

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(2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte H. JOSEPH ENGEL

Appeal No. 98-0344
Application 90/004,211¹

HEARD: Sep. 16, 1998

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

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Reexamination proceeding for U.S. Patent No. 4,623,823 issued November 18, 1986, to Herman J. Engel, and based on application 06/795,228, filed November 5, 1985, which is a continuation of application 06/534,082, filed September 20, 1983, now U.S. Patent No. 4,570,105, issued February 11, 1986. Reexamination request filed April 9, 1996.

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This is a decision on appeal from the final rejection of claims 1 through 15 and 19 through 24 in this reexamination proceeding of U.S. Patent No. 4,623,823. Claims 16 through 18 have been confirmed.

The invention is directed to a fluorescent lamp adapter assembly for an incandescent lighting fixture.

Representative independent claim 1 is reproduced as follows:

1. A fluorescent lamp adapter assembly for an incandescent lighting fixture means, comprising:

(a) a hollow housing;

(b) a base member associated with and extending from an end of the housing, and including means for establishing electrical interconnection with the incandescent lighting fixture means;

(c) a cover member associated with and extending from another end of the housing, and including means for establishing electrical interconnection with the fluorescent lamp and retaining means adapted to retain the fluorescent lamp within the adapter assembly; and

(d) an essentially toroidally shaped ballast means located within the housing and between the base member and cover member, and electrically associated in series between the electrical interconnection establishing means of the base and cover members, thereby permitting use of a fluorescent lamp in place of an incandescent light source.

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The examiner relies on the following references:

Rogers	2,505,993	May 2, 1950
Haraden et al. (Haraden)	4,405,877	Sep. 20, 1983
Young	4,414,489	Nov. 8, 1983 (filed Nov. 4, 1981)
Mollet et al. (Mollet)	4,426,602	Jan. 17, 1984 (filed May 29, 1981)
Wang	4,490,649	Dec. 25, 1984 (filed Oct. 20, 1982)
Thomson (UK)	731,500	Jun. 8, 1955
Kerekes (UK)	2,092,831	Aug. 18, 1982

Claims 1 through 15 and 19 through 24 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Rogers, Wang and Kerekes with regard to claims 1, 2, 4 through 14, 19, 20 and 22 through 24, adding Mollet to this combination with regard to claims 22 and 23 and adding Thomson to the original combination with regard to claims 3 and 21. With regard to claim 15, the examiner cites Rogers, Wang and Kerekes in view of either one of Young or Haraden.

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Rather than reiterate the many arguments of appellant and the examiner, reference is made to the briefs and answers for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner, the arguments in support of the rejections and the evidence of obviousness relied upon by the examiner as support for the prior art rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the answers as well as the evidence submitted by appellant, in the form of five declarations as attachments to the principal brief, in support of nonobviousness.

It is our view that the examiner has set forth a prima facie case of obviousness with regard to the instant claimed subject matter and that prima facie case has not been successfully rebutted either by appellant's arguments or by the declarations submitted alleging secondary considerations

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of nonobviousness. We have reconsidered the instant claimed subject matter as a whole in view of the totality of the circumstances indicated by the declarations' allegations of long-felt need, commercial success, surprising results, etc. but it is our view that the examiner's rejections of the claims was proper.

Initially, we note that appellant has grouped the claims into two groups for purposes of this appeal (See page 6 of the principal brief): Group 1 consists of claims 1, 2, 4 through 15, 19, 20 and 22 through 24, and, with respect to this group, appellant directs the argument to the essentially toroidally shaped ballast means. Group 2 consists of claims 3 and 21 and, with respect to this group, appellant directs the argument to an essentially toroidally shaped ballast means with a longitudinal gap.

Turning first to the rejection of claims 1, 2, 4 through 15, 19, 20 and 22 through 24, the examiner contends that Rogers teaches the claimed subject matter but for the specifics of how Rogers' reactor (ballast) is situated inside the hollow housing and cover, although the examiner contends

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that there must be an opening (unshown) large enough through which to place the reactor, and the particular characteristics of the reactor (i.e., whether it is "essentially toroidally" shaped). The examiner also recognized that Rogers was silent as to the cover member having a truncated generally conical shape.

