

File

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

FEB. 15 1996

Ex parte STANLEY B. WILKINSON

PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 95-1472  
Application 07/511,248<sup>1</sup>

ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 2, 3, 8-11, 19, 20, 29-31, 34, 35, 38, 39, 42, 43, 45, 46, 55-59 and 64-70. Claims 1, 7, 27, 32, 33 and 41 have been canceled. Claims 4-6, 12-18, 21-26, 28, 36, 37, 40, 44, 47-54 and 60-63 have been indicated as

<sup>1</sup> Application for patent filed April 19, 1990.

Appeal No. 95-1472  
Application 07/511,248

containing allowable or allowed subject matter. An amendment filed after final rejection on December 20, 1993 was denied entry by the examiner.

The claimed invention pertains to a transformer differential relay which has increased reliability. More particularly, the relay is able to discriminate between transformer inrush currents and undesirable fault currents.

Representative claim 10 is reproduced as follows:

10. In a transformer differential relay of the type employing at least one operate signal and at least one restraint signal to generate a trip signal when the magnitude of the sum of said at least one operate signal exceeds the magnitude of the sum of said at least one restraint signal by a predetermined amount, means for enhancing reliability of operation of said relay in the presence of current transformer saturation, said means comprising

(a) means for generating a vector sum operate signal representative of the vector sum of currents flowing in at least two windings of a transformer;

(b) means for generating a signal representative of the absolute value of said vector sum operate signal; and

(c) means for generating an additional operate signal when the magnitude of the absolute value of said vector sum operate signal exceeds a first predetermined magnitude.

The examiner relies on the following references:

Li	4,704,653	Nov. 03, 1987
Allmanna Svenska Elektriska Aktiebolaget (Allmanna)	1,078,104 (UK)	Aug. 02, 1967

M. S. Jamil-Asghar et al. (Jamil-Asghar), "A solid-state relay for transformer switching," International Journal of Electronics, Vol. 61, No. 4, 1986, pages 539-542.

Appeal No. 95-1472  
Application 07/511,248

Claims 10, 11, 19, 20, 34, 35, 38 and 39 stand rejected under 35 U.S.C. § 102(b) as clearly anticipated by the disclosure of Jamil-Asghar. Claims 2, 3, 8-11, 19, 20, 29-31, 34, 35, 38, 39, 42, 43, 45, 46, 55-59 and 64-70 stand rejected under 35 U.S.C. § 103 as unpatentable over the teachings of Jamil-Asghar in view of Allmanna or Li.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief 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 disclosure of Jamil-Asghar fails to anticipate any of the appealed claims before us. It is also our view that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill

Appeal No. 95-1472  
Application 07/511,248

in the art the obviousness of the invention as set forth in the claims on appeal before us. Accordingly, we reverse.

Appellant has argued the claims in several separate groupings with respect to each of the rejections. Appellant has made no separate arguments with respect to the claims within each group so that all the claims within any one group will stand or fall together. Note In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Accordingly, we will consider a claim from each of appellant's proposed and argued groups as representative of all the claims within that group.

We consider first the rejection of claims 10, 11, 19, 20, 34, 35, 38 and 39 under 35 U.S.C. § 102(b) as fully met by the disclosure of Jamil-Asghar. The examiner's statement of this rejection is that these claims are "clearly anticipated" by Jamil-Asghar. Appellant argues that these claims recite several features which are not disclosed by Jamil-Asghar.

We consider claim 10 as representative of the group of claims also including claims 19, 34 and 38. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherence, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc.,

Appeal No. 95-1472  
Application 07/511,248

730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). The examiner does not specifically identify which elements of Jamil-Asghar correspond to each recited element of claim 10, but instead, notes that Jamil-Asghar teaches a relay which can distinguish the magnetizing inrush current from the short circuit of a transformer [answer, page 4]. In other words, the examiner has located a device which is functionally similar to the disclosed invention, but the examiner has not specifically considered the language recited in the claims. It was error not to consider the specific recitations of the claims.

