

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD P. KOZEK and ROBERT M. JOHNSTONE

Appeal No. 95-4678
Application 08/097,572¹

ON BRIEF

Before COHEN, LYDDANE, and McQUADE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1 through 9, 14 through 22 and 28 through 31. Claims 10 through 13 and 23 through 27, the only other claims pending in the application, stand allowed.

¹ Application for patent filed July 26, 1993. According to the appellants, the application is a continuation of Application 07/591,719, filed October 2, 1990, now abandoned.

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The subject matter on appeal relates to an illuminated exit sign. Claim 1 is illustrative and reads as follows:

1. An exit sign assembly adapted for attachment to an electrical junction box found in a wall or ceiling of a building, comprising:

A. an exit sign housing defining an exit sign housing enclosure therein and including means defining indicia thereon;

B. means on said exit sign housing adapting said exit sign housing for attachment to the electrical junction box;

C. primary illumination means mounted within said exit sign housing enclosure comprising:

i. at least one low voltage primary lamp mounted within said exit sign housing enclosure to fully illuminate said indicia defining means in a uniform manner; and

ii. a primary electric power circuit operationally connected to said at least one low voltage primary lamp for supplying power to said at least one low voltage primary lamp; and

D. emergency illumination means mounted within said exit sign housing enclosure and operationally connected to said primary illumination means to detect failure thereof and thereafter provide auxiliary illumination to said indicia defining means comprising:

i. an emergency power pack housing defining an emergency power pack housing enclosure therein;

ii. at least one low voltage emergency lamp mounted on said emergency power pack housing;

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- iii. an emergency electric power supply located within said emergency power pack housing enclosure and operationally connected to said at least one low voltage emergency lamp for supplying power to said at least one low voltage emergency lamp; and
- iv. an emergency electric power circuit within said emergency power pack housing enclosure for detecting failure of said primary electric power circuit and for switching to said emergency electric power supply.

The references relied upon by the examiner as evidence of obviousness are:

Shine	3,931,689	Jan. 13, 1976
Duncan, British Patent Document	686,796	Jan. 28, 1953

Claims 1 through 9, 14 through 22 and 28 through 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Duncan in view of Shine.

Reference is made to the appellants' main and reply briefs (Paper Nos. 41 and 45) and to the examiner's main and supplemental answers (Paper Nos. 43 and 46) for the respective positions of the appellants and the examiner with regard to the propriety of these rejections. To support their position that

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the subject matter on appeal would not have been obvious within the meaning of 35 U.S.C. § 103, the appellants rely on the 37 CFR § 1.132 declarations and affidavits of record which are listed on pages 17 and 18 in the main brief.

Claims 1 and 20, the two independent claims on appeal, respectively recite an exit sign assembly and kit comprising, inter alia, an exit sign housing defining an exit sign housing enclosure, means on the exit sign housing adapting it for attachment to an electrical junction box, and emergency illumination means mounted (claim 1) or mountable (claim 20) within the exit sign housing enclosure. The emergency illumination means are required to comprise an emergency power pack housing defining an emergency power pack housing enclosure, at least one low voltage emergency lamp mounted on the emergency power pack housing, an emergency electric power supply located within the emergency power pack housing enclosure, and an emergency electric power circuit within the emergency power pack housing enclosure for detecting failure of the primary electric power circuit and switching to the emergency electric power supply. Claim 20 additionally calls for an access plate

mountable on the exit sign housing when the emergency illumination means is not mounted within the exit sign housing enclosure.

Duncan discloses a "lighting unit embodying a secondary lighting system which will function to maintain illumination in the event of a break down [sic] in the main lighting system due either to a failure in the supply current or to failure of the lamp itself" (page 1, lines 12 through 17). As described by Duncan,

[r]eferring first to Fig. 1, there is shown a sign 1 of general box-like form and having a removable front panel 2 which has the words [e.g. EXIT] or matter to be displayed cut out or stencilled [sic] thereon. An angle section strip 3 is fixed within the casing as shown to provide a supporting surface 4 for the lamps, said strip also defining a rear compartment 5 which houses the relay and associated mechanism. A dry battery 6 for operating the secondary lighting system is shown supported on the platform 4 but it will be understood that the battery also may be accommodated in the rear compartment, if desired, or the several components may be arranged in any other convenient manner within the casing.

