

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MITSUhide KATO
AND TERUHISA TSURU

Appeal No. 2000-1941
Application 08/567,128

ON BRIEF

Before JERRY SMITH, DIXON 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 rejection of claims 2 and 9-25, which constitute all the claims remaining in the application.

The disclosed invention pertains to a high frequency switch having first to fourth ports in which each of the first and second ports can be connected to either of the third and fourth ports.

Representative claim 2 is reproduced as follows:

2. A high frequency switch having first to fourth ports and enabling connection of each of the first and second ports to either of the third and fourth ports, comprising:

a first diode coupled between the first and third ports;

a second diode coupled between the first and fourth ports;

the first and second diodes each having first and second polarity terminals, the first and second diodes being directly connected to each other at a first common connection, the first common connection being coupled to the first port whereby the first and second diodes are connected so that the same polarity terminal of each of the first and second diodes is coupled to the first port;

a first coupling capacitor connected between said first port and said first common connection; a second coupling capacitor connected between said third port and said first diode and a third coupling capacitor connected between said fourth port and said second diode;

and further comprising:

a third diode coupled between the second and third ports;

a fourth diode coupled between the second and fourth ports;

the third and fourth diodes each having first and second polarity terminals, the third and fourth diodes being directly connected to each other at a second common connection, the second common connection being connected to the second port whereby the third and fourth diodes are connected so that the same polarity terminal of each of the third and fourth diodes, which is the same polarity terminal as the terminals of the first and second diodes connected to the first port, is connected to the second port, and

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a fourth coupling capacitor connected between said second port and said second common connection of the third and fourth diodes, a fifth coupling capacitor connected between the third port and the third diode and a sixth coupling capacitor connected between the fourth port and the fourth diode;

a resistance element coupled to said first common connection of said first and second diodes and said second common connection of said third and fourth diodes, the resistance element being coupled to a first terminal which is isolated from the first and second common connections by the resistance element, a first potential being applied to said first terminal, said first potential comprising one of a positive voltage, an opposite negative voltage and a ground potential, the switch further comprising a second terminal coupled to a terminal of said first diode coupled to the third port, a third terminal coupled to a terminal of said second diode coupled to the fourth port, a fourth terminal connected to a terminal of said third diode coupled to the third port and a fifth terminal connected to a terminal of said fourth diode coupled to the fourth port, one of the first potential and ground potential being coupled to a first one of said second through fifth terminals, a remaining one of said first potential and ground potential not applied to said first one of said second through fifth terminals being applied to the remaining ones of the second to fifth terminals thereby coupling the first port to the third port or the fourth port and the second port to the third port or the fourth port, only a ground potential and a selected one of two opposite potentials being applied to said first through fifth terminals to actuate said switch.

The examiner relies on the following references:

Concelman	3,374,364	Mar. 19, 1968
Ertel	3,475,700	Oct. 28, 1969
Nelson	5,170,139	Dec. 08, 1992
Chigodo et al. (Chigodo)	5,507,011	Apr. 09, 1996 (filed Dec. 21, 1993)
Kato et al. (Kato)	5,642,083	June 24, 1997

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The following rejections are on appeal before us:

1. Claims 10, 16, 19, 22 and 25 stand rejected under the judicially created doctrine of double patenting over claims 1-9 of the Kato patent "since the claims, if allowed, would improperly extend the 'right to exclude' already granted in the patent."

2. Claims 2, 9, 12 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Nelson taken alone.

3. Claim 9 stands additionally rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Ertel taken alone.

4. Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Concelman taken alone.

5. Claims 11, 14, 17, 20, 22 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Ertel in view of Chigodo.

6. Claims 15, 16, 18, 19, 21, 23 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Nelson in view of Chigodo.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the

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respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections 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 not 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 reverse.

