

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* JOHN P. KLING

Appeal No. 96-0829  
Application 08/005,701<sup>1</sup>

ON BRIEF

MAILED

FEB 18 1997

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before KRASS, BARRETT and FLEMING, *Administrative Patent Judges*.

FLEMING, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 12 through 16. Claims 9 and 11 have been allowed. Claims 1 through 8 and 10 have been canceled.

Appellant's invention relates to a one-piece pi filter for filtering out unwanted frequencies from electronic signals. On page 3 of the specification, Appellant discloses that Figure 4 is a side, sectional view of the filter of the invention. Appellant

<sup>1</sup> Application for patent filed January 19, 1993.

Appeal No. 96-0829  
Application 08/005,701

discloses on page 4 of the specification that Figure 4 shows the filter which includes a body formed as a sleeve 26 providing inductive properties, a plating 28 and 32, a dielectric coating 36 providing capacitive properties and an overplating 34 and 38.

Independent claim 12 is reproduced as follows:

12. A filter for providing filtering of unwanted frequencies in the megahertz range to isolate signal circuits of a type having a signal conductor and a ground conductor, said filter comprising:

a body formed as a sleeve having a conductor-receiving bore therethrough dimensioned slightly larger than an elongate signal conductor and extending between opposed body ends and thereby being adapted to fit around and along the signal conductor, said body extending radially outwardly to an outwardly facing surface proximate to a ground conductor, and said body having inductive properties;

a first conductive coating extending at a constant predetermined thickness continuously therearound at least from portions adjacent said conductor-receiving bore to said outwardly facing surface of said body and axially therealong from said opposite body ends to define a signal electrode having two separated signal electrode regions longitudinally spaced apart;

a coating of dielectric material having capacitive properties disposed over said outwardly facing surface of said body, and both said signal electrode regions thereon; and

a second conductive coating extending coaxially over the dielectric material to define a ground electrode partially overlapping both said signal electrode regions and spaced radially apart therefrom by the dielectric material,

the signal electrode regions extending to said portions adjacent the signal conductor upon placement of the body over the signal conductor, for termination thereto, and the ground electrode being exposed along the outwardly facing surface of the dielectric material to be terminated to a ground structure, all thereby defining a one-piece filter.

Appeal No. 96-0829  
Application 08/005,701

The reference relied on by the Examiner is as follows:

Hurst

3,588,758

Jun. 28, 1971

Claims 12 through 16 stand rejected under 35 U.S.C. § 102 as being anticipated by Hurst.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the brief and the answer for the respective details thereof.

#### *OPINION*

After a careful review of the evidence before us, we agree with the Examiner that claims 12 through 16 are anticipated under 35 U.S.C. § 102 by Hurst.

At the outset, we note that Appellant has indicated on page 3 of the brief that claims 12 through 16 stand together. We further note that Appellant has argued the claims as one group. As per 37 CFR § 1.192(c)(5) revised Oct. 22, 1993 which was controlling at the time of Appellant's filing the brief, it will be presumed that the rejected claims stand or fall together unless there is a statement otherwise, and in the appropriate part or parts of the arguments Appellant presents reasons as to why Appellant considers the rejected claims to be separately

Appeal No. 96-0829  
Application 08/005,701

patentable. We will, thereby, consider the Appellant's claims as standing or falling together.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). "Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984), cert. dismissed, 468 U.S. 1228 (1984), citing *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

Appellant argues on page 4 of the brief that Hurst does not disclose Appellant's limitation of "constant predetermined thickness continuously therearound". Appellant points out that the Hurst filter is made by assembly of tubes 14 and 16 and then the entire assembly is fired allowing molten metal to flow in the gap that separates the two tubes 14 and 16. Appellant argues that such a method would not result in the conductive layer to remain constant radially around the ferromagnetic member 14 as required by Appellant's claims.

Appeal No. 96-0829  
Application 08/005,701

We note that Appellant's claim 12 recites "a first conductive coating extending at a constant predetermined thickness continuously therearound." Upon reviewing Hurst, we find that Hurst teaches in column 1, line 74, through column 2, line 11, a pair of coated layers 22 and 24 that extend around the ends of the core 14 and cover the outer end portion thereof. On page 2 of the final rejection, the Examiner reads Appellant's first conductive coating on the Hurst pair of coated layers 22 and 24.

