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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOMENIC P. MARZANO and MICHAEL GUSTASON

Appeal 2011-000619
Application 11/058,880
Technology Center 3600

Before MICHAEL C. ASTORINO, LYNNE H. BROWNE and SCOTT A.
DANIELS, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Domenic P. Marzano and Michael Gustason, (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 1, 3-7, 12-18 and 21-25. Claims 2, 8-11, 19 and 20 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

THE INVENTION

Claim 1, reproduced below with added emphasis, is illustrative of the subject matter on appeal.

1. A selectively actuated eddy current braking system to apply a selected braking force to a magnetically reactive member comprising:

a) first and second modules located along substantially parallel first and second longitudinal axes and separated by a space sufficient to permit passage of the magnetically reactive member therethrough, at least the first module being linearly displaceable relative to the second module along the longitudinal axes and each module comprising an array of permanent magnets arranged in alternating polarity, the array of permanent magnets of the first module substantially in opposite polarity juxtaposition with the array of permanent magnets of the second module;

b) a drive operably connected to at least the first module to effect a displacement of the first module along the longitudinal axes and relative to the second module thereby providing a selectable braking force on the magnetically reactive member having a minimum when the modules are moved substantially out of opposite polarity juxtaposition and the minimum braking force being substantially zero; and

c) a first stop capable of fixing the first module in substantially opposite polarity juxtaposition with the second module should the drive fail.

THE REJECTIONS

1. Claims 1, 3-7, 12-18 and 21-25 stand rejected under 35 U.S.C. § 112, 1st paragraph, as failing to comply with the written description requirement.
2. Claims 1, 21, 23 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Pribonic (US 6,659,237 B1, iss. Dec. 9, 2003) and Rosner (US 2004/0262103 A1, pub. Dec. 30, 2004).
3. Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Pribonic, Rosner and Smith (US 3,794,425, iss. Feb. 26, 1974).
4. Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Pribonic, Rosner and Tsuboi (US 6,326,708 B1, iss. Dec. 4, 2001).
5. Claims 7, 12, 13, 18, 22 and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Pribonic, Rosner and Frank (US 6,253,887 B1, iss. Jul. 3, 2001).
6. Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Pribonic, Rosner, Frank and Smith.
7. Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Pribonic, Rosner, Frank and Tsuboi.

OPINION

Written Description

Claims 1 and 12 each recite in relevant part “a first stop capable of fixing the first module in substantially opposite polarity juxtaposition with the second module should the drive fail.” Claim 21 similarly recites “providing a stop capable of fixing the first module in substantially opposite polarity juxtaposition with the second module should the drive fail.”

The Examiner contends that “[t]he originally filed disclosure fails to provide support for the limitation of the stop being capable of fixing the first module in substantially opposite polarity juxtaposition with the second module should the drive fail” Ans. 4.

Appellants argue “the Examiner seemingly fails to consider both the drawings and the inherent action of the magnetic braking system.” (App. Br. 9) stating, in support of this argument “[a]s shown in Figure 1, a first stop (32) fixes the modules in substantially opposite polarity juxtaposition” and “[o]ne skilled in the art would then appreciate that, absent the force, the modules would inherently align in substantially opposite polarity juxtaposition.” App. Br. 10; Reply Br. 4.

We agree that one of ordinary skill in the art would understand that if the drive fails, the modules would inherently align in substantially opposite polarity juxtaposition because of the tendency of magnets to align in this manner; however, Appellants’ argument that the stop 32 is capable of fixing the modules in this position is unconvincing. Figure 1 does not support Appellants’ contention. Figure 1 shows the first and second modules in substantially opposite polarity juxtaposition. In this configuration stop 32

does not engage the first module and thus, cannot be fairly understood to be capable of fixing the first module in substantially opposite polarity juxtaposition.

Appellants further argue “[t]he end points of the pathway are only limited by the length of the push rod 22, the length of the linear sliding bearing 14, or the placement of the cushion bump stops 30, 32.’ Paragraph 0020. The stops are affixed ‘so as to limit the motion of the system.’ Id.” App. Br. 12; Reply Br. 5. Concluding, “[t]he specification and drawings clearly show and describe the stops limiting module displacement. The modules can move only between the stops, and the first stop fixes the modules in substantially opposite juxtaposition.” App. Br. 12.

Appellants’ argument is unconvincing because it mischaracterizes the capabilities of stop 32 as they would be understood by one of ordinary skill in the art. As argued by Appellants *supra*, the Specification clearly states that “[t]he end points of the pathway are only limited by the length of the push rod **22**, the length of the linear slide bearing **14**, or the placement of the cushion bump stops **30, 32**.” Spec., para. 0020 (emphasis added). One of ordinary skill in the art would understand from this disclosure that the stops are capable of preventing the module from moving past them; however, this description would not convey to one of ordinary skill in the art that the stops are capable of fixing the module in any particular position. Rather, one of ordinary skill in the art would understand that while the stops prevent movement in one direction they do not prevent movement in the opposite direction and therefore cannot fairly be understood to be capable of fixing the module. Specifically, one of ordinary skill in the art would understand that the stop 32 prevents movement of the module in a direction opposite to

the arrows shown in Figure 5A, once the module is engaged with stop 32, while allowing movement in the direction of the arrows. Thus, stop 32 limits one end point of the pathway, but does not fix the module in any position. Further, as discussed *supra*, the drawings do not show a configuration wherein the stop 32 is engaged and the modules are fixed in substantially opposite polarity juxtaposition.

