

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

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHALOM WERTSBERGER

Appeal No. 2004-1681
Application No. 09/749,216

ON BRIEF

Before KRASS, PAK and PAWLIKOWSKI, **Administrative Patent Judges**.

PAWLIKOWSKI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection claims 1-25.

Claims 1, 9, 10, 12, 14, 15, 21, 22, 23, and 25 are representative of the subject matter on appeal, and are set forth below:

1. An electrostatic discharge device comprising:

an electrical fixture wallplate having an outer surface and an inner surface, said wallplate having at least one grounding point;

a contact electrode affixed substantially directly to said wallplate;

an electrostatic discharge circuit, comprising at least one resistor connected between a first and a second terminal points, and wherein the first terminal point is electrically coupled to said contact electrode, and the second terminal point is electrically coupled to said grounding point.

9. The electrostatic discharge device of claim 1 wherein said contact electrode comprises an electrically conductive or resistive pattern deposited on the outer surface of said wallplate.

10. An electrostatic discharge device comprising:

an electrical fixture wallplate having an outer surface and an inner surface, said outer surface having at least one contact electrode deposited substantially directly thereupon;

an electrostatic discharge circuit attached to said wallplate, said circuit having a first and a second terminal points, said discharge circuit comprises at least one resistor; and wherein the first terminal point is electrically coupled to said contact electrode; and,

a grounding point electrically coupled to said second terminal point.

12. The electrostatic discharge device of claim 11 wherein said electrode is deposited on or in proximity to the outer periphery of said outer surface.

14. The electrostatic discharge device of claim 10 wherein said resistor comprises a pattern made of resistive material deposited on said inner surface.

15. The electrostatic discharge device of claim 14 wherein said resistive pattern having a spark gap constructed therein.

21. The electrostatic discharge device of claim 10 wherein said wallplate is formed at least partially from a material having high specific resistivity, and wherein said resistor is formed integrally to said wallplate.

22. An electrostatic discharge device comprising an electrical fixture wallplate having an electrode means for providing a contact point, suspended therefrom; said electrode means being in electrical communication with an electrical ground by electrostatic discharge circuit means.

23. An electrostatic discharge device comprising:
an electrical switch having an operating handle;
a contact electrode deposited on said handle;
an electrical discharge circuit having at least two terminal points and comprising at least one resistor;

Wherein said circuit having a first terminal point in electrical communication with said electrode and the other terminal point in electrical communication with an electrical grounding point.

25. The electrostatic discharge device of claim 23 further comprising a wallplate having an inner surface, and wherein said electrode extends proximally to said inner surface; and,

wherein said resistor comprises a resistive pattern deposited on said inner surface, said pattern having at least one end thereof in proximity to or in contact with said electrode.

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Claims 1-8, 10-13, 17-20, and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schwalm.

Claims 9, 14-16, and 21 stand rejected under 35 U.S.C. § 103 as being obvious over Schwalm in view of Comerci.

Claims 23 and 24 stand rejected under 35 U.S.C. § 103 as being obvious over Schwalm in view of Becker.

Claim 25 stands rejected under 35 U.S.C. § 103 as being obvious over Schwalm in view of Becker and further in view of Comerci.

The examiner relies upon the following references as evidence of unpatentability:

Becker	3,621,164	Nov. 16, 1971
Schwalm	5,222,013	Jun. 22, 1993
Comerci et al. (Comerci)	5,281,155	Jan. 25, 1994

On page 5 of the brief¹, appellant states that claims 1-8 stand or fall together, that claims 10-13, 16-20 stand or fall together, and that claims 23-24 stand or fall together. Appellant also states that claims 9, 12, 14, 15, 21, 22, and 25 should be considered for separate patentability. We therefore consider claims 1, 9, 10, 12, 14, 15, 21, 22, 23, and 25 in this appeal. See 37 CFR § 1.192(c)(7) and (c)(8) (2003).

¹We use the brief filed on November 13, 2003 (Paper No. 14).

OPINION

I. The 35 U.S.C. § 102(b) rejection of claims 1-8, 10-13, 17-20, and 22

We consider claims 1, 10, 12, and 22 in this rejection.

