

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL JEROME WHIPPLE  
and RALPH MASON ENNIS

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Appeal No. 1999-2209  
Application No. 09/069,355

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ON BRIEF

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

LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-13, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a circuit breaker having a common test button for a ground fault circuit and an arc fault

circuit. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A circuit breaker comprising:

a housing;

separable contacts mounted in said housing;

an operating mechanism for opening said separable contacts when actuated;

trip means for actuating said trip<sup>1</sup> mechanism in response to predetermined current conditions and including ground fault trip means for actuating said trip mechanism in response to a ground fault, and arc fault trip means for actuating said trip mechanism in response to an arc fault;

test means including a ground fault test circuit having a ground fault test switch for testing said ground fault trip means, and an arc fault test circuit having an arc fault test switch for testing said arc fault means; and

a common test actuator moveable to a first position for actuating said ground fault test switch, a second position for actuating said arc fault test switch and a neutral position in which neither said ground fault test switch nor said arc fault test switch is actuated.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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<sup>1</sup> It appears to us that the term "trip" should be replaced with the term "operating" based upon the language set forth on line 4 of the claim. We consider this to be a minor formality that can be addressed by the examiner subsequent to this appeal.

Morris et al. (Morris)	4,686,600	Aug. 11, 1987
Foster et al. (Foster)	4,823,225	Apr. 18, 1989
Mackenzie et al. (Mackenzie)	5,546,266	Aug. 13, 1996

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Morris in view of Mackenzie.

Claims 2-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morris in view of Mackenzie, and further in view of Foster.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 9, mailed April 1, 1999) and the final rejection (Paper No. 4, mailed October 15, 1998) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 8, filed February 25, 1999) and reply brief (Paper No. 10, filed May 17, 1999) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could

have made but chose not to make in the briefs have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' 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 examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-13. Accordingly, we reverse.

We begin with the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Morris in view of Mackenzie. In rejecting claims under 35 U.S.C. § 103, it is

incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.

1992). If that burden is met, the burden 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. See id.; 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).

The examiner's position (final rejection, page 2) is that "Morris et al. shows everything claimed except the common actuator testing both a groundfault [sic] condition or an arc fault condition." To make up for this deficiency in Morris, the examiner turns to Mackenzie for a teaching of a circuit interrupter having both ground fault and arc fault detectors, as well as a device for indicating which of the detectors caused the fault, upon the occurrence of a fault condition. The examiner concludes (id.) that "[i]t would have been obvious, as a means to insure proper operation, to use a test means as well as an indicator for a fault."

Appellants assert (answer, pages 4 and 5) that:

Morris et al. discloses a circuit breaker having

a ground fault detector with a test switch. Mackenzie et al. discloses a circuit breaker with a ground fault detector and an arc fault detector each without any test circuit . . . . The art does not teach or suggest a test circuit that could properly test the arc fault detector and, hence, does not suggest a switch for the arc fault detector.

Appellants further assert (id.) that Morris and Mackenzie do not disclose a common test actuator having first and second positions and a neutral position.

From our review of the record, we are in agreement with appellants that the teachings of Morris and Mackenzie would not have suggested an arc fault test circuit and an arc fault test switch. We further find that the teachings of Morris and Mackenzie would not have suggested a three position common test actuator.

The examiner and appellants are in agreement that neither Morris nor Mackenzie discloses an arc fault test circuit or arc fault test switch as required by claim 1. We do not agree with the examiner's position that Morris' disclosure of a ground fault test circuit and switch therefore suggests a test circuit and switch for an arc fault circuit, because ground fault and arc fault circuits have different structure and are for different purposes. From the evidence of record, we find

no disclosure of a test circuit and switch for an arc fault circuit. Nor do we find any persuasive line of reasoning that would have suggested to an artisan the desirability of a test circuit and switch for an arc fault circuit. Since neither reference teaches the use of an arc fault test circuit nor an arc fault test switch, and no persuasive line of reasoning has been presented, we find that the suggestion for these limitations comes from appellants invention. In addition, neither Morris nor Mackenzie teach the three position common test actuator, as claimed. Although Mackenzie does disclose the use of a single switch 71 for resetting both the ground fault and arc fault detection indicators 51, 55, claim 1 requires that the common test actuator be a three position switch. A first position is for actuating the ground fault test switch. The second position is for actuating the arc fault test switch. The third position is a neutral position in which neither the arc fault test switch nor the ground fault test switch is actuated. The reset switch 71 is not a three position switch. The reset switch is only a two position switch that is mechanically operated by circuit breaker handle 73. Through the operation of camming surface

75, the switch is closed when the handle 75 is in the "off" position (col. 5, lines 26-34). Thus, we find no suggestion for a three position common test actuator for actuating an arc fault test switch and a ground fault test switch, except from appellants' disclosure.

As stated by our reviewing court, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)). Because neither Morris nor Mackenzie teach or suggest the use of an arc fault test circuit, an arc fault test switch, or a three position common test actuator for a ground fault test switch and an arc fault test switch, we are not

persuaded that teachings from the applied prior art would have suggested the claim limitations. We therefore find that the examiner has failed to establish a prima facie case of obviousness. Accordingly, the rejection of claim 1 under 35 U.S.C. § 103(a) is reversed.

We turn next to the rejection of claims 2-13 under 35 U.S.C. § 103(a) where the examiner additionally relies upon the teachings of Foster. The examiner (final rejection, page 3) relies upon Foster for a teaching of a three position rocker switch, which we find in figure 2A of Foster. However, Foster does not overcome the deficiencies of the basic combination of Morris and Mackenzie because Foster does not disclose an arc fault test circuit and arc fault test switch. Accordingly, the rejection of claims 2-13 under 35 U.S.C. § 103(a) is therefore reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-13 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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STUART S. LEVY	)	
Administrative Patent Judge	)	

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