

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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER A. FRENCH and EZRA T. PEACHEY

Appeal No. 2002-1316
Application No. 09/049,036

ON BRIEF

Before COHEN, ABRAMS and McQUADE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Roger A. French et al. originally took this appeal from the final rejection (Paper No. 10) of claims 1 through 4, 6 and 8 through 18. As the appellants have since canceled claim 18, the appeal now involves claims 1 through 4, 6 and 8 through 17, all of the claims currently pending in the application.

THE INVENTION

The invention relates to "a magnetic gasket that can be used to fasten together components in an electronic device"

(specification, page 1). Representative claims 1, 10 and 17 read as follows:

1. A magnetic gasket to fasten together components in an electronic device, comprising:

magnetic strip with an essentially rectangular cross-section having a first, second, third, and fourth sides, with said first and third and second and fourth sides respectively opposed to each other, said second side being substantially perpendicular to said first side;

an adhesive layer attached to the first side of said magnetic strip; and

an electrically conductive gasket made of a deformable material that extends beyond said opposed first and third sides attached to the second side of said magnetic strip.

10. A magnetic gasket to fasten together components in an electronic device, comprising:

magnetic strip with an essentially rectangular cross-section having a first, second, third, and fourth sides, with said first and third and second and fourth sides respectively opposed to each other, said second side being substantially perpendicular to said first side;

an electrically conductive layer on said magnetic strip, the electrically conductive layer conductively connecting said first and third sides of said magnetic strip; and

an electrically conductive adhesive layer attached to said electrically conductive layer at said first side of said magnetic strip, said adhesive layer being located on a surface of said electrically conductive layer away from said magnetic strip.

17. A magnetic gasket to fasten together a first component and a second component in an electronic device, comprising:

a magnetic strip;

an adhesive layer attached to said magnetic strip; and

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an electrically conductive gasket attached to said magnetic strip, said electrically conductive gasket being configured to electrically connect the first component to the second component.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Hartwell	3,026,367	Mar. 20, 1962
Rostek	3,969,572	Jul. 13, 1976
Harada et al. (Harada)	5,160,806	Nov. 3, 1992

THE REJECTIONS

Claims 1 through 4, 6, 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Harada in view of Hartwell.

Claims 10 through 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rostek.

Attention is directed to the appellants' main, reply and supplemental reply briefs (Paper Nos. 14, 16 and 20) and to the examiner's answer (Paper No. 19) for the respective positions of the appellants and examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 103(a) rejection of claims 1 through 4, 6, 8 and 9 as being unpatentable over Harada in view of Hartwell

Harada discloses "an electromagnetic shielding member which is used for a seam portion of a metal case or a door portion of an electromagnetic shielding chamber so as to suppress electromagnetic waves leaking from a contact portion" (column 1, lines 8 through 12). The embodiment illustrated in Figures 12 and 13 includes a series of magnetic strips 12 and conductive strips 13 having rectangular cross-sections and arranged in alternating sequence to form a plate-like member 11, and an elastic conductive shielding member 16 composed of a polyurethane foam member coated with conductive cloth. As best shown in Figure 13, the elastic conductive shielding member 16 extends laterally from the free side, and vertically above the top, of a magnetic strip 12 at one end of the plate-like member. So disposed, it bridges the gap between, and conductively contacts, opposed conductive walls 14a and 14b of a metal case (see column 2, lines 62 through 68; and column 7, lines 28 through 33). Of particular interest is that Harada, observing that "strong conductive contact . . . is not required" (column 4, lines 4

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through 6), characterizes the conductive contact between the elastic conductive shielding member 16 and the walls 14a and 14b as "slight" (column 7, line 29). Harada also suggests (see column 5, lines 41 through 43) that the shielding member as a whole can be fixed to the wall 14a by a conductive adhesive agent.

The examiner concedes (see page 3 in the answer) that Harada does not respond to the limitation in independent claim 1 requiring the electrically conductive gasket to extend beyond the opposed first and third sides of the magnetic strip. Harada's electrically conductive gasket element, i.e., elastic conductive shielding member 16, extends beyond the upper or "third" side of the magnetic strip 12 to which it is attached, but not beyond the lower or "first" side of the strip. To cure this deficiency, the examiner turns to Hartwell.