The examiner employed Wang to show the obviousness of employing the claimed cover having a generally conical shape (claims 6-9) and the examiner employed Kerekes for the teaching of the "essentially toroidally shaped ballast means," concluding that it would have been obvious, within the meaning of 35 U.S.C. § 103, to have combined the teachings of the references in such a manner as to arrive at the claimed subject matter. We agree.

The main issue focuses on whether Kerekes does, indeed, teach an "essentially toroidally shaped ballast means," as claimed. While Kerekes clearly teaches that the impedance unit 7 (Kerekes' ballast) is "preferably annular or cup shaped," has "an internal annular bore" and that an inductor

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within the ballast is "a toroidal coil," appellant contends that the ballast means of Kerekes is simply not the instant claimed ballast means and that Kerekes would not have suggested the claimed "essentially toroidally shaped ballast means" to the skilled artisan.

Initially, appellant cites In re Donaldson, 16 F.3d 1189, 29 USPQ2d 1895 (Fed. Cir. 1994) for the proposition that one must look to the specification and interpret the claim language "essentially toroidally shaped ballast means" in light of the corresponding structure, and equivalents thereof. It is appellant's position that if we do this, the claimed toroidally shaped ballast means clearly distinguishes over the ballast taught by Kerekes since the former has a plurality of wire coils which are wound spirally along a toroidally shaped core.

First, we are unconvinced that Kerekes does not teach a plurality of wire coils wound spirally along a toroidally shaped core. The vertical lines shown within the ballast element 7 in Kerekes would appear to indicate that Kerekes does teach wire coils wound spirally along a toroidally shaped

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core. But, in any event, we do not agree that Donaldson is applicable in the instant case. The appropriate portion of that decision involved the application of 35 U.S.C. § 112, sixth paragraph, to "means plus function" language. We do not find such "means plus function" language in the instant claims. For example, instant claim 1 calls for "an essentially toroidally shaped ballast means" but there is no particular function recited. While the claim further recites, "...thereby permitting use of a fluorescent lamp in place of an incandescent light source," this does not result, in our view, in such "means plus function" language as to invoke Donaldson. Rather, the claim recites a definite structure, i.e., a toroidally shaped ballast means, which permits the substitution of a fluorescent lamp for an incandescent lamp. Merely because a named element of a patent claim is followed by the word "means" does not automatically make that element a "means plus function" element under the sixth paragraph of 35 U.S.C. § 112. Cole v. Kimberly-Clark Corp., 102 F.3d 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996).

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Since we find that the claim language "toroidally shaped ballast means" does not constitute "means plus function" language, we need not resort to the sixth paragraph of 35 U.S.C. § 112 to determine the corresponding structure described in the specification. Accordingly, we find no need to give the claimed phrase "toroidally shaped ballast means" any more meaning than the simple, direct claim language implies.

Kerekes clearly discloses, at element 7, "an essentially toroidally shaped ballast means," as claimed. Note the "toroidal coil" recited at column 3, line 62, the "annular coil" recited at column 5, line 47 and the "toroidal or a polygonal coil" in claim 9 of Kerekes.

Appellant argues that at least some embodiments of Kerekes' device include a coiled capacitor. However, there is nothing in the instant claims which would preclude a coiled capacitor. Further, while appellant points to declarations by Messrs. Miller and Scott which contend that nothing in Kerekes would have suggested to them that Kerekes used the phrase "toroidal coil" to mean a spiral wrapping of wire coils around

the outside of a toroidal core, as explained supra, the instant claims do not require such limitations but for claim 3, which requires spiral, wound tape laminations and a plurality of windings toroidally applied to the core but appellant does not argue the spiral, wound tape "laminations" limitation, while Kerekes apparently does teach a plurality of windings toroidally applied to the core (note element 7).

