

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MINORU USUI, TAKAHIRO KATAKURA, FUJIO AKAHANE,
KAZUMI KAMOI, SATOSHI SHINADA, YUKIHISA TAKEUCHI,
and NOBUO TAKAHASHI

Appeal No. 2000-0166
Application No. 07/809,042

HEARD: February 5, 2002

Before RUGGIERO, LALL, and BLANKENSHIP, 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 1-3 which constitute all the claims in the application.

The disclosed invention is directed to a piezo-electric/electrostrictive film type chip including a ceramic substrate having a spacer plate with a windows-disposed pattern

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comprising at least a plurality of window portions and a thin closure plate for closing the window portions which is unitarily connected with the spacer plate. The window portions and the closure plate form pressurizing rooms. The film-type chip also includes a plurality of piezo-electric/electrostrictive working portions each of which includes a laminate of a lower electrode, a piezo-electric/electrostrictive layer, and an upper electrode, each working portion being disposed at a closure portion of each window on the outer window of the surface of the closure plate, wherein all the working portions are disposed in a single plane (see Figure 1 and 3 of the disclosure). A positioning pin hole (52) is disposed in or near the center of gravity of the window-disposed pattern, and is separated from the pressurizing rooms and extends in a direction perpendicular to the plane. This configuration of the pin hole near the center of the plates gives a product that can be readily used in ink-jet printers and the like, wherein one may be assured that there is a proper correspondence between the orifices in the piezo-electric/electrostrictive film type chip and the ink-jet nozzles. Accordingly, one may be assured that the device

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Rather than repeat the arguments of appellants and the examiner, we make reference in the briefs¹ and the answer for the respective details thereof.

OPINION

We have considered the rejection advanced by the examiner and the supporting arguments. We have, likewise, reviewed the appellants' arguments set forth in the briefs.

We reverse.

In our analysis, we are guided by the general proposition 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

¹ A reply brief was filed on August 9, 1999 as paper no. 22.

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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). We are further guided by the precedent of our reviewing court that 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 also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192(a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobviousness distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967) ("This court has uniformly followed the sound rule that an issue raised below which is not argued in that court, even if it has been properly brought here by reason of appeal is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.").

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At the outset, we note that claims 1-3 are grouped together, see brief at page 4.

We take claim 1 for our discussion here. The examiner asserts (answer, at page 4) that the admitted prior art, as demonstrated by appellants' figs. 4 and 5, teaches all the recited features of the piezo-electrostrictive film type chip except that the pin holes used in assembling the unit are not located near the center of gravity of the transducer. The examiner relies on Maltsev for the teaching of the recited pin being near the central gravity of the transducer assembly. The examiner asserts (id. at 4) that "it would have been obvious . . . to place the alignment hole of the prior art [at] the center of the transducer assembly."

Appellants argue, brief at pages 5 and 6, that "[t]here would have been no reason for the person of ordinary skill in the art to have even looked to a stacked structure such as Maltsev to solve problems associated with the planar devices having a pin hole at an edge portion thereof." The examiner responds, answer at page 5, that "it is not seen how two transducers both using the same materials [,] both used as ink jet printers and, both cited in the European search report and

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both classified in the same class and subclass of the U.S. Patent system can be viewed [as non-related.] Maltsev shows the hole at a non-geometric center when considering only one plate." We agree with the examiner to the extent that both the admitted prior art and the Maltsev references are directed to the problems with ink-jet printers and the alignment of the nozzles and the working chambers formed by different plates. However, the construction of Maltsev is distinctly different from the appellants' recited structure. The structure in Maltsev is made up of a plurality of plates forming the working chambers stacked on top of each other in the vertical direction, whereas in the appellants' recited structure, the sets of plates forming the working chambers lie in the same plane, and are separated from each other in the horizontal direction. Therefore, the problem of alignment in the Maltsev device is different from the alignment problem in the Appellants' arrangement. The position and the importance of pin 14 and hole 10d in Maltsev together with the alignment notch 10e (Figure 2) is different from the function of the pin 58 in the pin hole 52 of the appellants' structure (figure 2 of appellants disclosure). Therefore, we agree with appellants that an artisan would not have looked to

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Maltsev pin 14 for the purposes of alignment of pin 58 in the pin hole 52 of the single plane structure of appellants. Furthermore, we find, by looking at Figures 2 and 3a of Maltsev, that pin 14 corresponding to the pin hole 10d is not separated from the recited pressurizing rooms. We do not see any reason whatsoever shown in Maltsev or given by the examiner that pin 14 in Maltsev would suggest putting pin 42 of the prior art (Figure 5 of appellants disclosure) in the geometric center of the plates. Therefore, we are in agreement with appellants that the admitted prior art and Maltsev would not have been found obvious to be modified as suggested by the examiner to meet the recited structure in claim 1. Consequently, we do not sustain the obviousness rejection of claim 1 and its dependent claims 2 and 3 over the admitted prior art in view of Maltsev.

The decision of the examiner rejecting claims 1-3 under 35 U.S.C. § 103 is reversed.

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REVERSED

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PARSHOTAM S. LALL)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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JUDGE LALL

APPEAL NO. 2000-0166

APPLICATION NO. 07/809,042

APJ LALL

APJ BLANKENSHIP

APJ RUGGIERO

DECISION: **REVERSED**

PREPARED: Sep 30, 2002

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK