

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. MARTTER, CRAIG C. SUNDBERG,
RICHARD N. GIARDINA, BRIAN S. FETSCHER AND
G. JAMES DEUTSCHLANDER

Appeal No. 2005-0128
Application No. 10/120,158

ON BRIEF

Before THOMAS, DIXON, and BARRY, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4, 7, 8, 19, 21 and 22. The examiner has indicated that claim 20 would be allowed if rewritten in independent form.

We REVERSE and REMAND.

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Appellants' invention relates to a lighting device for use in a LED device. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. An apparatus for use as a light emitting diode (LED) lighting device, comprising:

a metal substrate having a surface;

a fired dielectric coating layer superimposed on the surface of the metal substrate;

an electric circuit disposed upon the coating layer; and

a light emitting diode (LED) mounted on the substrate and electrically connected to the circuit, whereby the metal substrate is a heat sink for the LED.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Hochstein	5,857,767	Jan. 12, 1999
Ellis et al. (Ellis)	6,233,817	May 22, 2001

Claims 1-4, 7-8, 19, 21 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hochstein in view of Ellis.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's

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answer (mailed Jul. 1, 2004) for the examiner's reasoning in support of the rejections, and to appellants' brief (filed Feb. 12, 2004) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction

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of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), **citing In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617,

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citing McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) .

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1. Independent claim 1 requires an apparatus for use as a LED comprising a metal substrate and a fired dielectric coating on the metal substrate. The examiner maintains that Hochstein teaches all the limitations but for the use of stainless steel as the metal substrate and the "fired" dielectric. The examiner maintains that Ellis teaches the use of a stainless steel substrate and the use of a dielectric substrate is fired to 600-900 °C and that it would have been obvious to one of ordinary skill in the art at the time of the invention to use the stainless steel substrate and fired dielectric as taught by Ellis at columns 3 and 4 in combination with the teachings of Hochstein. (Answer at pages 3-4.) Appellants argue that two of the three criteria of a *prima facie* case of obviousness have not been met by the examiner. Appellants argue that the examiner has not established a teaching or suggestion to make the combination nor has the examiner established a reasonable expectation of success in the prior art. (Brief at page 17.)

Appellants argue that the examiner has not established any teaching or motivation as to why it would have been obvious to one of ordinary skill in the art at the

time of the invention to combine the low temperature LED array as taught by Hochstein with the stainless steel substrate as taught by Ellis, which is not disclosed for use with LED's and not used at a significantly higher temperature than Hochstein. (Brief at pages 19-20.) Furthermore, appellants argue that Ellis neither discloses nor suggests a circuit for use in a LED circuit contrary to the examiner's position in the final rejection. (Brief at pages 19-20.) The examiner modified the statement of the rejection to remove the statement that Ellis teaches a LED lighting circuit and summarily concludes that it would have been obvious to one of ordinary skill in the art to combine the teachings. (Answer at pages 3-4.) Furthermore, we find the examiner's rationales for combination are mere conclusions and not based upon the express teachings of Ellis. Moreover, we do not find the examiner's line of reasoning for the combination to be convincing based upon the general teachings of Ellis without any suggestion for use in a LED circuit.

From our review of the teachings of Ellis, we find the word "led" rather than "LED" for a Light Emitting Diode. (See Ellis at column 6, line 17.) Here, we do not find any teaching or suggestion in either Hochstein or Ellis that would have suggested the combination as maintained by the examiner. Therefore, we cannot sustain the rejection of independent claim 1 since the examiner has not established the initial showing of a *prima facie* case of obviousness. Similarly, we cannot sustain the rejection of dependent claims 2-4, 7, 8, 19, 21, and 22.

REMAND

We remand this application to the examiner to consider the product by process limitation recited in independent claim 1 as it relates to the application of prior art applied against the claims. We note that independent claim 1 does not recite the use of stainless steel and Hochstein teaches the use of a metal substrate. Here, appellants have argued the difference between the prior art and the claimed invention with respect to the “fired dielectric” and the examiner relies on the teachings of Ellis with respect to the fired dielectric. We leave it to the examiner to consider whether the fired dielectric is a process limitation or a structural limitation of the circuit would limit the product and distinguish over Hochstein alone. M.P.E.P. § 2113 provides guidance on examining product-by-process claims.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4, 7, 8, 19, 21 and 22 under 35 U.S.C. § 103 is reversed.

REVERSED and REMANDED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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LANCE LEONARD BARRY)	
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