

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERT M. JUERGENS, III

Appeal No. 97-3064
Application 08/235,332¹

ON BRIEF

Before MEISTER, STAAB and NASE, **Administrative Patent Judges.**

MEISTER, **Administrative Patent Judge.**

DECISION ON APPEAL

Albert M. Juergens III (the appellant) appeals from the
final rejection of claims 1 and 15, the only claims remaining
in the application.²

¹ Application for patent filed April 29, 1994.

² Claims 1 and 15 have been amended subsequent to final
rejection.

OPINION

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and reply brief and by the examiner in the answer. As a consequence of this review, we will sustain the rejection of claim 15. We will not, however, sustain the rejection of claim 1.

Considering first the rejection of claim 15 under 35 U.S.C. § 102(b) as being anticipated by Wittel, it is the examiner's position that

Wittel meets the structural limitations of the apparatus as claimed and, thus, would ***inherently*** accommodate such an elongated flexible resilient strip of nominally curved lateral cross section and the characteristics of such [***i.e.***, "snap to . . ." and "snap back . . ."] would be exhibited if such a strip is placed in the apparatus. Moreover, Wittel discloses the ability of the apparatus to handle various types of film [Answer, pages 6 and 7; emphasis ours.]

The appellant does not contest the examiner's assertion

can rightly be distinguishable over prior art because of functional and operational limitations" (page 3, footnote 2).

that the device of Wittel would inherently "accommodate" a flexible resilient strip of nominally curved lateral cross section and that the claimed characteristics would therefore be "exhibited." Instead, the appellant argues that

Wittel does not suggest that the bending of his strip in its arcuate path is sufficient to snap a laterally curved strip into a flat lateral cross section.

If the only point of difference between claim 15 and Wittel was that the claimed apparatus is operated with a laterally curved strip whereas Wittel operates his apparatus with a laterally flat strip, then the Examiner's argument might have some merit. However, that is not the case. The point of distinction is in element (b) of apparatus claim 15, which is a permissible means plus function structural limitation,⁴ requiring the arcuate path be

⁴ Claim 15 in subparagraph b) sets forth "drive means for longitudinally advancing the strip along the arcuate path . . . to bend . . . and by that bending cause the nominally curved lateral cross section to snap to a flat lateral cross section." We observe, however, the drive means (*i.e.*, rollers 20,21) is simply the mechanism which causes the strip to **advance**, it is the tracks which **guide** the advancing strip along the arcuate path that actually performs the function of causing the advancing strip to "snap" as claimed. In the event of further prosecution before the examiner, this informality should be corrected. For purposes of the § 102(b) rejection, we will consider subparagraphs a) and b) to collectively define a means for advancing and guiding the strip which causes the advancing strip to bend and "snap" in the required manner.

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such as to achieve longitudinal bending to a degree causing the laterally curved strip to snap laterally flat. [Reply brief, page 3.]

We are unpersuaded by the appellant's arguments. A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *See Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). If a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists regardless of whether there was a recognition that it could be used to perform the claimed function. *See In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). See also *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990):

"The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from prior art, can not impart patentability to claims to the known composition."

Here, as the examiner has noted, Wittle discloses guide

tracks or gates 17, 18 that define a curved guide path through which film 16 (*i.e.*, a flexible resilient strip) is advanced by a driving mechanism 34. Comparing Fig. 1 of Wittle and Fig. 2 of the appellant's device, it is readily apparent that Wittle's curved guide path is remarkably similar to the appellant's curved guide path. The tracks or gates 17, 18 of Wittle are stated to be spaced apart by a distance of two film thicknesses (page 1, line 35; page 2, lines 58 and 59) and, thus, the guide path defined by these tracks or gates clearly has the capability of guiding a longitudinally advancing strip which has a "nominally curved lateral cross section." In view of the remarkable similarity of the guide path of Wittle to that of the appellant, there is a reasonable basis to conclude that if the device of Wittle was used to guide and advance a strip having a "nominally curved lateral cross section," Wittle's device would inherently function to cause the strip to "snap" in the claimed manner.⁵ Whether Wittle's device actually is

⁵ Where, as here, there is a sound basis to believe that the critical function for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art device, it is incumbent upon an appellant to

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or might be used to guide a strip having a nominally curved lateral cross section depends upon the performance or non-performance of a future act of use, rather than upon a structural distinction in claim 15. Stated differently, the strip advancing and guiding device of Wittle would not undergo a metamorphosis to a new device simply because it was used to advance and guide a strip having such a cross section. **See In re Pearson**, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) and **Ex parte Masham**, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

In view of the foregoing, we will sustain the rejection of claim 15 35 U.S.C. § 102(b) as being anticipated by Wittle.

Turning to the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Wittle, this claim expressly requires the step of "advancing the strip [*i.e.*, the strip having a 'nominally curved lateral cross section' as set forth

prove that the prior art device does not in fact possess the characteristics relied on. **See, e.g., In re Spada, supra; In re Fitzgerald**, 619 F.2d 67, 70, 205 USPQ 594, 597 (CCPA 1980); **In re Glass**, 474 F.2d 1015, 1019, 176 USPQ 529, 532 (CCPA 1973) and **In re Ludtke**, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971).

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in the preamble] longitudinally toward the processing station" There is absolutely nothing in Wittle which would either teach or suggest a strip having such a cross section. Throughout Whittle's disclosure the strip only broadly referred to as a "film," with no disclosure whatsoever as to its lateral cross section. Since each and every feature set forth in claim 1 cannot be found in Wittle, either explicitly or under the principles of inherency, we will not sustain the rejection of claim 1 under 35 U.S.C.

§ 102(b) as being anticipated by Wittle.

In summary:

The rejection of claim 1 under 35 U.S.C. § 102(b) is reversed.

The rejection of claim 15 under 35 U.S.C. § 102(b) 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

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