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for publication and is not binding precedent of the Board.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 MARSHALL L. WEINGARDEN

Appeal No. 2006-1387
Application No. 10/715,180

HEARD: June 6, 2006

Before FRANKFORT, CRAWFORD, and BAHR, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 21, which are all of the claims pending in this application.

The appellant's invention relates to a hub post for mounting an information-bearing disk to a substrate (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The Prior Art

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

Tillet et al. (Tillet)	5,332,089	Jul. 26, 1994
Joyce et al.	5,417,324	May. 23, 1995
Condorodis	5,735,396	Apr. 7, 1998
Attar et al. (Attar)	5,975,291	Nov. 2, 1999
Cerda-Vilaplana et al. (Cerda-Vilaplana)	6,276,524	Aug. 21, 2001
Fliegel	6,574,188	Jun. 3, 2003

The Rejections

Claims 1 to 3, 5, 7 to 10, 13, 14, 16, 18 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tillett.

Claims 1 to 3, 5, 7 to 10, 13, 14, 16, 18 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Fliegel.

Claims 1 to 5, 7 to 10, 13 to 16, 18 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tillet in view of Attar.

Claims 1 to 5, 7 to 10, 13 to 16, 18 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fliegel in view of Attar.

Claims 6 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tillet and Attar in view of Joyce.

Claims 6 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fliegel and Attar in view of Joyce.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tillett and Attar in view of Condorodis.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fliegel and Attar in view of Condorodis.

Claims 19 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tillet and Attar and in view of Cerda-Vilaplana.

Claims 19 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fliegel and Attar in view of Cerda-Vilaplana.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed November 15, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed September 27, 2005) and reply brief (filed January 12, 2006) 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, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Rejections based on Tillet

The examiner has rejected claims 1 to 3, 7 to 10, 13, 14, 16, 18 and 20 under 35 U.S.C. § 102(b) as being anticipated by Tillett. We initially note that to support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The examiner's rationale in support of this rejection can be found on pages 4 , 5 and 7 of the answer.

The appellant argues that Tillett does not describe the invention of claim 1 in that Tillett does not describe:

> the base and the post being integral and at least the post being substantially solid and constructed of a stiffly resilient synthetic polymeric material having a durometer providing a balance of resilient characteristics and renitent characteristics for establishing the aforesaid selective gripping and selective release and for resisting deleterious compression and crushing while retaining the disk upon the post.

Specifically, appellant argues that Tillet describes a hub post comprised of a material that is designed specifically for ready compression and easy crushing and is not stiffly resilient.

Tillet describes a hub post comprised of a material which is resiliently compressible and formed of a cross-linked closed cell polyolefin foam having an easily but resiliently compressible nature (col. 4, lines 14 to 17). The hub post is configured

and dimensioned to extend snugly through the central aperture of a disc and retains the disc on the hub post until the disc is forcibly removed therefrom (col. 3, lines 55 to 59).

In our view the hub post material described in Tillett would inherently have some balance of resilient and renitent characteristics. As Tillet describes that the disc is held on the hub post until forcibly removed, presumably by hand, the balance of resilient and renitent characteristics allows selective gripping of the disc. (col. 3, line 58 to 59). In addition, this inherent balance of renitent and resilient characteristics resists compression and crushing at least to some extent. We note that claim 1 does not recite to what extent the hub post material resists compression and crushing. While Tillet does describe the material as easily compressible, Tillet nonetheless describes a material which is stiff enough to grip and thereby hold the disc thereon and prevent accidental displacement of the disc from the hub post (col. 4, lines 9 to 13).

Although the appellant may be correct that Tillet does not disclose a durometer for the hub post material, the material of the Tilllet hub post would inherently have a durometer and as the hub post provides the required balance of renitent and resilient characteristics, the hub post of Tillet satisfies the requirements of claim 1.

In view of the foregoing, we will sustain the examiner's rejection of claim 1. We will also sustain this rejection as it is directed to claims 2, 3, 7 to 10, 13, 14, 18 and 20 as these claims stand or fall with claim 1 (brief at page 14).

Claims 5 and 16 recite that the material which forms the hub post has a durometer reading of about 55 to 65 Shore A.

We will not sustain this rejection as we agree with the appellant that Tillett does not describe a hub post with a durometer reading of about 55 to 65 Shore A. The examiner's reasoning that the durometer reading "should be inherently met" does not satisfy the requirements of 35 U.S.C. § 102 which requires that the examiner establish that the durometer reading is necessarily met. See Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (F.3d. Cir. 1991) .

We turn next to the examiner's rejection of claims 1 to 5, 7 to 10, 13 to 16, 18 and 20 under 35 U.S.C. § 103 as being unpatentable over Tillett in view of Attar. The examiner relies on Attar for teaching a hub post comprised of urethane.

We will sustain this rejection as it is directed to claims 1 to 3, 7 to 10, 13 to 14, 18 and 20 as we have determined above that Tillet alone describes the elements of these claims as these claims do not require that the hub post is comprised of urethane. We note that anticipation is the epitome of obviousness. Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

In regard to claims 4, 15 which recites that the hub post is comprised of urethane, appellant argues that Attar does not describe a hub post comprised of urethane but rather describes a hub post having teeth, bumps, ribs, ridges and indentations comprised of polyurethane and that the polyurethane used is soft, very flexible and resilient.

We will not sustain the rejection as it is directed to claims 4 and 15 because although Attar does describe an embodiment in which the hub post is comprised of polyurethane, it is the teeth that secure and grip the disc rather than the substantially continuous unbroken gripping surface of the hub post (col. 3, line 43), as required by claim 1 from which claim 4 depends. In the Attar embodiment without the teeth, the hub post is comprised of polypropylene (col. 4, lines 1 to 5).

We will also not sustain this rejection as it is directed to claims 5 and 16 because Attar does not cure the deficiencies of Tillett noted above for the subject matter of these claims.

We turn next to the examiner's rejection of claims 6 and 17 under 35 U.S.C. § 103 as being unpatentable over Tillett, Attar and Joyce. Claims 6 and 17 recite that the base and hub post are comprised of substantially transparent material. The examiner relies on Joyce for teaching a transparent hub post.

Joyce describes a compact disc tray having top, bottom and hub post comprised of clear material to enhance the cosmetic appearance and provide a more pleasing clear package (col. 1, lines 40 to 42).

We agree with the examiner that Joyce provides a teaching to form the hub post of clear material and a motivation for forming the hub post from clear material, i.e. to obtain a better appearance. Therefore, we will sustain this rejection.

While the appellant is correct that the material utilized to form the hub post in Joyce is disclosed as brittle, we agree withe the examiner that:

> While the Joyce et al. material is disclosed as brittle, it is not the material being employed, but the concept of using transparent polymeric materials to comprise a hub post that has been employed by the examiner in the rejection, and transparent polyurethane would work equally as well as any other transparent material in the manner suggested by Joyce et al.. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) [answer at pages 9-10].

In view of the foregoing, this rejection is sustained.

We turn next to the examiner's rejection of claims 11 and 12 under 35 U.S.C. § 103 as being unpatentable over Tillett, Attar and Cordorodis. Claims 11 and 12 require that the post is canted at a small angle to the central longitudinal axis. The examiner relies on Cordorodis for disclosing a post which is canted at a small angle to the central longitudinal axis.

We will not sustain this rejection because we agree with the appellant that while the post in Cordorodis has a surface which is slanted or canted, Cordorodis does not disclose a post that is itself canted relative to the longitudinal axis.

We turn next to the examiner's rejection of claims 19 and 21 under 35 U.S.C. § 103 as being unpatentable over Tillett, Attar and Cerda-Vilaplana. Claims 19 and 21 require that the hub post is polyhedral. The examiner relies on Cerda-Vilaplana for teaching a polyhedral hub post.

We will not sustain this rejection because while Cerda-Vilaplana discloses a polyhedral hub post, we agree with the appellant that Cerda-Vilaplana does not disclose that this polyhedral post grips the disk upon reception of the hub post within the mounting hole, as required by claim 1 from which claims 19 and 21 depend. Rather, it is the stems 3 which grip the disk (col. 3, lines 24 to 27).

