

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLE K. NILSSEN

Appeal No. 1997-2289
Application 08/395,691

ON BRIEF

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

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection¹ of claims 1 to 19, which constitute all

¹An amendment after the final rejection was filed [paper no. 6]. It made no changes to the claims, however, it contained two affidavits questioning the validity of one of the applied references. The Examiner, in advisory action [paper no. 7], commented on the two affidavits as “[i]t is improper for the Examiner to comment on the validity of a patent” citing 35 U.S.C. § 282. This issue is, however, not relevant to this decision.

the claims in the application.

The invention relates to a source operative to provide an AC power line voltage between a pair of power terminals and a control voltage between a control output terminal and one of the power line terminals, the source including a control means to adjust the control voltage and an electronic ballast having input terminals connected with the power line terminals and a control input terminal connected with the control output terminal. The ballast output terminals are connected with a gas discharge lamp. The control circuitry is responsive to the control voltage and functions to control the magnitude of the lamp current supplied to the gas discharge lamp. The invention is further illustrated by the following claim.

1. An arrangement comprising:

a source operative to provide: (i) an AC power line voltage between a pair of power line terminals; and (ii) a control voltage between a control output terminal and one of the power line terminals; the source including a control means operative to effectuate adjustment of the control voltage; and

an electronic ballast having: (i) two power input terminals connected with the power line terminals and one control input terminal connected with the control output terminal; (ii) a set of ballast output terminals connected,

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via a tuned LC circuit, with a gas discharge lamp and operable to supply an alternating lamp current thereto, the frequency of the alternating lamp current being many times higher than that of the AC power line voltage and remaining substantially constant during a complete

period of the AC power line voltage; and (iii) control circuitry responsive to the control voltage and functional to control the magnitude of the lamp current supplied to the gas discharge lamp and thereby the amount of light generated thereby.

The Examiner relies on the following references:

Anderson	4,127,798	Nov. 28, 1978
Stevens	4,277,728	Jul. 7, 1981
Ganser et al. (Ganser)	4,471,269	Sep. 11, 1984

Claim 2 stands rejected under 35 U.S.C. § 112, first paragraph.

Claim 1, 2, 5, 7 to 9, 11 to 13, and 16 to 19 stand rejected under 35 U.S.C. § 102 over Anderson.

Claims 1, 2 and 4 to 7 stand rejected under 35 U.S.C. § 103 over Ganser in view of Stevens.

Claims 3, 4, 6, 10, 14 and 15 stand rejected over Anderson and Stevens.

Rather than repeat the positions and the arguments of

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Appellant and the Examiner, we make reference to the briefs² and the answer for their respective positions.

OPINION

We have considered the rejections advanced by the Examiner. We have, likewise, reviewed Appellant's arguments against the rejections as set forth in the principal brief.

It is our view, after consideration of the record before us, that the rejections under 35 U.S.C. § 112, under 35 U.S.C. § 102 and under 35 U.S.C. § 103 are not proper. Accordingly, we reverse.

We now consider the various rejections.

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner rejects claim 2 by stating that "[n]o support exists for the range of values defined in ... claim 2" [Answer, page 4]. It appears that the Examiner is relying on

²A supplemental brief was filed to merely supply the formal information for compliance with the rules [paper no. 14].

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the written description requirement of the 35 U.S.C. § 112, first paragraph. Appellant illustrates how the claimed limitation in claim 2 is adequately explained by pointing to page 2 of the originally filed specification.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vasilkov-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117

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(Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vasilkov-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

In view of the above guidelines and the Appellant's explanation, we are convinced that the written description requirement is met in this case. Therefore, we do not sustain the rejection of claim 2 under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 102

The Examiner has rejected claims 1, 2, 5, 7 to 9, 11 to 13, and 16 to 19 as being anticipated by Anderson.

We note that a prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d

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1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)).

We take the exemplary claim 1. After considering Appellant's arguments [Brief, pages 4 to 6] and Examiner's position [Answer, pages 4 to 5 and 8 to 9], we are persuaded by Appellant that Anderson does not show all the limitations recited in claim 1. For example, in applying Anderson, the Examiner has ignored the claimed limitation, "the frequency of the alternating lamp current ... remaining substantially constant during a complete period of the AC power line voltage." Therefore, the anticipation requirement is not met by Anderson and we do not sustain the rejection, under 35 U.S.C. § 102, of claim 1 and other independent claims 8, 12 and 17 which each contain the same or corresponding limitation.

For the same reason, we also reverse the anticipation rejection of the respective dependent claims 2, 5, 7, 9, 11,

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13, 16, 18 and 19 over Anderson.

Rejections under 35 U.S.C. § 103

There are two separate groups of claims rejected over two separate combinations of references. However, we first outline the criteria for a rejection under 35 U.S.C. § 103. As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward 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 In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); 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).

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Now we analyze the two groups separately.

Claims 1, 2 and 4 to 7

These claims are rejected over Ganser and Stevens. Take claim 1 as illustrative. We have reviewed Examiner's position [answer, pages 6, 7 and 9] and the Appellant's position [brief, pages 6 to 8] and conclude that the Examiner has ignored some of the claimed limitations. For example, neither Ganser nor Stevens, singly or in combination, show the claimed limitation, "the frequency of the alternating lamp current ... remaining constant during a complete period of the AC power line voltage." Therefore, we do not sustain the obviousness rejection of claim 1 and its dependent claims 2 and 4 to 7 over Ganser and Stevens.

Claims 3, 4, 6, 10, 14 and 15

These claims are rejected over Anderson and Stevens. They variously depend on independent claims 1, 8 and 12 discussed above under 35 U.S.C. § 102 over Anderson. By virtue of their dependence on said independent claims, they each contain, besides other limitations, the claimed limitation, "the frequency of the alternating lamp current ...

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remaining substantially constant during a complete period of the AC power line voltage." We already noted above that Anderson does not disclose that limitation. We find that the additional reference, Stevens, does not cure the noted deficiency of Anderson. Therefore, we do not sustain the obviousness rejection of 3, 4, 6, 10, 14 and 15 over Anderson and Stevens.

In conclusion, we reverse the Examiner's final rejection of claim 2 under 35 U.S.C. § 112, first paragraph. We also reverse the rejection claims 1, 2, 5, 7 to 9, 11 to 13, and 16 to 19 under 35 U.S.C. § 102. Further, we reverse the rejection under 35 U.S.C. § 103 of claims 1, 2 and 4 to 7, and claims 3, 4, 6, 10, 14 and 15.

REVERSED

JERRY SMITH)
Administrative Patent Judge)
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) BOARD OF PATENT
MICHAEL R. FLEMING)
Administrative Patent Judge) APPEALS AND

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