We consider first the rejection of claims 10, 16, 19, 22 and 25 based on the ground of double patenting. These claims stand or fall together as a single group [brief, page 8]. In the rejection before the final rejection, the only double patenting rejection of the claims was termed a non-statutory double patenting rejection, and In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) was cited. In the final rejection, this

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rejection was set forth as an obviousness-type double patenting rejection based on the claims in the Kato patent. In the examiner's answer, this rejection was again set forth as a non-statutory double patenting rejection based on Schneller.

Appellants' only response to this [these] rejection[s] is that the examiner has failed to show the obviousness of the appealed claims over the claims of the Kato patent [brief, page 13].

In our view, regardless of whether the rejection is considered to be a conventional double patenting rejection based on obviousness-type double patenting or a double patenting rejection of the non-statutory type based on Schneller, the examiner has failed to set forth a prima facie case of double patenting. The examiner has simply asserted that there would be improper double patenting here, but the examiner has failed to provide any analysis in support of this assertion. In a double patenting rejection, the examiner has the same burden to establish a prima facie case of unpatentability as with any other rejection. The examiner cannot satisfy this burden by simply noting that the conditions for double patenting are met without a comparative analysis of the claims on appeal with the claims of the corresponding patent or application. Since the examiner has failed to provide us with an appropriate comparative analysis of

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the claims on appeal with the claims of the Kato patent, we will not sustain the examiner's rejection of claims 10, 16, 19, 22 and 25 based on double patenting. The examiner should also note section 804 of the most recent edition of the MPEP which discusses non-statutory rejections based on Schneller.

We now consider the various rejections of the claims under 35 U.S.C. § 103. 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), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert.

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denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

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 appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We will consider the rejections of independent claims 2, 9 and 10 over Nelson taken alone (claims 2 and 9), Ertel taken alone (claim 9) and Concelman taken alone (claim 10) together because each of the rejections raises similar arguments by the examiner and by appellants. Specifically, the examiner does not

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actually read any of claims 2, 9 and 10 on any of the three separately applied references. Instead, the examiner identifies a partial list of the elements of the claimed invention, notes that there are differences between the claimed invention and each of the applied references, and the examiner then dismisses the acknowledged differences as being a routine design expedient which the artisan would be motivated to attain [answer, pages 7-9].

Appellants argue that neither Nelson, Ertel nor Concelman teaches or suggests the claimed resistance element with the particular application of voltage potentials as recited in the claims on appeal. Appellants argue that the examiner's rejection results from hindsight reasoning [brief, pages 8-13].

The examiner responds that the three applied references are functionally or structurally equivalent to the claimed invention, and the examiner simply asserts that the modifications necessary to achieve the claimed invention would have been obvious to the artisan [answer, pages 10-13].

We will not sustain any of the examiner's rejections based on Nelson, Ertel or Concelman taken alone because the examiner has failed to establish a prima facie case of obviousness. The examiner has basically ignored the specific

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recitations of the claims and focused instead on broader concepts and on the "fact" that the claims recite well known electrical elements. When we attempt to read any of the independent claims on any one of the applied prior art references, we quickly find that there are many differences between the claimed invention and the prior art which the examiner has completely ignored. Thus, the rejections fail because they do not address all the differences between the claimed invention and the applied prior art.

The rejections also fail because the examiner has simply dismissed all acknowledged differences between the claimed invention and the prior art as resulting from obvious design expedients without any evidence on this record to support that assertion. The examiner cannot fulfill his responsibility of establishing a prima facie case of obviousness by simply concluding that such differences are obvious.

Since the rejections which also rely on Chigodo in addition to Nelson or Ertel still rely on the deficiencies of Nelson or Ertel as discussed above, and since Chigodo does not overcome these deficiencies, we will not sustain the rejection of any of the dependent claims based on Nelson or Ertel in view of Chigodo.

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In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 2 and 9-25 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JOSEPH L. DIXON)	
Administrative Patent Judge)	APPEALS AND
)	
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