The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-1026
Application No. 09/682,279

ON BRIEF

Before HAIRSTON, JERRY SMITH, and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 5-8. An amendment filed concurrently with the appeal brief has cancelled claim 7. Accordingly, this appeal now involves claims 5, 6 and 8.

The disclosed invention pertains to an illuminating device for a Universal Serial Bus (USB).

Representative claim 5 is reproduced as follows:

5. An illuminating device for the Universal Serial Bus (USB) comprising:

a. an elongated, standard USB wire comprising:

i. a flexible, tubular stabilizing agent which is easily bendable, and

ii. having a first end and a second end;

b. a USB connector electronically coupled to said first end of said elongated, standard USB wire;

c. an illuminating light(s) electronically coupled to said second end of said elongated, standard USB wire.

The examiner relies on the following references:

Tseng	5,615,945	Apr. 01, 1997
Kim	5,938,770	Aug. 17, 1999

Claims 5, 6 and 8 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Tseng in view of Kim. The examiner's rejection of claim 8 under 35 U.S.C. § 112 has been withdrawn by the examiner [answer, page 4]. Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of

obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the 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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

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). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to

combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F.3d

1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). 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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). 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 and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner finds that Tseng teaches an illuminating device that can be plugged into a computer, but the examiner notes that Tseng is silent with respect to the plug being a USB connector. The examiner notes that the lamp in Tseng is plugged into a computer socket that can be used by the keyboard or an interface

card of the computer. The examiner finds that a USB connector is one example of a modern interface card. The examiner cites Kim as teaching that a USB card can be connected to a light source. The examiner finds that it would have been obvious to the artisan to use a USB connector in Tseng as taught by Kim [answer, pages 5-6].

Appellant argues that the examiner has not provided any evidence from within the references in support of their combination. Specifically, appellant argues that Tseng does not disclose or suggest a USB connector for coupling a flexible cable to a light source in order to supply power to the light source, and Kim is not aimed at seeking alternative ways to provide power to a lamp assembly attached to an electronic device via use of a standard USB connector and cable. Appellant asserts that there is no correlation between the devices of Tseng and Kim, and the two references have no common problems to be addressed [brief, pages 6-8].

The examiner responds that the artisan would have been motivated to replace the interface card port of Tseng with the USB port of Kim because at the time of the filing of this application, USB ports had replaced interface card ports because

of their speed and ease of use. The examiner notes that Kim was cited because it teaches that a USB interface was used to replace the type of interface taught by Tseng [answer, page 6-7].

We will sustain the examiner's rejection of claim 5. Tseng teaches an illuminating device to be connected to an electronic device such as a laptop computer (Figure 4). The illuminating device is plugged into the laptop computer by use of a plug 3 fastened to an electronic socket 4 of the computer. Tseng discloses that this electronic socket is the type used by the keyboard or interface card of the computer [column 2, lines 61-63], and the illuminating device receives its power from the computer. Kim teaches that power can be supplied to a computer peripheral device by use of a USB adapter. Kim teaches that a light pen, a mouse, a keyboard, a monitor and a computer can all be interconnected by using USB hubs and USB cables. Thus, we agree with the examiner that Kim teaches that the same types of devices that are powered and plugged into the interface port of Tseng can also be powered and plugged into the USB port of a computer. Therefore, the claimed invention recites nothing more than the replacement of the interface port of Tseng with the comparable USB port taught by Kim. The artisan would have been

motivated to replace the interface port of Tseng with the USB port of Kim because, at the time this application was filed, USB interface ports had become the standard interface of choice in personal computers and were replacing all other types of connections.

With respect to claim 6, appellant argues that the combination of Tseng and Kim would produce a wire connected to a peripheral device and a light assembly which would transfer both power and data signals. Appellant notes that the USB ports of Kim transfer both power and data which is contrary to claim 6. Appellant notes that although Tseng transfers only power to the illuminating device disclosed therein, Tseng does not use a USB cable and port. With respect to claim 8, appellant argues that Tseng and Kim do not provide an illumination device having a standard USB wire wherein the USB wire utilizes only the V_{BUS} wire and the GND wire as claimed [brief, page 9-10]. The examiner responds that since Tseng teaches that only power is transferred between the computer and the illuminating device, it would have been obvious to the artisan that only power would be transferred between the illuminating device and the computer over a USB bus [answer, page 7].

We will sustain the examiner's rejection of claims 6 and 8. The collective teachings of Tseng and Kim would not lead to a connection to both a peripheral device and a light assembly as argued by appellant, but rather, as noted above, to a replacement of the port taught by Tseng with a USB port as taught by Kim. Since an illuminating device connected to the computer of Tseng does not require data or transfer data, the artisan would have recognized that the data ports of the USB connector would not be used when only a light is connected. Since the data connectors would not be used, there would be no transfer of data as recited in claim 6. Kim teaches that USB connectors supply power using the V_{BUS} wire and the GND wire. Since the data wires of the USB connector would not be used as discussed above, the USB wire of the Tseng/Kim device would utilize only the V_{BUS} wire and the GND wire as recited in claim 8.

In summary, we have sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 5, 6 and 8 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

JS/kis

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