

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SURESH GOYAL, PRATOD V. KASBEKAR,
DHIRENDRA M. PATEL, and SANJAY S. UPASANI

Appeal No. 2004-1110
Application No. 08/866,754

ON BRIEF

Before GARRIS, WARREN, and POTEATE, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 52-58. These are all of the claims remaining in the application.

The subject matter on appeal relates to a portable device having a clamshell housing made of two halves which comprises a single fastener (e.g., see screw 107 in Figure 1 of the application drawing) and a plurality of engaging elements (e.g.,

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see teeth 109 and recesses 115 in Figure 1), wherein the engaging elements are oriented so that when engaged they prevent the two halves of the clamshell housing from having substantial relative motion between themselves along the interface when the device is subjected to bending and/or torsional moments. Further details regarding this subject matter are set forth in representative independent claim 52, which reads as follows:

52. A portable device having a clamshell housing made of two halves, said halves meeting at an interface and being controllably separable, said device comprising:

a single fastener for coupling said two halves one to the other to form said clamshell;

a plurality of engaging elements, said engaging elements being positioned at said interface along at least a portion of each clamshell side and each comprising an item from the set consisting of:

(i) a tooth added to one of said halves and a matching recess added to the other of said halves,

(ii) a snap added to one of said halves which engages a receptacle added to the other of said halves,

(iii) a post added to one of said halves and matching receptacle added to the other of said halves, and

(iv) a pimple projecting from a surface of one of said halves which engages a gasket contained in a recess in the other of said halves;

wherein said engaging elements are oriented so that when engaged they prevent said two halves of said clamshell housing from having substantial relative motion between themselves along said interface when said device is subjected to bending and/or torsional moments.

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The prior art set forth below is relied upon by the examiner in the section 102 rejections before us:

Kuhfus	4,672,666	Jun. 9, 1987
Gordecki et al. (Gordecki)	5,469,982	Nov. 28, 1995

Photo marked AW showing Motorola telephone housing, 1994 (Motorola).

Under 35 U.S.C. § 102(b), claims 52-57 are rejected as being anticipated by Kuhfus, claims 52 and 54-58 are rejected as being anticipated by Gordecki, and claims 52-58 are rejected as being anticipated by Motorola.¹

We refer to the brief² and to the answer for a complete discussion of the opposing viewpoints expressed by the appellants and by the examiner concerning these rejections.

OPINION

For the reasons which follow, we will sustain the rejections based on Gordecki and Motorola but not the rejection based on Kuhfus.

¹ As indicated on page 3 of the brief, the appealed claims will stand or fall together. Accordingly, in assessing the merits of the above noted rejections, we will focus on claim 52 which is the sole independent claim on appeal.

² We will not consider or further comment upon the appellants' arguments regarding the examiner's drawing objection since this is a petitionable rather than appealable matter as explained on page 2 of the answer.

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The appellants argue that claim 52 distinguishes over the Kuhfus reference via the limitation "a single fastener for coupling said two halves one to the other to form said clamshell." According to the examiner, "[t]he comprising language does not preclude the reference from having additional fasteners" (answer, page 3). This unfortunately worded statement by the examiner suggests that the examiner believes the "comprising" language of appealed independent claim 52 allows the claim scope to encompass the plural fastener device of Kuhfus notwithstanding the "single fastener" limitation of the appellants' claim. Such a belief is not well taken.

The term "comprising" permits the inclusion of other steps, elements or materials. In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981). In the examiner's view, this long established definition should be broadened so that the term "comprising" permits the inclusion of, not just other unrecited elements, but also additional recited elements such as the here claimed fastener. There simply is no authority for such a broader definition. Moreover, the claim interpretation urged by the examiner is antithetical to the "single fastener" limitation expressly recited in claim 52. Because of its antithetical impact, this interpretation does not comply with the requirement

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that a claim interpretation must be reasonable and consistent with the specification. See In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

In light of the foregoing, we cannot sustain the examiner's section 102 rejection of claims 52-57 as being anticipated by Kuhfus.

