

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAHANGIR S. RASTEGAR

Appeal No. 2006-0974
Application No. 10/244,336
Technology Center 3600

ON BRIEF

Before FRANKFORT, OWENS, and BAHR, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 56-63. Claims 1-55 and 64-114 have been canceled.

THE INVENTION

The appellant claims a structural beam having a cavity containing a non-compressible material which, the appellant states (specification, page 1, lines 5-10), provides rigidity and/or vibration dampening. Claim 56 is illustrative:

56. A structural beam comprising:
an upper surface;
a lower surface;

a first and second wall connecting the upper and lower surface, the volume between the walls defining a cavity; and

a non-compressible material disposed in the cavity; wherein

the walls are shaped such that a first compressive force tending to compress the beam by a first deflection causes an amplified second deflection of the walls into the non-compressible material, exerting a second compressive force against the non-compressible material, resulting in a resistance to the first deflection and the force tending to compress the beam.

THE REFERENCES

Fox	4,019,301	Apr. 26, 1977
Konsevich	4,566,231	Jan. 28, 1986
Rivin	5,533,309	Jul. 9, 1996

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 102(b) as follows: claims 56-63 over Rivin, claims 56, 57, 59 and 61-63 over Konsevich, and claims 56-59 over Fox.¹

OPINION

We enter a new rejection under 37 CFR § 41.50(b) of claims 56-63 under 35 U.S.C. § 112, second paragraph, affirm the rejection over Rivin, and reverse the rejections over Konsevich and Fox.

New rejection under 35 U.S.C. § 112, second paragraph

Claims 56-63 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

¹ In the examiner's answer rejections under 35 U.S.C. § 102(b) of claims 56-63 over US 5,338,783 to Olsen and claim 60 over Fox are withdrawn (pages 2-3).

Claim 56, which is the sole independent claim, requires "an amplified deflection of the walls". "The walls" are the first (104) and second (103) wall, each of which actually is a pair of opposing walls (figures 1B and 1C). The appellant's specification, however, only indicates that the first wall (104) has a concave shape that causes an amplified second deflection of that wall (page 12, line 15 - page 13, line 7). The second wall (103), which preferably is opposing plates (specification, page 11, line 23), is not indicated as deflecting.

Therefore, the meaning of "the walls" in "an amplified deflection of the walls" is unclear. Accordingly, claim 56 and its dependent claims 57-63 are rejected under 35 U.S.C. § 112, second paragraph.

In some instances, it may be impossible to determine whether or not claimed subject matter is anticipated by or would have been obvious over references because the claims are so indefinite that considerable speculation and assumptions would be required regarding the meaning of terms employed in the claims with respect to the scope of the claims. See *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). In other instances, however, it is possible to make a reasonable, conditional interpretation of claims adequate for the purpose of resolving patentability issues to avoid piecemeal appellate

review. In the interest of administrative and judicial economy, this course is appropriate wherever reasonably possible. See *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993); *Ex parte Ionescu*, 222 USPQ 537, 540 (Bd. App. 1984).

In the present case, we consider such a reasonable, conditional interpretation to be possible. This interpretation is that "the walls" in "an amplified deflection of the walls" refers only to the first wall in the appellant's claim 56 which, the appellant's specification indicates, is a pair of opposed concavely shaped walls (104) which undergo an amplified second deflection (page 12, lines 15-20).

Rejection over Riven

Riven discloses a structural beam comprising a tubular element (101) having the cross-sectional shape shown in figure 2. That figure can be visualized as comprising two walls, one above and one below an approximately 45° line drawn downwardly from left to right through the figure. Each of those walls is concave toward the other. A transformable material (102) such as water fills the tubular element (col. 3, lines 40-42).

The appellant argues that Riven's structural beam has only a single wall (brief, page 6). That argument is not persuasive

because each of the opposing surfaces of Riven's tubular element reasonably can be considered a wall.

The appellant argues that a compressive force will not cause an amplified second deflection of Riven's wall into Riven's transformable material (ice) as required by the appellant's claim 56, and that the ice can cause the walls to buckle outwardly because water expands when transformed from the liquid to the solid phase (brief, page 6). We are not convinced by that argument because the fact that Riven's walls 101 are concave like the appellant's walls 104 indicates that before Riven's water is frozen, Riven's structural beam, like that of the appellant, meets that claim requirement.

For the above reasons we are not convinced of reversible error in the examiner's rejection of claims 56-63 over Riven. Hence, we affirm that rejection.

Rejection over Konsevich

Konsevich discloses a printed wiring board vibration dampening stiffener beam having thin metal foil strips (32) bonded to each other and to a stiffening web (24) by a viscoelastic adhesive (34) (col. 3, line 22; col. 4, lines 1-4).

The examiner argues that "[b]y its very nature and shape Konsevich would 'react' such that a first compressive force, (along any of the sides), tending to compress the beam by a

first deflection causes an amplified second deflection of the walls into the non-compressible material, exerting a second compressive force against the non-compressible material, resulting in a resistance to the first deflection and the force tending to compress the beam" (answer, page 5). The appellant's second deflection is amplified due to the concave shape of the opposing walls 104 (specification, page 12, lines 15-20). The examiner has not established that Konsevich's planar walls which lack this concave shape nevertheless are capable of undergoing an amplified second deflection.

Consequently, the examiner has not carried the burden of establishing a *prima facie* case of anticipation of the appellant's claimed invention by Konsevich.

Rejection over Fox

Fox discloses a structural member having around it a protective encasement member made of a material such as fiberglass bonded to the structural member by a filler of inert material such as concrete or epoxy resin (col. 1, lines 10-13 and 59-66; col. 2, lines 22-31; col. 4, lines 1-6).

The examiner argues that "[b]y its very nature and shape Riven [sic, Fox] would 'react' such that a first compressive force, (along any of the sides), tending to compress the beam by a first deflection causes an amplified second deflection of the

walls into the non-compressible material, exerting a second compressive force against the non-compressible material, resulting in a resistance to the first deflection and the force tending to compress the beam." The examiner does not explain how Fox's planar encasement member walls, which lack the appellant's concave shape, are capable of undergoing an amplified second deflection.

The examiner, therefore, has not established a *prima facie* case of anticipation of the appellant's claimed invention by Fox.

DECISION

The rejection under 35 U.S.C. § 102(b) of claims 56-63 over Rivin is affirmed. The rejections under 35 U.S.C. § 102(b) of claims 56, 57, 59 and 61-63 over Konsevich and claims 56-59 over Fox are reversed. Under the provisions of 37 CFR § 41.50(b) a new ground of rejection of claims 56-63 has been entered.

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69

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Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . .

Should the appellant elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application,

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abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

AFFIRMED, 37 CFR § 41.50(b)

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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) BOARD OF PATENT
TERRY J. OWENS) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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JENNIFER D. BAHR)
Administrative Patent Judge)

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SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

TJO/jrg