Rejections based of Fliegel

We turn next to the rejections based on the Fliegel reference. The examiner has rejected claims 1 to 3, 5, 7 to 10, 13, 14, 16, 18 and 20 under 35 U.S.C. § 102(e). We will not sustain this rejection because in our view, the disclosure in Fliegel that the material that forms the hub post is a moss rubber which is a yielding material does not meet the requirement of claim 1, from which all the other claims depend, of a "stiffly resilient" material. It is our view that although the material of Fleigel has an inherent durometer and a balance of resilient and renitent material of some sort, such is not a balance that permits selective gripping, resists crushing and compression and retains the disk on the post. Fleigel discloses that the hub post is a yielding material, is soft, and that the disk is held in place because the diameter of the hub post is slightly larger than the diameter of the disc not by the resiliency and renintence of the hub post.

We will likewise not sustain the remaining rejections which rely on Fliegel because the disclosures of Attar, Joyce, Cordorodis an of Cerda-Vilaplana do not cure the deficiency noted above for the Fliegel reference.

In summary:

The examiner's rejection of claims 1 to 3, 7 to 10, 13, 14, 18 and 20 stand under 35 U.S.C.§ 102(b) as being anticipated by Tillett is sustained.

The examiner's rejection of claims 5 and 16 under 35 U.S.C. § 102(b) as being anticipated by Tillett is not sustained.

The examiner's rejection of claims 1 to 3, 5, 7 to 10, 13, 14, 16, 18 and 20 under 35 U.S.C. § 102(e) as being anticipated by Fliegel is not sustained.

The examiner's rejection of claims 1 to 3, 7 to 10, 13 to 14, 18 and 20 under 35 U.S.C. § 103 as being unpatentable over Tillet in view of Attar is sustained.

The examiner's rejection of claims 4, 5, 15 and 16 under 35 U.S.C. § 103 as being unpatentable over Tillet in view of Attar is not sustained.

The examiner's rejection of claims 1 to 5, 7 to 10, 13 to 16, 18 and 20 under 35 U.S.C. § 103 as being unpatentable over Fliegel in view of Attar is not sustained.

The examiner's rejection of claims 6 and 17 under 35 U.S.C. § 103 as being unpatentable over Tillet and Attar in view of Joyce is sustained.

The examiner's rejection of claims 6 and 17 under 35 U.S.C. § 103 as being unpatentable over Fliegel and Attar in view of Joyce is not sustained.

The examiner's rejection of claims 11 and 12 under 35 U.S.C. § 103 as being unpatentable over Tillett and Attar in view of Condorodis is not sustained.

The examiner's rejection of claims 11 and 12 under 35 U.S.C. § 103 as being unpatentable over Fliegel and Attar in view of Condorodis is not sustained.

The examiner's rejection of claims 19 and 21 under 35 U.S.C. § 103 as being unpatentable over Tillet and Attar in view of Cerda-Vilaplana is not sustained.

The examiner's rejection of claims 19 and 21 under 35 U.S.C. § 103 as being unpatentable over Fliegel and Attar in view of Cerda-Vilaplana is not sustained.

No time period for taking any subsequent action in connection with this appeal maybe extended under 37 CFR § 1.136(a) (1) (iv).

AFFIRMED-IN-PART

CHARLES, E. FRANKFORT Administrative Patent Judge	)	
MURRIEL, E. CRAWFORD Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER, D. BAHR Administrative Patent Judge	)	

MEC/lg

Arthur Jacob
25 East Salem Street
P.O. Box 686
Hackensack, NJ 07601

Comment [jvn1]: Type address

APPEAL NO. 2006-1387
APPLICATION NO. 10/715,180

APJ CRAWFORD

APJ FRANKFORT

APJ

DECISION:

PREPARED: Aug 15, 2006

OB/HD

PALM:

ACTS 2:

DISK (FOIA):

REPORT:

BOOK:

GAU:

44C1:

IFW in E. Cook's Incoming: