

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD L. SIEVERS

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Appeal No. 1996-1577  
Application No. 08/215,205<sup>1</sup>

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ON BRIEF

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Before JERRY SMITH, BARRETT and LALL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed March 21, 1994. According to appellant, this application is a continuation of Application No. 07/988,730, filed December 10, 1992, now abandoned; which is a continuation-in-part of Application No. 07/809,388, filed December 17, 1991, now abandoned.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 2, 5-8, 11-13, 18 and 19. Claims 3, 4, 9, 10, 14 and 15 have been indicated as containing allowable subject matter. Claims 16 and 17 have been canceled. An amendment after final rejection was filed on July 10, 1995. This amendment has not been officially entered, and the entry or nonentry of this amendment has never been communicated to appellant. The appeal brief includes the claims in amended form. The examiner's answer indicates both that the appellant's statement of the status of amendments after final rejection is incorrect [answer, section (2)] and that the copy of the claims contained in the brief is correct [id., section (6)]. Since the noted amendment only makes minor corrections of form to the claims, our decision is not affected by whether or not the amendment has been entered by the examiner.

The disclosed invention pertains to an apparatus for dimming a plurality of parallel connected gas discharge lamps. A complete AC supply voltage waveform is applied to each ballast of the gas discharge lamps upon initial application of

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power or upon momentary interruption of power. The AC supply voltage waveform applied to the ballasts is progressively reduced in response to control signals to act as a dimmer. The reduced AC supply voltage is then applied to each of the lamp ballasts after the control signals are removed.

Representative claim 1 is reproduced as follows:

1. An apparatus for dimming a plurality of parallel connected gas discharge lamps wherein each of said lamps includes a ballast, comprising:

first means in response to a first set of control signals for applying an entire voltage waveform of an AC supply voltage to each ballast of said lamps upon the initial application or the momentary interruption of power to said dimming apparatus;

second means in response to a second set of control signals for progressively reducing said AC supply voltage applied to each of said ballasts from said entire voltage waveform to a minimum portion of each half-cycle; and

means for applying reduced AC supply voltage to each of said ballasts in response to the deactivation of said second set of control signals.

The examiner relies on the following references:

Helmuth	3,944,876	Mar. 16, 1976
Niimi	4,904,998	Feb. 27, 1990



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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 does not fully meet nor render obvious the invention as set forth in claims 1, 2, 5-8, 11-13, 18 and 19. Accordingly, we reverse.

We consider first the rejection of independent claim 1 on the alternative grounds of 35 U.S.C. § 102(b) and 35 U.S.C. § 103 based on Helmuth. With respect to the rejection under 35 U.S.C. § 102, anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to

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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. 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

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

The examiner indicates how he reads claim 1 on the disclosure of Helmuth and, alternatively, why the invention of claim 1 would have been obvious over Helmuth [answer, pages 3-5]. A key portion of the examiner's rejection is based on the examiner's position that several limitations of claim 1 relate to an intended use of the apparatus or to "futuristic" limitations which may not occur. According to the examiner, these claim limitations are not entitled to patentable weight [id., page 5].

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Appellant argues that the apparatus of claim 1 is recited in means plus function form and that the examiner has failed to properly consider the functional language of claim 1 [brief, pages 3-6]. We agree with appellant.

The examiner frequently defines appellant's invention as the application of an entire voltage waveform to a lamp followed by application of a reduced voltage to the lamp and ballast [answer, pages 9 and 12]. This simplistic reduction of appellant's invention ignores some of the limitations clearly set forth in claim 1. The claimed first means must operate both in response to initial application of power to the lamps or in response to a momentary interruption of power to the lamps to provide a specific voltage to each ballast of the lamps as set forth in appellant's specification. We fail to see how Helmuth performs the function of the first means under both conditions as disclosed and claimed. The claimed second means progressively reduces the AC supply to each ballast. Helmuth does not even disclose a plurality of lamps and ballasts. The claimed third means maintains the application of the reduced AC supply voltage even when the signals which initiated the reduction are removed. We fail to

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see how this function is performed in Helmuth using the control signals as defined by the examiner in the rejection.

Thus, we agree with appellant that the examiner has ignored specific language of claim 1 in making the rejections. Since the examiner has not properly considered the scope of independent claim 1, he has failed to establish a prima facie case of anticipation or obviousness. Therefore, we do not sustain the examiner's rejection of independent claim 1 under either

35 U.S.C. § 102 or § 103. Since all the dependent claims depend from claim 1, we also do not sustain the rejection of any of the dependent claims as well based on Helmuth alone. Although the teachings of Niimi or Sievers are additionally applied against claims 7, 8 and 11-13, neither Niimi nor Sievers overcomes the basic deficiencies of Helmuth discussed above. Therefore, we also do not sustain the rejection of these dependent claims under 35 U.S.C. § 103.

In conclusion, we have not sustained any of the examiner's rejections of the claims. The decision of the

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examiner rejecting claims 1, 2, 5-8, 11-13, 18 and 19 is  
reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
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LEE E. BARRETT	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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	)	
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PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	

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