

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MORDECHAI HAMMER

Appeal No. 96-1870
Application 08/088,570¹

ON BRIEF

Before LYDDANE, STAAB, and McQUADE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 3 and 5. Claims 1, 2 and 4, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

¹ Application for patent filed July 9, 1993. According to the appellant, the application is a continuation-in-part of Application 07/923,657, filed August 3, 1992, now Patent No. 5,322,334, issued June 21, 1994; which is a continuation-in-part of Application 07/912,415, filed July 13, 1992, now Patent No. 5,324,086, issued June 28, 1994.

The subject matter on appeal relates to "a device made up of [a] plurality of interacting members which can be easily extended and retracted so as to place in the desired location a tool or other instrumentality attached to the device" (specification, page 1). Claims 3 and 5 read as follows:

3. An extendible-retractable device, comprising:
 - (a) a first member having a first rack;
 - (b) a second member, said first member being movable relative to said second member;
 - (c) a third member, said third member being movable relative to said second member and having a second rack;
 - (d) a toothed wheel mounted onto said second member, said toothed wheel engaging said first and said second racks such that said first and third members move together in opposite directions.

5. An extendible-retractable device, comprising:
 - (a) a first member having a first rack;
 - (b) a second member, said first member being movable relative to said second member;
 - (c) a third member, said third member being movable relative to said second member and having a second rack;

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- (d) a pair of toothed wheels mounted onto said second member, said toothed wheels being connected to each other through a flexible connector, said toothed wheels engaging said first and said second racks such that said first and third members move together in opposite directions.

The references relied upon by the examiner as evidence of anticipation are:

Young	2,835,527	May 20, 1958
Luhrs	3,094,007	June 18, 1963
Vranish et al. (Vranish)	4,707,013	Nov. 17, 1987

The claims on appeal stand rejected as follows:

a) claim 5 under 35 U.S.C. § 112, first paragraph, as being based on a specification which is objected to as "failing to provide an adequate written description of the invention"

(answer, Paper No. 19, page 3); and

b) claim 3 under 35 U.S.C. § 102(b) as being anticipated by Young, Luhrs or Vranish.

With regard to the rejection of claim 5, the examiner considers that the appellant's specification fails to provide an adequate written description of the invention because

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there is no clear and proper disclosure therein of the structure and operation of the embodiment of Fig. 11 and how a flexible connector as recited in claim 5 is incorporated therein. For example, the specification fails to properly disclose that the embodiment of Figs. 11 and 12 includes a flexible connector. Further, it is unclear how the toothed wheels will be able to engage the first and second racks if a flexible connector is connected to the toothed wheels [answer, Paper No. 19, page 3].

The examiner's explanation indicates that the rejection at issue is based on an alleged failure of the appellant's specification to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. The dispositive issue with regard to the enablement requirement is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id. In the present case, the examiner has failed to meet this burden.

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A person of ordinary skill in the art would have readily appreciated the disclosure in the appellant's specification relating to the extendible-retractable device embodiments illustrated in Figures 10 through 12 (see specification pages 9, 25 and 26) as being directed to a device having a pair of toothed wheels connected to each other through a flexible connector as recited in claim 5. Although the appellant's disclosure does not set forth specifically how the flexible connector is connected to the toothed wheels so as to allow them to engage their associated racks, such connection would appear to be a rather simple and straightforward matter. The examiner has not advanced any reason, nor is any apparent, why a person of ordinary skill in the art, as of the date of the appellant's application, would not have been able to make and use an extendible-retractable device having the toothed wheel/flexible connector construction required by claim 5 without undue experimentation.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claim 5.

We shall sustain, however, the standing 35 U.S.C. § 102(b) rejection of claim 3 as being anticipated by Young, Luhrs or Vranish.

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Anticipation is established 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). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 3 reads on, and is fully met by, the devices respectively disclosed by Young, Luhrs and Vranish for the reasons set forth by the examiner on pages 3 and 4 in the answer. The appellant's arguments to the contrary (see pages 6 through 8 in the main brief, Paper No. 18²) are not persuasive because they

² The record indicates that the examiner has refused entry of the reply brief filed by the appellant on April 29, 1996 (Paper No. 22), and that the examiner's decision in this regard has been upheld on petition (see Paper No. 25). Accordingly, we have not considered the arguments advanced in the reply brief in reviewing the merits of the appealed rejections.

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are predicated on alleged differences between the claimed and prior art devices which are embodied by limitations from the appellant's specification which are not recited in the claim and/or by features of the prior art devices which are not excluded by the claim. In other words, the appellant's arguments are not commensurate with the relatively broad scope of claim 3.

In summary, the decision of the examiner to reject claims 3 and 5 is affirmed with respect to claim 3 and reversed with respect to claim 5.

AFFIRMED-IN-PART

WILLIAM E. LYDDANE)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/088,570

APJ McQUADE

APJ LYDDANE

APJ STAAB

DECISION: AFFIRMED-IN-PART

Typed By: Jenine Gillis

DRAFT TYPED: 20 Apr 99

FINAL TYPED: