

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 EDWARD M. PRIBONIC
and
MARC T. THOMPSON

Appeal No. 2004-2291
Application No. 10/318,506

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 26, which are all of the claims pending in this application.¹

We AFFIRM-IN-PART.

¹ Claim 25 was amended subsequent to the final rejection.

BACKGROUND

The appellants' invention is generally related to permanent magnet linear brakes and is more particularly directed to eddy brake systems for movable cars, for example, rail supported cars, go-carts, elevator cars, conveyor cars, and roller coaster cars, among others (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Mutaguchi et al. (Mutaguchi)	5,778,797	July 14, 1998
Hazelton et al. (Hazelton)	6,104,108	Aug. 15, 2000

Claims 21 to 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mutaguchi.

Claims 1 to 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mutaguchi in view of Hazelton.

Claims 1 to 6, 11 to 21 and 23 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 7, 9 and 11 to 20 of U.S. Patent No. 6,523,650 B1.

Claims 21 to 24 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 to 5 of U.S. Patent No. 6,533,083 B1.²

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed April 14, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed February 18, 2004) and reply brief (filed May 17, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

² It is unclear to us why these two obviousness-type double patenting rejections have been denominated as provisional obviousness-type double patenting rejections.

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The obviousness-type double patenting rejections

The appellants have not specifically contested these rejections in the brief or reply brief. In the reply brief (p. 8), the appellants indicate that in view of the provisional nature of these rejections, the appellants have elected to delay filing of a terminal disclaimer to overcome these rejections until the prior art rejections of claims 1 to 26 is overturned by the Board. Accordingly, we summarily sustain both the rejection of claims 1 to 6, 11 to 21 and 23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 7, 9 and 11 to 20 of U.S. Patent No. 6,523,650 B1 and the rejection of claims 21 to 24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 to 5 of U.S. Patent No. 6,533,083 B1.

The anticipation rejection

We will not sustain the rejection of claims 21 to 26 under 35 U.S.C. § 102(b).

A claim is anticipated only if 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.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Independent claims 21 and 23 read as follows:

21. Eddy current braking apparatus for a rail mounted car, the apparatus comprising:

a car moveable along at least one rail; the rail being disposed in a curvilinear pattern about a vertical reference;
magnet means, disposed on the car, for providing a magnetic flux, said magnet means consisting of a single array of magnets; and
conductive means disposed in a curvilinear pattern exterior to the car about the vertical reference, for engaging the magnetic flux and causing movement of the car along the rail to produce eddy currents in the conductive means resulting in a braking force between the magnet means and the conductive means.

23. Eddy current braking apparatus for a rail mounted car, the apparatus comprising:

a car moveable along at least one rail; the rail being disposed in a curvilinear pattern about a vertical reference;
magnet means, disposed in a curvilinear pattern exterior to the car about the vertical reference, for providing a magnetic flux, said magnet means consisting of a single array of permanent magnets; [and]

conductive means, disposed on the car, for engaging the magnetic flux and causing movement of the car along the rail to produce eddy currents in the conductive means resulting in a braking force between the magnet means and the conductive means.

The appellants argue (brief, p. 6; reply brief, pp. 3-4) that even if one would interpret the weight 5 of Mutaguchi as a "car" it is not moveable along a rail in a curvilinear pattern about a vertical reference. The examiner's response (answer, p. 10) to this argument is that Figure 16A of Mutaguchi shows element 5 movable on rail 3 in a curvilinear pattern with a radius R about a vertical reference, Y-axis.

Damping mass 5 of Mutaguchi is not disclosed as being moveable along a rail disposed in a curvilinear pattern about a vertical reference. Mutaguchi teaches (column 11, lines 39-67) that a pair of parallel guide rails 3 having pedestals 4 are placed on the base frame 2 fixed on a floor 1 of a carriage of a gondola, and that each guide rail 3 is arcuate and has a radius of curvature R centered at O as shown in Figure 16A. Figure 16A depicts a front view of a vibration damping device. Thus, the rails are disposed in a curvilinear pattern about a horizontal reference, not a vertical reference as required by claims 21 and 23. Accordingly, claims 21 and 23 are not anticipated by Mutaguchi.

For the reasons set forth above, claims 21 and 23 are not anticipated by Mutaguchi. Therefore, the decision of the examiner to reject claims 21 and 23, and claims 22 and 24 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

Independent claims 25 and 26 read as follows:

25. Eddy current braking apparatus for a rail mounted car, the apparatus comprising:
a car moveable along at least one rail;
magnet means, disposed on the car, for providing a magnetic flux, said magnet means consisting of a single array of permanent magnets; and
conductive means disposed in a curvilinear pattern exterior the car and on opposite sides of the car, for engaging the magnetic flux and causing movement of the car along the rail to produce eddy currents in the conductive means resulting in a braking force between the magnet means and the conductive means.

26. Eddy current braking apparatus for a rail mounted car, the apparatus comprising:
a car moveable along at least one rail;
magnet means, disposed in a curvilinear pattern exterior to the car and on opposite sides of the car, for providing a magnetic flux, said magnet means consisting of a single array of permanent magnets; [and]
conductive means, disposed on the car, for engaging the magnetic flux and causing movement of the car along the rail to produce eddy currents in the conductive means resulting in a braking force between the magnet means and the conductive means.

The appellants argue (brief, pp. 6-7; reply brief, pp. 4-5) that Mutaguchi does not disclose the utilization of magnet means or conductive means disposed on opposite sides of the car. The examiner's response (answer, p. 10) to this argument is that

Figure 17E of Mutaguchi shows the utilization of magnet means 8 and conductive means 7 disposed on opposite sides of the car 5.

Figures 17A-17H of Mutaguchi show the utilization of magnets 8 and conductive plates 7 disposed on the same side of the damping mass 5, not on opposite sides of the damping mass 5. Figures 17A-17H of Mutaguchi illustrate four sides of the damping mass 5 (an upper side (top), a lower side (bottom), a left side and a right side). Mutaguchi's magnets 8 and conductive plates 7 are all disposed on the lower side (bottom) of the damping mass 5. Thus, claims 25 and 26 are not anticipated by Mutaguchi.

For the reasons set forth above, claims 25 and 26 are not anticipated by Mutaguchi. Therefore, the decision of the examiner to reject claims 25 and 26 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

We will not sustain the rejection of claims 1 to 20 under 35 U.S.C. § 103.

In the obviousness rejection before us in this appeal, the examiner (answer, p. 6) ascertained that Mutaguchi lacked "a plurality of flux steering magnets disposed in gaps

between said spaced apart permanent magnets ... the magnetic flux of spaced apart permanent magnets." The examiner then concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Mutaguchi's apparatus with magnet means that consist of permanent magnets and flux steering magnets such as taught by Hazelton in order to enhance the magnetic flux advantageously as taught by Hazelton.

The appellants argue that the applied prior art does not suggest the subject matter of claims 1 to 20. We agree. Hazelton is directed to magnet arrays for linear motors. We have reviewed the disclosure of Hazelton but find nothing therein which would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified Mutaguchi's vibration damping apparatus so as to arrive at the subject matter of claims 1 to 20. In our view, the only suggestion for modifying Mutaguchi in the manner proposed by the examiner stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 20 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6, 11 to 21 and 23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 7, 9 and 11 to 20 of U.S. Patent No. 6,523,650 B1 is affirmed; the decision of the examiner to reject claims 21 to 24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 to 5 of U.S. Patent No. 6,533,083 B1 is affirmed; the decision of the examiner to reject claims 21 to 26 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 1 to 20 under 35 U.S.C. § 103 is reversed.

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

AFFIRMED-IN-PART

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 2004-2291
Application No. 10/318,506

Page 12

WALTER A. HACKLER
2372 S.E. BRISTOL, SUITE B
NEWPORT BEACH, CA 92660-0755

JVN/jg