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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUAKI SUGITA

Appeal No. 2004-0949
Application No. 09/528,986

ON BRIEF

Before WALTZ, DELMENDO and PAWLIKOWSKI, **Administrative Patent Judges**.

PAWLIKOWSKI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-8. Claim 1 is representative of the subject matter on appeal and is set forth below:

> 1. A sealed battery, comprising:
> a generator element that is an electrode group impregnated with electrolyte;
> an external casing that has an opening and encloses the generator element;
> a closure cap for sealing the opening, the closure cap having a gas release valve that is formed

by covering a gas release hole in the closure cap with a thin film; and

a shielding member that is located between the thin film and the generator element to protect the thin film from the electrolyte so as to secure a gas channel from an internal space of the external casing to the gas release hole.

The examiner relies upon the following references as evidence of unpatentability:

Wakabe et al. (Wakabe)	6,136,464	Oct. 20, 2000
Matsushita (Japanese Patent Publication)[1]	JP07022013	Jan. 24, 1995

Claims 1-8 stand rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103, as being obvious of over Wakabe.

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. § 103 as being obvious over Matsushita.

We have carefully reviewed the answer, the brief, and the reply brief, and the applied references, in making our determinations set forth below.

I. <u>The 35 U.S.C. § 102/ § 103 rejection over Wakabe</u>

We refer to pages 3-4 of the answer regarding the examiner's position for this rejection. In particular, in one embodiment of Wakabe, the examiner finds that Wakabe discloses a valve that includes a thin film cover, that is penetrated by a cutting device, and the examiner refers to Figures 4, 8 and 9 of

[1] We rely upon and cite from a computer-assisted English translation of this document, previously made of record.

Wakabe in connection with this embodiment. The examiner states that the charge-discharge lead 102 is, in effect, appellant's claimed thin film. The examiner states that the cutting device 103 acts as a parallel barrier formed between the electrode assembly and the cover vent. Finally, the examiner states that packing material located on the bottom of the opening serves as the barrier formed between the electrode assembly and the cover vent, and this packing material is porous which allows for gas to exit through the vent hole and these materials prevent the electrolyte from directly contacting the thin metal cover.

Beginning on page 5 of the answer, the examiner further explains that the cutting device 103 acts as a parallel barrier for shielding thin film 102 from the electrolyte in the generator element as depicted in Figures 4 and 8-10. On page 6 of the answer, the examiner states that the cutting device 103 is the shielding member located between the thin film 102 and the electrode assembly. The examiner refers to Figure 14 regarding another embodiment of Wakabe and states that the packing member depicted therein (item (207)) functions as a shielding member located between the electrode assembly and the thin film (209).

On page 4 of the answer, the examiner states that Wakabe may not clearly show the embodiment wherein the shielding member is a plate, set in parallel with the thin film (appellants' claim 3), wherein the thin film is on the exterior of the casing elements, but concludes it would have been obvious to combine the embodiments of Wakabe to include the cutting device as a parallel barrier formed between the electrode assembly and the cover vent, wherein the cover vent has a thin metal cover on the

exterior of the hole, as shown in Figure 14. The examiner states that the exterior cover would also prevent leakage of electrolyte, and the cutting device would prevent the direct contact of the electrolyte.

On page 6 of the brief, appellant states that the examiner refers to Wakabe's charge-discharge lead 102 and cutting device 103, which are located below the gas vent hole V in case cover 108. Appellant states that the charge-discharge lead 102 is designed to be cut by cutting device 103. Appellant states that the purpose of the cutting device 103 is to interrupt current flow, and not to release gas. Appellant concludes, therefore, that these elements do not represent a gas release valve as recited in claim 1.

Our comments are set forth below.

Claim 1 requires a sealed battery, comprising: (1) a generator element that is an electrode group impregnated with electrolyte; (2) an external casing that has an opening and encloses the generator element; (3) a closure cap for sealing the opening, the closure cap having a gas release valve that is formed by covering a gas release hole in the closure cap with (4) a thin film; and (5) a shielding member that is located between the thin film and the generator element to protect the thin film from the electrolyte so as to secure a gas channel from an internal space of the external casing to the gas release hole.

We also note that a claim is anticipated when each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Here, the examiner does not explain how each and every element recited in claim 1 is disclosed by Wakabe. In particular, if charge-discharge lead 102 corresponds to appellant's claimed thin film, and if cutting device 103 corresponds to the claimed shielding member, the examiner does not explain what component in Wakabe is the closure cap. Also, once the thin film 102 is punctured, cutting device 103 is no longer located between the thin film and the generator element. Hence, the examiner has not met his burden. Id. The examiner's obviousness rejection fails to explain how modification of Wakabe (regarding the above-mentioned deficiencies) would have been obvious.

In view of the above, we therefore reverse the anticipation and obviousness rejections of claims 1-8 over Wakabe.

II. The Obviousness Rejection over Matsushita

We refer to pages 4-5 and 7 of the answer regarding the examiner's position for this rejection. We observe that the examiner states that Matsushita does not teach "a cover hole to be covered with a thin film". Yet, the examiner states that "[i]t would be obvious to one skilled in the art at the time the invention was made to include a shielding member for preventing the liquid electrolyte of a battery from exiting the cell or coming into contact . . .". Answer, pages 4-5. Hence, the examiner recognizes a deficiency found in Matsushita (a cover hole to be covered with a thin film). Yet, the examiner does not explain how this deficiency is made obvious; rather, the

examiner explains how inclusion of a shielding member would have been obvious. That is, the examiner does not remedy the deficiency he finds in Matsushita.

We note that in presenting a proper prima facie case of obviousness, the examiner must make a comparison between the scope of the claim (with respect to every claimed element) and the teachings of the applied art to determine whether a prima facie case of obviousness exists based upon such a comparison. Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). In the instant case, the examiner's rejection does not provide us with such a comparison. The examiner does not address each element of claim 1 and discuss whether or not a particular element is taught, or not taught, by Matsushita, and, then, why any element not taught, would have been obvious. For example, if component 9 is the thin film, the examiner has not explained whether or not Matsushita teaches the claimed closure cap also. Nor has the examiner explained why it would have been obvious to modify the battery of Matsushita to include a closure cap. Because of these failings found in the examiner's rejection, we reverse the obviousness rejection.

III. Conclusion

The rejection of claims 1-8 under 35 U.S.C. § 102(e) as being anticipated by, or in the alternative, under 35 U.S.C. § 103 as being obvious over Wakabe is reversed.

The rejection of claims 1-2 and 4-5 under 35 U.S.C. § 103 as being obvious over Matsushita is reversed.

REVERSED

THOMAS A. WALTZ Administrative Patent Judge	)
ROMULO H. DELMENDO Administrative Patent Judge	)BOARD OF PATENT) APPEALS AND) INTERFERENCES
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	)

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