

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte LARS OSTLIE

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Appeal No. 2005-2636  
Application No. 08/708,961

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ON BRIEF

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Before FRANKFORT, McQUADE and NAPPI, Administrative Patent Judges.  
FRANKFORT, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 33 through 92, all of the claims remaining in the application. Claims 1 through 32 have been canceled.

Appellant's invention addresses the problem of fouling of items that are placed in water, such as boat hulls and other marine structures. More specifically, the invention relates to an apparatus for harming or killing fouling flora or fauna so as to reduce or eliminate the fouling problem and to items carrying such apparatus. Independent claims 33, 47, 61 and

76 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellant's brief.

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

Diprose et al. (Diprose)	4,869,016	Sep. 26, 1989
Usami et al. (Usami)	5,088,432	Feb. 18, 1992

Claims 33 through 92 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Usami in view of Diprose.

Rather than attempt to reiterate the examiner's commentary with regard to the above-noted § 103 rejection and the conflicting viewpoints advanced by appellant and the examiner regarding that rejection, we make reference to the examiner's answer (mailed July 3, 2000) for the reasoning in support of the rejection, and to appellant's brief (filed April 20, 2000) and reply brief (filed August 31, 2000) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the above-noted § 103 rejection will not be sustained. Our reasons follow.

In rejecting claims 33 through 92 under 35 U.S.C. § 103(a), the examiner contends that Usami shows

an anti-fouling system for substances in contact with sea water comprising a solid dielectric member 3 a first conductor 8 located on a first side of the solid dielectric member and in electrical contact therewith. The first conductor has a surface to be mounted on a hull 1 of a ship. Usami shows a second conductor 14 located on a second side of the solid dielectric member and in contact therewith and a switched DC power source. Diprose shows a marine biofouling reduction system using an A. C. power source (answer, page 3).

The examiner has not specifically identified any differences between the anti-fouling system of Usami and the apparatus and items defined in the various claims before us on appeal, but notes

that Diprose shows a marine biofouling reduction system using an AC power source. The examiner then urges that “[i]n reference to claim 1 [sic], it would have been obvious to

provide Usami with an A.C. power source as shown by Diprose since merely substitution of one power source for another is contemplated" (answer, pages 3-4).

For the reasons adequately set forth in appellant's brief and reply brief, we find that the examiner has failed to make out a *prima facie* case of obviousness with regard to the presently claimed subject matter. First, considering independent claim 33, even if one of ordinary skill in the art were to view the switched DC power supply (9) seen in Figure 3 of Usami as providing a polarity reversing function (col. 6, lines 15-18) and thus as being analogous to an AC power supply providing a square wave output, we find no basis in Usami for viewing the conductive lead line (8) of the embodiment seen in Figures 3 and 4 as being responsive to the "first conductor" set forth in appellant's claim 33. In that regard, while it may be true that the lead line (8) is located on a first side of the insulating or dielectric member (3) and may arguably be in contact therewith via the connecting terminals (4a, 4b), the conductive lead line (8) does not have "a surface to be mounted on a hull of a ship," as set forth in claim 33. Moreover, the embodiment of Figures 3 and 4 of Usami does not have a second conductor "located on a second side of said solid dielectric material and in contact therewith; and an AC power source connected to said first and second conductors" as required in claim 33.

Concerning the embodiments of Figures 1, 5 and 9 of Usami, those embodiments have a DC power source (7) which is clearly different from the switched DC power source (9) seen in the Figure 3 embodiment discussed above. Moreover, we do not see that the conductive lead line (8) which connects the steel hull plate (1) and the separate cathode electrode (6) in those embodiments can be viewed as corresponding to the "first conductor" of apparatus claim 33 on appeal, which first conductor is "located on a first side of said solid dielectric member and in contact therewith, said first conductor having a surface to be mounted on a hull of a ship." Contrary to the examiner's apparent belief, there is no disclosure in Usami that the conductive lead line (8) seen in Figures 1, 5 and 9 passes through or otherwise is in contact with the insulating epoxy resin paint layer (3), which the examiner reads as being the "solid dielectric member" of appellant's claim 33. Nor do we believe that the conductive lead line (8) in the embodiments of Figures 1, 5 and 9 would have been viewed by one of ordinary skill in the art as having "a surface to be mounted on a hull of a ship."

Regarding independent claim 47, we find no basis to conclude that one of ordinary skill in the art would have viewed Usami as teaching or suggesting an arrangement wherein "one of said first and second conductors is bare or has no more than a semi-insulating coating, and the other of said first and second conductors has on a side thereof to be directed toward the water during use an insulating coating to insulate said other electrode

[sic, conductor] from the water during use," as in claim 47 on appeal. See, particularly, appellant's arguments in the reply brief, page 3.

As for independent claims 61 and 76 on appeal, the examiner has not separately treated those claims with any reasonable degree of specificity, and has thus failed to establish a *prima facie* case of obviousness concerning those claims and the claims which depend therefrom. Claims 61 and 76 define the structure of items to be placed in water and the examiner has not even attempted to explain why such items would have been obvious to one of ordinary skill in the art at the time of appellant's invention.

In the final analysis, we agree with appellant that the examiner has not met his burden of establishing a *prima facie* case of obviousness. For that reason, and those otherwise expressed above, we will not sustain the examiner's rejection of claims 33 through 92 under 35 U.S.C. § 103(a).

In light of the foregoing, the decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT )  
Administrative Patent Judge )  
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JOHN P. McQUADE ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS  
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 ) INTERFERENCES  
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