

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID HAROLD BERRY

Appeal No. 1999-1740
Application No. 08/799,433¹

ON BRIEF

Before FRANKFORT, NASE, and GONZALES, 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 to 14. Claim 19 has been allowed. Claim 15 has been objected to as depending from a non-allowed claim. Claims 16 to 18 have been canceled.

¹ Application for patent filed February 13, 1997.

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Application No. 08/799,433

We REVERSE.

BACKGROUND

The appellant's invention relates to a flush glass seal insert with a belt-line extension. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

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

Omura et al. (Omura) 1990	4,908,989	Mar. 20,
Norton 1997	5,694,718	Dec. 9,

(filed Sept. 6, 1996)

Claims 1 to 4, 6 to 8 and 10 to 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Omura.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Omura.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Omura in view of Norton.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 16, mailed February 26, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15, filed November 16, 1998) 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 anticipation rejection

We will not sustain the rejection of claims 1 to 4, 6 to 8 and 10 to 14 under 35 U.S.C. § 102(b).

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the 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 Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed 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)).

All the independent claims on appeal (i.e., claims 1, 6, 10 and 13) include the limitation that the insert include "a

line of weakness" for "permitting the second leg to be separated from the base."

The examiner's anticipation rejection (answer, pp. 4 and 5-6) is founded on the basis that the claimed "line of weakness" is readable on the slit 16 in Omura's glass run (see Figure 8). Specifically, the examiner states (answer, p. 5) that Omura discloses "a slit or line of weakness which is taught to be ripped or torn." We do not agree. We have reviewed the entire disclosure of Omura and fail to find any teaching therein that Omura's slit is "ripped or torn." Accordingly, we find ourselves in agreement with the appellant's argument (brief, pp. 4-6, 8 and 12-13) that Omura does not disclose "a line of weakness" as recited in the claims under appeal.

Since all the limitations of claims 1 to 4, 6 to 8 and 10 to 14 are not disclosed in Omura for the reasons stated above, the decision of the examiner to reject claims 1 to 4, 6 to 8 and 10 to 14 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejections

We will not sustain the rejections of claims 5 and 9 under 35 U.S.C. § 103.

As pointed out above, the limitation regarding "a line of weakness" is not taught or suggested by Omura. We have also reviewed the reference to Norton applied in the rejection of claim 5 but find nothing therein which would have suggested the claimed "line of weakness." Since all the claimed limitations are not suggested by the applied prior art, the decision of the examiner to reject claims 5 and 9 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 4, 6 to 8 and 10 to 14 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 5 and 9 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

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APPLICATION NO. 08/799,433

APJ NASE

APJ GONZALES

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 02 Aug 99

FINAL TYPED: