

The opinion in support of the decision being entered today  
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 GARY L. REINERT*

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Appeal 2007-2399  
Application 10/896,417  
Technology Center 2800

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Decided: July 17, 2007

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Before TONI R. SCHEINER, LORA M. GREEN, and RICHARD M.  
LEBOVITZ, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 21- 26.  
We have jurisdiction of this appeal under 35 U.S.C. § 6(b). We affirm.

**STATEMENT OF CASE**

The claims are drawn to a stainless steel alignment assembly apparatus for airport inset lights. Claims 21-26, all the pending claims, are rejected over prior art. The Examiner relies on the following evidence of unpatentability:

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|              |              |               |
|--------------|--------------|---------------|
| Reinert '362 | US 5,541,362 | Jul. 30, 1996 |
| Reinert '201 | US 5,594,201 | Jan. 14, 1997 |

Admitted Prior Art (APA) on page 18, lines 11-12 of the Specification

The following grounds of rejection are on appeal:

- 1) Claims 21-23, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as obvious over Reinert '302 in view of Reinert '201 (Answer 4).
- 2) Claim 24 stands rejected under 35 U.S.C. § 103(a) as obvious over Reinert '302 in view of Reinert '201, and further in view of APA (Answer 5).

Claims 21-23, 25, and 26 stand or fall together because separate reasons for patentability were not provided. *See* 37 C.F.R. § 41.37 (c)(1)(vii). We select claim 21 as representative. Claims 21 and 24 read as follows:

21. A stainless steel alignment assembly apparatus for airport inset lights comprising:

- (a) a stainless steel light fixture support base for placement as a partially embedded light fixture in an airport runway, taxiway, or other aircraft ground traffic area;
- (b) a fixed connecting flange on said stainless steel light fixture support base for holding an airport inset light;
- (c) an extension flange having connecting means for attachment to said fixed connecting flange on said stainless steel light fixture support base;
- (d) mounting means on said extension flange for holding an airport inset light.

24. A stainless steel alignment canister set apparatus for an airport inset light as set forth in Claim 23, wherein said mud dam protection ring is positioned to protect the lighting fixture and its lenses from grout, when grout is poured.

## DISCUSSION

### *Obviousness over Reinert ‘302 in view of Reinert ‘201*

The Examiner contends that Reinert ‘362 describes elements (a) through (d) of the claimed assembly apparatus for airport inset lights, but does not describe the assembly constructed of stainless steel as recited in claim 21 (Answer 4). However, the Examiner states that Reinert ‘201 “teaches the use of stainless steel construction in airport inset lights (col. 2 line 55)” (Answer 4). The Examiner concludes that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have the [Reinert] ‘362 reference include the stainless steel construction of [Reinert] ‘201 for the purpose of preventing corrosion cause by ground water and free electron sources present in the soil in which the light fixture is embedded.

(Answer 4.)

### *Priority claim*

Appellant contends that the instant application is entitled to the benefit of the earlier filing dates of Reinert ‘362 and Reinert ‘201 (Br. 12). Consequently, Appellant asserts that the rejection is improper because Reinert ‘362 and Reinert ‘201 are not prior art to the application (Br. 13).

In order for a later filed application to be accorded the benefit of the filing date of an earlier filed application, 35 U.S.C § 120 requires that the later filed application contain or be amended to contain a specific reference to the earlier filed application. As stated in 35 U.S.C. § 120:

An application for patent for an invention . . . shall have the same effect . . . as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a

specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director.

Here, Appellant asserts that his application is entitled to the benefit of the filing date of earlier filed applications – U.S. Ser. No. 08/002,014, filed Jan. 8, 1993, now Reinert ‘362, and U.S. Ser. No. 08/058,356, filed May 10, 1993, now Reinert ‘201 – but the application does not contain a specific reference to the earlier filed applications as required under 35 U.S.C. § 120. Because the instant application has not satisfied the statutory requirement of 35 U.S.C. § 120, it does not get benefit of the filing dates of the earlier filed applications, which are therefore properly cited as prior art in this proceeding.

Although the instant application has not been amended in accordance with 35 U.S.C. § 120, Appellant argues the application is entitled to the benefit of the earlier filed applications because “[a] chain of claim of entitlement under 35 USC 120 to the benefit of the earlier application further exists from . . . U.S. Patent 6,572,240 [which is specifically referenced in the instant application] back to” Reinert ‘362 and Reinert ‘201 (Br. 11). The so-called “chain” consists of a series of U.S. Patents, each claiming priority,

one at a time, back to an earlier filed application;<sup>1</sup> the earliest filed application properly claims the benefit of Reinert ‘362 and Reinert ‘201. Appellant does not cite any authority, and we know of none, for according benefit based on a series of nested claims<sup>2</sup> to an earlier filed patent application, where the full chain is not explicitly referenced in any one application, let alone in the application for which benefit of the earlier filing dates is asserted.

