The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ULETT S. BLUE

Appeal No. 2004-1250
Application No. 09/760,400

ON BRIEF

Before KIMLIN, KRATZ and TIMM, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4 and 6, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a portable vibratory device. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. A portable, vibrating relaxation device for an infant or child, specifically configured to accommodate use in a crib, bassinet, playpen, stroller, car seat or other surface, wherein said portable, vibrating relaxation device comprises:
>
> a main housing appropriately sized to accommodate an infant or child of pre-school age;
>
> a vibration genertor retained within said main housing and attached to an internal sidewall of said main housing;
>
> a removable cover fabricated of a washable, textile material forming a rectangular void for receiving said main housing;
>
> an integrated circuit timer for regulating the control of said vibration generator;
>
> attachment means for securing said portable, vibrating relaxation device to said crib, bassinet, playpen, stroller, car seat or other surface.

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

Komatsu	5,076,260	Dec. 31, 1991
Chung	6,077,238	Jun. 20, 2000 (filed Feb. 29, 1996)

Claims 1-3 and 6 stand rejected under 35 U.S.C. § 102 as being anticipated by Chung. Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Chung in view of Komatsu.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellant and the examiner concerning the issues before us on this appeal.

OPINION

Having carefully considered each of appellant's arguments set forth in the brief and reply brief, appellant has not persuaded us of reversible error on the part of the examiner. Accordingly, we will affirm the examiner's rejections for substantially the reasons set forth by the examiner in the answer. We add the following for emphasis.

§ 102 Rejection

Appellant maintains that "[e]ach claim forms a separate group of claims [such] that each [claim] stand[s] or fall[s] independent of the others" (brief, page 8). However, appellant's brief does not include separate arguments for the patentability of each appealed claim subject to this rejection in compliance with 37 CFR § 1.192(c)(7) and (c)(8) (2000). See In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. 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”). Accordingly, appealed claims 1-3 and 6 stand or fall together and we select independent claim 1 as the representative claim on which we shall decide this appeal with respect to this ground of rejection.

Under 35 U.S.C. § 102, anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Other than appellant’s arguments pertaining to the use of the claimed device with infants and small children and sizing of the claimed device to accommodate same (brief, page 9), appellant does not specifically dispute the examiner’s factual determinations that Chung discloses a portable vibratory structure corresponding to the claim 1 structure including: (1) a housing (Figure 2 and column 3, lines 24 and 25) corresponding to the claimed main housing; (2) a vibratory generator (23, Figure 2)) attached to an internal wall (32, Figure 2) of the housing corresponding to the claimed vibration generator; (3) a removable cover (element 20, Figures 1 and 2 and column 3, lines 17-21) fabricated to correspond with the claimed cover; (4) an integrated circuit timer (308, Figure 3) corresponding to the claimed circuit timer;

and (5) an attachment means (straps depicted in Figure 1 and described at column 3, lines 5-8) for securing the portable vibratory device to a seat or other surfaces that corresponds to the structure of the like attachment means as recited in representative claim 1. See pages 3 and 4 of the answer.

We are not persuaded by the arguments advanced by appellant in the briefs before us. We note that representative claim 1 is drawn to a "portable, vibrating relaxation device for an infant or child" that is "specifically configured to accommodate use in a crib, bassinet, playpen, stroller, car seat or other surface" (underlining supplied). Chung clearly describes a vibratory massaging apparatus in the form of a covered cushion that is configured for use on a automobile seat or other surface. See column 2, lines 53-58 of Chung. Whether or not a child of preschool age or an infant is positioned so as to enjoy the cushion of Chung, which clearly is constructed to accommodate a person, including such an infant or child, is irrelevant since the subject matter of representative claim 1 is drawn to the device not a particular use thereof. See In re Self, 671 F.2d 1344, 1350-1351, 213 USPQ 1, 7 (CCPA 1982) (when the claim does not recite allegedly distinguishable features, "appellant[s] cannot rely on them to establish patentability.").

While claim 1 provides that the housing of the vibratory generator is sized to 'accommodate' a child of preschool age or an infant, appellant has not fairly explained how that allegedly "functional" size limitation of the generator housing serves to distinguish the claimed generator housing over the generator housing of Chung. In this regard, the housing of the claimed invention and the prior art are each constructed for holding the vibration generator not a child.[1] For purposes of this appeal, the claimed 'accommodation' limitation is construed to relate to an intended use of the device with a child or infant and does not serve to restrict the size of the claimed vibration generator housing to any particular size that differentiates over the disclosure of Chung.

In a case such as this where the critical limitation that is argued as establishing novelty for the claimed subject matter is recited, at best, as a functional characteristic that reasonably appears to be a characteristic of the prior art structure insofar as broadly called for in the representative appealed claim based on the correspondence in structure between the representative

[1] In the event of further prosecution of this subject matter before the examiner, the examiner should determine whether or not the claims are in compliance with the first and second paragraphs of 35 U.S.C. § 112 given the functional size limitation associated with the main housing that was added by amendment.

claim and the applied prior art, it is incumbent upon appellant to prove that the applied prior art does not in fact possess the characteristics relied on. See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1658 (Fed. Cir. 1990); In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. See Best, 562 F.2d at 1255, 195 USPQ at 434. Here, appellant has not satisfied this burden.

It follows that, on this record, we shall sustain the examiner's § 102 rejection.

§ 103(a) Rejection

Concerning appealed claim 4, the examiner relies on the teachings of Komatsu in addition to Chung to establish the obviousness of the claimed subject matter. In this regard, the examiner (answer, page 5) has reasonably determined that it would have been prima facie obvious to one of ordinary skill in the art to arrive at the claimed subject matter with a reasonable expectation of success in so doing by employing a vibratory generator including a coil wrapped magnet (armature) and plate arrangement as disclosed in Komatsu as a vibratory generator in Chung for the purpose of providing vibrations in the device of

Chung for their beneficial effects in relaxing the mind and body as taught by Komatsu (column 2, lines 3-8). Concerning this matter, Chung (column 2, lines 66 and 67) teaches that other vibrators may be used in the disclosed seat cushion device.

Appellant's arguments with respect to the patentability of claim 4 based on the features of claim 1 are not persuasive for the reasons set forth above. Moreover, appellant's discussion concerning alleged differences over the Hofmeister reference are not relevant since the examiner's rejection is over the combined teachings of Chung and Komatsu, not Hofmeister. As for appellant's viewpoint that impermissible hindsight may be involved in the examiner's proposed modification of Chung based on the teachings of Komatsu, we note that appellant does not specifically address much less persuasively refute the examiner's reasons for the proposed modification based on asserted benefits described in Komatsu. On this record, we will sustain the examiner's § 103(a) rejection.

CONCLUSION

The decision of the examiner is affirmed.

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

AFFIRMED

EDWARD C. KIMLIN Administrative Patent Judge	)	
PETER F. KRATZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CATHERINE TIMM Administrative Patent Judge	)	

PFK/sld

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