Appellant further cites the Miller and Scott declarations for the proposition that the Kerekes toroidal coils should be construed to mean "air-core" toroidal coils which do not have an iron core or ring-shaped coils which do have an iron core. However, we find no reason to so narrowly construe the toroidal coil of Kerekes based on Kerekes' recitation of a broader "toroidal coil." Moreover, we note that the instant claims do not preclude "air-core" toroidal coils in view of our finding that the sixth paragraph of 35 U.S.C. § 112, construing the claimed limitations as covering only the corresponding disclosed structure and its equivalents,² is not

² In any event, it is our view, after consideration of all the evidence before us, that the toroidal core of Kerekes

invoked here since the claims are not in "means-plus-function" format.

Appellant makes reference to a U.S. Patent by Kerekes and concludes from reference thereto that the applied Kerekes reference was really describing an "air-core" toroidal coil. The relevance of the U.S. Patent to Kerekes to the Kerekes reference applied against the claims is dubious since the applied Kerekes appears to offer a full disclosure in itself and there is no indication that the two references do not, in fact, describe two very different, albeit somewhat related, devices.

We would also note, as an aside, that, contrary to allegations by appellant's representative, at the hearing of September 16, 1998, that the U.S. Patent to Kerekes does not constitute "prior art" against the instant claims, U.S. Patent No. 4,546,290 to Kerekes certainly does constitute "prior art," within the meaning of 35 U.S.C. § 102, since its

is certainly an "equivalent" of the disclosed structure, the disclosed structure described in column 6 of the patent under reexamination. Clearly, the ballast 7 of Kerekes provides for an annular region, the space therein providing the longitudinal gap, a cylindrical core and a number of windings applied to the core.

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effective filing date of April 27, 1982 (the filing date of the parent U.S. patent application of which it is a continuation) is prior to the effective filing date (September 20 1983) of the instant application. Moreover, while we do not enter a new ground of rejection because, in our view, the U.S. Patent to Kerekes is merely cumulative to that taught by the applied Kerekes reference, the U.S. Patent to Kerekes would also appear to be applicable to the instant claims since, as noted supra, the claims do not preclude "air-core" toroidal coils.

For all of appellant's protestations and arguments regarding what is disclosed, definitions of "toroidal coil," statements regarding air-cores and iron cores, etc., the simple fact is that the claims, e.g. claim 1, call for, simply, a ballast (which is just what Kerekes' impedance element 7 is) which is "essentially toroidally shaped." There can be no question that element 7 in Kerekes is "essentially toroidally shaped."

Appellant makes the argument that because the instant device is more expensive to manufacture and, yet, still sells

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regardless of its higher cost because of its longer life and efficiency, this is evidence of nonobviousness. This argument which can be classified as commercial success in spite of higher cost is alleged to be evidenced by the Miller and Scott declarations.

Mr. Miller states that since "a trend in the industry was to build cheaper adapters, not more expensive ones such as the Engel adapter" he and others of ordinary skill would have been led "to experiment with different inexpensive toroidal coil configurations, not the expensive ballast in the Engel adapter" [Miller, paragraph 22]. Mr. Scott states that "[b]ecause the adapter lasts longer and is more efficient, the belief was that customers would be willing to pay more for these features" [Scott, paragraph 9]; that, in fact, "I have found that...customers are willing to pay a higher amount for the Engel adapter's unique advantages" [Scott-paragraph 11] and that he, too, would have been led by Kerekes to "experiment with different inexpensive toroidal coil configurations" [Scott-paragraph 16].

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We are unpersuaded by the Scott and Miller declarations in this regard. To the extent that they purport to provide evidence of commercial success of the instant invention, there is no evidence of record that any such success is due to the instant invention, *as claimed*. A nexus is required between the merits of the claimed invention and the evidence offered, if that evidence is to be given substantial weight en route to a conclusion on the obviousness issue. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1539, 218 USPQ 871, 879 (Fed. Cir. 1983). The term "nexus" is often used to designate a legally and factually sufficient connection between the proven success and the claimed invention, such that the objective evidence should be considered in the determination of obviousness. Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 1392, 7 USPQ2d 1222, 1226 (Fed. Cir.), cert. denied, 488 U.S. 956 (1988). Of course, the burden is on appellant to establish a prima facie case of nexus. Ex parte Remark, 15 USPQ2d 1498, 1504 (Bd. Pat. App. & Int. 1990).