Appellant also asserts that his application is entitled to the filing date of the earlier filed applications because a statement<sup>3</sup> was submitted during prosecution which traced its priority back to Reinert ‘362 and Reinert ‘201 (Br. 13). 35 U.S.C. § 120 is explicit: a later filed application is entitled to “benefit of the filing date of the first application . . . if it contains or is amended to contain a specific reference to the earlier filed application.” In

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<sup>1</sup> For example, as explained on pages 11-12 of the Brief:

1) U.S. Pat. No. 6,572,240, specifically referenced on page 1 of the instant application, is stated on its cover page to be a continuation-in-part of U.S. Ser. No. 09/514,089, filed Feb. 28, 2000, now U.S. Pat. No. 6,196,697;

2) U.S. Pat. No. 6,196,697 is stated on its cover page to be a continuation-in-part of U.S. Ser. No. 09/118,980, filed on Jul. 10, 1998, now U.S. Pat. No. 6,033,083;

3) U.S. Pat No. 6,033,088 is stated on its cover page to be a continuation-in-part of U.S. Ser. No. 08/687,809, filed July 26, 1996, now U.S. Pat. No. 5,779,349; and

4) U.S. Pat. No. 5,779,349 is stated on its cover page to be a continuation-in-part of Reinhart ‘362 and Reinhart ‘201.

<sup>2</sup> Like a set of Russian dolls of graduated size, each encased inside the next larger doll.

<sup>3</sup> Appellant states that the statement was submitted on Oct. 21, 2004 (Br. 13). We could not find a paper filed on that date which describes the priority tree of the instant application. However, we do find such a statement made in a paper filed Jan. 17, 2006.

our opinion, a statement submitted during prosecution is not the same or equivalent to the act of amending the application, itself. It is not a substitute for the amending the application with a specific reference as required under 35 U.S.C. § 120.

Appellant had the opportunity to amend the Specification with the priority claim after the Examiner, in a non-final rejection (having a mailing date of Oct. 18, 2005), set forth a new ground of rejection over Reinert '362 in view of Reinert '201. 37 C.F.R. § 1.78 sets forth the rules for claiming benefit of an earlier filed application, when the claim is not submitted on the filing date of the later-filed application. However, Appellant did not amend the Specification at this time.

Finally, Appellant argues that the claims at issue were previously allowed by another Examiner, and relying on MPEP § 706.04, “full faith and credit [is] to be accorded [the previous Examiner’s] determination of allowability of claims 21-26 (Br. 20).

This argument has no merit. While great care should be given in rejecting claims previously indicated as allowable, “[f]ull faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art.” M.P.E.P. § 706.04 (Edition 8, August 2001; revised August 2006). In this case, the present Examiner apparently determined that an error had been made in not rejecting the claims over Reinert '362 in view of Reinert '201. We agree with the Examiner’s determination.

*Merits of the rejection over Reinert ‘362 in view of Reinert ‘201*

On pages 14-17 of the Brief, Appellant describes the advantages of the “present invention,” including its improvements over the assembly apparatus described in Reinert ‘362. Appellant does not challenge the Examiner’s findings (Answer 4) that elements (a) through (d) recited in claim 21 are disclosed in Reinert ‘362 nor the Examiner’s conclusion that the claimed invention would have been obvious over Reinert ‘362 in view of Reinert ‘201 (Answer 4). We agree with the Examiner’s findings and conclusion that the subject matter of claim 21 is obvious over the cited prior art. Consequently, we affirm the rejection of claim 21. Because claims 22-23, 25, and 26 were not separately argued, they fall with claim 21.

*Obviousness over Reinert ‘302 in view of Reinert ‘201 and APA*

Claim 24 further requires that a mud protection ring is position to protect the lighting fixture and its lenses from grout.

The Examiner contends

‘362 in combination with ‘201 teach[ ] the invention as claimed but lacks reference to a mud dam. On page 18 lines 11-12 of the current specification the applicant states that a mud ring is, “commonly known in industry.” It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the ‘362 combined with ‘201 invention include a mud dam as is known in the industry for the purpose of expanding the capability of use of the inset light to a wide variety of soil types without negatively impacting the performance of the light assembly.

(Answer 5.)

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Appellant argues that “[t]he so-called Admitted prior art is disclosed by Appellant in Appellant’s specification and used by the Examiner in *improper* hind sight” (Br. 23).

In our opinion, the Examiner has the better argument. The Examiner has not relied on hindsight, but has provided a logical reason for combining the mud protection ring with the assembly of Reinert ‘302 in view of Reinert ‘201. As we find no defect in the Examiner’s reasoning, we affirm the rejection of claim 24.

#### TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

#### AFFIRMED

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