Referring now to Fig. 2, the primary lighting system is shown as comprising a lamp 7 connected to an A.C. "mains" supply 8 for operation at the mains voltage and, in association therewith, there is provided a low voltage secondary lighting system. . . . The secondary system in this instance comprises two lamps 13, although the number of these lamps may of course vary according to requirements, and to feed these lamps a suitably reduced voltage is taken from the mains through a step-down transformer 14 or, if desired, by a direct drop through a resistance or a

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capacitive or inductive reactor. An alternative source of current is provided by the battery 6, selection of the transformer or battery circuit being effected by a two-way switch 15 actuated by the armature 16 of relay 10 [page 1, line 77 through page 2, line 27].

According to the examiner, the Duncan reference does not meet the limitations in independent claims 1 and 20 noted above because Duncan "does not disclose making the power pack housing in the form of an enclosure or the use of attachment means to secure the sign to a support structure" (main answer, page 4).

Shine discloses an illuminated exit sign assembly comprising a main housing 20, a self-contained auxiliary power supply 22 removably mountable to the top of the housing, and means on the housing for attaching it to an electrical junction box (see column 4, line 64 through column 5, line 24).

In explaining the appealed rejection, the examiner states that

[i]n view of the teachings of Shine it would have been obvious to one in the art to modify [Duncan] by placing an attachment means on the exit sign since this would allow the sign to be attached to a support structure. In view of the teachings of Shine it would have been obvious to one in the art to modify [Duncan] by making the power pack housing in the form of an enclosure since this would allow the power pack housing to be easily attached and removed from the sign housing to allow easy access to the components inside the power pack housing [main answer, page 4].

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The appellants do not dispute the examiner's conclusion that Shine would have suggested providing the Duncan sign with attachment means of the sort recited in independent claims 1 and 20. Indeed, the combined teachings of Duncan and Shine provide ample justification for this conclusion.

The appellants do contend, however, that "the [Duncan]-Shine combination clearly does not teach what is set out in the appellants' claims regarding the emergency battery pack housing defining an enclosure, which houses the electrical components including the battery pack, all within the enclosure of the exit sign housing" (main brief, page 10). In this vein, it is argued that

[i]n attempting to substitute one emergency lighting system for another as is being done in the subject rejection, it is improper to ignore the logical teachings (i.e., mounting a power supply container 35 on the exterior of the exit sign and using a removable cover 36 to permit access to the components (37, 38) in the container 35) found in the applied secondary reference to Shine or to force the Shine teachings into the primary reference. Such improper modifications can only be made with use of impermissible hindsight in view of appellants' own invention [main brief, pages 11 and 12].

This impermissible hindsight argument is well taken. There is nothing in the combined teachings of Duncan and Shine which would have suggested mounting a self-contained emergency power supply or module of the sort disclosed by Shine within the sign

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housing disclosed by Duncan as proposed by the examiner. At best, Shine would have suggested replacing Duncan's emergency lighting system, which is enclosed within the sign housing, with a self-contained emergency power supply or module mounted on the exterior of the housing.

