

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL C. SHAW and DONALD F. BUSH

Appeal No. 1996-3525
Application No. 08/089,595¹

HEARD: February 9, 1999

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 3, 7, 10 and 11. Claims 5, 6, 8, 9 and 12 through 15 have been objected to as depending from a non-allowed claim. Claims 16 through 26 have been withdrawn

¹ Application for patent filed July 12, 1993. According to the appellants, the application is a continuation of Application No. 07/822,201, filed January 17, 1992, now abandoned, which was a continuation-in-part of Application No. 07/800,718, filed December 3, 1991, now abandoned, which was a continuation of Application No. 07/607,275, filed October 31, 1990, now abandoned, which was a division of Application No. 07/382,113, filed July 20, 1989, now U.S. Patent No. 4,985,944.

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from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. Claim 4 has been canceled.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a pushbutton assembly for control of plumbing fixtures in prisons and the like. An understanding of the invention can be derived from a reading of exemplary claims 1² and 10, which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Morris et al. (Morris '374)	4,195,374	April 1, 1980
Morris et al. (Morris '163)	4,480,163	Oct. 30, 1984

Claim 2 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 1 through 3, 7, 10 and 11 stand rejected under

² On page 4 of the answer, the examiner noted a minor error in the copy of claim 1 at line 8 where "elements" should be --element--.

35 U.S.C. § 103 as being unpatentable over Morris '374 in view of Morris '163.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 26, mailed February 7, 1996) and the supplemental examiner's answer (Paper No. 28, mailed May 14, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 25, filed December 13, 1995) and reply brief (Paper No. 27, filed April 8, 1996) for the appellants' arguments thereagainst.

OPINION

Initially we note that the drawing objection relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by the appellants on pages 1-2 of the reply brief.

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness issue

We will not sustain the rejection of claim 2 under 35 U.S.C. § 112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner determined (answer, p. 5) that claim 2 was unclear as to the structure defined by the language "one of a toilet, sink and shower." The examiner then stated that

"alternative language should be avoided when it defines dissimilar structure."

The appellants argue (reply brief, pp. 2-3) that claim 2 is definite. Specifically, the appellants contend that alternative language is not inherently subject to rejection and that claim 2 is directed to "a sort of Markush group."

We agree with the appellants that claim 2 is definite. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. In this instance, the examiner has not expressed any rationale as to why the metes and bounds of the claimed invention is not known with a reasonable degree of precision and particularity. In our view, the metes and bounds of the claimed invention would be known with a reasonable degree of precision and particularity. Accordingly, claim 2 is definite and the decision of the examiner to reject claim 2 under 35 U.S.C. § 112, second paragraph, is reversed.

The obviousness issues

We sustain the rejection of claims 10 and 11 under 35 U.S.C. § 103, but not the rejection of claims 1 through 3 and 7.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

The examiner determined (answer, pp. 5-6) that it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a push button assembly as taught by Morris '163 as the push button assembly in the system of Morris '374.

The appellants do not contest the examiner's determination of the obviousness of combining the teachings of Morris '374 with the teachings of Morris '163. Instead, the appellants argue that certain claimed limitations would still not be met by the combined teachings of the applied prior art.

Claims 10 and 11

With respect to claims 10 and 11, the appellants argue (brief, pp. 12-13 and reply brief, p. 4) that the combined teachings of the applied prior art would not have suggested the limitations found in paragraph e) of claim 10³. Specifically, the appellants argue that push button 37 of Morris '163 is not a sensor and does not generate a signal.

It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the

³ Paragraph e) of claim 10 recites:

a sensor axially movable relative to said plunger for generating a demand signal upon the user moving said plunger into operative association with said sensor.

specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

In applying these principles to claim 10 we conclude that the limitations thereof are readable on the combined teachings of the applied prior art. In that regard, the limitations of paragraph e) of claim 10 read on the push button switch assembly of Morris '163 as follows: a sensor (push button 37) axially movable (push button 37 is axially movable within the shaft 35 as shown by dashed lines in Figure 2) relative to said plunger (push button 17) for generating a demand signal upon the user moving said plunger into operative association with said sensor (upon pushing push button 17 axially against the bias of spring 24 it engages push button 37 which moves axially to close switch 30 thereby generating a demand signal by connecting conductors 31 and 32 together). Thus, it is

clear to us that in Morris '163, a demand signal is generated upon the user moving push button 17 into operative association with the push button 37 sufficient for push button 37 to close the switch 30. Furthermore, it is our determination that the claimed term sensor⁴ is readable on push button 37 of Morris '163 because the push button 37 is designed to respond to a physical stimulus (the motion of push button 17) and transmit a resulting impulse for operating a control (switch 30).

