

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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Appeal No. 2006-0576  
Application No. 10/284,473

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ON BRIEF

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Before HAIRSTON, RUGGIERO, and SAADAT, Administrative Patent Judges.  
RUGGIERO, Administrative Patent Judge.

### DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-27, which are all of the claims pending in this application.

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The claimed invention relates to a curing lamp which includes a band-pass filter which transmits light having a particular wavelength and reflects light having other wavelengths. A heat sink, formed of a woolen material such as steel wool, is provided proximate the band-pass filter and serves to absorb the light transmitted through the band-pass filter and to dissipate the associated heat.

Claim 1 is illustrative of the invention and reads as follows:

1. A lamp light trap and heat transfer apparatus comprising:

a light source adapted to radiate light having a plurality of wavelengths including light having a wavelength in a first range and a wavelength outside of the first range;

a band-pass filter positioned in the path of at least some of the light which the light source is adapted to radiate, the band-pass filter being adapted to reflect light having wavelengths in the first range and to transmit light having wavelengths outside of said first range;

a heat sink provided proximate the band-pass filter, wherein the heat sink is formed of a woolen material adapted to absorb the light transmitted by the band-pass filter.

The Examiner relies on the following prior art references:<sup>1</sup>

Nath	4,149,086	Apr. 10, 1979
Glaus	4,644,899	Feb. 24, 1987
Arai et al. (Arai)	5,932,886	Aug. 03, 1999

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<sup>1</sup> In addition, the Examiner relies on Appellant's admissions as to the prior art at paragraphs 0005-0011 of the specification and Figure 1 of the drawings.

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Hampden 6,572,370 Jun. 03, 2003  
(filed March 07, 2002)

B. J. Ronkese (Ronkese), "Metal Wool and Indium Heat Sink," IBM Technical Disclosure Bulletin, vol. 21, no. 3, 1143-44 (August 1978).

Claims 1-27, all of the appealed claims, stand rejected under 35 U.S.C. § 103(a).

As evidence of obviousness, the Examiner offers Glaus in view of Hampden with respect to claims 1, 2, 4, 7-11, 14, 17, 18, 20, and 23-27, adds Arai to the basic combination with respect to claims 3, 5, 6, 12, 19, 21, and 22, and adds Nath to the basic combination with respect to claims 15 and 16. In a separate rejection under 35 U.S.C. § 103(a), the Examiner offers the admitted prior art in view of Hampden with respect to claims 1-11, 14, and 17-27, adds Arai to this basic combination with respect to claim 12, and adds Nath to the basic combination with respect to claims 15 and 16. In a further separate rejection under 35 U.S.C. § 103(a), claims 1 and 13 stand finally rejected as being unpatentable over Glaus in view of Ronkese and, in the alternative, as being unpatentable over the admitted prior art in view of Ronkese.<sup>2</sup>

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief (filed May 3, 2005) and Answer (mailed July 12, 2005) for the respective details.

<sup>2</sup> As indicated at page 2 of the Answer, the obviousness-type double patenting rejection of claims 1, 9, 11, and 12 has been withdrawn.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness 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 Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-27. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one

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having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1 and 17 based on the combination of Glaus and Hampden, Appellant asserts that the Examiner has failed to set forth a prima facie case of obviousness since proper motivation for the proposed combination of references has not been established. After reviewing the arguments of record from Appellant and the Examiner, we are in general agreement with Appellant's position as stated in the Brief.

The Examiner proposes (Answer, page 4)) to modify the device of Glaus by substituting the steel wool heat sink disclosed by Hampden for the cooling rib heat sink structure disclosed by Glaus. In our view, however, the system described by Hampden

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has little relevance to the curing lamp device of Glaus and, at best, provides only a disclosure that steel wool heat sinks may be

known in the art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Our review of the disclosure of Hampden reveals that, while a steel wool heat sink may be used by Hampden, the disclosure of Hampden is directed to a forced air home heating system. The problem addressed by Hampden, however, i.e., the need to efficiently capture heat from the flue pipe of a heating system and recycle it through the heat exchanger, does not exist in the curing lamp device of Glaus.

In our view, the ordinarily skilled artisan, looking to improve the heat sink device of Glaus, would find in Hampden only a teaching that heat sinks are used to absorb heat, a fact known by Glaus since the existing device of Glaus uses a heat sink for heat absorbing purposes. We find nothing in the disclosure of Hampden which teaches why a steel wool heat sink, as opposed to

any other heat sink material, is used for the heat recovery unit heat sink.

Further, while it is well settled, as alluded to by the Examiner (Answer, pages 12 and 13) that features of prior art references may be combined for a different reason than that of a claimed invention, the Examiner has the burden of showing that the stated rationale for a proposed combination has some basis in fact. In the present factual situation, no evidence is forthcoming from the Examiner that would indicate how the stated motivation rationale, i.e., improved heat absorbance by having a larger surface area, would result from the modification of Glaus with the teachings of Hampden. The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the asserted conclusion. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them,

any attempt to combine them in the manner proposed by the Examiner could only come from Appellant's own disclosure and not from any teaching or suggestion in the references themselves.

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We have also reviewed the Arai and Nath references cited by the Examiner to address the window shielding and heat sink fan features of the several of the dependent claims. We find nothing, however, in either of the Arai or Nath references which would overcome the innate deficiencies of the Glaus and Hampden references as discussed supra.

In view of the above discussion, since we are of the opinion that the proposed combination of the Glaus, Hampden, Arai, and Nath references set forth by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claims 1 and 17, nor of claims 2-16 and 18-27 dependent thereon.

We also do not sustain the Examiner's obviousness rejection of the appealed claims based on the combination of the Hampden, Arai, and Nath references with the admitted prior art. It is

apparent from our review of the disclosure of the admitted prior art at paragraphs 005-0011 of Appellant's specification, as well as the illustration in Figure 1 of the drawings, that such disclosure, which describes a curing lamp utilizing a solid material heat sink, is cumulative to that of the previously discussed Glaus reference. For all of the reasons discussed supra with regard to Glaus, we find that the Examiner has not established a

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prima facie case of obviousness for the proposed modification of the solid heat sink device of the admitted prior art with the steel wool heat sink teachings of Hampden.

Lastly, we do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 1 and 13 based on the combination of Ronkese with either of Glaus or the admitted prior art. In our view, the disclosure of Ronkese, as with Hampden, at best, provides a teaching that steel wool heat sinks exist. Absent a suggestion from Appellant's own disclosure, we find nothing in the disclosure of Ronkese that would lead the ordinarily skilled art, seeking to improve the device of Glaus or the admitted prior art, which have existing heat sink devices, to construct a heat sink of woolen material as claimed.

In summary, we have not sustained the Examiner's rejections of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-27 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON )  
Administrative Patent Judge )  
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JOSEPH F. RUGGIERO ) BOARD OF PATENT  
 ) APPEALS

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Administrative Patent Judge ) AND  
MAHSHID D. SAADAT ) INTERFERENCES  
Administrative Patent Judge )  
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FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET, N.W.  
WASHINGTON, DC 20007