We refer to pages 4-5 of the answer regarding the examiner's position in this rejection. We refer to pages 5-9 of the brief, and pages 1-2 of the reply brief, regarding appellant's position for this rejection.

Claim 1

With regard to claim 1, appellant argues that Schwalm does not disclose a contact electrode "affixed substantially directly" to said wallplate. Brief, pages 5-7 and reply brief, pages 1-2. Appellant argues that he has defined "substantially directly" as mounting of the electrode to the wallplate with or without an intervening part or parts, not essential to the invention, such as fasteners, intervening layers of insulating or non-insulating material, studs, separators, glue, and other equivalents to mounting not required to change the operation of the invention. Brief, page 5.

As an initial matter, we note that during patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 320, 322 (Fed. Cir. 1999). The claimed phrase "affixed substantially directly to said wallplate" is not as limited as appellant suggests on pages 5-6 of the brief. In fact, paragraph 22 on page 5 of the

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specification discloses that the contact electrode can be formed by fitting a metal cover over the wallplate.

Hence, we agree with the examiner's position as set forth on pages 4, 7, and 8 of the answer. The examiner states that the electrode 44 of Schwalm is substantially directly mounted to wallplate 12. See Figure 4 of Schwalm.

In view of the above, we therefore affirm the rejection of claim 1 (claims 2-8 fall with claim 1).

Claim 10

With regard to claim 10, claim 10 recites "at least one contact electrode deposited substantially directly thereupon."

Beginning on page 7 of the brief, appellant argues that the term "deposited", as found in this phrase, relates to a metal deposition, or a printing with conductive or resistive ink deposition onto the wallplate, and the equivalence of such deposition or printing process.

On page 8 of the answer, the examiner states that claim 10, along with claims 11-13 and 16-20, are directed to an apparatus/product, rather than a method of manufacturing the electrode itself, and the examiner therefore states that the term "deposited" can be interpreted as meaning securing or attaching on a wallplate.

The issue here is whether an electrode "deposited" substantially directly thereupon results in a different structure than that disclosed in Schwalm. The examiner does

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not explain how it does not result in a different structure. We therefore reverse the rejection.

Hence, we reverse the rejection of claim 10 (and we reverse the rejection of the dependent claims of claim 10, which are 11, 12, 13, and 17-20).

Claim 22

With regard to claim 22, appellant sets forth his argument on pages 17-19 of the brief. Appellant argues that claim 22 is a means for performing a function as defined under 35 U.S.C. § 112, paragraph 6. Appellant argues that the structure to which the electrode means of claim 22 relates should be interpreted in light of the specification. Appellant states that the specification does not relate to an electrode located in an insulating housing (as in Schwalm) but to an electrode affixed or deposited substantially directly on the wallplate. Brief, page 18.

The use of means without the recitation of a definite structure in support of the recited function creates a presumption that the inventor used the term advisedly to invoke the statutory mandate of 35 U.S.C. §112, ¶ 6. Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997). When 35 U.S.C. §112, ¶ 6 is invoked, it requires us to look to the specification and interpret the claimed means plus function language as of the corresponding structure described therein, and equivalents thereof, to the extent that the specification provides such disclosure. 35

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U.S.C. §112, ¶ 6 (2003); see also In re Donaldson Co., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(en banc).

With regard to the disclosure of appellant's specification, as pointed out in the brief, by appellant, there are several embodiments regarding the contact electrode, in the specification, which include an electrode affixed substantially directly to the wallplate, deposited on the wallplate, suspended from the wallplate, extended to or from its periphery, and integrated into the wallplate by making the wallplate, or a portion thereof, of highly resistive material. Brief, page 18.

As discussed supra, electrode 44, as shown in Schwalm's Figure 4, is affixed in a manner such as being extended to or from the periphery of the wallplate or affixed substantially directly to the wallplate. As explained by the examiner on page 4 of the answer, Schwalm discloses an electrostatic device 10 having a fixture wallplate 12, an electrode 44, for providing a contact point 86. Hence, Schwalm reflects the corresponding structure as set forth in appellant's specification, and therefore anticipates claim 22. Hence, we affirm the rejection of claim 22.

