

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

JANUARY 1996  
vs. parte HISAKI TORISAKA, RYUTARO SHIMOGAWA  
and KOJI SHOYAMA

Appeal No. 95-2395  
Application 68/064,352

HEARD September 13, 1995

Before STONER, ACTING CHIEF ADMINISTRATIVE PATENT JUDGE, and  
COHEN and MEISNER, Administrative Patent Judges.  
STONER, Acting Chief Administrative Patent Judge.

**DECISION ON APPEAL**

Hisaki Torisaka, Ryutaro Shimogama and Koji Shoyama (collectively appellants) appeal<sup>2</sup> from the final rejection<sup>3</sup> of claim 4, the only claim now pending in this application, under 35 U.S.C.

<sup>1</sup> Application for patent filed May 20, 1993. According to applicant, this application is a continuation of Application 07/751,289, filed September 27, 1991, now abandoned.

<sup>2</sup> Notice of appeal filed December 13, 1993.

<sup>3</sup> Final Office action mailed August 12, 1993.

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§ 103 for obviousness. We reverse and, pursuant to the provisions of 37 CFR § 1.196(b), we reject claim 4 under 35 U.S.C. § 112, second paragraph.

The claimed invention may be understood from a consideration of claim 4 which reads as follows:

4. A device for reducing noise from a source of noise such as a cover for an oil pan or the like of an automotive vehicle component comprising a retaining plate disposed over and spaced apart from a vibration loop of said cover or the like, bolts releasably connecting said plate to said cover or the like for preventing movement of said plate away from said cover or the like, and a sheet-like elastic member compressedly interposed between said cover or the like and said retaining plate said plate having the sole property<sup>5</sup> of retaining said sheet-like elastic member in its position of use.

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<sup>4</sup> For reasons which we shall express subsequently, we consider indefinite the language "a cover for an oil pan or the like of an automotive vehicle component" and the later appearing term "said cover or the like." In order to reach the prior art rejection, we shall consider the cover in question to be a cover for an oil pan of an automotive vehicle component.

<sup>5</sup> A definition of "property" found in *The Random House College Dictionary* (Random House Inc, New York, 1982) which appears proper in the context of defining a structural member is "an essential or distinctive attribute of something." In the case of the retaining plate defined by this claim language, we understand the term "property" to refer to the distinctive or essential attributes of that plate. Due to what might be considered multiple distinctive attributes possessed by the disclosed plate, including the plate's length, width, and height dimensions, it would not appear wholly accurate to characterize the plate as having a "sole property." When queried concerning this language at oral hearing, the appellants' counsel indicated that "property" as used here is synonymous with "function." We have, accordingly, interpreted it in that way.

The references relied upon by the examiner are:

Moore et al. (Moore)	4,851,271	Jul. 25, 1989
Japanese Utility Model (Japanese publication <sup>6</sup> )	57-129939	Aug. 13, 1992

Claim 4 stands rejected under 35 U.S.C. § 103 as unpatentable over Moore in view of the Japanese publication. Central to the examiner's rejection is the determination that Moore's disclosed sound dampened automotive enclosure differs from that claimed by the appellants only in that Moore uses spot welds rather than bolts for connecting liner 40, corresponding to the appellants' claimed retaining plate, to the oil pan housing 10. Finding in the Japanese publication a teaching of connecting an outer plate 4 to an oil pan body 12 by way of bolts, the examiner concludes that it would have been obvious to one having ordinary skill in the art to have replaced Moore's spot welds with bolts. For the examiner's complete statement of this rejection, we direct attention to pages 5 through 7 of the answer.<sup>7</sup>

Having carefully considered the respective positions expressed in the examiner's answer and supplemental answer<sup>8</sup> and in the appellants' brief<sup>9</sup>, reply brief<sup>10</sup> and reply to the

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<sup>6</sup> Our understanding of this Japanese document is based upon an abridged translation attached to the document, both of which were supplied by the appellants as part of the information disclosure statement filed November 18, 1991.

<sup>7</sup> Mailed May 31, 1994.

<sup>8</sup> Mailed October 7, 1994.

<sup>9</sup> Filed February 14, 1994.

supplemental answer<sup>11</sup>, it is our determination that the rejection is not well founded. Even if we were to assume that the Japanese publication would have suggested the modification posited by the examiner<sup>12</sup>, we must agree with the appellants that there is nothing in either reference or their collective teachings which would have produced a construction having "a sheet-like elastic member compressedly interposed between said cover . . . and said retaining plate." There is no disclosure in either Moore or the Japanese publication to indicate that the composition or blank 30 of Moore or the rubber elastic body 3 of the Japanese publication are or should be compressed, nor does anything in those references suggest any advantage that would have resulted from exerting such a compressive force so as to suggest a modification producing the appellants' claimed invention. Indeed, we share the view expressed at pages 3 and 4 of the appellants' reply brief regarding Moore:

It is clear that the pressing action to which Moore refers relates to the time in the manufacturing cycle at which the layer is inelastically deformable. This does not result in a sheet-like elastic member compressedly interposed between a cover and a retaining plate as in the present invention. As should be readily apparent, in the Moore arrangement the

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<sup>10</sup> Filed August 1, 1994.

<sup>11</sup> Filed October 31, 1994.

<sup>12</sup> The appellants do not agree that this is the case, urging that there is nothing to suggest the modification of Moore following the Japanese publication. We need not reach that question.

components are assembled and thereafter the composition layer is activated to fill spaces between the housing and the liner. Upon consideration of Moore as a whole, it should be readily apparent that the composition layer 30 is provided as a "filler" (see e.g., the Abstract) which "should be sufficient to fill the space between the housing and the liner." (col. 4, lines 52-53). Moreover, the Moore specification makes clear that the activation which results in the composition filling the space between the liner and housing "has to occur after the composition and liner are in place" (col. 4, lines 40-41). Still further, the reference to the composition being constrained (e.g., as at col. 4, line 35 and col. 4, line 61) does not reflect that the composition is in a compressed state. As should be readily recognized, water is constrained by glass, but is not compressed thereby. As discussed earlier, the only reference to the pressing action of Moore relates to the situation in which the composition is in the thermoplastic or malleable state. Thus, Moore does not teach that the composition 30 is compressedly interposed as set forth in the . . . Examiner's Answer [emphasis in the original].

The rejection of claim 4 under 35 U.S.C. § 103 is reversed.

Pursuant to the provisions of 37 CFR § 1.196(b), we reject claim 4 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim that which the appellants regard as their invention. The operative standard for determining whether this requirement is met is "whether those skilled in the art would understand what is claimed when the claim is read in light of the specification." *The Beachcombers, Int'l. v. WildeWood Creative Prod.*, 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656, (Fed. Cir. 1994); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). We consider the recitation in the preamble of claim 4 regarding "a cover for an oil pan or the like of

an automotive vehicle component" and the similar recitations in the body of the claim relating to "said cover or the like" to be vague and uncertain because it is not clear from claim language read in light of the specification what the appellants intended to cover by the recitation of "or the like." See *Ex parte Kristensen*, 10 USPQ2d 1701, 1703 (Bd. Pat. App. & Int. 1989).

Looking to the specification, we see that the appellants, in describing the prior art, have referred to noise which is produced by vibration from a cylinder head and have said that, "[o]ther noise sources of automotive vehicles are oil pans, timing gear cases, bodies and so on" (specification, page 1, third paragraph). Similarly, the appellants make reference to a vibration loop of a "head cover" and state that the elastic member 18 "can be attached to any automotive vehicle components such as oil pan, timing gear case, body and so on" (specification, page 5, third complete paragraph). These passages from the specification are themselves vague and uncertain, for they liken "oil pans," "gear cases" and "bodies" (whatever may be meant by the term body in this context) to one another without giving a hint of how they are alike apart from somehow being a noise source under some unspecified circumstance. For good measure, these passages add "and so on" without ever providing an indication where that direction leads. Under these circumstances, we do not think that the claim language defines the invention with

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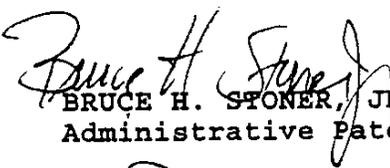
the precision and particularity required by 35 U.S.C. § 112,  
second paragraph.

In summary, we have reversed the rejection of claim 4 under  
35 U.S.C. § 103 and have, pursuant to the provisions of 37 CFR  
§ 1.196(b), rejected claim 4 under 35 U.S.C. § 112, first para-  
graph.

Any request for reconsideration or modification of this  
decision by the Board of Patent Appeals and Interferences based  
upon the same record must be filed within one month from the date  
of the decision. 37 CFR § 1.197. Should appellants elect to  
have further prosecution before the examiner in response to the  
new rejection under 37 CFR § 1.196(b) by way of amendment or  
showing of facts, or both, not previously of record, a shortened  
statutory period for making such response is hereby set to expire  
two months from the date of this decision.

No time period for taking any subsequent action in connec-  
tion with this appeal may be extended under 37 CFR § 1.136(a).

**REVERSED - 37 CFR § 1.196(b)**

  
BRUCE H. STONER, JR., Acting Chief )  
Administrative Patent Judge )  
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IRWIN CHARLES COHEN )  
Administrative Patent Judge ) BOARD OF PATENT  
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JAMES M. MEISTER )  
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