

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD F. HONIGSBAUM

Appeal No. 1999-0347
Application No. 08/804,635¹

ON BRIEF

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 4 and 8 to 19, which are all of the claims pending in this application.²

¹ Application for patent filed February 25, 1997.

² We note that claim 19 was not included in any rejection set forth in the examiner's answer (Paper No. 13, mailed August 14, 1998) and that claims 1, 4 and 17 were amended subsequent to the final rejection (Paper No. 7, mailed

(continued...)

Appeal No. 1999-0347
Application No. 08/804,635

We REVERSE.

²(...continued)
December 22, 1997).

BACKGROUND

The appellant's invention relates to a process and apparatus for discouraging countermeasures against a weapon transport device. An understanding of the invention can be derived from a reading of exemplary claims 1 and 13, which appear in the appendix to the appellant's brief.³

The art of record relied upon by the examiner in rejecting the appealed claims are:

Ball	5,067,411	Nov.
26, 1991		

January 29, 1988 Letter with enclosure from Richard F. Honigsbaum to the attention of P. Napoli (the Honigsbaum letter)

March 22, 1988 Letter from Maida Kari to Richard F. Honigsbaum (the Kari letter)

The claims on appeal stand rejected as follows⁴:

³ We understand the term "said weapon" as recited in claim 1, paragraph (d); claim 13, paragraph (c); and claim 17, paragraphs (c) and (d) as referring to the "weapon transport device" rather than the "target-intended weapon."

⁴ Since the other grounds of rejection set forth in the
(continued...)

(1) Claims 1 to 4 and 8 to 12 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellant, at the time the application was filed, had possession of the claimed invention;

(2) Claims 1, 2, 4, 8, 9, 11, 13, 14 and 16 to 18 under 35 U.S.C.

§ 102(b) as being anticipated by the Honigsbaum letter and the Kari letter (the printed publication rejection);

(3) Claims 1, 2, 4, 8, 9, 11, 13, 14 and 16 to 18 as being "on sale" under 35 U.S.C. § 102(b) as evidenced by the Honigsbaum letter and the Kari letter;

(4) Claims 1, 2, 8, 12 to 14 and 16 under 35 U.S.C. § 103 as being unpatentable over Ball; and

⁴(...continued)
final rejection were not set forth in the examiner's answer we assume that these other grounds of rejection have been withdrawn by the examiner. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

(5) Claims 3, 4, 10, 11 and 15 under 35 U.S.C. § 103 as being unpatentable over Ball in view of various admissions of prior art.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 12, filed July 24, 1998) and reply brief (Paper No. 14, filed October 20, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The written description rejection

We will not sustain the rejection of claims 1 to 4 and 8 to 12 under 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re

Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The examiner determined (answer, p. 6) that the following lacked written description support: (1) the "means for sensing countermeasures against said weapon transport device" as recited in claim 1; and (2) the "means for sensing further comprises means for sensing signals from said guidance system" as recited in claim 2.

While there is no literal support in the original disclosure for the two above-noted claimed limitations, we agree with the appellant's argument (brief, pp. 7-8, and reply brief, pp. 6-7) that the disclosure of the application as originally filed⁵ reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter (i.e., the two above-noted claimed limitations).

⁵ See, for example, page 9, lines 13-18; page 12, lines 1-4; page 14, lines 1-19; page 16, lines 14-16; page 19, lines 1-15; and page 20, line 12, to page 22, line 11.

For the reasons stated above, the decision of the examiner to reject claims 1 to 4 and 8 to 12 under 35 U.S.C. § 112, first paragraph, is reversed.

The printed publication rejection

We will not sustain the rejection of claims 1, 2, 4, 8, 9, 11, 13, 14 and 16 to 18 under 35 U.S.C. § 102(b).

We agree with the appellant's argument (brief, pp. 8-13, and reply brief, p. 7) that neither the Honigsbaum letter or the Kari letter constitute a "printed publication" under 35 U.S.C.

§ 102(b). In that regard, the "touchstone" of a printed publication is "public accessibility," In re Hall, 781 F.2d 897, 899, 228 USPQ 453, 455 (Fed. Cir. 1986), and information is publicly accessible if "interested members of the relevant public could obtain [it] if they wanted to," Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1569, 7 USPQ2d 1057, 1062 (Fed. Cir. 1988). The proponent of the publication bar must show that prior to the critical date the reference was sufficiently accessible, at least to the public interested in the art, so that such a one by examining the reference could make the claimed invention without further research or experimentation. In re Hall, supra. In this case, the examiner has not carried that burden since the examiner has

not established that either the Honigsbaum letter or the Kari letter was sufficiently accessible so that interested members of the relevant public could obtain either or both letters if they wanted to.

For the reasons stated above, the decision of the examiner to reject claims 1, 2, 4, 8, 9, 11, 13, 14 and 16 to 18 under 35 U.S.C. § 102(b) is reversed.

The on sale rejection

We will not sustain the rejection of claims 1, 2, 4, 8, 9, 11, 13, 14 and 16 to 18 under 35 U.S.C. § 102(b).

We agree with the appellant's argument (brief, p. 14, and reply brief, p. 7) that neither the Honigsbaum letter or the Kari letter establish an "on sale" bar under 35 U.S.C. § 102(b). In that regard, clearly the Kari letter is not germane to this issue since it is a letter acknowledging receipt of the Honigsbaum letter. The Honigsbaum letter

states that the appellant's object is "a transfer of part or all of my interest in this invention ... to the Government on a basis to be negotiated after the evaluation [of the invention] is completed." In our opinion, the Honigsbaum letter does not place the invention on sale within the meaning of 35 U.S.C. § 102(b). An assignment or sale of the rights in the invention and potential patent rights is not a sale of "the invention" within the meaning of 35 U.S.C. § 102(b). Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 1266, 229 USPQ 805, 809 (Fed. Cir. 1986), cert. denied, 479 U.S. 1030 (1987). At best, the Honigsbaum letter is an offer for sale of rights in the invention and potential patent rights and thus does not trigger the on sale bar.⁶

⁶ We have considered the Supreme Court decision in Pfaff v. Wells Electronics., Inc., 523 U.S. , 142 L. Ed. 2d 261, 119 S.Ct. 304, 48 USPQ2d 1641 (1998) and the article entitled *The On-sale Bar after Pfaff v. Wells Electronics: Toward a Bright-Line Rule*, by Isabelle R. McAndrews, published in the *Journal of Patent and Trademark Office Society*, March 1999, Volume 81, No. 3, pages 155-80, especially pages 165-168. However, we do not consider the Pfaff decision to have altered the principle noted above set forth in Moleculon.

For the reasons stated above, the decision of the examiner to reject claims 1, 2, 4, 8, 9, 11, 13, 14 and 16 to 18 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejections

We will not sustain the rejection of claims 1 to 4, 8 and 10 to 16 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill

in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977).

We agree with the appellant's argument (brief, pp. 14-18, and reply brief, p. 8) that independent claims 1 and 13 (the

only independent claims rejected under 35 U.S.C. § 103) are not rendered obvious from the applied prior art.

Specifically, the examiner has not cited any evidence that would have suggested modifying Ball's secondary weapons 5 to be separable "in response to countermeasures against said weapon transport device" as recited in claims 1 and 13. In addition, the examiner has not cited any evidence that would have suggested modifying Ball's weapon system to include (1) "means for sensing countermeasures against said weapon transport device" as recited in claim 1, (2) the means recited in paragraph (f) of claim 1, or (3) the step recited in paragraph (c) of claim 13.

Since all the limitations of independent claims 1 and 13, and claims 2 to 4, 8, 10 to 12 and 14 to 16 dependent thereon, are not suggested by the applied prior art for the reasons stated above, the decision of the examiner to reject claims 1 to 4, 8 and 10 to 16 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 4 and 8 to 12 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 1, 2, 4, 8, 9, 11, 13, 14 and 16 to 18 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 1 to 4, 8 and 10 to 16 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 1999-0347
Application No. 08/804,635

Page 16

MARTIN B. PAVANE
COHEN PONTANI LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176

APPEAL NO. 1999-0347 - JUDGE NASE
APPLICATION NO. 08/804,635

APJ NASE

APJ STAAB

APJ ABRAMS

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 24 Jun 99

FINAL TYPED:

Gloria: Check for any update to the Pfaff case cited in footnote 6 on page 8.