

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETRA C. TINHORN

Appeal No. 97-3197
Application No. 08/418,021¹

ON BRIEF

Before COHEN, STAAB, 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 5 through 8, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed June 9, 1995.

BACKGROUND

The appellant's invention relates to a music emitting pillow. A copy of claims 5 through 8 is attached to the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Boos	2,940,088	June 14, 1960
Ramey	4,228,793	Oct. 21, 1980
Fry	4,862,438	Aug. 29, 1989
Johanning	5,392,478	Feb. 28, 1995

Claim 8 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 appellant regards as the invention.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Boos in view of Fry and Ramey.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fry in view of Boos and Ramey.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Boos in view of Fry and Ramey as applied to claim 6 above, and further in view of Johenning.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fry in view of Boos and Ramey as applied to claim 6 above, and further in view of Johenning.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 and § 112 rejections, we make reference to the examiner's answer (Paper No. 12, mailed March 26, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 11, filed February 20, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the

examiner. As a consequence of our review, we make the determinations which follow.

The Indefiniteness Issue

We do not sustain the rejection of claim 8 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).

On page 3 of the answer, the examiner determined that

[t]he recitation "wherein said head depression has . . . an oval shaped side surface" renders the claim indefinite. . . . The side surface does not have an oval shaped, instead the side surface forms an oval shape.

It is our opinion that the language at issue (i.e., oval shaped side surface) would be understood as merely reciting that the side surface of the head depression forms an oval shape.

Accordingly, the metes and bounds of the claimed invention have been defined with the necessary degree of precision and particularity required by the second paragraph of 35 U.S.C. § 112.

The Obviousness Issue

We do not sustain the rejections of claims 5 through 8 under 35 U.S.C. § 103.

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).

Claim 5, the only independent claim on appeal, recites a music emitting pillow comprising, inter alia, a head depression, a neck support channel, a music producing means and a pressure activated switch for turning off and on the music producing means in response to changes in pressure upon the head depression.

In our opinion, the combined teachings of all the applied prior art (i.e., Boos, Fry, Ramey and Johenning) would not have been suggestive of providing a pressure activated switch for turning off and on a music producing means in response to changes in pressure upon the head depression part of the pillow. Contrary to the examiner's determination, we do not believe that

Ramey's teaching of a pressure activated switch for actuating a vibrator in a pillow would have suggested placing a pressure activated switch for turning off and on a music producing means in the head depression part of the pillow. Since all the limitations of claim 5 are not suggested by the applied prior art, we cannot sustain the examiner's rejection of appealed independent claim 5, or claims 6 through 8 which depend therefrom, under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claim 8 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 5 through 8 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES

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APJ NASE

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DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 05 Jan 98

FINAL TYPED: