

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 10-36 are pending in the present application, Claims 10-36 having been added, and Claims 1-9 having been canceled without prejudice or disclaimer. Support for the present amendment is believed to be self-evident from the originally filed specification. The specification is amended to provide a new Abstract. Applicants respectfully submit that no new matter is added.

In the outstanding Office Action, Claims 5-9 were objected to for being improper multiple dependent claims; and Claims 1-4 were rejected under 35 U.S.C. §103(a) as unpatentable over Delevoye (FR 2 876 180).

As an initial matter, it is noted that MPEP §706.02 II is relevant to rejections based on a foreign language document, which is relevant since Delevoye is in French.

This MPEP section makes it clear that if the Examiner is relying on a reference that is not in English, a translation of this document is to be obtained and supplied prior to implementing a final Action. This MPEP section states:

If the document is in a language other than English and the examiner seeks to rely on that document, a translation ***must*** be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.

Therefore, Applicants respectfully submit that ***the Office Action does not provide a prima facie rejection of the pending claims based on the foreign language cited reference.***

To the extent that any subsequent Action relies on Delevoye, a copy of the full translation must be supplied as required under MPEP §706.02 II. ***See also Ex Parte Gavin, 62 USPQ2d 1680, where the Board of Patent Appeals and Interferences placed the burden of obtaining a translation on the Examiner.***

Nevertheless, in order to expedite issuance of a patent in this case, Applicants explain why the newly presented claims patentably distinguishes over Delevoye.

The objection to Claims 5-9 and the rejection of Claims 1-4 are moot in view of the cancelation of these claims.

New Claim 10 patentably distinguishes over Delevoye. Claim 10 recites, *inter alia*, “**a plurality of vibrating cells**, each connected to and disposed between said at least two deformable linking beams, **said plurality of vibrating cells being distributed along the deformable linking beams and a length between two of the plurality of anchoring points being greater or equal to a length of a number of cells greater or equal to 1.**” Delevoye does not disclose or suggest at least this feature of Claim 10.

In Delevoye, anchoring beams 4 connect one cell directly to a pair of anchoring points 3. Delevoye does not disclose or suggest how an oscillating cell should be modified to link a plurality of cells together. Thus, there is no disclosure or suggestion in Delevoye of the claimed “**a plurality of vibrating cells**, each connected to and disposed between said at least two deformable linking beams, **said plurality of vibrating cells being distributed along the deformable linking beams and a length between two of the plurality of anchoring points being greater or equal to a length of a number of cells greater or equal to 1.**”

On page 3 of the Office Action, the Office states:

it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V Bemis Co.*

In making these statements, the Office does not apply the facts of *St. Regis Paper* to the present application, but instead applies a fact specific holding in this case as a *per se* rule. The Federal Circuit has emphasized that rejections that rely on *per se* rules while turning a blind eye to the fact specific inquiry required by 35 U.S.C. §103 rejections are improper, stating (emphasis in original):

The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention -- including all its limitations -- with the teachings of the prior art, flouts section 103 and the fundamental case law applying it...But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention *as claimed* in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations.¹

In *St. Regis Paper Co.*, the court stated "Bemis has further demonstrated that the fourth element of the Lokey bag, its use of multiple layers to achieve the effect of many bags within one, has been known in the bag industry for many years."² However, in the present application, no such admission has been made, and the Office has provided no evidence that a plurality of vibrating cells have been arranged as claimed prior to the date of the claimed invention.

Furthermore, the Office misapplies the holding in *In re Japikse* at page 3 of the outstanding Office Action. MPEP § 2144.04 states:

C. Rearrangement of Parts

In *re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch **would not have modified the operation of the device.**); In *re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223

¹See *In re Ochiai*, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995).

² 193 USPQ 8, 11 (7th Cir. 1977).

USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). (Emphasis added.)

Thus, because the shifting position of the starting switch in *In re Japikse* did not **affect the operation of the device**, the CCPA held that this difference did not patentably distinguish over the prior art.

However, page 11 of the present specification, for example, explains that the arrangement of the anchoring points affects the operation of the oscillator. Thus, *In re Japikse* is not applicable to the claimed features pertaining to the arrangement of the anchoring points since this feature does have an effect on the operation of the device.

In view of the above-noted distinctions, Applicants respectfully submit that new Claim 10 (and any claims dependent thereon) patentably distinguish over Delevoye.

Claim 19 recites, *inter alia*, “a plurality of vibrating cells each connected to and disposed between said at least two deformable linking beams, said plurality of vibrating cells being regularly distributed along the deformable linking beams with a pitch, a ratio between said spans and said pitch being an integer greater than or equal to 1.” As characterized above, Delevoye does not disclose or suggest at least this feature of amended Claim 19.

Applicants respectfully submit that new Claim 19 (and any claims dependent thereon) patentably distinguish over Delevoye.

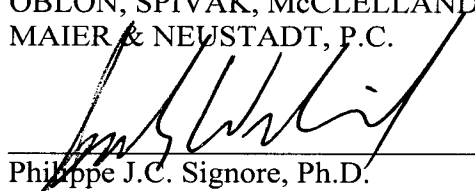
Claim 28 recites, *inter alia*, “a plurality of vibrating cells each connected to and disposed between said at least two deformable linking beams, said plurality of vibrating cells being regularly distributed along the deformable linking beams with a constant pitch, a ratio between said spans and said pitch being an integer greater than 1.” As characterized above, Delevoye does not disclose or suggest at least this feature of amended Claim 28.

Applicants respectfully submit that new Claim 28 (and any claims dependent thereon) patentably distinguish over Delevoye.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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