

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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERRINGTON JOHN ENTERPRISES, LTD.,
A Corp. of Canada

Appeal No. 98-1496
Reexamination Control No. 90/004,292¹

ON BRIEF

Before BARRETT, FLEMING and CARMICHAEL, ***Administrative Patent Judges.***

CARMICHAEL, ***Administrative Patent Judge.***

DECISION ON APPEAL

¹ Application for patent filed June 28, 1996. According to appellants, this application is a Reexamination of Application 07/786,451 filed November 1, 1991, now Patent No. 5,311,100 issued May 10, 1994.

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This is an appeal from the Final Office action in Reexamination No. 90/004,292. Claims 2-8, 10-13, and 15-20, which constitute all the remaining claims stand rejected.

Claim 16 reads as follows:

16. A survival lamp unit for mounting to a flotation device above and in proximity to the water line, said survival lamp comprising:

a hermetically sealed light transmissive housing;

a light source mounted in said housing;

a battery mounted in said housing, said battery being electrically connected to said light source for supplying electrical energy thereto; and

a water-responsive actuator in an electrical path that connects said battery and said light source for controlling an operation of said light source, said actuator including a sensing element extending outside said housing, said actuator being responsive to a momentary contact between said sensing element and a coherent body of water to actuate said light source during an operative cycle continuing over a predetermined time period that largely exceeds a duration of said momentary contact, and including means for initiating a new operative cycle by a subsequent momentary contact between said sensing element and a coherent body of water irrespective of whether said subsequent momentary contact occurs during or subsequent to a prior operative cycle.

The examiner's Answer cites the following prior art:

Horino
1966

3,278,921

Oct. 11,

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Millen 1983	4,408,193	Oct. 4,
Hutton (England) 28, 1944	566,409	Dec.
Tsumaki (Japanese) 1982	57-87788	June 1,

OPINION

This appeal involves three grounds of rejection: **(1)** claims 11-13 stand rejected under 35 U.S.C. § 103 as unpatentable over Tsumaki in view of Hutton, Millen, and Haran;² **(2)** claims 17 and 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

² The examiner apparently intends this rejection to apply to any claim still dependent on claim 1. Final Rejection (Paper No. 11) at 14, lines 3-5; Examiner's Answer at 3, lines 3-8. This includes claims 11-13. By an apparent inadvertence, only claims 12 and 13 were mentioned in the statement of the grounds of rejection in the final office action or in the Examiner's Answer. We note appellant's concession that "[a]ll claims have been rejected. Applicant withdraws the rejection of claims 11-13 from appeal". Appeal Brief at 2, lines 2-4. In view of appellants' failure to dispute the obviousness rejection, we will treat this rejection as also applying to claim 11 as in the first Office Action (Paper No. 7) at 1, lines 8-10.

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which applicant regards as the invention; and **(3)** claims 2-8, 10, and 15-20 stand rejected under 35 U.S.C. § 305 as enlarging the scope of a claim of the patent.

(1) Obviousness

Appellants do not contest the obviousness rejection. Therefore, we will sustain the rejection of claims 11-13 under 35 U.S.C. § 103.

(2) Indefiniteness

Claims 17 and 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. We will address claims 17 and 18 separately.

Claim 17 stands rejected for indefiniteness because according to the examiner the following two recitations conflict with each other: "upon expiration of said predetermined time period said water-responsive actuator deactivating said light source;" and "responsive to a subsequent momentary electric path established between said

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terminals through a coherent body of water to reactivate said light source for a subsequent predetermined time period irrespective of whether said light source is operating at the time of said subsequent momentary electric path."

We agree with appellants that in light of the description of the invention, one skilled in the art would clearly recognize that if reactivation occurs during a prior interval, the end point for the prior interval is negated, the light remaining on until the termination of the subsequent interval. Appeal Brief at 17. Thus, this rejection of claim 17 will not be sustained.

Claim 18 stands rejected for indefiniteness because according to the examiner it cannot be determined what "a previous determined time period" is or what it refers to. According to appellants, that recitation is clearly referring to "said predetermined time period." Appeal Brief at 18.

We agree with the examiner. In the context of claim 18, it is not clear that "a previous determined time period" refers to "said predetermined time period." We find that "a previous determined time period" could be considered to be any previous determined time period whereas "said predetermined

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time period" is a specific time period. If appellants mean "said predetermined time period," the claim should say so.

Thus, the rejection under 35 U.S.C. § 112, second paragraph, will be sustained as to claim 18 but not as to claim 17.

(3) Broadening

Claims 2-8, 10, and 15-20 stand rejected under 35 U.S.C. § 305 as enlarging the scope of a claim of the patent. These claims all permit the claimed emergency lamp to be continuously illuminated during overlapping time periods.

According to the examiner, all of the originally patented claims were narrower in that they required the lamp to be turned off at the end of a first predetermined time period, before an additional time period of lamp operation could commence. Appellants argue that patented claim 1 did not have that limitation. According to appellants, patented claim 1 permitted the termination associated with a first operative cycle to be overridden by initiation of a new operative cycle. Appeal Brief at 7.

We agree with appellants.

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The disclosed emergency lamp remains on continuously beyond the termination of the first operative cycle if a new operative cycle is initiated during the first. See column 3, lines 25-64; and column 6, lines 54-61. One skilled in the art reading patented claim 1 in light of the specification would find that claim 1 permitted such overlapping.

Because claims 2-8, 10, and 15-20 in this reexamination are no broader than a claim in the patent, their rejection under 35 U.S.C. § 305 is not sustained.

CONCLUSION

The rejection of claims 11-13 under 35 U.S.C. § 103 is sustained. The rejection under 35 U.S.C. § 112, second paragraph, is sustained as to claim 18 but not as to claim 17. The rejection of claims 2-8, 10, and 15-20 under 35 U.S.C. § 305 is not sustained.

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

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Administrative Patent Judge)	APPEALS AND
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