

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

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY D. MONTGOMERY

Appeal No. 1998-1063
Application 08/715,239

ON BRIEF

Before PAK, WARREN and DELMENDO, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief, and based on our review, find that we cannot sustain either of the rejections of appealed claims 12 through 15 and 18 through 31,¹ all of the claims in the application, under 35 U.S.C. § 112, first paragraph, written description requirement, and under 35 U.S.C. § 103 as being unpatentable over Hilgers.² For the reasons pointed out by appellant in the brief and reply brief, the examiner has failed to make out a *prima facie* case with respect to both grounds of rejection.

¹ See, e.g., the amendments of February 27, 1997 (Paper No. 20).

² Answer, pages 3-5.

We have carefully considered the positions taken by the examiner and appellant with respect to both grounds of rejection and find that the views expressed are essentially based on different interpretations of the phrase “disposing a plurality of fusible elements on the surface of the substrate,” and the related claim language “disposing first and second terminations at the respective ends of said fusible elements” and “said fuse assembly clears by each of said plurality of fusible elements opening substantially simultaneously,” which are, respectively, the second step, part of the third step and an operational limitation on the structure of the fuse assembly as stated in the claimed method of manufacturing a fuse assembly encompassed by representative appealed claim 12. The examiner’s view of the requirement for “a plurality of fusible elements on the surface of the substrate” is represented by the his statement, with respect to the ground of rejection under § 112, first paragraph, written description requirement, that “[i]t is submitted that if the time at which *a single fuse in a group of fuses* blows cannot be known with precision, then it would be highly improbable to have each fuse in the group of fuses blow ‘substantially simultaneously’ to the others” (answer, page 7; emphasis supplied). With respect to this same ground of rejection, appellant states that “[t]he specification clearly teaches one of ordinary skill in the art that each of the multiple elements **14** opens simultaneously” (brief, page 6), and further states with respect to the ground of rejection under § 103, that “by using multiple fusible elements in a single fuse assembly, each of the fusible elements is absorbed within a different area of arc suppressant glass” (id., page 16; emphasis in original deleted).

It seems to us that when considered in light of the written description in the specification as interpreted by one of ordinary skill in this art, *see, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), including the drawings thereof, *see, e.g., In re Wright*, 866 F.2d 422, 423-25, 9 USPQ2d 1649, 1650-51 (Fed. Cir. 1988) (the claimed method was “disclosed in both words and drawings”), we must agree with appellant that the plain language of appealed claim 12 requires that the fuse assembly constitutes a single fuse with multiple fusible elements.

Accordingly, in view of our interpretation of the appealed claims, we must reverse the ground of rejection under § 112, first paragraph, written description requirement, because the examiner (answer, pages 5 and 7) has not established a *prima facie* case that the claims do not comply with this statutory provision by showing that the written description in the application does not “convey with reasonable

clarity to those skilled in the art that, as of the filing date sought, [applicant] was in possession of *the invention . . . now claimed.*” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); see also *In re Alton*, 76 F.3d 1168, 1175-76, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996), citing *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976).

In similar manner, the examiner has also not made out a *prima facie* case of obviousness under § 103(a) by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellant’s disclosure. See generally, *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (“When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted.] This suggestion or motivation need not be expressly stated. [Citation omitted.]”); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Indeed, the examiner has relied on the disclosure of a plurality of *individual* fuses linked together on one substrate as disclosed in the reference (answer, page 5), and has not shown that some objective teaching, suggestion or motivation in the knowledge generally available to one of ordinary skill in this art would have led that person to a plurality of fusible elements in the *same* fuse.

The examiner’s decision is reversed.

Reversed

CHUNG K. PAK)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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ROMULO H. DELMENDO)	
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