

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 37

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte BENJAMIN JOFFE

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Appeal No. 1999-2328  
Application No. 08/485,492

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HEARD: April 23, 2002

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Before ABRAMS, FRANKFORT, 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, 2, 6-8 and 11. Claims 3-5, 9, 10 and 12-21 have been withdrawn from consideration as being directed to a non-elected species.

WE REVERSE THE STANDING REJECTIONS UNDER 35 U.S.C. § 112 AND REMAND THE APPLICATION TO THE EXAMINER FOR CONSIDERATION OF MATTERS CONCERNING THE REJECTIONS UNDER 35 U.S.C. § 102.

BACKGROUND

The appellant's invention relates to a moving table system. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

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

Pryor	5,380,095	Jan. 10, 1995
Joffe <u>et al.</u> (Joffe)	5,407,519	Apr. 18, 1995

The following are the rejections as set forth on pages 3 and 4 of the final rejection (Paper No. 19):

Claims 1, 2, 6-8 and 11 are 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(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 2, 6-8 and 11 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 6-8 and 11, to the extent understood, are rejected under 35 U.S.C. § 102(b) and/or (e) as being anticipated by Pryor or Joffe et al.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer

(Paper No. 29) and the final rejection (Paper No. 19) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 28) and Reply Brief (Paper No. 30) 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.

#### Claim 1

A moving table system comprising:

relatively movable table members, at least one of said members comprising a magnet;

rolling elements held firmly, by magnetic force developed by the magnet, between the members for fully rolling motion along both members;

wherein at least some of the rolling elements roll along the magnet.

### The Rejections Under Section 112

The examiner has rejected claims 1, 2, 6-8 and 11 under Section 112 on the following bases:

(1) Under the first paragraph as not being described in such a manner as to reasonably convey that the applicant was in possession of the claimed invention at the time the application was filed.

(2) Under the first paragraph as not being described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same.

(3) Under the second paragraph as failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

As we understand the examiner's position, all three of these rejections are based upon the premises that the original disclosure was inadequate and the amendment filed by the appellant in an effort to overcome the rejections is "virtually all new matter" (Paper No. 19, pages 2-5).

We first point out that all of the claims under appeal were original claims, and therefore constitute part of the original disclosure (claims 7 and 11 were amended to correct minor errors). Our evaluation of the original disclosure leads us to conclude that it provides sufficient description regarding the structure and operation of the invention as recited in claims 1, 2, 6-8 and 11 to enable one of ordinary skill in the art to make and use the invention.

Using the language of claim 1 as a guide, we are of the view that it is clear from Figures 1-4 as originally filed, and from the explanations of the prior art and the present invention set out in the specification as originally filed, that the application discloses a moving table system comprising several relatively movable table elements. At least one

of the table elements is recognizable as a magnet in view of the stippling and dashed lines of force present in the drawings,<sup>1</sup> as well as the description of Figure 1 in the specification as showing a table “incorporating balls or other rotating elements that operate directly on a magnet surface.” This being the case, the artisan would have understood that the drawings depict rolling elements held in place by magnetic force developed by the magnets. By virtue of the absence of grooves or the like in the table surfaces, the artisan further would have understood that the balls are capable of fully rolling motion along both table members. Figures 2 and 4 show that at least some of the rolling elements roll along the magnets. These conclusions are reinforced by the description of this general type of apparatus presented in the appellant’s U.S. Patent No. 5,407,519, which was cited on page 5 of the present specification, with particular reference to Figures 7-11 thereof. In the final analysis, the structure and operation of apparatus of this general type would have been within the knowledge that should be accorded to one of ordinary skill in the art at the time the appellant’s present application was filed.

Claim 6 recites that a first one of the members defines a pair of interfaces, each being shaped and oriented for constraining relative movement between the members with respect to at least one direction of motion, and a second member shaped and

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<sup>1</sup>Like the appellant, we note that the magnetic elements (17) in all of the other embodiments of the appellant’s invention are depicted in this same manner.

disposed to fit at the interfaces. From our perspective, one of ordinary skill in the art would have understood that this refers to the L-shaped tables shown in Figures 2 and 4, which in their left-hand portions (as shown in the drawings) present horizontal and vertical interfaces constituting a right angled corner with rolling members interposed between the horizontal and vertical surfaces and held there by the magnetic forces.

The subject matter in dependent claims 2, 7 and 8 also can be discerned from the drawings, as can that of independent claim 11, with regard to which we note that the range of distance occupied by the balls was set forth in the claim as originally filed.

Further regarding the issue of the ability of one of ordinary skill in the art to understand the structure and operation of the present invention from the original Figures 1-4, we point out that the appellant's prior U.S. Patent No. 5,524,499, of which the present application is a continuation-in-part, discloses in Figures 3a, 3b and 4, as the prior art, systems in which rolling elements are held firmly between surfaces by magnetic force, and in Figure 9 an arrangement in which the members have two interfaces at right angles to one another, which devices are explained in columns 5 and 7-8, respectively. We also again note that like elements in the other embodiments of the appellant's invention are shown in the same general manner as the elements of Figures 1-4.

