

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD PRITCHARD

Appeal No. 1998-0340
Application 08/449,682

HEARD: FEBRUARY 10, 2000

Before KRASS, LALL and GROSS, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-6, 8 and 9, claim 7 having been canceled.

The disclosed invention is directed to an antenna for a radio or a cell phone. The antenna comprises a flexible sheet which is preferably constructed of Mylar and is also

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preferably transparent. A transparent metal oxide coating covers one side of the sheet. An elongated strip of electrically conductive material is provided along one side of the sheet. The strip is in contact with the metal oxide coating. The strip is further connected to the radio or cellular phone antenna whereupon the device forms an antenna.

Representative claim 1 is reproduced as follows:

1. An antenna for a radio comprising:

a flexible plastic sheet,

a metallic oxide coating on said sheet,

an elongated strip extending along at least one side of said sheet, said strip being in contact with said metal oxide coating and having a high electrical conductivity, and

means for connecting said strip to the radio.

The Examiner relies on the following reference:

Inaba et al. (Inaba) 4,768,037 Aug. 30, 1988

Claims 1-3, 5, 6, 8 and 9 stand rejected under 35 U.S.C. § 102 as being anticipated by Inaba, while claim 4 stands rejected under 35 U.S.C. § 103 as being obvious over Inaba.

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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 considered the rejections advanced by the Examiner and the supporting arguments. We have, likewise, reviewed Appellant's arguments set forth in the briefs.

It is our view that claims 1-3, 5, 6, 8 and 9 are anticipated by Inaba, while claim 4 is not obvious over Inaba. Accordingly, we affirm-in-part.

We now consider the two rejections.

In our analysis, we are guided by the precedence of our reviewing court. Claims are to be construed in the light of Appellant's disclosure and not in a vacuum. However, the limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957); In re Queener, 796 F.2D 461, 230 USPQ 438 (Fed. Cir. 1986). We are also mindful of the requirements of anticipation under 35 U.S.C. § 102. Anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses,

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either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Sys., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). While applying the test of obviousness, we keep in mind the guidelines of our reviewing court. The pertinent general proposition is that 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).

Rejection of under 35 U.S.C. § 102

Claims 1-3, 5, 6, 8 and 9 are rejected as being anticipated by Inaba. We take for our analysis independent

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claim 1 which is also representative of this grouping of the claims. The crux of the issue is whether element 21 in Inaba's Fig. 3 can be considered a "sheet" as recited in claim 1. See answer, page 4, paragraphs 3 and 4, brief, page 4, paragraph 2 and reply brief, page 1, last paragraph bridging to page 2. The Examiner contends that element 21 of Inaba can be considered a sheet on which is applied the conductive coating 20 to serve as an antenna, whereas Appellant argues that said element 21 is a film, not a sheet. To support his position, Appellant argues [reply brief, pages 1 to 2] that "[r]ather, it is crystal clear from the Inaba et al. patent that it is the glass panes which support the polyester film 21 and conductive film 20 of Inaba et al. A glass sheet, however, is not 'flexible' and that limitation is clearly and definitely set forth in the appeal claims."

We are not persuaded by Appellant's arguments. We find no language in claim 1 which calls for the sheet as "supporting the metal oxide film" as Appellant argues. Claim 1 calls for "a metal oxide coating on said sheet". Inaba does show that, see col. 4, lines 1 to 2. Furthermore, we do not agree with Appellant's argument regarding the distinction

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between the terms "sheet" and "film." It is true that Inaba talks about its element 21 as a film, however, the meaning of film in Inaba is not the same as Appellant alleges. The term "film" is defined by "The American Heritage Dictionary", second college edition, as "[a] thin, generally flexible transparent sheet, as of plastic used in wrapping or packaging" (emphasis added). Clearly, the term "film" is not restricted to a coating. This is also borne out by the manner in which element 21 is described in Inaba. For example, Inaba, at col. 4, lines 1 to 5, states that "[t]he transparent conductive film 20 is coated on ... film 21, and the laminate ... is sandwiched ... between glass sheets 12 and 14." The term "laminate" is defined, by the supra dictionary, as "[a] laminated product, as plywood." Thus, Inaba implies that the laminate of elements 20 and 21 is a sheet which is sandwiched between the glass sheets and the interlayers 16 and 16'. Furthermore, since element 20 is disclosed to be just a coating (Inaba, col. 4, line 2), element 21 of Inaba has to be a sheet, and we so conclude. Thus, we sustain the anticipation rejection of claim 1 and, hence, claims 2, 3, 5, 6, 8 and 9 over Inaba.

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Rejection under 35 U.S.C. § 103

Claim 4 is rejected as being obvious over Inaba. The Examiner contends [answer, page 3] that "[i]t would have been an obvious matter of design choice to mount the antenna to an interior side of a roof of a vehicle, since applicant has not disclosed ... any particular purpose and it appears that the invention would perform equally well with the antenna being mounted to a window of a vehicle as taught by Inaba et al." Appellant argues [brief, page 5] that "the Patent Examiner has engaged in impermissible piecemeal reconstruction of Applicant's invention." Appellant further argues [reply brief, page 2] that "since the entire Inaba et al. patent is directed to a 'vehicle window glass antenna using transparent conducting film', to discard the glass sheets as suggested by the Examiner would be entirely contrary to the teachings of the Inaba et al. patent."

Here we are persuaded by Appellant's arguments. The Examiner has not presented any evidence, other than alleging that it would be "a matter of design choice", to modify Inaba to meet the structure recited in claim 4. It appears to us that the Examiner is indulging in reconstructing the claimed

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structure by using Appellant's invention as a blue print. That is not permitted within the meaning of obviousness under 35 U.S.C. § 103. Therefore, we do not sustain the obviousness rejection of claim 4 over Inaba.

In conclusion, we have sustained the rejection of claims 1-3, 5, 6, 8 and 9 under 35 U.S.C. § 102, while we have not sustained the rejection of claim 4 under 35 U.S.C. § 103. Accordingly, we affirm-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

Errol A. Krass)
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