

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL NATHAN KARPEN

Appeal No. 2001-1918
Application No. 09/096,999

ON BRIEF

Before JERRY SMITH, DIXON, and BLANKENSHIP, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-16, which are all the claims in the application.

We affirm.

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We refer to the Final Rejection (Paper No. 5) and the Examiner's Answer (Paper No. 15) for a statement of the examiner's position and to the Brief² (Paper No. 14) for appellant's position with respect to the claims which stand rejected.

OPINION

Appellant submits that, for purposes of the instant appeal, claims 1-16 stand or fall together.³ Accordingly, we select instant claim 1 as representative of the invention. See 37 CFR § 1.192(c)(7).

Appellant refers to a "combined 132 and 131 Declaration with exhibits" filed on August 24, 1999. (Brief at 7.) Appellant contends that the paper shows that applicant's invention predated that of Blocher. (Id.)

37 CFR § 1.131 provides in pertinent part:

(a)(1) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 102(a) or (e), or 35 U.S.C. 103 based on a U.S. patent to another or others which is prior art under 35 U.S.C. 102(a) or (e) and which substantially shows or describes but does not claim the same patentable invention, as defined in § 1.601(n), or on reference to a foreign patent or to a printed publication, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under § § 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to overcome the patent or publication....

² Appellant filed an earlier brief (Paper No. 12) that was denied entry for lack of compliance with 37 CFR § 1.192(c). See Notification of Non-compliance (Paper No. 13).

³ To the extent that the grouping of claims statement (Brief at 6) may be viewed as submitting separate patentability for two groups of claims, we note that appellant does not provide separate arguments for independent claim 1 and independent claim 8.

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(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

We find that the filing date of the instant application is June 13, 1998. However, appellant claims benefit under 35 U.S.C. § 120 to an earlier application filed February 12, 1996; the present application is designated a continuation-in-part of the earlier application. Since there is no indication by the examiner to the contrary, we assume that all present claims find support (i.e., as required by 35 U.S.C. § 112, first paragraph) in the earlier application. The effective filing date of the claims before us is therefore deemed to be February 12, 1996. Blocher, filed May 13, 1994 and issued August 29, 1995, is thus considered to be a patent to others which is prior art under 35 U.S.C. § 102(e), and therefore may be antedated by a Rule 131 declaration provided that the requirements of 37 CFR § 1.131(a)(1) are met. The critical date -- that which must be antedated to remove Blocher as a reference -- is May 13, 1994.

Appellant contends that "the Applicant worked diligently on the subject matter of the present invention, in that as noted the Applicant conceived of his invention prior to the May 13, 1994 filing date of U. S. Pat. No. 5,446,617 of Blocher." (Brief at 8.)

Conception is defined as "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367,

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1376, 231 USPQ 81, 87 (Fed. Cir. 1986). We have carefully considered the declaration and evidence filed August 24, 1999, and we do not understand how the evidence may be thought to show conception of the invention prior to May 13, 1994. Under Rule 131, there must be “a factual showing of completion of the invention before the critical date.” In re Borkowski, 505 F.2d 713, 719, 184 USPQ 29, 33-34 (CCPA 1974). The “handwritten telephone notes,” alleged to be generated on or about September, 1993 (Brief at 8), fail to show a definite and permanent idea of the complete and operative invention, either alone or in combination with the other evidence provided.

Moreover, it was appellant’s burden to explain how the exhibits may show completion of the invention. See Borkowski at 719, 184 USPQ at 33 (“It was appellants’ burden to explain the content of these notebook pages as proof of acts amounting to reduction to practice. That was not done.”). Vague and general statements in a declaration with respect to what the exhibits show -- i.e., general, conclusory statements such as “conception” and “reduction to practice” -- are insufficient. See id. at 718, 184 USPQ at 33 (vague and general statements amount to mere pleading, unsupported by proof or showing of facts).

We conclude that the character and weight of the evidence submitted pursuant to 37 CFR § 1.131(b) is insufficient to show conception before the critical date of May 13, 1994.

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Appellant refers (Brief at 8) to a “Disclosure Document” filed June 26, 1995, but the Brief is unclear with respect to what the Disclosure Document is submitted to show.⁴ In the instant case, the Disclosure Document cannot be relied upon as showing conception of the invention, since the Disclosure Document date is subsequent to the critical date. If one were to assume the Disclosure Document may represent a constructive reduction to practice of the invention -- thus assuming an allegation of conception before the critical date and reduction to practice after the critical date -- the declaration and exhibits fail to meet the requirements for showing “due diligence” at least during the more-than-one-year period from prior to May 13, 1994 until the Disclosure Document date of June 26, 1995. Appellant has not “account[ed] for the entire critical period by showing either activity aimed at reduction to practice or legally adequate excuses for inactivity.” 3 D. Chisum, Patents, §10.07 at 10-120 (1986).

Having determined that Blocher has not been antedated as a reference, we turn to review the substance of the section 103 rejection applied against the claims. Appellant contests the rejection, in part, on the theory that Blocher “electrically grounds” the ballast while applicant’s invention “magnetically shields” the ballast.

While it is true that Blocher describes housing 10 (Fig. 1) as being electrically grounded (via grounding wire 50; Fig. 3), the reference is clear that housing 10 also

⁴ The “Disclosure Documents” program is a service provided by the USPTO for preserving evidence of the date of conception of an invention. Manual of Patent Examining Procedure § 1706, p. 1700-7 (8th Ed. Aug. 2001).

serves as magnetic shielding. The enclosure and grounding structure decreases transmission of radio frequency interference (RFI) and electro-magnetic interference (EMI). Col. 1, ll. 6-16. The enclosure effectively encloses and captures any RFI and EMI that may be transmitted by the ballast circuit or related components. See col. 4, ll. 6-17. We further note that Blocher claims the feature of capturing RFI and EMI transmitted by the ballast circuit (e.g., claim 2).