Appellants then argue that the Examiner “fails to meet the burden of proof” by failing to present evidence or reasons why one of ordinary skill in the art would not recognize in the disclosure a description of the invention defined by the claims. App. Br. 11. Appellants’ argument is unconvincing because the Examiner met the initial burden by specifically identifying the information missing from the Specification and not shown in the drawings and clearly articulating why one of ordinary skill in the art would not have recognized in the disclosure a description of the invention. Ans. 11-12.

For these reasons, we sustain the Examiner’s rejection of claims 1, 3-7, 12-18 and 21-25 under 35 U.S.C. § 112, 1st paragraph.

Obviousness

Claims 1, 3-7, 21-23 and 25

In the rejection, the Examiner finds “Pribonic is silent with regards to the direction of movement of the first module parallel to the member being linearly along the longitudinal axes.” Ans. 5. The Examiner “notes that the language . . . which teaches that the module can be moved in a direction parallel to the member would encompass parallel motion of the module with respect to the member linearly in a longitudinal direction . . .” *Id.*, (citing Pribonic col. 1, ll. 49-51). Then, the Examiner concludes that “[i]t would have been obvious . . . to have modified the motion of the module to have

been linearly displaced along the longitudinal axes . . . in order to achieve relative positioning of the modules to create an adjusted braking force condition.” Ans. 5-6.

Appellants respond that “[t]he Examiner argues the silence of Pribonic permits motion in any direction, but an inference drawn from silence is not sufficient to maintain an obviousness rejection.” Reply Br. 6.

Appellants’ argument is persuasive. The portion of the Specification cited by the Examiner is insufficient to support the Examiner’s reasoning that module motion in a direction parallel to the member necessarily encompasses module motion in a longitudinal direction with respect to a second module. The embodiment referred to in the citation provided by the Examiner is shown in Figures 9 and 10; and, further described in column 5, line 57 through column 6, line 8. Figures 9 and 10 only show one module (104). Accordingly, the position of the second module (106) with respect to the first module (104) cannot be determined from the figures. Similarly, in the portion of the Specification that describes Figures 9 and 10, only one of the modules (104) is described. Accordingly, the position of the first module with respect to the second module cannot be determined from the Specification either. Therefore, Pribonic cannot fairly be considered to teach “the first module being linearly displaceable relative to the second module along the longitudinal axes” as required by claim 1.

For this reason, we do not sustain the Examiner’s rejection of claim 1 and claim 23 which depend therefrom under 35 U.S.C. § 103(a). The Examiner’s rejection of claims 3 and 4 contains the same factual deficiency which is not cured by Smith and likewise is not sustained. The Examiner’s rejection of claims 5 and 6 contains the same factual deficiency which is not

cured by Tsuboi and likewise is not sustained. The Examiner's rejection of claim 7 contains the same factual deficiency which is not cured by Frank and likewise is not sustained.

Claim 21 requires "displacing at least the first module along the longitudinal axis in a displacement to alter the polarity juxtaposition relative to the second module" The Examiner's reasons for modifying Pribonic to meet this limitation of claim 21 similarly lack rational underpinning for the reasons discussed *supra*.

Accordingly, we do not sustain the Examiner's rejection of claim 21 and claim 25 which depends therefrom under 35 U.S.C. § 103(a). The Examiner's rejection of claim 22 contains the same factual deficiency which is not cured by Frank and likewise is not sustained.

Claims 12-18 and 24

Appellants contend "[l]ike claims 1 and 21, claim 12 describes a braking system comprising linearly displaceable modules . . ." (App. Br. 16) concluding "[f]or the reasons stated in the arguments *supra*, Applicant does not believe Pribonic and Rosner render obvious claim 12." (App. Br. 17). We agree as discussed *supra*. Frank does not cure this deficiency.

For these reasons, we do not sustain the Examiner's rejection of claim 12 and claims 13, 18 and 24 which depend therefrom under 35 U.S.C. § 103(a). The Examiner's rejection of claims 14 and 15 contain the same factual deficiency which is not cured by Smith and likewise is not sustained. The Examiner's rejection of claims 16 and 17 contain the same factual deficiency which is not cured by Tsuboi and likewise is not sustained.

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DECISION

We affirm the Examiner's rejection of claims 1, 3-7, 12-18 and 21-25 under 35 U.S.C. § 112, 1st paragraph, as failing to comply with the written description requirement.

We reverse the Examiner's rejections of claims 1, 3-7, 12-18 and 21-25 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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