

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(2) is not binding precedent of the Board.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 HIDETAKA YOKOTA

Appeal No. 94-2716
Application 07/764,775¹

HEARD: AUGUST 4, 1997

Before THOMAS, HAIRSTON, and TORCZON, Administrative Patent
Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's
final rejection of claims 1 to 10. In a response to a new ground
of rejection entered in the examiner's answer, appellant filed a

¹ Application for patent filed September 24, 1991.

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reply brief amending some claims and canceling claim 10, leading the examiner to subsequently withdraw the new rejection.

Therefore, claims 1 to 9 remain on appeal before us.

Representative claim 1 is reproduced below:

1. A camera comprising:

a structural body comprising a plurality of integrally coupled functional components including a lens barrel having an optical axis;

a cover enclosing said structural body;

a plurality of slender members extending in parallel to said optical axis of said lens barrel and between said structural body and said cover, said structural body being supported by said cover through said slender members; and

said slender members being sufficiently rigid to position said structural body and said cover in a substantially fixed relationship with respect to each other, and sufficiently flexible to be elastically deformable to dampen shocks when shocks are applied thereto.

The following reference is relied on by the examiner:

Fujita et al. (Fujita) 4,887,109 Dec. 12, 1989

Claims 1 to 9 stand rejected under 35 U.S.C. ' 102(b) as being anticipated by Fujita.

Rather than repeat the positions of the appellant and the examiner, reference is made to the briefs and answers for the respective details thereof.

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OPINION

We reverse.

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 Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1544, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The focus of the dispute between the examiner and the appellant is the functional language in the last clause of claim 1 on appeal. As best set forth in the second supplemental answer, we agree with the examiner's position that the corresponding guide rods in Figure 3 of Fujita are sufficiently rigid to position the structural body and the cover in a substantially fixed relationship with respect to each other. However, we disagree with examiner's urging that the claimed feature of the slender members being ~~A~~sufficiently flexible to be elastically deformable to dampen shocks when shocks are applied thereto^o is met by Fujita.

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The focus of the examiner's reasoning in the answers is that essentially all that is necessary to show anticipation is the structure that may be correlated from a reference to a claim. However, the above noted case law requires that the structure must be capable of performing the recited functions as well. When the fixed outer lens barrel 2 of Figure 3 is considered against the perspective view in Figure 1, it is seen that there is a relatively short distance between the camera body 1 and the fixed outer lens barrel 2. Fujita's written description does not discuss the guide rods shown in Figure 3 to which the examiner refers as a basis of his rejection and the figures do not label them. To achieve the wide-angle or telephotographic mode operations in the Figure 1 and 3 embodiment of Fujita, the movable inner lens barrel 3 is thrust to a fully forward or fully backward position; both of which positions require the support lugs 3b to be abutting against the inner surfaces of the fixed outer lens barrel 2. In such fixed positions, we do not understand Fujita as being sufficiently flexible to be elastically deformable to dampen shocks. Further, assuming there is a fixed, or stopped, intermediate position within the fixed outer lens barrel 2 for the movable inner lens barrel 3

to be moved to along the guide rods of Figure 3, we conclude as well that there would be no functional flexibility of the guide rods to be elastically deformable to dampen shocks. As to this intermediate position, it is speculative to us that there would be any elastic deformation of the illustrated guide rods such as to dampen shocks. Comparing Figures 1 and 3 of Fujita, the corresponding structure found by the examiner presents a rather rigid structure and, as such, we find ourselves in agreement with the observation of appellant at the top of page 6 of the principal brief on appeal that the overall structure of Fujita's Figure 3 would appear to transmit rather than dampen shocks.²

For true anticipation to exist, it is necessary for the disclosed structure in a reference to perform the recited functions. The examiner misperceives the functional properties of the claimed slender members by the repeated reasoning that anticipation does not reside in the intended manner of use. Claim 1 does not set forth any intended manner of use or any Afor

² We also agree with the observations of appellant at page 4 of the principal brief in the last paragraph, which also recognizes that the Figure 3 embodiment of Fujita illustrates unnumbered guide rods and springs which appear to cooperate with moveable element 5 in the bottom left portion of Figure 3. Although this is an unargued position of the examiner, it was readily apparent to us in our study of this reference. However, again we agree with appellant's interpretation of these shown but undiscussed features in Fujita. Similarly, we have considered but find no merit to the examiner's alternative line of reasoning as to the Figure 7 embodiment, which position is expressed only briefly at the bottom of page 6 of the answer.

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use@-type language, but does positively recite in the last clause of claim 1 two functional properties attributable to the slender members.

Since we did not sustain the rejection of independent claim 1 under 35 U.S.C. ' 102, we must also reverse the rejection of its dependent claims 2 to 9. Therefore, the decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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KENNETH W. HAIRSTON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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