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We find no evidence provided by the declarations of any commercial success since there is no information provided as to sales dollar amounts, the number of sales, or a comparison of the sales of the device covered by the instant patent with competitive devices. Furthermore, there is no evidence that any such commercial success is due to the invention, as *claimed*. Exactly what limitations in the claims are alleged to be the cause of the commercial success? If it is the specific structure of the toroidal coil, the claims only require an "essentially toroidally shaped ballast means" which is clearly shown by Kerekes, as broadly claimed. Therefore, giving all due weight to the declarations of commercial success as well as other secondary indicia, such as long-felt but unsolved need, the objective evidence of nonobviousness does not render the claimed invention unobvious or patentable when all of the evidence before us is taken into account.

While declarants contend that they would not have been led to experiment with more expensive toroidal coil configurations when the trend was toward cheaper configurations, this is irrelevant to the instant claimed

invention since the cost of the instant configuration forms no part of the instant claims.

At page 14 of the principal brief, appellant argues that the Wang reference does not describe a toroidally shaped ballast of any sort and that Wang "does not teach or suggest the use of replaceable fluorescent lamps which can be separately obtained and then combined with the compact adapter described in the '823 patent." However, Wang is not employed by the examiner for a teaching of a toroidally shaped ballast. The examiner cited Kerekes for such a teaching. With regard to a suggestion of replaceable fluorescent lamps separately combined with the adapter, appellant has failed to point to any specific claim limitation to which this argument relates.

Appellant also argues that the combination of Rogers, Kerekes and Wang is improper and cites the Scott and Miller declarations for the statements [Miller-paragraph 26; Scott-paragraph 20] that the combination of these references would not have taught the declarants to spirally wrap wire coils along a toroidal core to create a compact fluorescent lamp adapter. Again, appellant does not identify the specific

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claim to which he refers. Independent claim 1, for example, does not require spirally wrapped coils along a toroidal core. Moreover, however technically competent these declarants may be, and we don't doubt their impressive credentials for a minute, conclusions of obviousness, within the meaning of 35 U.S.C. § 103, are legal conclusions. Declarations, such as the ones of record in the instant record, are meant to present facts. They are not meant, nor are they persuasive, to present legal conclusions. Nor is there any indication that declarants are, indeed, qualified to make such determinations. We reach our conclusion of obviousness from a consideration of all the evidence before us, including, inter alia, the facts set forth by the declarants.

Citing the Miller [paragraph 8], Scott [paragraph 5] and Calleo [paragraph 10] declarations, appellant contends that the use of an essentially toroidally shaped ballast means was contrary to conventional wisdom in the fluorescent lamp adapter industry. However, while giving the evidence provided by the declarations due consideration, when the evidence of record, as a whole, is taken into consideration, as we must do

in reaching a conclusion of obviousness/nonobviousness, we do not find that the use of an essentially toroidally shaped ballast means was contrary to conventional wisdom when Kerekes clearly teaches such a toroidally shaped ballast means, as broadly set forth in the claims.

At pages 15 through 18 of the principal brief, appellant describes differences between the toroidally shaped ballast means, as intended by appellant, and the prior art by depicting how the magnetic flux configuration differs between the two. However, again, it is not clear exactly what specific claim limitations are relied upon to distinguish the magnetic flux configuration of the instant invention from that of the prior art. Further, it is not clear where this magnetic flux configuration is disclosed in the instant specification.

With regard to claim 15, appellant argues that the recitation of the base member of the adapter capable of rotation relative to the adapter's housing distinguishes over the prior art. The examiner cites either one of Young or Haraden for such a teaching.

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We do agree with appellant that the application of Young appears to be in error. We are not persuaded by appellant's argument that Young requires removal of the ballast housing from the base so that it is no longer in electrical or mechanical contact because claim 15 does not require continuous electrical or mechanical contact. However, once the bulb, the ballast module 28 and the base 33 are connected, we do not consider the base member 33 to be "capable of rotation" relative to the housing. It appears that as the base member is screwed into the incandescent-type socket, the base housing 28 turns with the base member. Therefore, there is no "relative rotation" between the two elements. Accordingly, we will not sustain the rejection of claim 15 under 35 U.S.C. § 103 based, in part, on Young.

