

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT C. MARTIN, PHILLIP RAMBOSEK,
WILLIAM J. VANDERHEYDEN, JOHN W. LOUKS, DONALD L. POCHARDT
and SATINDER K. NAYAR

Appeal No. 97-0145
Application 08/073,327¹

ON BRIEF

Before MEISTER, ABRAMS and STAAB, *Administrative Patent Judges*.
ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1 through 9 and 11 through 14. At that point, remaining claims 10 and 15 through 22 had been withdrawn by the examiner as being directed to a nonelected invention. After

¹ Application for patent filed June 8, 1993.

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consideration of the appellants' Brief on Appeal, the examiner decided that claims 1 through 9 were allowable (Answer, page 5). This being the case, only claims 11 through 14 remain before us on appeal.

The appellants' invention, as expressed in claims 11 through 14, is directed to a cartridge housing comprising a base and a cover having mating projections and pockets. The appealed claims appear in an appendix to the Brief on Appeal.

THE REFERENCES

The references relied upon by the examiner to support the final rejection of claims 11 through 14 are:

Bettinger <i>et al.</i>	4,566,653	Jan. 28, 1986
(Bettinger)		

The admitted prior art as described on pages 1 through 3 of the appellants' specification.²

THE REJECTIONS

Claim 11 stands rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Bettinger.

² While the examiner has not specified the exact portion of the specification upon which he relies, we believe these to be the pages.

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Claims 12 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bettinger.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Bettinger in view of the admitted prior art.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellants are set forth in the Brief and the Reply Brief.

OPINION

After consideration of the positions and arguments presented by both the examiner and the appellants, we have concluded that all three of the rejections set forth above should be sustained. Our reasons for this decision follow.

The Rejection Under 35 U.S.C. § 102(b)

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994). It does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See *Verdegaal Brothers Inc. v. Union Oil Co. of*

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California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does it require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984). It is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of the claim. See *In re Mott*, 557 F.2d 266, 269, 194 USPQ 305, 307 (CCPA 1977).

The appellants have not responded directly to the Section 102 rejection; all of their comments concern obviousness. To the extent that these apply to the rejection on anticipation, they focus on construction of the pockets which mate with the projections, as well as the disclosed use to which the projections and pockets are put in Bettinger. Claim 11 requires that there be at least one projection having an end wall, and this reads on pegs 36 of Bettinger, with the end walls being the top face on the pegs, as shown in Figure 5. The claimed pockets read on holes 35, each of which has, along the circumferential side walls, what can be read as "an inner portion, and outer

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portion, and two side portions" (emphasis added), which is all that the claim requires. As for intended use, it is our view that these elements not only are capable of acting as locators during the assembly of the base and the cover of the cartridge housing, but do perform such a function. Whether or not they capture or control the flash resulting from ultrasonic welding is of no import, for claim 11 does not even mention this function, much less recite structure which accomplishes it.

All of the language set forth in claim 11 reads on Bettinger, and thus this rejection is worthy of being sustained.

The Rejections Under 35 U.S.C. § 103

The question under 35 U.S.C. § 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary

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skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985).

Claim 12 depends from claim 11 and has been rejected as being unpatentable over Bettinger. As we concluded above, Bettinger discloses all of the subject matter of claim 11. Bettinger further discloses that the pockets are in the base and the projections are in the cover, as is added by dependent claim 12. Thus, Bettinger establishes a *prima facie* case of obviousness with regard to the subject matter of this claim.

Claim 13 adds to claim 11 the limitation that each projection end wall is angled and is complementary to the walls of the pockets. Among the several embodiments of the interlocking devices disclosed by Bettinger is one in which complementary angled walls are present in both the projections and the pockets (Figure 7). It is our view that one of ordinary skill in the art would have found it obvious to utilize complementary angled walls on both the projections and the pockets in view of this teaching. Suggestion for such is found

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in the self evident advantage of ease of aligning the base and the cover as they are being joined, which would have been known to the artisan, as well as Bettinger's explicit teaching that embodiments utilizing both non-angled and angled walls are usable in joining the base and the cover of a tape cartridge (columns 3 and 4). Thus, the teachings of Bettinger establish a *prima facie* case of obviousness with regard to the subject matter of claim 13.

The examiner has rejected claim 14 as being unpatentable over Bettinger in view of the admitted prior art contained in the appellants' specification. Bettinger does not disclose any technique for attaching together the base and the cover of the cartridge, however, one of ordinary skill in the art would have recognized that it is implicit in this reference that such means must be provided, or else the cartridge would be inoperative for the purpose intended. On page 2 of their specification, the appellants' state that it was known at the time of their invention to ultrasonically weld together the two portions of a tape cartridge. It therefore is our opinion that one of ordinary skill in the art would have found it obvious to utilize such a method for attaching together the base and the cover of the Bettinger cartridge. In the course of this it further would have

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been obvious to provide an "energy concentrator," that is, a weld bead, at an appropriate point in the pocket, in the fashion admitted to have been known in the prior art. See specification, page 2, lines 20 through 29. The appellants' argument concerning the lack of provisions for controlling and capturing the flash caused by such welding cannot be considered to be persuasive because it is predicated upon limitations that are not present in the claims. See *In re Self*, 671 F.2d 1344, 1346-47, 213 USPQ 1, 3 (CCPA 1982). A *prima facie* case of obviousness therefore is established here, also.

SUMMARY

All of the rejections having been sustained, the decision of the examiner is affirmed.

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

AFFIRMED

JAMES M. MEISTER)	
Administrative Patent Judge))	
)	
)	
NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
LAWRENCE J. STAAB)	
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