The appellants' disclose (specification, p. 18) that the preferred sensor is an inductive sensor and that an inductive sensor is one that generates a signal in response to a disturbance within a designated space. However, since the claimed sensor is not limited to an inductive sensor, it would be inappropriate to apply the appellants' definition of inductive sensor to the claimed sensor since limitations are not to be read into the claims from the specification.

⁴ Webster's Third New International Dictionary, (1971) defines sensor as "a device designed to respond to a physical stimulus (as heat or cold, light, a particular motion) and transmit a resulting impulse for interpretation or measurement or for operating a control."

For the reasons stated above, the decision of the examiner to reject claims 10 and 11 under 35 U.S.C. § 103 is affirmed.

Claims 1 through 3 and 7

With respect to claims 1 through 3 and 7, the appellants argue (brief, pp. 9-11 and reply brief, pp. 3-4) that the combined teachings of the applied prior art would not have suggested the "means disposed about and slidably engaged with said element for selectively positioning and maintaining said element intermediate axially spaced first and second points" of claim 1. Specifically, the appellants argue that the structure of Morris '163 corresponding to this means is not equivalent to the structure disclosed by the appellants (i.e., resilient elastomeric frustoconical cone 108 shown in Figure 7). We agree.

As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the PTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Per Donaldson, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

Clearly the appellants intend to invoke the statutory mandate of 35 U.S.C. § 112, sixth paragraph, from their use of the term "means . . . for."⁵ Section 2183 of the MPEP provides

If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed

⁵ The term "means for" generally invokes 35 U.S.C. § 112, sixth paragraph. Greenberg v. Ethicon Endo-Surgery, Inc., 91 F.3d 1580, 1584, 39 USPQ2d 1783, 1786-87 (Fed. Cir. 1996).

limitation is anticipated by the prior art element. The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure, material or acts disclosed in the application. *In re Mulder*, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant disagrees with the examiner's conclusion, and provides reasons why the prior art element should not be considered an equivalent.

Section 2184 of the MPEP provides

If the applicant disagrees with the inference of equivalence drawn from a prior art reference, the applicant may provide reasons why the applicant believes the prior art element should not be considered an equivalent to the specific structure, material or acts disclosed in the specification.

. . .
When deciding whether an applicant has met the burden of proof with respect to showing nonequivalence of a prior art element that performs the claimed function, the following factors may be considered. First, unless an element performs the identical function specified in the claim, it cannot be an equivalent for the purposes of 35 U.S.C. 112, sixth paragraph. *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 4 USPQ2d 1737 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 961 (1988).

Second, while there is no litmus test for an "equivalent" that can be applied with absolute certainty and predictability, there are several indicia that are sufficient to support a conclusion that one element is or is not an "equivalent" of a different element in the context of 35 U.S.C. 112, sixth paragraph. Among the indicia that will support a conclusion that one element is or is not an equivalent of another are:

(A) Whether the prior art element performs the function specified in the claim in substantially the same way, and produces substantially the same results as the

corresponding element disclosed in the specification. *Lockheed Aircraft Corporation v. United States*, 193 USPQ 449, 461 (Ct. Cl. 1977). The concepts of equivalents as set forth in *Graver Tank & Mfg. Co. v. Linde Air Products*, 339 U.S. 605, 85 USPQ 328 (1950) are relevant to any "equivalents" determination. *Polumbo v. Don-Joy Co.*, 762 F.2d 969, 975, n. 4, 226 USPQ 5, 8 - 9, n. 4 (Fed. Cir. 1985).

