smith, dated December 30, 1994, and of record in this application file, the aperture-free cover disclosed in the design application constituted a contribution by Mr. Smith. We note that there is no declaration of record from Mr. Michael A. Savona, the other co-inventor in the design application.

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to be accorded under 35 U.S.C. § 120, the application upon which priority is sought must have a disclosure which satisfies 35 U.S.C. § 112. In re Berkman, 642 F.2d 427, 429, 209 USPQ 45, 46 (CCPA 1981).

Our review of Design Patent No. 287,583 to Smith, as well as Exhibit C of the brief, labeling various portions of the figures of the design patent, indicates that Smith clearly discloses therein, inter alia, a cover for a telephone network interface wherein the cover is "free from apertures communicating with the inside" of a base member, line terminals, holes for plug cables, sockets, c-shaped portions of the base member for receiving an elongated bar member, and slots for printed circuit boards. Thus, as to these features, we find that appellant had possession of, and disclosed, these features as of July 5, 1984.

Accordingly, we find that Hampton, with a filing date of March 17, 1986, is not a viable reference with regard to claims 2, 6 and 30 because the limitations of these claims are all disclosed in the design patent which has a filing date of July 5, 1984 for which appellant is given priority under 35 U.S.C. § 120. More particularly, the design patent clearly

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shows the claimed base member and a hinged cover member free from apertures wherein the cover member provided limited access to the owner of the premises while providing complete access to a telephone service employee and wherein the base member includes an open top having a circumscribing wall portion with a telephone subscriber loop termination disposed therein. Further, as depicted in Figure 8 of the design patent, there are a plurality of slotted post members, as recited in claim 6.

Thus, the rejection of claims 2, 6 and 30 under 35 U.S.C. § 103 over Hampton is reversed, as Hampton is not applicable to these claims due to the priority date accorded the subject matter of these claims.

With regard to claims 3 through 5 and 7 through 28, we will sustain the rejection of these claims under 35 U.S.C. § 103 as unpatentable over Hampton.

Claims 3 and 16, and, therefore, the claims dependent therefrom, contain, respectively, limitations including "first means for electrically connecting said plug means to said first set of terminals and second means for electrically

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connecting said socket to said second set of terminals" and "electrical components" including various terminals and electrical contacts "electrically and mechanically engaged and disengaged with each other."

Because the design patent covers and shows merely the design of a protector housing for telecommunication equipment, there are no actual electrical connections shown. Therefore, the design patent does not show a "first means for electrically connecting said plug means to said first set of terminals and second means for electrically connecting said socket to said second set of terminals" or "electrical components" including various terminals and electrical contacts "electrically and mechanically engaged and disengaged with each other." Accordingly, appellant has not shown to our satisfaction that the subject matter of instant claims 3 through 5 and 7 through 28 was disclosed in the earlier design patent. Therefore, appellant may not be accorded the priority date of July 5, 1984 for the subject matter of these claims and Hampton is a viable reference as to such subject matter.

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We must now determine the appropriateness of the rejection of claims 3 through 5 and 7 through 28 under 35 U.S.C. § 103 over Hampton.

Appellant admits [brief-page 16] that Hampton does, indeed, include the feature of a hinged cover member being free from apertures communicating with the interior of the base member means. Appellant merely contends that Hampton was filed *after* the instant invention. For the reasons supra, we cannot agree.

Appellant then makes various arguments relating to Hampton including the teaching, by Hampton, of C-shaped members disposed on the cover and on the shield means with the bar provided on the base, "which is contrary to the teachings of the instant invention, since the instant invention the bar member provided is on the cover and the shield means with C-shaped members provided on the base"[sic] [brief-page 16]. Appellant also argues [brief-page 17] that the hinges of Hampton allow for the removal of the cover and shield to be effected in only particular positions and that this is different from the instant invention. Further, appellant argues that Hampton uses terminal blocks with slots to be

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slidable along a cooperating rib provided in the base member which is, again contrary to the teaching of the instant invention.

The problem with these arguments by appellant is that they are not directed to the *claimed* invention. Appellant has pointed to no language *in the claims* which distinguish over what is disclosed and suggested by Hampton. The arguments are directed only to various differences between Hampton and the instant *disclosed* invention. Moreover, to the extent that there are differences between the instant *claimed* invention and that taught by Hampton, appellant has only pointed to perceived differences without any argument as to why such perceived differences make the instant *claimed* invention patentable over Hampton, within the meaning of 35 U.S.C. § 103. After all, the examiner made the rejection under 35 U.S.C. § 103, rather than § 102, because there are recognized differences but appellant has not addressed the obviousness issue under 35 U.S.C. § 103 anent the instant *claimed* subject matter.

Accordingly, we will sustain the rejection of claims 3 through 5 and 7 through 28 under 35 U.S.C. § 103 over Hampton.

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Finally, we turn to the rejection of claims 1 and 29 under 35 U.S.C. § 102 as being anticipated by "many apparatuses," the examiner citing Berkman, Whatley and Tuohy as examples of various "apparatuses" which would anticipate the instant claimed subject matter.

The issue here is what weight is to be accorded the preambles of broad claims 1 and 29. The examiner gives the preambles, relating to "A telephone network interface apparatus..." and "In a telephone network interface apparatus..." no consideration, contending that the recited apparatus need not be a telephone network interface and the fact that appellant intends to use the apparatus with no aperture on its cover as a telephone network interface does not differentiate the apparatus from a tool box, cabinet, etc., used by an electrician "for receiving electrical components." Each of the cited patents discloses an apparatus having a hinged cover free from apertures communicating with the inside.

It is appellant's position that the preamble of claim 1 has a specific limitation that is deemed "essential to point

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out the area and scope of the invention...necessary to give life, meaning and vitality to the claims" [brief-page 15], citing Kropa v. Robie, 187 F.2d 150, 88 USPQ 478; 38 CCPA 858 (CCPA 1951). We disagree.

Generally, a preamble does not limit the claims, and thus preamble statements of intended use are not claim limitations. Loctite Corp. v. Ultraseal, Ltd., 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985). Whether a preamble stating an intended purpose constitutes a limitation to the claim depends on whether the language is essential to particularly point out the invention. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677-78, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

We find that the preambles of instant claims 1 and 29 are merely statements of intended use and are not claim limitations. The preamble language, relating to a "telephone network interface" is clearly not essential to particularly point out the invention since the body of the claims never even relate back to the language of the preamble. After the statement of intended use, the claims merely recite a base member for receiving electrical components in the interior

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thereof and that the base member has an open top. Clearly, the evidence provided by the examiner, including a tool box, shows such a base member with an open top. The claims next require a hinged cover attached to the base member (the prior art tool boxes disclose such) and that the cover member be free from apertures communicating with the interior of the base member (clearly, the hinged cover of the tool box is free from such apertures). The examiner has, inferentially, drawn a line of demarcation with a claim such as broad claim 30 which also calls for a "telephone network interface" in its preamble but then goes on to recite that this provides limited access to the owner while providing complete access to a telephone employee, thus giving life and meaning to the "telephone network interface" in the preamble.

Accordingly, we will sustain the rejection of claims 1 and 29 under 35 U.S.C. § 102 as anticipated by any one of the devices shown by Berkman, Whatley or Tuohy.

We have reversed the three rejections of claims 1 and 29 under 35 U.S.C. § 103. We have sustained the rejection of claims 1 and 29 under 35 U.S.C. § 102. We have also sustained the rejection of claims 3 through 5 and 7 through 28 under 35

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U.S.C. § 103 but we have not sustained the rejection of claims
2, 6 and 30 under 35 U.S.C. § 103.

Accordingly, the examiner's decision is affirmed-in-part.

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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

	James D. Thomas)	
	Administrative Patent Judge)	
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	Errol A. Krass)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
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