

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ISAO TAKAHASHI

Appeal No. 2004-0967
Application No. 10/145,031

ON BRIEF

Before ABRAMS, STAAB and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-16, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an insertion/removal jig for pulling out a printed circuit board from electronic equipment. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

Claims 1-16 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (mailed Oct. 7, 2003) for the examiner's complete reasoning in support of the rejections, and to the Brief (filed Aug. 13, 2003) and the Reply Brief (filed Dec. 8, 2003) 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 and to the respective positions articulated by

¹A rejection of claims 1-16 under 35 U.S.C. § 102(b) as being anticipated by Barnes et al. U.S. Patent No. 4,454,552 was withdrawn in the Answer.

the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention is directed to solving the problem of breaking off the distal ends of circuit boards if an attempt is made to pull them from their slot in the apparatus without disengaging the connectors that perpendicularly engage the board. This is accomplished by providing a board pulling device comprising movable and stationary frames between which an elastic body is interposed. In the statement of the rejection on page 4 of the Answer, the examiner has taken the position that with regard to the recitation of the properties of the elastic body

the claims, as amended, recite the limitations, "compression stiffness", and, "tensile stiffness" (independent claims 1, 5, 9, 13, dependent claims 3, 7, 11, 15) which are not disclosed in the Specification as originally filed,

which causes the claims not to be in compliance with 35 U.S.C. § 112, first paragraph.

The examiner goes on to explain that the disputed terms are not supported "expressly, implicitly, or inherently" in the specification, and therefore one of ordinary skill in the art is not instructed as to how to make and use the invention. We find ourselves in agreement with the appellant that this rejection is not well taken, and we will not sustain it. Our reasoning follows.

The examiner is correct in asserting that the terms "compression stiffness" and "tensile stiffness" are not present in the specification. However, there is no requirement that the language in claims be recited verbatim in the specification (see MPEP

§ 2163(I)(B)), and it is our view that one of ordinary skill in the art would have understood the meaning of these terms from the description of the invention found in the specification. From the explanation beginning on page 9 it is clear that, with respect to the embodiment shown in Figures 2-4, spring 12 must be so designed as not to compress when the board that is pulled by the device has been uncoupled from the connectors, but to compress if the board that is pulled remains coupled to the connectors, thus providing an indication of the existence of the coupled condition. With regard to the embodiment shown in Figure 7, it is the tensile strength that is oriented to achieve the same results. In describing these phenomena, the terms used in the specification are “force” and “stiffness” (see, for example, page 9, line 22 et seq.), and we note here that the common applicable definition of “force” is “strength or energy exerted or brought to bear” and, with regard to mechanisms, “stiffness” is “impeded in movement.”²

From our perspective, one of ordinary skill in the art would have understood from the specification that the “compression stiffness” and “tensile stiffness” recited in the claims describes the level of force that must be applied to the elastic body to overcome its design strength in compression or tension, that is, its impediment or resistance to movement. This being the case, the disputed phrases are supported by the disclosure as originally filed, and the claims comply with the first paragraph of Section 112.

²See, for example, Webster’s New Collegiate Dictionary, 1973, pages 449 and 1142.

CONCLUSION

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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