

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM M. GREENBAUM

Appeal No. 1998-0500
Application 08/504,478

ON BRIEF

Before HAIRSTON, JERRY SMITH and GROSS, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 13-18. Claims 1-12 have been allowed by the examiner. An amendment after final rejection was filed on February 11, 1997 and was entered by the examiner.

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answer, and is, therefore, presumed to be withdrawn.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Brodsky does not fully meet the invention as recited in claims 13-16 and 18. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as

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set forth in claim 17. Accordingly, we reverse.

We consider first the rejection of claims 13-16 and 18 as being anticipated by the disclosure of Brodsky.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to each of these claims, the examiner indicates how he reads these claims on the disclosure of Brodsky on page 2 of the answer. Appellant argues that the examiner's interpretation of Brodsky is based solely on unsupported speculation. It is also argued that the examiner

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has disregarded the recitations set forth in the preambles and the whereby clauses of independent claims 13 and 18 [brief, pages 6-7]. The examiner responds that the structural elements of the claims are all disclosed in Brodsky so that Brodsky must function in the same manner as appellant's invention [answer, pages 3-5].

Although the basic difference between appellant's position and the examiner's position revolves around claim interpretation of the preamble and the whereby clause, we decide this issue on the more fundamental observation that Brodsky does not even disclose the structure means and the elastomeric interface interconnected as recited in the claims.

The examiner has identified parts 51 and 31 of Brodsky as corresponding to the two mating parts. There is no conductive pattern, however, associated with element 31. Thus, there is no structure in Brodsky which corresponds to the first and second structure means of claim 13 because these structure means must include the conductive patterns for verifying alignment and contact of the mated parts. The claim

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must also be read such that the elastomeric interface is located between the two conductive patterns. As clearly seen in Brodsky's Figure 4, the elastomeric interface 41 is not between conductive patterns 13 and 61. Therefore, we find that Brodsky does not fully meet every feature as recited in the claimed invention.

Since we agree with appellant that every limitation of claims 13-16 and 18 is not fully disclosed by Brodsky, we do not sustain the examiner's rejection of claims 13-16 and 18 under 35 U.S.C. § 102.

We now consider the rejection of claim 17 under 35 U.S.C. § 103 as unpatentable over the teachings of Brodsky. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior

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art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of

presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden 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 Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d

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1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

Claim 17 depends from claim 13. The examiner relies on Brodsky for teaching all the limitations of claim 13 as noted above. The examiner's explanation of this rejection does not overcome the deficiencies of Brodsky noted above. Thus, there are differences between the claimed invention and the disclosure of Brodsky which have not been properly addressed by the examiner. The failure to address the obviousness of these differences between the claimed invention and the applied prior

art results in a failure to properly establish a prima facie case of obviousness. As noted above, the failure to make the prima facie case of obviousness by the examiner must result in a reversal of the rejection made under 35 U.S.C. § 103.

In conclusion we have not sustained either of the

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examiner's rejections of the claims. Therefore, the decision
of the examiner rejecting claims 13-18 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
ANITA PELLMAN GROSS)	
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