

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOM DENEDIOS

Appeal No. 1997-3179
Application No. 08/244,286¹

ON BRIEF

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

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed May 23, 1994. According to the appellant, the application is a continuation of Application 07/951,396, filed September 25, 1992, now abandoned.

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This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 16-22, which represents all of the claims remaining in the application. In an Amendment after Final (paper number 10), claims 17 and 18 were canceled. Accordingly, claims 16 and 19-22 remain before us on appeal.

The invention pertains to an electrical circuit and a method for filtering radio frequency interference (RFI) from telecommunication circuits. More specifically, the claimed invention comprises a pair of inductor circuits with each inductor circuit having a lead connected respectively to tip and ring leads of telephone circuitry. The opposite end of each inductor circuit is connected to a respective coil either of a transformer, or, as noted in an alternative embodiment, a ferrite-core inductor.

Claims 16 and 19 are illustrative of the claimed invention, and they read as follows:

(16) A method of suppressing longitudinally-conducted radio frequency interference in voice frequency loops having two circuit branches consisting of inserting in series in each of the branches a first inductor coupled with a second ferrite-core inductor.

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(19) A filter for suppressing longitudinally-conducted radio frequency interference in voice frequency loops consisting of:

a first inductor;

a second inductor; and

a transformer having a first winding and

a second winding; wherein said first inductor and said first winding of said transformer are coupled in series and said second inductor and said second winding of said transformer are coupled in series.

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

Weissner	2,144,950	Jan. 24, 1939
Hale	2,362,549	Nov. 14, 1944
Pontius	2,621,252	Dec. 9, 1952
Hudson, Jr.	3,987,380	Oct. 19, 1976
Kane	4,614,925	Sep. 30, 1986

Claims 16 and 19-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weissner in view of Kane or Hale.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 19, mailed March 31, 1997) for the examiner's reasoning in support of the rejections, and the appellant's brief (Paper

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No. 17, filed February 12, 1997) for appellant's arguments thereagainst.

OPINION

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

The obviousness rejection of claims 16 and 19-22 is reversed.

Turning to the rejection of claims 16 and 19-22, the examiner recognizes (Answer, page 4) that the difference between the claimed invention and Weissner is:

Weissner presents (condensers) capacitor[s] connected to ground which are essential to eliminate high frequency from the incoming signal, the claims presented eliminate the capacitor component by closed ended language "consisting," however, there is inherently distributed capacitance present between the conductors of the circuit (electrodes/connections) and the tip and ring line conductors as well as between the turns of the coil(s).

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The examiner goes on to reason that Kane teaches the use of distributed capacitance inherent in line transmission systems and Hale teaches the use of distributed capacitance inherent in the inductors of a line transmission filter. Based on these auxiliary teachings, the examiner concludes (Answer, page 5) that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to eliminate the condensers (capacitors) taught by Weissner for reducing high frequency signals... for the reason of eliminating parts count and thus cost of product....

In response, the appellant argues that his invention would not have been suggested by the cited references. Stated differently, appellant appears to be arguing that the examiner has resorted to hindsight in reconstructing the prior art to demonstrate the obviousness of the claimed invention. In support thereof, the appellant (Brief, pages 4-5) points to the fact that both Hale and Kane require the inclusion of a capacitor device to obtain the necessary control and make their respective inventions functional.

In rebuttal, the examiner maintains the position (Answer, page 7) that Kane and Hale teach that there are inherent

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distributed capacitances that exist in line transmission systems. The examiner further maintains that Kane teaches using the distributed capacitance to determine equivalent impedances and capacitances inherently within the lines in order to effectively filter undesired frequencies. It is not entirely clear from the record what the examiner gleaned from the disclosures of Kane and

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Hale that would lead the examiner to the conclusion that it would have been obvious to one skilled in the art to eliminate the capacitors in the circuit of Weissner.

In view of the respective positions noted above, we are in general agreement with the appellant that the cited references relied upon by the examiner neither teach nor would have suggested appellant's claimed invention. We note that claim 16 requires "...two circuit branches consisting of inserting in series in each of the branches a first inductor coupled with a second ferrite-core inductor." (emphasis added). Accordingly, claim 16 specifically excludes all elements other than a first inductor coupled in series with a second ferrite-core inductor in each of the two circuit branches. Like the examiner, we note that Weissner fails to meet the limitations of claim 16 because Weissner includes, *inter alia*, condensers (capacitors shown as elements 5 and 6) in the two circuit branches. Quite the contrary, Weissner goes so far as to require (column 2, lines 9-11) the presence of condensers in the circuit branches for the purpose of short-circuiting or suppressing high frequencies.

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Neither Hale nor Kane corrects the deficiency noted above in Weissner because neither Hale nor Kane expressly teaches eliminating capacitors in branch circuits or recognizes any

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benefit that would be derived from doing so. More compelling is the fact that page 3, lines 22-25, of appellant's specification teaches that the two ferrite-core inductors form the second stage of the filter and function to suppress high frequency (RFI). Therefore, assuming *arguendo* that it would have been obvious to one skilled in the art to eliminate the capacitors from the invention of Weissner, the remaining circuit of Weissner would be incapable of suppressing high frequencies because Weissner's circuit requires condensers (capacitors) to suppress the high frequencies.

Consequently, we reverse the examiner's rejection of claims 16 and 19-22 because (1) the examiner's rejection fails to point to some teaching, suggestion, or motivation found either in the prior art relied upon or in knowledge generally available to one of ordinary skill in the art that supports eliminating the capacitors from the circuit of Weissner; ***In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Jones**, 958 F.2d 347, 351, 21 USPQ2d 1941, 1943-4 (***Fed. Cir. 1992***); and (2) removing the capacitors from the circuit taught by Weissner

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renders the circuit inoperable for its intended purpose of short-circuiting or suppressing high frequencies. ***In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).***

Appellant's final argument (Brief, page 4) is that the rejection of claims 16 and 19-22 under section 103 was presented for the first time in the second Office Action was based upon two references not relied upon in the previous Office Action. Based on the above, the appellant believes that the arguments and affidavit submitted in response to the final rejection should be considered in this matter. It appears that the appellant is questioning the propriety of the examiner's final rejection. Questions regarding the propriety or prematureness of the examiner's final rejection are petitionable to the Commissioner under 37 CFR 1.181, rather than appealable to the Board of Patent Appeals and Interferences under 37 CFR 1.191. Therefore, we do not have jurisdiction over the propriety of an examiner's action being

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made final. See M.P.E.P 706.07(c). Thus, we can not consider
appellant's affidavit.

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In short, we cannot sustain the examiner's obviousness rejection of claims 16 and 19-22 based on the combined teachings of Weissner in view of Kane or Hale.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
MICHAEL R. FLEMING)	
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APJ FLEMING

APJ JERRY SMITH

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: July 21, 2000

Draft Final

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OB/HD GAU

PALM/ACTS 2/BOOK
DISK(FOIA)/REPORT