

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD J. RICHARDSON

Appeal No. 2002-0532
Application No. 09/069,457

HEARD: FEBRUARY 13, 2003

Before FLEMING, BARRETT, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection¹ of claims 1-33, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to components and assemblies for lighting systems, such as socket assemblies and lamp

¹ The rejection of the claims 22-25 and 27-32 under 35 U.S.C. § 112, first paragraph, has been withdrawn by the examiner (answer, page 6).

insulator assemblies (specification, page 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A lamp element cover, the cover comprising:

a housing for covering part of a lamp; and

a wall extending away from the housing for encircling a contact on the lamp and extending in a first direction away from the housing a distance sufficient to encircle at least 25% of the length of the contact on the lamp and wherein at least part of the wall is dimensioned so as to allow a mating contact for the lamp contact to be inserted inside the wall and removed without damaging the wall.

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

Frensch	2,774,947	Dec. 18, 1956
Robertson et al. (Robertson)	5,904,415	May 18, 1999
		(filed June 26, 1996)

Claims 1-33² stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-11 and 13-33 stand rejected under 35 U.S.C.

² In an amendment (Paper No. 17, filed September 8, 2000) appellant added claims 27-32, as well as an additional set of claims erroneously numbered 30-33, instead of 33-36. Appellant subsequently submitted two amendments (Paper no. 23, filed July 9, 2001 and Paper No. 26, filed August 6, 2001) in attempts to correct the numbering of the claims. However, the amendments were denied entry by the examiner (Paper No. 25, mailed July 25, 2001 and Paper No. 27, mailed August 22, 2001). It is no altogether clear as to why appellant was not permitted to renumber the claims under 37 CFR § 1.126. Nevertheless, because the claims have not been renumbered, we shall refer to these claims as "misnumbered claims 30-33." Because the examiner refers to specific language of the misnumbered claims in the rejection of the claims under 35 U.S.C. §112, second paragraph, we consider these claims to have been considered by the examiner, and included in both the rejection under 35 U.S.C. § 112, second paragraph, as well as the rejection under 35 U.S.C. § 102(e).

§ 102(e) as being anticipated by Robertson.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Robertson in view of Frensch.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 28, mailed October 29, 2001) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 24, filed July 9, 2001) and reply brief (Paper No. 29, filed December 31, 2001) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's

rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we affirm-in-part.

We begin with the rejection of claims 1-32 and misnumbered claims 30-33 under 35 U.S.C. § 112, second paragraph. Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner's position is that in claim 1, the language "a housing for covering part of a lamp; and a wall extending away from the housing" is confusing and vague. The examiner argues (answer, page 3) to the effect that since the specification (page 25) discloses that the wall is part of the housing, it is unclear as to how the wall can extend away from the housing. From our review of the specification and drawing, we find that as illustrated in figure 33, 442 represents a housing, and 475 represents a wall that extends away from the housing 442. We see nothing inherently wrong with describing wall 475 as extending away from the housing. With respect to the examiner's assertion

(answer, page 3) that the terminology in the claims is inconsistent with the terminology in the specification, 37 CFR §1.75(d)(1) sets forth that the terms and phrases used in the claims must find clear support or antecedent basis in the description. If clear support or antecedent basis is not found, the examiner should consider an objection to the specification and claims under 37 CFR 1.175(d)(1). Accordingly, because we find that wall 475 extends away from housing 442, we reverse the rejection of claim 1 under 35 U.S.C. § 112, second paragraph.

Turning to claim 3, the examiner questions (answer, page 3) what appellant considers to be the housing, the housing wall, the first wall and the second wall. Appellant asserts (brief, page 13) that claim 3 states "at least two walls for encircling respective contacts on a lamp" and that sleeves 475 (figures 30 and 31) disclose sleeves 475 which encircle at least two walls which encircle contacts 440 of the lamp. We agree and note that figure 28 shows sleeves (walls) 475, 487 which extend from the housing a sufficient distance to encircle contacts 440 of lamp 430. Accordingly, the rejection of claim 3 under 35 U.S.C. § 112, second paragraph, is reversed.

We turn next to claims 12 and 13. The examiner asserts (answer, pages 3 and 4) that the language "housing includes a

housing wall" is unclear for the same reasons advanced with respect to claim 3. With respect to claim 12, from our review of the specification and drawings, we agree with appellant (brief, page 13) that housing 442 has an internal wall 444, and that a seal such as o-ring 452 (figure 28) seals between the housing wall and the lamp. With respect to claim 13, appellant does not dispute the examiner's assertion of indefiniteness and states that "[a]pplicant proposes amending claim 13, and will not consider this claim further with respect to the rejection under 35 U.S.C. § 112." We find that the language reciting "the housing walls encircle the at least two lamp contacts" sets forth a double recitation of the previously claimed "at least two walls for encircling the respective contacts on a lamp," rendering claim 13 indefinite. Accordingly, the rejection of claim 13, and claims 14-21, which depend therefrom, is affirmed³.

We turn next to claim 22. We find that the claimed lamp base refers to end cap 438. We consider either a separate base or the surface of the end cap containing the contacts 440 to be the first surface coupled to the base, as described on page 61 of

³ We are cognizant of the fact that an amendment was submitted by appellant (Paper No. 23, filed July 9, 2001) to address problems such as antecedent basis for language in the claims. However, because the amendment was not entered by the examiner (Paper No. 27, mailed August 22, 2001), we are constrained to address the claims as they stand before us on appeal.

the specification. We agree with appellant (brief, page 14) that the claimed contact sleeve is sleeve or wall 475 (figure 28). With respect to the limitation "a lamp sleeve coupled to the contact sleeve . . ." Appellant directs our attention to page 64, lines 25 and 26 of the specification. From our review of page 64 of the specification, we find that adapter 432 surrounds and protects the lamp, but is not coupled to the contact sleeve. Rather, adapter 432 is integral with the contact sleeve . In addition, we agree with the examiner that "the wall" lacks antecedent basis. We are not persuaded by appellant's assertion (reply brief, page 6) that "the Examiner does not dispute that the structure is found in the specification, but only that the term 'sleeve' as it relates to item 475 is used at the same time as the terms 'jacket or cylindrical wall'." The fact that the specification uses alternative terms to refer to a particular component of appellant's invention does not establish a conclusive presumption that interchanging the terms will result in a claim that particularly points out and distinctly claims appellant's invention. Although we believe that appellant is in fact referring to a contact sleeve, the examiner is technically correct that referring to "the wall" without antecedent basis for the term in the claim, renders the claim indefinite.

Accordingly, the rejection of claim 22 under 35 U.S.C. § 112, second paragraph is affirmed.

Turning next to claim 25, we agree with appellant (brief, page 14) that the claimed lamp connector refers connector 434.

Turning next to claim 26, we agree with appellant that the claimed connector sleeves refer to sleeves 532 and 538 (figure 28).

Turning next to claims 27-32, we agree with appellant that the engaging element is connector 434. We are not persuaded by the examiner's assertion (answer, page 4) that the cantilevered arm does not engage that lamp as claimed. Claim 27 does not require that the engagement element engages the lamp, but rather that the engagement element engages the combination of the lamp and the end cover.

Turning next to the claims filed September 8, 2000 and misnumbered as 30-32, we agree with appellant (brief, page 15) that the claimed connector sleeves refer to sleeves 532.

Turning next to the claim filed September 8, 2000 and misnumbered as claim 31, the examiner asserts (answer, page 5) that "it is unclear and confusing what applicant is referring to in the limitation that the 'lamp includes a cylindrical tube wall . . .'. Is this the same as the 'lamp wall extending in a second

direction' in claim 30?" Appellant does not dispute the examiner's determination of indefiniteness, but instead asserts (brief, page 16) that appellant proposes amending claim 31 to remove the redundant reference to the lamp wall. From our review of the claim, we agree that the "cylindrical tube wall" is a double inclusion of the previously claimed "lamp wall" of misnumbered claim 30, filed September 8, 2000, from which misnumbered claim 31 depends.

From all of the above, the rejection of claims 1-12 and misnumbered claim 30 under 35 U.S.C. § 112, second paragraph, is reversed. The rejection of claims 13-32, and misnumbered claims 31-33, under 35 U.S.C. § 112, second paragraph, is affirmed.

We turn next to the rejection of claims 1-11, 13-32 and misnumbered claims 30-33 under 35 U.S.C. § 102(e). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The examiner (answer, page 5) refers us to a marked-up copy of figure 2 of Robertson to explain how the claims are anticipated. Appellant asserts (brief, page 16) that the pin receptacles 104 and 105 of Robertson are fixed or molded in place so they cannot be inserted or removed.

Appellant argues that (brief, pages 16-19 and reply brief, pages 8 and 9) that claim 1 is not anticipated by Robertson because independent claim 1 requires "wherein at least part of the wall is dimensioned so as to allow a mating contact for the lamp contact to be inserted inside the wall and removed without damaging the wall." Independent claim 22 similarly requires that "wherein at least part of the contact sleeve is dimensioned so as to allow a mating contact for the lamp contact to be inserted within the wall and removed without damaging the wall." Misnumbered independent claim 30 requires "a removable connector removably contacting the lamp contact within the contact protector." Appellant further asserts (brief, page 19) that Robertson does not show "a housing for receiving the base and the lamp contact" as recited in misnumbered claim 30. From our review of Robertson and the marked-up copy of figure 2 of Robertson that is attached to the examiner's answer, we find that plate 109 of Robertson, identified by the examiner as the "housing" is not a housing and does not cover part of the lamp as recited in claim 1. Nor does plate 109 receive the base of the lamp or the lamp contacts 303, 304. Although we consider portion 103 (figure 3) of shield 102 of Robertson to be a housing that covers part of the lamp (claim 1) and receives the base of the lamp and the contacts when the lamp is inserted, we agree with

appellant that independent claims 1, 22, and misnumbered independent claim 30 are not anticipated by Robertson because we find no teaching in Robertson, and none has been brought to our attention by the examiner, that pin receptacles 104, 105 of Robertson are removable or can be inserted or removed without damaging the wall. We therefore find that the examiner has failed to establish a prima facie case of anticipation of claims 1-11, 13-32, and misnumbered claims 30-33. Accordingly, the rejection of claims 1-11, 13-32, and misnumbered claims 30-33 under 35 U.S.C. § 102(e) is reversed.

We turn next to the rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Robertson in view of Frensch. We reverse the rejection of claim 12 under 35 U.S.C. § 103(a) as Frensch does not make up for the deficiencies of Robertson.

CONCLUSION

To summarize, the decision of the examiner to reject claims 13-32 and misnumbered claims 31-33 under 35 U.S.C. § 112, second paragraph is affirmed. The decision of the examiner to reject claims 1-12 and misnumbered claim 30 under 35 U.S.C. § 112, second paragraph, is reversed. The decision of the examiner to reject claims 1-11, 13-32, and misnumbered claims 30-33 under 35

U.S.C. § 102(e) is reversed. The decision of the examiner to reject claim 12 under 35 U.S.C. § 103(a) is reversed.

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

AFFIRMED-IN-PART

LEE E. BARRETT)	
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