Be this as it may, the combined teachings of Duncan and Shine nonetheless establish a prima facie case of obviousness with respect to the subject matter recited in claim 1, and in claim 9 which depends from claim 1. In this regard, Duncan's secondary or emergency lighting system meets all of the limitations in claim 1 relating to the emergency illumination means. More specifically, Duncan's emergency system is mounted within its exit sign housing enclosure and is operationally connected to the primary illumination system to detect failure thereof and thereafter provide auxiliary illumination. Duncan's angle section strip 3 (see Figure 1), lamps 13, battery 6 and secondary lighting system power circuit (see Figure 2) respectively constitute an emergency power pack housing defining an emergency power pack housing enclosure, at least one low voltage emergency lamp mounted on the emergency power pack housing, an emergency electric power supply located within the emergency power pack housing enclosure and an emergency electric

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power circuit within the emergency powerpack housing enclosure for detecting failure of the primary electric power circuit and switching to the emergency electric power supply as recited in claim 1. As noted above, the appellants do not dispute the examiner's conclusion that Shine would have suggested providing the Duncan sign with attachment means of the sort recited in claim 1. The assembly resulting from this modification meets all of the limitations recited in claim 1. Moreover, since Duncan discloses that section strip 3 is fixed within its sign housing, these two elements are inherently "dimensionally sized so as to prevent relative movement therebetween" as recited in dependent claim 9.

The 37 CFR § 1.132 declarations and affidavits relied upon by the appellants as evidence of non-obviousness are not persuasive with respect to claims 1 and 9. This evidence purportedly establishes that the appellants' invention solves a long felt need in the art and has gained significant commercial success and industry recognition due to its removable emergency power pack module (see pages 16 through 27 in the main brief). Neither claim 1 nor claim 9, however, requires a removable emergency power pack module of the sort discussed in the declarations and affidavits. In other words, the appellants'

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evidence of non-obviousness is not commensurate in scope with the subject matter actually recited in claims 1 and 9. Thus, such evidence fails to outweigh the examiner's reference evidence of obviousness with respect to these claims.

Accordingly, we shall sustain the standing 35 U.S.C. § 103 rejection of claims 1 and 9 as being unpatentable over Duncan in view of Shine.

We shall also sustain the standing 35 U.S.C. § 103 rejection of dependent claims 3 through 6, 16² and 17 as being unpatentable over Duncan in view of Shine since the appellants have not challenged such with any reasonable specificity, thereby allowing these claims to fall with independent claim 1 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

We shall not sustain the standing 35 U.S.C. § 103 rejection of independent claim 20 or of dependent claims 2, 7, 8, 14, 15, 18, 19, 21, 22 and 28 through 31 as being unpatentable over Duncan in view of Shine. Each of these claims contains limitations (e.g., the access plate recitation in claim 20)

² The reference to "said . . . incandescent lamps" in claim 16 lacks a proper antecedent basis. This informality is deserving of correction in the event of further prosecution before the examiner.

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which are not met by Duncan, and which arguably would be met or suggested only if Duncan were modified in view of Shine in the manner proposed by the examiner. As indicated above, however, the only suggestion for combining these references in such a manner stems from hindsight knowledge impermissibly derived from the appellants' own disclosure. Thus, the combined teachings of Duncan and Shine fail to establish a prima facie case of obviousness with respect to the subject matter recited in claims 2, 7, 8, 14, 15, 18 through 22 and 28 through 31.

In summary, the decision of the examiner to reject claims 1 through 9, 14 through 22 and 28 through 31 under 35 U.S.C. § 103 is affirmed with respect to claims 1, 3 through 6, 9, 16 and 17, and reversed with respect to claims 2, 7, 8, 14, 15, 18 through 22 and 28 through 31. Since the basic thrust of our affirmance of the rejection of claims 1, 3 through 6, 9, 16 and 17 differs from that advanced by the examiner in support of this rejection, we hereby designate the affirmance to be a new ground of rejection pursuant to 37 CFR § 1.196(b) in order to provide the appellants with a fair opportunity to react thereto (see In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)).

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Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof 37 CFR § 1.197.

With respect to the new rejection under 37 CFR § 1.196(b), should appellants elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
WILLIAM E. LYDDANE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/097,572

APJ McQUADE

APJ COHEN

APJ LYDDANE

DECISION: AFFIRMED-IN-PART;
37 CFR § 1.196(b)

Typed By: Jenine Gillis

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FINAL TYPED: