

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY R. STONEHAM AND DAVID C. SMART

Appeal No. 96-0362
Application 07/909,350¹

ON BRIEF

Before KRASS, MARTIN, and CARMICHAEL, *Administrative Patent Judges*.

CARMICHAEL, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of Claims 1-12, which constitute all the claims remaining in the application.

We reverse.

¹ Application for patent filed July 6, 1992.

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Appellants' Claim 1 is reproduced as follows:

1. A magnetic reading and/or recording apparatus comprising a magnetic reading and/or recording head for reading and/or recording information from/on a magnetic information track on photosensitive material having a natural longitudinal curl which when longitudinally straightened assumes an inherent transverse curl; and edge follower means attached to said magnetic reading and/or recording head for tracking a longitudinal edge of the photosensitive material in response to movement of the photosensitive material; is characterized in that:

means are aligned with said edge follower means for bending the photosensitive material perpendicular to the transverse curl to eliminate the transverse curl of the photosensitive material.

The Examiner's Answer lists the following prior art:

Dwyer et al. (Dwyer)	5,016,030	May 14, 1991
Tamamura et al. (Tamamura)	5,097,278	Mar. 17, 1992

OPINION

Claims 1-3 and 7 stand rejected under 35 U.S.C. § 102(a) as anticipated by Tamamura. Claim 1-3, 6, and 7 stand rejected under 35 U.S.C. § 102(a) as anticipated by Dwyer. Examiner's Answer at 4. The rejection of the remaining claims (Claims 4-6 and 8-12) was withdrawn. Examiner's Answer at 7.

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The rejected claims stand or fall together with Claim 1. Appeal Brief at 5. First we will consider anticipation of Claim 1 by Tamamura, and then by Dwyer.

Anticipation by Tamamura

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 examiner states that all of the elements of Claim 1 are met by Tamamura. According to the examiner, the recited edge follower means is met by Tamamura's pressure plate 1. Examiner's Answer at 4.

Appellants contend that Tamamura does not anticipate Claim 1 because pressure plate 1 is not an edge follower means for tracking a longitudinal edge of the photosensitive material. Appeal Brief at 6.

We agree with Appellants.

Claims undergoing examination are given their broadest reasonable interpretation consistent with the specification. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (in banc).

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In the present case, the explicit language of Claim 1 requires an edge *follower* means for *tracking* a longitudinal edge of the photosensitive material in response to movement of the photosensitive material. The edge follower means is described in the specification and shown in Figure 4 as edge follower means 44 which is held against the longitudinal edge by bias spring 72. Specification at 6, lines 18-30 and at 8, lines 27-35. Edge follower means engages the longitudinal edge as the material is transported past magnetic reading and/or recording head 40.

In our view, calling Tamamura's pressure plate 1 an edge follower means for tracking the longitudinal edge is not reasonable and is not consistent with the specification. The Specification clearly uses "follower" and "tracking" to indicate that the edge follower means is held in engagement with and conforms to the movement of the longitudinal edge.

Because Tamamura's pressure plate 1 is not held in engagement with and does not conform to the movement of the longitudinal edge of the photosensitive material, Tamamura does not contain the recited edge follower means. Therefore, we will not sustain this rejection.

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Anticipation by Dwyer

The examiner states that all of the elements of Claim 1 are met by Dwyer. According to the examiner, the recited bending means is met by Dwyer's magnetic head 60 or pressure pad 66. Examiner's Answer at 4.

Appellants argue that Claim 1 is not anticipated by Dwyer because Dwyer does not disclose a bending means to *eliminate* the transverse curl of the photosensitive material as recited.

We agree with Appellants.

Interpreting the claim term "eliminate" in light of the Specification, we find that it refers to flattening the photosensitive material across its entire width. The Specification describes prior art shown in Figure 1 of the Specification in which transverse curl exists at the transverse edges 16 of photosensitive material 12. Specification at 1, line 38 through 2, line 5 and at 6, lines 4-8. In contrast, the Specification explains, the invention will eliminate that curl. Specification at 6, lines 24-26.

Therefore, we disagree with the examiner's position that the claims do not call for a means that eliminates entire transverse curl. Examiner's Answer at 7.

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Dwyer does not eliminate transverse curl across the entire width of the film; according to Dwyer "some transverse curl still exists." Column 3, lines 55-59. Dwyer shows the remaining curl at "F" in Figure 3. We cannot agree that a reference stating that "some transverse curl still exists" can be said to "eliminate" transverse curl.

Thus, we do not sustain this rejection.

CONCLUSION

The rejection of Claims 1-3 and 7 under 35 U.S.C. § 102(a) as anticipated by Tamamura is not sustained. The rejection of Claim 1-3, 6, and 7 under 35 U.S.C. § 102(a) as anticipated by

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Dwyer is not sustained. The rejections of the remaining claims
(Claims 4-6 and 8-12) were withdrawn in the Examiner's Answer and
so are not sustained.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN C. MARTIN)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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