

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAMIAN KRAUSE

Appeal 2007-3061
Application 10/355,389
Technology Center 2600

Decided: July 14, 2008

Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT,
and KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1, 3, and 6. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF CASE

Appellant discloses an illumination device controlled by a passive infrared motion detector, where the housing of the device appears as an article of nature. (Spec. 1:3-7).

Claims 1, 3, and 6 are pending in the application. Independent claim 1 is the sole independent claim:

1. An apparatus comprising:

a translucent housing having the appearance of an article that is an element of nature;

a base to which the housing is sealed and in which there is an access panel;

a light source located within the housing powered by at least one replaceable battery which acts as a power source and

a motion detector adapted to be coupled to the power source and to the light source for switching power to the light source when it detects motion.

The prior art relied upon by the Examiner in rejecting the claims on appeal:

Samen	US 4,978,948	Dec. 18, 1990
O'Connell	US 6,409,359 B1	Jun. 25, 2002
Fung	US 6,461,219 B1	Oct. 8, 2002
Fan	US 6,554,443 B2	Apr. 29, 2003 (filed Aug. 10, 2001)

The Examiner rejected claims 1, 3, and 6 under 35 U.S.C. § 103(a) as unpatentable over Fung, O'Connell, Fan, and Samen.

Appellant argues that there is no suggestion in any of the references which would motivate one skilled in the art to combine the references, that the combination is based on impermissible hindsight reconstruction, that aspects of the references teach away from their combination and that any combination would fail to provide the benefits of Appellant's lighting apparatus. (App. Br. 4-6; Reply Br. 1-2). The Examiner finds that sufficient and proper motivation has been provided to support the combination of the cited references and that all of the elements of the claims are disclosed by the cited references. (Ans. 4-6).

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Has Appellant shown that the Examiner erred in finding that Fung, O'Connell, Fan, and Samen teach or suggest all of the disputed elements recited in claims 1, 3, and 6?

FINDINGS OF FACT

1. Fung discloses an animated display, which includes a semi-transparent covering that covers a base that includes a sensor. The sensor is used to detect the approach of a person, can be based on motion, sound or vibration, and provides an activation signal to the electric motors and internal lights. (Col. 1, l. 60 – col. 2, l. 26; Fig. 1, elements 3, 5, 6, 7, and 9).

2. O'Connell discloses a lighted rock that has an internal light source within its rock shell. The structure has a base that allows for the shell to be sealed thereto. (Col. 2, ll. 53-65; Fig. 2, elements 12, 16, and 20).

3. Fan discloses a pumpkin lighting fixture having a housing covering a lighting mechanism, where the lighting mechanism is accommodated into a rounded depression in a base having an access panel. (Figs. 2 and 3, elements 10, 20, 21).

4. Samen discloses a combined earthquake sensor and night light which can use rechargeable batteries as a main or standby power source. (Col. 2, ll. 64-68).

PRINCIPLES OF LAW

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellant to overcome the prima facie case with argument and/or evidence. *In re Mayne*, 104 F.3d 1339, 1342 (Fed. Cir. 1997).

“[A] patent for a combination which only unites old elements with no change in their respective functions ... obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” *Great Atlantic & Pac. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950). “The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art. Under the correct analysis, any need or problem known in the field of endeavor at the time of invention

and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007).

“[I]nterpreting what is *meant* by a word *in* a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348 (Fed. Cir. 2002), (emphasis in original) (citing *Intervet Am., Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989)). "Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

ANALYSIS

Appellant makes many arguments regarding the benefits of the claimed invention, (i.e., enhancing the appearance of the lighting article, to provide discrete lighting, to provide gentle guiding light as needed along paths, to provide a flexible system, etc.), (App. Br. 5-6; Reply Br. 1-3), but none of the stated benefits is recited in the claims. While the Specification may extol the virtues of Appellant’s invention, we must evaluate the claim language alone to determine the propriety of the rejection. Given that Appellant tacitly acknowledges that the cited references disclose all of the

elements of claims 1, 3, and 6, (App. Br. 6; Reply Br. 2-3), (FF. 1-4), Appellant must convince us that the combination is improper.

Appellant argues that the combination of the references in the rejection is based on impermissible hindsight reconstruction, as there is no suggestion in any of the references that would motivate the combination. (App. Br. 4-5). However, a reason to combine the teachings of the cited references need not come from the references themselves; in the instant case the elements of the separate references are united without any change in their respective functions. The Examiner has supplied rationales why one of ordinary skill in the art would combine elements of the cited references, (Ans. 3-4), and we find no error in the Examiner's findings. While Appellant suggests that unrelated elements have been picked out "to cobble together the elements of appellant's claim 1," (App. Br. 5), we find that it would have been obvious to one of ordinary skill in the art to have combined the cited elements of the references to achieve the benefits recited in the rejection of claims 1, 3, and 6.

Additionally, Appellant suggests that Fung teaches away from the device recited in claim 1 because the animated displays are tethered together. (App. Br. 4). However, alternate teachings do not constitute "teaching away," because they do not suggest to one of ordinary skill in the art that the combination would not be desirable. Similarly, Appellant argues that the opaque housing of O'Connell would negate the purpose of the invention, and thus teach away from the combination, (Reply Br. 2), but other cited references, namely Fung and Fan, (FF. 1 and 3), disclose

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translucent housings. As such, we find no deficit in the Examiner's rejection of claims 1, 3, and 6.

CONCLUSION OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1, 3, and 6, and we affirm the Examiner's rejection of those claims under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner is affirmed.

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).

AFFIRMED

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