Hartwell discloses an electrical shielding arrangement for preventing radiation leakage through the seam between a cover and wall of a conductive container. The arrangement comprises a strip 10 having a generally rectangular cross-section and an elastic conductive filamentary shielding member 17 attached to a side surface of the strip and dimensioned to extend beyond the top and bottom surfaces of the strip (see Figure 3). When

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installed, "shielding member 17 is tightly compressed between the container cover and wall so that the filaments of the shielding member form a low resistance electrical contact with the adjacent surfaces" (column 3, lines 64 through 67).

In proposing to combine Harada and Hartwell to reject claim 1, the examiner concludes that it would have been obvious to one of ordinary skill in the art "to modify the Harada . . . device as taught by . . . Hartwell for the purpose of making a good electrical contact between a shielding member (a gasket) and surfaces (conducting walls)" (answer, page 4).

There is nothing in the combined teachings of Harada and Hartwell, however, which indicates that the electrical contact provided by Harada's elastic conductive shielding member 16 is in any sense lacking. To the contrary, Harada seemingly expresses a preference for the "slight" conductive contact afforded by the elastic conductive shielding member 16 as opposed to "strong" conductive contact of the type ostensibly afforded by Hartwell's tightly compressed elastic conductive filamentary shielding member 17. In this light, the appellant's argument that the proposed combination of Harada and Hartwell advanced by the examiner stems solely from impermissible hindsight is persuasive.

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Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claim 1 and dependent claims through 4, 6, 8 and 9 as being unpatentable over Harada in view of Hartwell.

II. The 35 U.S.C. § 102(b) rejection of claims 10 through 17 stand rejected under as being anticipated by Rostek

Rostek discloses an electromagnetic interference shielding gasket for sealing discontinuities in electrical equipment enclosures. The gasket 26 comprises a flexible magnetic strip 28, a flexible plastic foam strip 30, an adhesive film 32 bonding the magnetic and foam strips to one another, a pliable conductive metal strip 36 spirally wrapped around the magnetic and foam strips, and a conductive adhesive 37 bonding the gasket to an enclosure surface.

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). 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,

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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).

Accepting the examiner's finding (see page 5 in the answer) that Rostek's magnetic strip 28 and conductive metal strip 36 respectively constitute a magnetic strip and an electrically conductive layer of the sort recited in independent claim 10, the Rostek gasket still does not meet the limitation in the claim requiring the electrically conductive layer to conductively connect the first and third sides of the magnetic strip. Instead, Rostek's conductive metal strip 36 conductively connects the "third" or bottom side of magnetic strip 28 with the top side of foam strip 30. Hence, Rostek does not disclose each and every element of the magnetic gasket recited in claim 10.

Therefore we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claim 10 and dependent claims 11 through 16 as being anticipated by Rostek.

We also shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claim 17 as being anticipated by Rostek.

Claim 17 requires the magnetic gasket recited therein to comprise three distinct elements: a magnetic strip, an adhesive

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layer attached to the magnetic strip and an electrically conductive gasket attached to the magnetic strip. While Rostek arguably discloses a magnetic strip and adhesive layer in the form of magnetic strip 28 and adhesive film 32, contrary to the finding made by the examiner (see page 6 in the answer), Rostek does not also disclose a distinct electrically conductive gasket attached to the magnetic strip.

III. Remand for additional consideration by the examiner

On page 8 in the answer, the examiner states that "[e]ven if Rostek did not meet claim 17, Harada disclose[s] it." The implication here that Harada might render the subject matter recited in claim 17 unpatentable, at least under the provisions of 35 U.S.C. § 103(a), would seem to have some merit. Unfortunately, the examiner has not entered any prior art rejection of claim 17 based on Harada. Therefore, the application is remanded to the examiner to enter such a rejection if such is found to be warranted.

SUMMARY

The decision of the examiner to reject claims 1 through 4, 6 and 8 through 17 is reversed and the application is remanded to the examiner for further consideration.

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REVERSED AND REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN P. McQUADE)	
Administrative Patent Judge)	

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