Appellant's argument thus raises the question of whether Blocher is an enabling disclosure of the claimed invention. Appellant bears the burden of introducing evidence that Blocher lacks an enabling disclosure. In re Fracolossi, 681 F.2d 792, 793, 215 USPQ 569, 570 (CCPA 1982). Appellant has produced no such evidence. We therefore take Blocher's disclosure at face value -- i.e., the invention operates as the reference describes.

Appellant points to evidence (i.e., text from a book addressing "Grounding and Shielding") suggesting that aluminum may not be as effective as other materials at shielding low-frequency magnetic fields.⁵ (Brief, ¶¶ bridging pp. 9 and 10.) Blocher discloses housing 10 as "preferably made of aluminum" (col. 3, ll. 48-49). We thus might assume that embodiments of appellant's invention more effectively shield low-frequency magnetic fields than does the preferred embodiment of Blocher. However,

⁵ Appellant does not suggest that the evidence is submitted to show that Blocher lacks an enabling disclosure. We find that the equivocal nature of the language in the text concerning what "may be" insignificant or "may be" necessary is such that the evidence is insufficient to establish that Blocher lacks an enabling disclosure. However, the evidence may be viewed as showing that aluminum is not the best material for shielding low-frequency magnetic fields.

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that embodiments of appellant's invention may be superior in some respects to Blocher's preferred embodiment does not speak to the scope of invention circumscribed by instant claim 1. Claims are to be given their broadest reasonable interpretation during prosecution, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). We do not consider the arguments to be commensurate with the scope of the invention that is claimed.

Moreover, the rejection relies on a combination of references. The Brief speaks extensively of alleged merits of the instant invention, in comparison to Blocher, but appears to ignore the teachings of CO-NETIC. (See, e.g., Brief at 14, "[t]he present invention is not anticipated by Blocher...."). However, nonobviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. In re Merck & Co., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986) (citing In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)).

We find that CO-NETIC describes materials for magnetic shielding for fields from DC to 100 kHz. Page 3, col. 1, "Magnetic vs. RF Shielding." CO-NETIC also teaches that, in environments requiring particular attention to the effects of electromagnetic interference, fluorescent lighting usually has intolerable magnetic noise. Page 4, col. 1,

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“LIGHTING.” We thus find suggestion in the combination of references for adding a CO-NETIC or NETIC alloy to the aluminum shielding case of Blocher for enhancement of magnetic shielding as taught by CO-NETIC, for use in the specialized environments taught by CO-NETIC.

Appellant refers to three articles (Brief at 11-12) authored by appellant, but it is unclear what the articles are submitted to show (e.g., indicia of nonobviousness as “commercial success of the invention, satisfying a long-felt need, failure of others to find a solution to the problem at hand, and copying of the invention by others.” Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1572, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996)). The articles, and many of the arguments in the Brief, may form a basis for showing that appellant’s reasons for modifying the prior art may be different from that of the prior art before us. However, for the purposes of an obviousness inquiry, there is no requirement that an artisan’s reasons for making modifications of the prior art be the same as that of the patent applicant. See In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996) (citing In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc) (“Although the motivation to combine here differs from that of the applicant, the motivation in the prior art to combine the references does not have to be identical to that of the applicant to establish obviousness.”)).

Appellant does make reference (Brief at 12) to an indicator of nonobviousness -- solving a “long-felt and unresolved need” to shield fluorescent ballasts “in order to

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eliminate the magnetic component of the electromagnetic field being emitted from the ballast circuitry.” Contrary to argument, however, the claims recite “reducing,” rather than “eliminating,” magnetic component. On this record, as noted above, we find that Blocher operates as the reference describes and reduces the magnetic component of the electromagnetic field emitted from ballast circuitry, thus solving the alleged “long-felt need.” See Newell Cos. v. Kenney Mfg. Co., 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988) (“[O]nce another supplied the key element, there was no long-felt need or, indeed, a problem to be solved.”) In any event, appellant has not submitted any evidence to show a “long-felt and unresolved need” in the art.

Finally, it is unclear what we are urged to infer from the declaration submitted by “a manufacturer of diffusers for lighting fixtures,” addressed at pages 10 and 11 of the Brief. We consider it of no moment that “no one ever mentioned” the “problems of electromagnetic fields from fluorescent lighting” to the declarant. As we have noted previously, each of the two references relied upon by the rejection recognizes the problems of electromagnetic fields from fluorescent lighting.

In light of the references supporting the rejection of the claims and the evidence and arguments submitted by appellant in support of nonobviousness of the subject matter as a whole, we conclude that the overall weight of the objective evidence of nonobviousness does not outweigh the evidence of obviousness relied upon by the examiner. Accordingly, we sustain the rejection of claims 1-16 under 35 U.S.C. § 103.

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We have considered all of appellant's arguments in making our determinations. Arguments not relied upon are deemed waived. See 37 CFR § 1.192(a) ("Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.") and §1.192(c)(8)(iv) (the brief must point out the errors in the rejection).

CONCLUSION

The rejection of claims 1-16 under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

JERRY SMITH
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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ALFRED M WALKER
PATENT ATTORNEY
225 OLD COUNTRY ROAD
MELVILLE , NY 11747-2712