With respect to the section 102 rejection based on Gordecki, the appellants "acknowledge that Gordecki . . . does indeed have teeth and recesses" (brief, page 7), which structurally correspond to the here claimed engaging elements (i.e., see item (i) of appealed independent claim 52), but argue that the teeth and recesses of patentee's device do not satisfy the functional limitation of their independent claim, namely, "wherein said engaging elements are oriented so that when engaged they prevent said two halves of said clamshell housing from having substantial relative motion between themselves along said interface when said device is subjected to bending and/or torsional moments."³

³ The appellants seem to believe that the above quoted functional language of independent claim 52 requires that "the engaging elements must keep the halves of the clamshell housing from separating from each other" (brief, page 8). This is incorrect. Neither this claim nor the appellants' specification disclosure expressly recites such a requirement. We here remind the appellants that, during examination proceedings, claims are given their broadest reasonable interpretation consistent with

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According to the appellants, this is because patentee's latch 70 prevents the relative motion under consideration and thereby "prevents the teeth and recesses from functioning as applicants' engaging element is required to function by the recitation of applicants' claim 52" (brief, page 7). The appellants' position is not well taken for a number of reasons.

First, it is indisputable that the Gordecki disclosure contains no express teaching that latch 70 prevents relative motion as urged by the appellants. Second, it is unreasonable to believe patentee's latch 70 would inherently perform such a function since it is explicitly disclosed by Gordecki as being "thin enough to provide elasticity" (column 2, lines 7-8). That is, it would be unreasonable and unrealistic to expect Gordecki's elastic latch 70 to be capable of preventing relative motion in accordance with the functional language of claim 52. Third, even if this latch inhibited relative motion to some degree, the teeth and recesses (i.e., engaging elements) of Gordecki's device still would function to prevent relative motion to at least some extent

³(...continued)
the specification. In re Hyatt, 211 F.3d at 1372, 54 USPQ2d at 1667. When claim 52 is so interpreted, particularly in light of the penultimate paragraph disclosure on specification page 7, it is clear that the claim language in question merely requires the engaging elements to restrict either one or the other or both of bending and torsional motion.

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(and indeed to an extent far greater than the elastic latch). In this regard, we observe that the functional language of claim 52 does not require substantial relative motion to be prevented by the engaging elements only. See Comack Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1186, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998) (limitations from the specification are not to be read into the claims).

Under these circumstances, we are led to the determination that it is reasonable to consider the teeth and recesses of Gordecki as inherently satisfying the functional requirements of appealed independent claim 52 and correspondingly that it is appropriate for the appellants to carry the burden of proving otherwise. See In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). Also see In re Swinehart, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) and In re Ludtke, 441 F.2d 660, 663-64, 169 USPQ 563, 566-67 (CCPA 1971). On the record before us, the appellants have proffered no such proof.

Therefore, we hereby sustain the examiner's section 102 rejection of claims 52 and 54-58 as being anticipated by Gordecki.

Finally, the appellants argue that the Motorola device appears to involve snaps matable with receptacles which are

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significantly longer than the snaps and accordingly that the Motorola device would not satisfy the above discussed functional requirement of claim 52 since "the snaps can slide within the receptacle allowing them to disengage, and the housing to open up, when bending and/or torsion is applied" (brief, page 8). The appellants' characterization of the Motorola device has no perceptible merit. The "receptacles" to which the appellants seemingly refer plainly include a U-shaped section that is dimensioned to snugly receive the "snaps" of the Motorola device. Thus, we consider these elements of the Motorola device to be inherently capable of performing the function recited in claim 52 and correspondingly that it is the appellants' burden of showing otherwise. Again see In re Schreiber, 128 F.3d at 1478, 44 USPQ2d at 1432; In re Swinehart, 439 F.2d at 212, 169 USPQ at 228; and In re Ludtke, 441 F.2d at 663-64, 169 USPQ at 566-67. Again, the appellants have provided the record before us with no such proof.

It follows that we also hereby sustain the examiner's section 102 rejection of claims 52-58 as being anticipated by Motorola.

The decision of the examiner is affirmed.

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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

Bradley R. Garris)	
Administrative Patent Judge)	
)	
)	
Charles F. Warren)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
Linda R. Poteate)	
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BRG:tdl

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