

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. FINLAY SR., PATRICK J. MURPHY
and THOMAS N. PACKARD

Appeal No. 1999-2207
Application No. 08/967,152

ON BRIEF

Before HAIRSTON, DIXON, and LEVY, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 7-11, 13 and 14, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to thermal protection for surge suppressors by placing the thermal fuse near the geometric center of the varistor body and providing a thermally conductive adhesive therebetween to hold them together. An understanding of the invention can be derived from a reading of exemplary claim 9, which is reproduced:

9. A transient voltage suppressor for an electrical circuit comprising:

a varistor having a varistor body;

a thermal fuse having a thermally responsive element disposed within a fuse body, the fuse mounted with respect to the varistor so that the thermally responsive element is approximately adjacent the geometrical center of the varistor body; and

a layer of adhesive between the varistor body and the thermal fuse.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Allina

4,866,560

Sep. 12, 1989

Claims 7-11, 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Allina.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's

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answer (Paper No. 9, mailed Feb. 2, 1999) for the examiner's reasoning in support of the rejection, and to appellants' brief (Paper No. 8, filed Dec. 28, 1998) and reply brief (Paper No. 10, filed Mar. 26, 1999) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

"To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. **See In re Deuel**, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness." **In re Rouffet**, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). Here, we disagree with the examiner's rejection with respect to independent claim 9 and find that appellants have shown the rejection lacks support for the invention as recited in independent claim 9.

Therefore, we find that appellants have overcome the rejection by showing insufficient evidence of *prima facie* obviousness.

. The examiner relies solely on the teachings of Allina and “design choice” for the physical placement of the thermal fuse and that the physical arrangement of the thermal fuse and varistor would have “no impact” on the operation of the circuit. (See answer at pages 4-5.) We disagree with the examiner’s position. In our view, the examiner’s position is mere speculation as to the specific placement of the thermal fuse relative to the geometric center of the varistor in the teaching of Allina. From our review of the teachings of Allina, Allina does not specifically identify where the thermal fuse is located within the fuses 112a and 112b (or 118a' or 118b') nor does Allina disclose a need or desire to have the thermal fuse adjacent to the geometric center of varistor 14 or 14'. (See Allina with respect to Figure 9 in combination with Figures 5 and 6.) The examiner maintains that thermal fuse 112a is near the center of varistor 14. (See brief at page 4.) We disagree with the examiner’s finding. Rather, in our view, it is speculation to assume that the thermal element is near the geometric center since Allina teaches the use of two thermal fuses where 112b is clearly not near the geometric center and neither is thermal fuse 118b'. Nor does the embodiments in Figures 3 and 4 teach the motivation to locate the thermal fuse near the geometric center of the varistor. Here, it is our view that the examiner is merely speculating as to

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the various placements of the varistor relative to the thermal fuse and we will not speculate as to the teachings of the reference. “The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 174 (CCPA 1967). Therefore, we find that the examiner has not established a **prima facie** case of obviousness, and we will not sustain the rejection of independent claim 9 and its dependent claims 10 and 11.

With respect to independent claim 14, the examiner maintains that the placement of the end with the thermal fuse therein would be mounted away from the printed circuit board and the other end of the fuse being mounted proximate to the printed circuit board. The thermal element being mounted adjacent the geometric center of the varistor is again maintained as an obvious “design choice,” and the skilled artisan would have been motivated to modify Allina to position the thermal fuse to any position. (See answer at page 4.) We disagree with the examiner and again find that the examiner is speculating on the teachings of Allina. The examiner further maintains that more than a mere rearrangement of parts is necessary for patentability. (See answer at page 5.) We agree with the examiner, but find that the examiner has not provided a convincing line of reasoning for modifying the teachings of Allina to place the circuit elements in the respective positions as recited in independent claim 14. The examiner maintains that as

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long as the orientation of the fuse does not change the operation of the fuse, the fuse may be placed in any orientation. (See answer at pages 7-8.) We agree with the examiner, but find that the examiner has not made any findings that the orientation recited in claim 14 does not change the operation of the circuit. The examiner merely maintains that a **prima facie** case of obviousness has been shown and that the burden has been shifted to appellants. We disagree with the examiner. The examiner then states that the skilled artisan is deemed to know something about the art separate from the literal disclosure of the references. (See answer at pages 7-8.) We agree with the examiner, but the examiner has not set forth what this knowledge would be or how it would be used in combination with the teachings of Allina. Therefore, we find that the examiner has not established a **prima facie** case of obviousness, and we will not sustain the rejection of independent claim 14 and its dependent claims 7 and 8.

With respect to independent claim 13 and the use of thermally conductive adhesive, the examiner maintains that even though not disclosed by Allina, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use adhesive to prevent accidental separation of the fuse and the geometrical center of the body of the varistor to ensure proper actuation to suppress transients. (See answer at page 9.) Again, we find that the examiner has not established a basis in the prior art or a convincing line of reasoning for this conclusion. The examiner is

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relying upon speculation with respect to the teachings of Allina. Therefore, we find that the examiner has not established a *prima facie* case of obviousness and we will not sustain the rejection of independent claim 13.

CONCLUSION

To summarize, the decision of the examiner to reject claims 7-14 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
STUART S. LEVY)	
Administrative Patent Judge)	

jld/vsh

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WALL, MARJAMA & BILINSKI
101 SOUTH SALINA STREET
SUITE 400
SYRACUSE, NY 13202