However, the alternative reference applied by the examiner in this regard is Haraden and we will sustain this rejection.

As indicated in column 2, lines 26-28 of Haraden, there is a clear relative rotation between the base 34 and lower part 36 which is contiguous with body 14 wherein the ballast

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is located. Appellant argues that Haraden is nonanalogous art. We disagree. Haraden is clearly within the same field of endeavor, i.e., fluorescent lamp adapters permitting fluorescent lamps to be used in incandescent lamp sockets, as appellant's device. While appellant argues that Haraden is not a "compact" device, we do not find this to be a requirement of claims 1 and 15 nor do we find such a relative term as "compact" as imparting any distinction between the instant device and what is shown in Haraden.

With regard to the rejection of claims 22 and 23, these claims add the limitation of the starter housing extending into the interior of the cylindrical area defined by the ballast means. The examiner cites Mollet to show a starter 13 situated in a sleeve-shaped wall portion and combines this with the other references in a manner which clearly suggests that artisans would have placed a starter in a walled portion which would then have been inserted into the longitudinal gap of the toroidal coil in Kerekes. Appellant's response [principal brief-page 21] is to contend that Mollet does not show the use of a lamp starter located in the center of a

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toroidally shaped ballast means. This is true but the rejection is based on a combination of references, not Mollet alone. Similarly, the argument that Kerekes does not show a starter in the central cavity is not persuasive since the rejection is based on a combination of references. Accordingly, appellant's arguments with regard to claims 22 and 23 are not persuasive.

With regard to claims 3 and 21, appellant contends that Thomson does not teach or suggest the claimed "longitudinal gap." More specifically, Thomson is directed to transformers, not lighting adapters. We agree with appellant with regard to Thomson, but we will still sustain the rejection because the longitudinal gap is clearly taught in Kerekes by the gap, or internal annular bore of impedance unit 7, through the center of the toroidal coil, the Thomson reference being unnecessary to the rejection.

While we have carefully considered each and every one of the submitted declarations of Messrs. Calleo, Miller, Scott, Engel and King, we find the evidence provided therein to be unpersuasive of nonobviousness since the statements provided

therein relative to long-felt but unsolved need, failed attempts by others, initial skepticism followed by praise and commercial success are not connected in any way to specific claim limitations. Therefore, we find it difficult to draw a nexus between the claim limitations relied upon and the secondary indicia of nonobviousness proffered by appellant.

At pages 30-31 of the principal brief, appellant argues that there is evidence of nonobviousness in the acquiescence of competitors in the validity of the Engel patent. However, we find no objective evidence that would lead to this conclusion. For example, appellant cites a few lawsuits and conflicts in which the patent under reexamination was the subject and states that Kerekes was discovered in one such lawsuit but concludes that since, in each of those conflicts, appellant succeeded in licensing the adversary where the adversary desired to continue manufacturing the infringing device, competitors have deemed the patent valid. We are unpersuaded of the probative value of the licensing agreements. While no details of the settlements are given, it may very well be, for example, that the competitors decided,

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for business and/or financial reasons, not to pursue the lawsuit and/or that it would be in their financial interest to merely license rather to fight. The decision not to pursue a lawsuit may be dictated by many factors other than an acquiescence in the validity of the licensed patent. Appellant has not provided us with enough facts on which we can make a determination in this regard. In any event, we cannot conceive of any relevance of a competitor's decision to license to the legal determination of obviousness.

CONCLUSION

We have sustained the rejection of claims 1 through 15 and 19 through 24 under 35 U.S.C. § 103. While we have reversed the rejection of claim 15 based on Rogers, Wang, Kerekes and Young, we have sustained the alternative rejection of claim 15 based on Rogers, Wang, Kerekes and Haraden. Accordingly, the examiner's decision is affirmed.

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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

	Kenneth W. Hairston)	
	Administrative Patent Judge)	
)	
)	
)	
	Errol A. Krass)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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