In summary, we affirm the rejection of claims 1-8 and 22, but we reverse the rejection of claims 10, 11, 12, 13, and 17-20.

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II. The 35 U.S.C. § 103 rejection of claims 9, 14-16, and 21 under 35 U.S.C. § 103 as being obvious over Schwalm in view of Comerci

We consider claims 9, 14, 15, and 21 in this rejection.

We refer to page 6 of the answer regarding the examiner's position in this rejection.

We refer to pages 9-14 of the brief regarding appellant's position for this rejection. Appellant also sets forth arguments on pages 2-3 of the reply brief.

Claim 9

Claim 9 includes the language "pattern deposited" on the outer surface.

On page 2 of the reply brief, appellant points out that Comerci does not teach a pattern 92 on a plate 90, but a conductive discharge shield 90 having a plate portion 92 that is not deposited on the inner surface of the wallplate. We agree. The examiner rebuts and states that plate 92 has a pattern. However, apertures 98 are not a pattern "deposited" on the outer surface of a wall plate.

Furthermore, on page 3 of the reply brief, in paragraph no. 11, appellant states that the examiner's combination ignores the fact that the incorporation of Comerci's electrostatic discharge shield 90 will change the principle of operation of the device of Schwalm. Appellant argues that "if the Schwalm electrode is placed behind the faceplate (with or without the insulating housing), it is not available for human contact, while the Comerci invention requires a conductive prong coupled to a plug to discharge electronic

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equipment benefits from a discharge plate that is hidden from human contact." We agree, and note that the examiner does not provide a convincing rebuttal regarding this point made by appellant. Answer, page 10. The examiner merely refers to In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981), and does not explain how one of ordinary skill in the art would have incorporated the electrostatic discharge shield 90 into the device of Schwalm without changing the operation of the device of Schwalm.

We therefore reverse the rejection of claim 9.

Claim 14

Claim 14 requires that the resistor of the device of claim 10 comprises a pattern made of resistive material "deposited" on the inner surface of the wallplate. For the same reasons that we reversed the rejection of claim 10 (regarding "deposited"), we reverse the rejection of claim 14.

Claim 15

With regard to claim 15, because claim 15 depends upon claim 14 (which depends upon claim 10), we reverse the rejection of claim 15.

Claim 21

With regard to claim 21, claim 21 depends upon claim 10, and therefore we reverse the rejection of claim 21.

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In view of the above, we therefore reverse the rejection of claims 9, 14-16, and 21 under 35 U.S.C. § 103 as being obvious over Schwalm in view of Comerci.

III. The 35 U.S.C. § 103 rejection of claims 23-24 under 35 U.S.C. § 103 as being obvious over Schwalm in view of Becker

We consider claim 23 in this rejection.

We refer to the examiner's position regarding this rejection as set forth on page 6 of the answer. We refer to pages 14-16 of the brief regarding appellant's position regarding this rejection. Appellant also presents arguments on page 4 of the reply brief.

Claim 23 recites, *inter alia*, "a contact electrode deposited on said handle".

Appellant argues that neither Schwalm nor Becker provides any teaching of depositing an electrode on the switch handle. We agree. The examiner does not point to any disclosure in the applied art teaching a contact electrode that is deposited, nor does the examiner explain why such would have been obvious in view of the applied prior art.

In view of the above, we reverse the rejection of claims 23 and 24.

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IV. The 35 U.S.C. § 103 rejection of claim 25

Claim 25 depends upon claim 23. Hence, we reverse the rejection of claim 25 also.

V. Conclusion

We affirm the anticipation rejection of claims 1-8 and 22, but reverse the anticipation rejection of claims 10-13 and 17-20.

We reverse 35 U.S.C. § 103 rejection of claims 9, 14-16, and 21 as being obvious over Schwalm in view of Comerci.

We reverse the 35 U.S.C. § 103 rejection of claims 23 and 24 as being obvious over Schwalm in view of Becker.

We reverse the 35 U.S.C. § 103 rejection of claim 25 under as being obvious over Schwalm in view of Becker and Comerci.

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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)(1)(iv)(effective Sept. 13, 2003; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat., Office 21 (Sept. 7, 2004)).

AFFIRMED-IN-PART

ERROL A. KRASS)
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