(B) Whether a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification. *Lockheed Aircraft Corporation v. United States*, 193 USPQ 449, 461 (Ct. Cl. 1977); *Data Line Corp. v. Micro Technologies, Inc.*, 813 F.2d 1196, 1 USPQ2d 2052 (Fed. Cir. 1987).

(C) Whether the prior art element is a structural equivalent of the corresponding element disclosed in the specification being examined. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). That is, the prior art element performs the function specified in the claim in substantially the same manner as the function is performed by the corresponding element described in the specification.

(D) Whether there are insubstantial differences between the prior art element and the structure, material or acts disclosed in the specification. *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 117 S.Ct. 1040, 41 USPQ2d 1865, 1875 (1997); *Valmont Industries, Inc. v. Reinke Manufacturing Co. Inc.*, 983 F.2d 1039, 25 USPQ2d 1451 (Fed. Cir. 1993).

In our opinion, the proper test for determining equivalence under the sixth paragraph of 35 U.S.C. § 112 is whether the differences between the structure in the prior art device and the structure disclosed in the specification are

insubstantial. See Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d at 1043, 25 USPQ2d at 1455 (In the context of section 112, however, an equivalent results from an insubstantial change which adds nothing of significance to the structure, material, or acts disclosed in the patent specification); Alpex Computer Corp. v. Nintendo Co., 102 F.3d 1214, 1222, 40 USPQ2d 1667, 1673 (Fed. Cir. 1996) (noting that equivalents under Section 112, Para. 6, and under the doctrine of equivalents both relate to insubstantial changes). In determining whether or not the differences between the structure in the prior art device and the structure disclosed in the specification are insubstantial (i.e., indicia (D) above), it is appropriate in our view to look at indicia (A), (B) and (C) set forth above in MPEP § 2184.

From our review of the record in the application, the examiner never specifically found that the structure of Morris '163 corresponding (e.g., the threaded shaft 35) to the recited means (i.e., "means disposed about and slidably engaged with said element for selectively positioning and maintaining said element intermediate axially spaced first and

second points") was equivalent to the structure disclosed by the appellants (i.e., resilient elastomeric frustoconical cone 108 shown in Figure 7). Moreover, the examiner never applied any of the above-noted indicia to support a conclusion that the structure of Morris '163 (e.g., the threaded shaft 35) is or is not an "equivalent" of the structure disclosed by the appellants in the context of 35 U.S.C. § 112, sixth paragraph.

Thus, it is our view that the examiner has not met the burden of establishing a prima facie case of obviousness⁶ since the examiner has not established the structure of Morris '163 (e.g., the threaded shaft 35) is an "equivalent" of the structure disclosed by the appellants. Thus, the appellants arguments as to why the structure of Morris '163 (e.g., the threaded shaft 35) is not an "equivalent" of the structure disclosed by the appellants are unanswered.

In any event, in applying the above-noted test for determining equivalence under the sixth paragraph of 35 U.S.C. § 112 to ascertain whether the structure of Morris '163 (e.g., the threaded shaft 35) is or is not an "equivalent" of the

⁶ In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

structure disclosed by the appellants, we conclude that the structure of Morris '163 is not an "equivalent" of the structure disclosed by the appellants. In that regard, it is clear to us that the structure of Morris '163 does not perform the function specified in the claim in substantially the same way, and does not produce substantially the same result as the corresponding element disclosed by the appellants.

Furthermore, it is our view that a person of ordinary skill in the art would not have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification. Based upon the above determinations, we conclude that there are substantial differences between the structure of Morris '163 and the structure disclosed by the appellants. Accordingly, under the above-noted test for determining equivalence under the sixth paragraph of 35 U.S.C.

§ 112 we conclude that the structure of Morris '163 is not equivalent to the structure disclosed by the appellants.

For the reasons stated above, the decision of the examiner to reject claims 1 through 3 and 7 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 2 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 1 through 3 and 7 under 35 U.S.C. § 103 is reversed; the decision of the examiner to reject claims 10 and 11 under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Administrative Patent Judge)

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APPLICATION NO. 08/089,595

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DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria

Henderson

DRAFT TYPED: 19 Feb 99

FINAL TYPED: