

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY A. FISHER and LARRY S. CHANDLER

Appeal No. 1998-1927
Application No. 08/703,276

ON BRIEF

Before COHEN, JENNIFER D. BAHR and LAZARUS, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 7-10, 12 and 21. Claims 11 and 22-24, the only other claims pending in the application, have been indicated as allowable by the examiner (Paper No. 9).

BACKGROUND

The appellants' invention relates to an acoustic sensor for monitoring a point in space remote from the sensor (specification, page 1). An understanding of the invention can be derived from a reading of exemplary claims 1 and 21, which appear in the appendix to the appellants' brief.¹

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

McCarty	5,107,709	Apr. 28, 1992
Fisher	5,155,707	Oct. 13, 1992
Slayton et al. (Slayton)	5,175,709	Dec. 29, 1992
Aida et al. (Aida)	5,590,653	Jan. 7, 1997 (filed Mar. 9, 1994)

The following rejections are before us for review.

Claims 1 and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fisher.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Fisher in view of Slayton.

Claims 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fisher in view of Slayton, as applied to claim 7 above, and further in view of Aida.

¹ The examiner (answer, page 3) points out a minor error in the copy of claim 1 in the appellants' appendix.

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Claims 10 and 21² stand rejected under 35 U.S.C. § 103 as being unpatentable over Fisher in view of McCarty or Aida.

Reference is made to the brief and reply brief (Paper Nos. 11 and 13) and the answer (Paper No. 12) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

OPINION

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. For the reasons which follow, we have determined that the examiner's rejections are sustainable.

Turning first to the examiner's rejection of claims 1 and 12 as being anticipated by the Fisher patent, the appellants argue on pages 4 and 5 of their brief that the Fisher patent lacks (1) an elongated sensing means for ***detecting said acoustic energy originating . . . at said focal point*** and (2) means for ***processing output signals . . . produced in response to simultaneous impingement of the acoustic energy therealong from the focal point*** and, thus, fails to anticipate³ claim 1.

² We note that the appellants (brief, pages 3-5) have argued the rejections of claims 21 and 12 as if they were under § 102 and § 103, respectively, notwithstanding that the examiner's final rejection (Paper No. 6) and answer (Paper No. 12) clearly indicate that claims 21 and 12 stand rejected under § 103 and § 102, respectively.

³ Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys.,
(continued...)

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With regard to the first argued distinction, the examiner's position appears to be that the inner surface of the spherically configured sensing coil 121 and reference coil 122 is concave and, thus, inherently has a focal point associated therewith (answer, pages 5 and 7). The appellants do not contest this assertion by the examiner, but urge that Fisher "fails to disclose or teach detection restricted to energy on the concave surface originating at its focal point" (reply brief, page 1).

It is well established that limitations not appearing in the claims cannot be relied upon for patentability. In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). 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).

Having carefully reviewed the terminology of claim 1, we fail to perceive any limitation that the detection performed by the sensing means be restricted to energy originating at the focal point of the concave surface as the appellants' argument would suggest. The sensing coil 121 of the acoustic sensor disclosed in the Fisher patent, as we understand it, will detect any

³(...continued)
Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). 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, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

and all acoustic energy which impinges thereupon, regardless of the location of origin of that energy. This, of course, inherently includes acoustic energy originating at the focal point of the concave surface defined by the sensing coil. The "elongated sensing means . . . for detecting . . ." recitation of claim 1 requires no more than this, in our opinion.

Likewise, with respect to the second argued distinction, the detector hardware 20, 26 senses the phase difference between the sensing and reference coils and produces signals in response to impingement along the sensing coil of acoustic energy from any and all locations of origin, including the focal point of the inner surface defined by the sensing and reference coils. Further, as the focal point of a spherical surface is equidistant from all points on such surface, any acoustic energy originating from the focal point will impinge upon all points of the sensing coil substantially simultaneously. We appreciate that the detector hardware of the Fisher patent does not appear to affirmatively discriminate between acoustic energy originating from the focal point and acoustic energy originating from other locations. However, claim 1 does not require such discrimination.

Thus, notwithstanding that the Fisher patent does not make reference to the focal point of the surface defined by the sensing and reference coils, the sensing coil 121 and detection hardware 20, 26 of the Fisher patent reasonably appear to inherently meet the limitations associated with the "sensing means" and "means for processing," respectively, recited in claim

1, so as to establish a *prima facie* case of anticipation.⁴ After the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to the appellants to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, the appellants' burden before the PTO is to prove that the sensing coil and detection hardware do not perform the functions defined in claim 1. The appellants have not come forward with any evidence to satisfy that burden.⁵

For the foregoing reasons, we shall sustain the examiner's rejection of claim 1 as being anticipated by the Fisher patent. The only argument offered by the appellants in support of the patentability of claims 7-10 and 12, which depend from claim 1, is that the various additional prior art references cited to support the obviousness rejections of these claims do not overcome the perceived deficiencies of the Fisher patent with regard to the limitations of claim 1 discussed *supra*. It thus follows that we shall sustain the examiner's rejections of these claims as well.

⁴ The prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. See Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed. Cir. 1985). Rather, if a claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding anticipation. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631-33, 2 USPQ2d 1051, 1052-54 (Fed. Cir. 1987).

⁵ An attorney's arguments in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

With regard to the examiner's rejection of claim 21 under 35 U.S.C. § 103 as being unpatentable over the Fisher patent in view of McCarty or Aida, the appellants' only argument is that the Fisher patent fails to disclose "means restrictively positioning . . . for location of the acoustic source at said focal point to establish said impingement of the acoustic energy simultaneously all along one of the pair of the fiber-optic cables on the detection surface" (brief, page 5). The examiner expressly concedes that the Fisher patent fails to disclose this feature, but takes the position that the teachings of either McCarty or Aida would have suggested inclusion of such a feature on the acoustic sensor of the Fisher patent (answer, pages 6 and 7). As the appellants have not included any argument in their brief or reply brief contesting the examiner's determination of obviousness, we are constrained to sustain the examiner's rejection of claim 21.⁶

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 12 under 35 U.S.C. § 102(b) and claims 7-10 and 21 under 35 U.S.C. § 103 is affirmed.

⁶ We hasten to point out that claim 21 is drafted as a Jepson (Ex parte Jepson, 1917 C.D. 62, 243 O.G. 525 (Ass't Comm'r Pat. 1917), incorporated into the rules as 37 CFR § 1.75(e)) type claim in which the preamble of the claim is an admission of prior art. Note, In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982). That is, the appellants admit that, akin to the teachings of Fisher, acoustic sensors of the type recited in claim 21 before "the improvement . . ." were well known in the art at the time of the appellants' invention and that the only distinction between the prior art and the appellants' claimed invention is the "means restrictively positioning . . . for location . . ." recited in claim 21. McCarty and Aida are evidence that means for locating the focal point of an acoustic transducer were also known in the art at the time of the appellants' invention and appear to us to provide suggestion for one of ordinary skill in the art to provide such a feature on the admitted prior art acoustic sensor to achieve the self-evident advantages thereof. This leads us to the same conclusion reached by the examiner, that the subject matter of claim 21 as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art within the meaning of 35 U.S.C. § 103.

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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

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JENNIFER D. BAHR)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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RICHARD B. LAZARUS)	
Administrative Patent Judge)	

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