

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES M. MOSKOWITZ
and ROGER Q. SMITH

Appeal No. 1999-1930
Application 08/907,859

ON BRIEF

Before FLEMING, RUGGIERO and DIXON, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-16.

The invention relates to a battery recharging system which enables charging of an extra or stand alone battery as well as a removable battery within a flashlight. The invention provides indicators to inform the user if one or both batteries are in a charging mode. Also, the invention provides an indicator to inform the user that a power failure is present. During a power outage, the flashlight with battery, if connected to the charger, is illuminated so that it is readily available to the user.¹

¹ See page 1 of the specification.

Independent claim 1 is as follows:

1. A battery charger comprising:

a housing;

a first receptacle in said housing for receiving a first rechargeable battery;

a second receptacle in said housing for receiving a flashlight including a rechargeable battery;

a first electrical contact for electrically cooperating with said first rechargeable battery;

a second electrical contact for electrically cooperating with the flashlight rechargeable battery;

a charging circuit, said charging circuit including:

a first charging circuit for charging the first battery, said first charging circuit to indicate charging;

a second charging circuit for charging the flashlight battery, said second charging circuit to indicate charging;

a first power outage circuit including an indicator to indicate a power loss; and

a second power outage circuit for illuminating the flashlight bulb when power loss occurs.

The Examiner relies on the following references:

Sherwood	3,217,156	Nov. 9, 1965
Keiper	4,563,629	Jan. 7, 1986
Dormer et al. (Dormer)	5,578,875	Nov. 26, 1996

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Claims 1-16 are rejected under 35 U.S.C. § 103 as being unpatentable over Dormer in view of Sherwood and Keiper. Appellants have indicated that claims 1-16 stand or fall together.

Rather than reiterate all arguments of Appellants and the Examiner, reference is made to the briefs and answer for the respective details thereof.²

OPINION

We will not sustain the rejection of claims 1-16 under 35 U.S.C. § 103.

On page 5 of the answer, the Examiner discusses motivation to combine the teachings of Dormer, Sherwood, and Keiper. The Examiner asserts that it would have been obvious to provide “the battery charger of Dormer with the teaching of Sherwood in order to provide a flashlight with a backup battery and power outage illumination so that the flashlight can be found when power fails and other sources of illumination are unavailable . . . [and] . . . to provide the indication teachings of Keiper . . . in order to provide a visible indication when the batteries are being charged and when they can not be charged due to power failure.”

Appellants traverse the rejection of claims 1-16 by asserting that neither Sherwood nor Keiper teaches or suggests motivation to utilize teachings disclosed therein with the

² See the brief filed January 19, 1999 and answer mailed February 16, 1999. An office communication was mailed June 5, 2000 stating that the reply brief filed August 11, 1999 would not be considered.

system disclosed by Dormer. They assert that absent hindsight, there exists no motivation to combine teachings of the applied references.³

The Federal Circuit states that “[t]he mere fact that the prior art may be modified in the manner suggested by Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that “[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem.” *Pro-Mold & Tool Co. v. Great Lakes Plastics*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996) *citing In re Rinehart*, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in *Para-Ordnance Mfg. v. SGS Importers Int’l*, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have reasonably expected to use the solution that is claimed by Appellants. However, “[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention.” *Para-Ordnance*, 73 F.3d at 1087, 37 USPQ2d at 1239, *citing W. L. Gore &*

³ See page 5 of the brief.

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Assocs., Inc. v. Garlock, Inc. 721 F.2d 1540, 1551-53, 220 USPQ 303, 311-13. In addition, our reviewing court requires the Patent and Trademark Office (PTO) to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

We find that the record provides no reason why one of ordinary skill in the art would have wanted to make use of a flashlight which is illuminated during a power outage in a system which is directed to charging of a stand alone battery as well as a battery in a portable unit, particularly when the stand alone battery is used to power the base unit associated with the portable unit. The motivation provided by the Examiner fails to address why the skilled artisan would wish to modify the system of Dormer to change the system associated with rechargeable batteries from one having a base and portable units, both of which require a power source, to a system in which the flashlight is the sole element requiring power.

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For these reasons, the rejection of claims 1-16 under 35 U.S.C. § 103 is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

MRF:yr

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