On the basis of the above reasoning, we find that, contrary to the examiner's conclusion, the original disclosure supports the position that the subject matter recited

in the claims on appeal was in the possession of the inventor at the time the application was filed, that it is sufficient to have enabled one of ordinary skill in the art to make and use the invention, and that the claims, when considered in the light of the original disclosure, do particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

We therefore will not sustain any of the rejections under 35 U.S.C. § 112.

#### The Rejections Under Section 102

Claims 1, 2, 6-8 and 11 stand rejected as being anticipated by Pryor or Joffe. What immediately strikes us about these references is that the effective filing date of each may be subsequent to the effective filing date of the claims on appeal. Thus, on its face, neither Pryor nor Joffe may qualify as a prior art reference under 35 U.S.C. § 102(b) or (e), and both rejections under Section 102 may be fatally defective on this basis. Of course, since the application before us is a continuation-in-part of a preceding application, which in turn is a continuation of another, the possibility exists that the claimed subject matter is not disclosed in both of the applications from which parentage is claimed, and therefore the effective filing dates of the two references could antedate that which can be accorded to one or more of the claims before us on appeal. The examiner has not, however, undertaken such an analysis. In this regard, Pryor and Joffe were mentioned on page 5 of the appellant's specification as being "of interest," with Pryor being discussed on page 8 and the appellant asserting that it was not prior

art with respect to at least some of the claimed subject matter. As for Joffe, the appellant states on page 18 of the Brief that none of the other inventors contributed to the magnetic devices disclosed in that patent, but evidence of such has not been submitted in accordance with Section 715.01(a) of the Manual of Patent Examining Procedure.

At the oral hearing, the Board questioned appellant's counsel regarding what of the claimed subject matter found support in the applied Joffe reference, and while counsel replied he was not prepared to answer at that time, he later stated in writing that "only claims 1 and 2 read on devices as shown in the '519 patent [the Joffe reference]," and that "Fig. 26 of that patent has a right-angled interface pair, but no member fits into an interface corner as in claim 6" (Paper No. 36, page 2). The appellant also pointed out, in response to the Board's questioning, that he had requested, without success, that the examiner assist him in perfecting his assertion that the Joffe patent was not a proper reference (Paper No. 36, pages 1 and 2).

Finally, the appellant complained on page 18 of the Brief that "[v]irtually no substantive analysis has appeared in the Official Actions in support of the [Section 102] rejections." We agree. The fact is that the entirety of the examiner's statement of the two Section 102 rejections is "[s]ee, for example, Pryor Figure 1a and col. 4, lines 53-55" (Paper No. 19, page 4). Not even a mention is made of Joffe. This clearly does not

meet the standard set forth in Section 1208(A)(10)(c) of the Manual of Patent Examining Procedure, which states:

For each rejection under 35 U.S.C. § 102, the examiner's answer, or a single prior action, shall explain why the rejected claims are anticipated and not patentable under 35 U.S.C. § 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.

Especially under the circumstances presented in this case, the fact that the examiner has left the appellant and the Board to their own devices to determine how the claimed subject matter reads on the references is unacceptable.

The result of the shortcomings described above is that the examiner and the appellant have not placed on the record sufficient information to allow the Board to determine whether Pryor and Joffe are valid references and whether or not the subject matter recited in the claims on appeal is anticipated by Pryor and/or Joffe. This being the case, we hold our decision on these rejections in abeyance pending action by the examiner in accordance with the remand of this application.

#### REMAND TO THE EXAMINER

This application is remanded to the examiner for action to alleviate the shortcomings in the record discussed above with regard to the rejection under 35 U.S.C. § 102. Specifically, the examiner is requested to do the following:

(1) Determine whether or not the subject matter, as a whole, recited in each of the claims on appeal is entitled to the filing date of Joffe U.S. Patent No. 5,331,861, and provide reasons in support of each determination.

(2) If it is determined that Joffe and/or Pryor are proper references under Section 102 with regard to subject matter recited in the claims on appeal, set forth rejection(s) of the claims with particularity, that is, point out where each of the specific limitations recited in the rejected claims is found in the prior art relied upon.

(3) Provide the appellant with such information and assistance as is necessary for him to perfect his claim regarding the inventorship of material disclosed in the Joffe reference in accordance with Section 715.01(a) of the Manual of Patent Examining Procedure..

(4) Take such additional action as may be deemed appropriate.

#### SUMMARY

None of the three rejections under 35 U.S.C. § 112 are sustained.

The decision on the rejections under 35 U.S.C. § 102 is held in abeyance pending the examiner's response to the remand of this application.

The application is remanded to the examiner for action in accordance with the instructions set forth above.

This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01 (Eighth Edition, Aug. 2001), item (D). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REVERSED AND REMANDED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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