

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

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN B. MERRETT,
DEVOR R. TAYLOR, MARK M. WHEELER
and DAN R. GALE

Appeal No. 2002-1214
Application No. 09/062,046

ON BRIEF

Before GARRIS, JEFFREY T. SMITH and MOORE, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal the decision of the Primary Examiner finally rejecting claims 1 to 8, 10, 11, 13 to 15, 17, 21 and 25 to 45.¹ We have jurisdiction under 35 U.S.C. § 134.²

¹ Claims 9, 12, 16, 18 to 20, 22 to 24 and 46 to 62 have been withdrawn from consideration due to and election by Appellants resulting from either a restriction requirement or an election of species. (Brief, p. 2; Answer, p. 2).

² In rendering this decision, we have considered Appellants' arguments presented in the Brief filed May 5, 2001, and the Reply Brief filed October 1, 2001.

BACKGROUND

Appellants' invention relates to an apparatus for the manufacture of fiber reinforced structures. The apparatus comprises an upper member and a lower member to consolidate and cure fiber elements. The upper member includes a pressure member and at least one end member. The lower member includes a pressure member and at least one end member. Claim 38, which is representative of the claimed invention, appears below:

38. Apparatus for use in the bonding of fiber elements of a composite structure, said apparatus comprising:

an upper member used in the bonding of said fiber elements of said composite structure, the upper member including a pressure member and at least one end member; and

a lower member used in the bonding of said fiber elements of said composite structure, the lower member including a pressure member and at least one end member.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Miller	3,533,352	Oct. 13, 1970
Alexander et al. (Alexander)	4,755,128	Jul. 05, 1988

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Horvath	5,494,546	Feb. 27, 1996
Bielfeldt et al. (Bielfeldt)	5,562,028	Oct. 08, 1996

The Examiner rejected claims 1, 2, 21, 25, 38 and 39 under 35 U.S.C. § 102(b) as anticipated by Miller; claims 26, 33 to 37 and 45 under 35 U.S.C. § 103(a) as obvious over Miller; claims 3 to 8, 10, 11, 13 to 15, 17 and 40 to 44 under 35 U.S.C. § 103(a) as unpatentable over the combination of Miller and Bielfeldt; claims 27 to 32 under 35 U.S.C. § 103(a) as unpatentable over the combination of Miller and either Alexander or Horvath; and claim 44 under 35 U.S.C. § 112, second paragraph. (Answer pp. 3 to 6).

At the outset, we note that Appellants state “[f]or purposes of this appeal, claims 1 through 8, 10, 11, 13 through 15, 17, 21 and 25 through 45 stand together. Claim 38 is the broadest claim. Claims 1, 2, 21, 25, 27 through 32 and 39 stand and fall with claim 38. Claims 3 through 8, 10, 11, 13 through 15, 17, 26, 33 through 37 and 40 through 45 stand, but do not fall, within claims 38.” (Brief, p. 5).

Appellants have failed to provide a grouping of the claims for each ground of rejection. There are several claims within Appellants’ groups that are subject to different ground of rejection. Since the Appellants have not properly selected claims for each ground of rejection, we will select a representative for each rejection. *See In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed.

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Cir. 2002) (“if the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim”).

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants concerning the above-noted rejections, we refer to the Answer and the Briefs. For the reasons set forth below, and in the Answer, we will sustain the §102(b), §103(a) and § 112, second paragraph rejections.

OPINION

I.

The Examiner rejected claims 1, 2, 21, 25, 38 and 39 under 35 U.S.C. § 102(b) as anticipated by Miller. We select claim 38 as the representative claim for this rejection.

Claim 38 is directed to an apparatus. “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1468, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Therefore, the patentability of an apparatus claim depends on the claimed structure, not on the use or purpose of that structure, *Catalina Marketing Int’l Inc. v. Coolsavings.com Inc.*, 289 F.3d 801, 809, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002), or the function or

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result of that structure. *In re Danly*, 263 F.2d 844, 848, 120 USPQ 528, 531 (CCPA 1959); *In re Gardiner*, 171 F.2d 313, 315-16, 80 USPQ 99, 101 (CCPA 1948). If the prior art structure possesses all the claimed characteristics including the capability of performing the claimed function, then there is a *prima facie* case of unpatentability. *In re Ludtke*, 441 F.2d 660, 663-64, 169 USPQ 563, 566-67 (CCPA 1971).

Miller describes an apparatus for the application of heat and pressure to a work element. (Col. 1, ll. 3-4). According to the Examiner, the apparatus of Miller includes an upper member including a pressure member and at least one end member and a lower member including a pressure member and at least one end member. (Answer, p. 4).

Appellants argue that claim 38 includes limitations that “cannot be disregarded as being immaterial to patentability as the limitations clearly impart structural definition to the claimed apparatus. The upper member and the lower member must both be configured so as to be able to be used in the bonding of fiber elements of a composite structure. Therefore, the ‘functional’ claim language imparts size and shape limitations on the present invention.” (Brief, pp. 9-10).

Claim 38 is directed to an apparatus. The claim specifies that the apparatus is “for use in the bonding of fiber elements of a composite structure”. Appellants

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are free to recite features of an apparatus either structurally or functionally. *See In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971). However, defining an element functionally carries with it a risk. *See Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432, citing *Swinehart*, “where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.”

As stated above, the Examiner has found that the apparatus of Miller has the same structural elements as the claimed invention. Specifically, the Examiner found that Miller includes upper and lower members that have at least one end member and a pressure member. These structural elements are used to apply pressure on work elements. (Miller, col. 1). Appellants have not challenged the Examiner’s factual determinations. Accordingly, we determine that the Examiner has met the initial burden of establishing a *prima facie* case of unpatentability under section 102. Therefore, the burden has been shifted to Appellants to show that the claimed product differs substantially from the product disclosed by Miller. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990); and *In re Best*, 562

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F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Appellants has not directed us to evidence that the apparatus of Miller is not capable of “bonding of fiber elements of a composite structure”.

In any event, assuming we interpret claim 38 as suggested by Appellants, the language “for use in the bonding of fiber elements of a composite structure” alone does not overcome the rejection under section 102. Contrary to Appellants’ argument, this claim language does not impart size and shape limitations on the invention. The claim language does not specify that the composite structures are large, small, planar or cylindrical.³ It appears that the “bonding of fiber elements of a composite structure” is achieved by the application of pressure to the composite structure by the upper and lower pressure members. The Examiner has found that Miller has upper and lower pressure members that apply pressure to work elements. Appellants have not argued that the upper and lower pressure members of Miller are not capable of “bonding of fiber elements of a composite structure”.

³ Moreover, according to the specification, page 3, lines 13-15, “composite structures are typically formed of ‘composite fiber elements’ or ‘fiber elements’ including carbon fiber impregnated or coated with a curable bonding agent. By way of example and not limitation, composite fibers may include elongated filaments of glass, graphite, boron, or polyarimid (Kevlar™).” (underlining added). Accordingly, the specification does not limit the composite structures to any special shape or size.

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For the reasons stated above, the rejection of claims 1, 2, 21, 25, 38 and 39 under 35 U.S.C. § 102(b) is affirmed.

II.

The Examiner rejected claims 26, 33 to 37 and 45 under 35 U.S.C. § 103(a) as obvious over Miller. We select claim 26 as the representative claim for this rejection.

Claim 26⁴ describes the heat members of the apparatus as including an electrical heat member. The Examiner concluded that electrical heat members were equivalent to infrared heat members and the substitution on one for another would have been obvious to a person of ordinary skill in the art. (Answer, pp. 4-5). Appellants' arguments, Brief pages 12 to 14, do not specifically challenge that Examiner's conclusion with regard to the substitution of electrical heat members for infrared heat members. Consequently, we affirm the rejection for the reasons presented by the Examiner.

III.

The Examiner rejected claims 3 to 8, 10, 11, 13 to 15, 17 and 40 to 44 under 35 U.S.C. § 103(a) as unpatentable over the combination of Miller and Bielfeldt.

⁴ Claim 26 further defines the subject matter of claim 2 which further defines the subject matter of claim 1.

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We select claim 40 as the representative claim for this rejection. The Examiner has determined that Miller does not disclose plural upper members as required by claim 40. To remedy this deficiency, the Examiner relies on Bielfeldt. The Examiner concludes that the use of plural upper members would have been obvious to provide flexibility to the press operation. (Answer, pp. 5 and 8). We agree. The addition of press members to the apparatus of Miller would allow for the pressure to vary in specific zones on the work element.

Appellants argue that Miller teaches or suggest nothing but an apparatus for a printed circuit board and that Bielfeldt teaches or suggest nothing but a press for particle board. (Brief, p. 16). It is well-settled that a prior art reference is relevant for all that it teaches to those of ordinary skill in the art. *In re Fritch*, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992). Miller is not limited to printed circuit boards. Miller discloses that the apparatus is suitable for use on work elements and is not limited to laminated printed circuit boards. (Col. 1). Bielfeldt teaches a press with various press zones for articles including particle boards, fiber boards and plastic boards. A person of ordinary skill in the art would have recognized that the addition of press members to the apparatus of Miller would allow for the pressure to vary in specific zones on the work element.

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IV.

The Examiner rejected claims 27 to 32 under 35 U.S.C. § 103(a) as unpatentable over the combination of Miller and either Alexander or Horvath. Appellants argue that these claims are “allowable as depending from independent claim 1.” (Brief, p. 18). The Examiner has presented reasonable arguments as to why the invention of the claims 27 to 32 are unpatentable. The Appellants have not rebutted the Examiner’s position that the additional limitations of claims 27 to 32 are unpatentable. Thus, for the reasons stated above and in the Answer, the rejection is affirmed.

V.

The Examiner rejected claim 44 under 35 U.S.C. § 112, second paragraph as not having proper antecedent. (Answer, pp. 3-4). Appellants argue that the rejection is not substantive and can be over come by amending the claim. (Brief, p. 8). Since the Appellants have not specifically rebutted the Examiner’s rejection, we affirm.

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CONCLUSION

The rejection of claims 1, 2, 21, 25, 38 and 39 under 35 U.S.C. § 102(b) as anticipated by Miller; claims 26, 33 to 37 and 45 under 35 U.S.C. § 103(a) as obvious over Miller; claims 3 to 8, 10, 11, 13 to 15, 17 and 40 to 44 under 35 U.S.C. § 103(a) over the combination of Miller and Bielfeldt; claims 27 to 32 under 35 U.S.C. § 103(a) over the combination of Miller and either Alexander or Horvath; and claim 44 under 35 U.S.C. § 112, second paragraph are affirmed.

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Time for taking action

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

AFFIRMED

BRADLEY R. GARRIS
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

JAMES T. MOORE
Administrative Patent Judge

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