We appreciate Appellant's argument that the Hurst filter is made by assembling of tubes 14 and 16 and then the entire assembly is fired allowing molten metal to flow in the gap that separates the two tubes 14 and 16. We note that Hurst teaches in column 2, lines 43-45, that when the tubular member 16 is inserted into the tubular member 14, there may be a slight air gap between the tubular member 16 and layers 22 and 24. However, Hurst does teach that after firing the result is a constant predetermined thickness continuously therearound as shown in Figure 1.

Hurst teaches in column 2, lines 23-25 that Figure 2 shows the dielectric member 14 and the ferrite member 16 prior to assembly and that the dielectric member 14 is coated by means of layers 22 and 24. In column 2, lines 25-27, Hurst teaches that the layers 22 and 24 are formed of a mixture of silver particles

Appeal No. 96-0829  
Application 08/005,701

and microscopic glass beads bound together by a conventional carrier agent. In column 2, lines 30-39, Hurst teaches that ferrite member 16 is inserted into the dielectric member 14 and the combined unit is fired in a furnace which causes the silver particles to float in the glass beads and become a vitreous mass. Hurst teaches that this results in the structure shown in Figure 1. We note Figure 1 does in fact show that the pair of coated layers 22 and 24 extend at a constant predetermined thickness continuously therearound at least from portions adjacent said conductor-receiving bore to said outwardly facing surface of said body ends to define a signal electrode having two separated signal electrode regions longitudinally spaced apart as recited in Appellant's claim 12.

Appellant argues that we are required to interpret the drawings from the view point of an artisan skilled in the art in a manner consistent with the entire disclosure of Hurst. We agree. We find that Hurst's entire disclosure is directed to providing RF filters that can be made without using soldering steps. See column 1, lines 11-61, of Hurst. Furthermore, we note that the thicknesses of the layers 22 and 24 are exaggerated in the drawing for the purpose of clarity and the thicknesses of these layers are as small as one-tenth the thickness of the tubular members 14 and 16. See column 2, lines 40-43. Thus, tolerance between the tubular members 14 and 16 is very small and

Appeal No. 96-0829  
Application 08/005,701

the resulting air gap is correspondingly very small as well. Furthermore, those skilled in the art would have known that the uniformity of the layers 22 and 24 is critical for both continuity as well as the frequency response of the filter. Therefore, Hurst teaches to those skilled in the art that the firing process will result in the structure shown in Figure 1 in which the layers 22 and 24 are of a constant predetermined thickness.

Therefore, upon considering Hurst as a whole, we find that Hurst does disclose a first conductive coating extending at a constant predetermined thickness continuously therearound at least from portions adjacent said conductor-receiving bore to said outwardly facing surface of said body ends to define a signal electrode having two separated signal electrode regions longitudinally spaced apart, as recited in Appellant's claim 12.

We note that Appellant has not argued that Hurst has failed to meet any of the other limitations of the claims. Appellant has chosen not to argue any of these specific limitations of the claims as a basis for patentability. We are not required to raise and/or consider such issues. As stated by our reviewing court in *In re Baxter Travenol Labs.*, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior

Appeal No. 96-0829  
Application 08/005,701

art." 37 CFR § 1.192(a) as amended at 58 F.R. 54510 Oct. 22, 1993, which was controlling at the time of Appellant's filing the brief, states as follows:

The brief ... must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences.

Also, 37 CFR § 1.192(c)(8)(iii) states:

For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

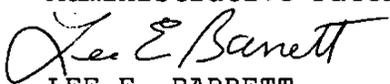
Thus, 37 CFR § 1.192 provides that just as the court is not under any burden to raise and/or consider such issues this board is not under any greater burden.

In view of the foregoing, the decision of the Examiner rejecting claim 12 through 16 under 35 U.S.C. § 102 is affirmed.

Appeal No. 96-0829  
Application 08/005,701

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

**AFFIRMED**

	)	
ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	

Appeal No. 96-0829  
Application 08/005,701

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