

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(2) is not binding precedent of the Board.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 GORDON W. CULP

Appeal No. 95-3565
Application 08/053,814¹

ON BRIEF

Before HAIRSTON, FLEMING and CARMICHAEL, ***Administrative Patent Judges***.

CARMICHAEL, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-7, 10, 11, and 19-28, which constitute all the claims remaining in the application.

¹ Application for patent filed April 29, 1993. According to appellant, this application is a continuation of Application 07/794,109 filed November 18, 1991, now abandoned.

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Claim 1 reads as follows:

1. A multiresonant traveling wave actuator comprising,
a multiresonant vibrator,
a movable object,

a means of providing a normal force to maintain a
contact between the object and the vibrator,

a controller to electrically activate an
electromechanical transducer, moving the object by traction with
negligible contact sliding,

the multiresonant vibrator having at least one
electromechanical transducer having a plurality of layers of
independently electrically addressable segments which receive
signals from the controller,

wherein the segments mechanically frequency sum to
produce waves in the multiresonant vibrator, the waves comprising
a longitudinal traveling wave having a contact area component for
engaging the object and a velocity component for moving the
object at a desired speed.

The examiner's Answer cites the following prior art:

Okumura et al. (Okumura)	4,763,776	Aug. 16, 1988
Okuno	4,857,793	Aug. 15, 1989
Kitani	5,041,750	Aug. 20, 1991
Okuno et al. (Okuno) '487 (Japanese Patent)	60-162487	Aug. 24, 1985

OPINION

The claims stand rejected (1) under 35 U.S.C. § 112,
first paragraph, as lacking a written description; (2) under 35

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U.S.C. § 112, second paragraph, as indefinite; and (3) under 35 U.S.C. § 102 as anticipated by any one of the four references listed above. We also note that the examiner has required removal of certain material, added by amendment, that the examiner considers new matter.

We reverse the rejections. As to the examiner's requirement for removing certain material from the disclosure, we do not have jurisdiction and will not adjudicate the matter. Such requirements are reviewable only by petition to the Commissioner, not by appeal to the Board.

(1) *Written description*

The written description rejection appears to fuse concepts of enablement and written description. However, the first paragraph of 35 U.S.C. § 112 contains three separate and distinct requirements for sufficiency of disclosure, i.e., the written description, enablement and best mode requirements. See ***In re Barker***, 559 F.2d 588, 194 USPQ 470 (CCPA 1977), ***In re Gay***, 309 F.2d 769, 135 USPQ 311 (CCPA 1962).

The examiner states that the specification fails to describe the recited "multiresonant vibrator having at least one electromechanical transducer having a plurality of layers of independently electrically addressable segments which receive

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signals from the controller." Appellants argue that the specification properly incorporates by reference patents describing the recited features. The examiner nonetheless maintains the rejection, finding that the incorporation by reference would merely invite a "wild goose chase." Appellants point out that it is permissible to incorporate disclosure by reference.

In addition, the examiner states there is no explanation of how to support vibrator 4 with constrained rotation and translation. The examiner's objection appears to be directed toward a statement in the specification, not in the claims. Examiner's Answer at 3-4. We can only speculate that the examiner may have had in mind the recited "means of providing a normal force to maintain a contact between the object and the vibrator."

Upon reviewing the originally filed disclosure, including that incorporated by reference, we find an adequate written description of the claimed invention. Therefore, we will not sustain the rejection.

(2) Indefiniteness

The examiner's indefiniteness rejection is largely grounded on the position, rejected above, that there is no

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written description for the recited "multiresonant vibrator having at least one electromechanical transducer having a plurality of layers of independently electrically addressable segments which receive signals from the controller."

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. ***In re Warmerdam***, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). Upon reading the claims in light of the disclosure, including that incorporated by reference, we find the claims reasonably apprise those of skill in the art of their scope. Therefore, we will not sustain the rejection.

(3) Anticipation

Anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found either expressly or inherently in a single prior art reference. ***In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); ***Kalman v. Kimberly-Clark Corp.***, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

The extent of the examiner's explanation for the anticipation rejection is as follows: "[c]laims 1-7, 11, and 19-28 (as understood) rejected [sic] under 35 U.S.C. § 102(a) as being clearly anticipated by Okumura, Okuno, Katani, JP (487)."

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Examiner's Answer at 6. This is insufficient for stating a *prima facie* case. Moreover, it appears that the examiner's rejection is based on the position, rejected above, that appellants are not entitled to claim a multiresonant (multiple frequency) device.

Because the examiner has not demonstrated how each element of a claim is found in a single prior art reference, we will not sustain the rejection.

CONCLUSION

The rejections of claims 1-7, 10, 11, and 19-28 are not sustained.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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