Claim 10 recites a "means for generating a vector sum operate signal," and we are unable to locate in Jamil-Asghar any element that performs a vector sum of anything. Claim 10 also recites a "means for generating a signal representative of the absolute value of said vector sum operate signal," and we also find no element in Jamil-Asghar that generates the absolute value of any signal, much less the non-existent vector sum signal. Finally, claim 10 recites a "means for generating an additional operate signal" which is a function of the absolute value of the vector sum signal. We can find nothing in Jamil-Asghar that would meet this claim recitation. Since claim 10 recites several elements which are not disclosed by Jamil-Asghar, the rejection

Appeal No. 95-1472  
Application 07/511,248

under section 102 is improper. We do not sustain the rejection of claims 10, 19, 34 and 38 under 35 U.S.C. § 102.

With respect to the rejection of claims 11, 20, 35 and 39 under 35 U.S.C. § 102, since these claims respectively depend from claims 10, 19, 34 and 38 considered above, we also do not sustain the rejection of these claims for the same reasons discussed above.

We now consider the rejections of all the claims on appeal before us under 35 U.S.C. § 103. The two rejections based upon the teachings of Jamil-Asghar in view of Allmanna or Li are very similar and read as follows:

The claims are considered to be met by Jamil-Asghar et al with the exception of generating a harmonic restraint signal. Allmanna Svenska Elektriska Aktiebolaget (or Li) discloses that it is well known in the art to generate a harmonic restraint signal in a transformer differential relay. It would have been obvious to one having ordinary skill in the art to provide a means for generating a harmonic restraint signal as taught by Allmanna ... (or Li) in Jamil-Asghar et al device to prevent the occasion of over-voltage occurring on a fault-free transformer (or to detect a recovery inrush current condition in the transformer). [Final Rejection, page 3].

It can be seen from these rejections that the examiner has not identified any specific elements of the claims, but instead, has noted that the concept of generating a harmonic restraint signal in a transformer differential relay was well known. This type of

Appeal No. 95-1472  
Application 07/511,248

rejection misses the point. It is not the concept per se which is being claimed but a specific manner of implementing the concept.

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, 5 USPQ2d 1596 (Fed. Cir. 1988) and compare Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (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, 5 USPQ2d 1434 (Fed. Cir.), cert denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). These showings by the examiner are an essential part of complying with the burden of

Appeal No. 95-1472  
Application 07/511,248

presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the examiner's assertion that Jamil-Asghar meets the claims except for the generation of a harmonic restraint signal is without any factual support.

Considering independent claim 43 for example, we are unable to see where any of the references teaches elements (a), (b), (d) and (e). The secondary references teach the conventionality of a harmonic restraint signal, element (c), but the examiner has not provided any indication of how the specific combination of elements recited in the claim is suggested by the applied prior art. The fact that the problem solved by appellant has been solved before does not make every specific solution to the problem obvious to the artisan. The examiner's failure to specifically consider the recited elements in each of the claims results in a failure to make the required prima facie case of obviousness.

For the sake of completeness, we consider the section 103 rejections against independent claims 42 and 10 as well. Claim 42 recites a pair of "summing, integrating and comparing means" which have not been identified in any of the references, nor has the examiner explained why such a specific pair of elements would have been obvious to one having ordinary skill in the art. Claim 10 recites elements which are not present in the primary

Appeal No. 95-1472  
Application 07/511,248

reference as we discussed above with respect to the 35 U.S.C. § 102 rejection, and again the examiner has not explained why it would have been obvious to include these specific elements in the claimed combination. Thus, the rejections of all the independent claims under 35 U.S.C. § 103 fail because the examiner has failed to properly identify and address the differences between the invention as claimed and the teachings of the prior art.

Since we have determined that none of the independent claims are obvious based on the teachings of Jamil-Asghar in view of Allmanna or Li, the remaining dependent claims clearly recite subject matter which is not rendered obvious by the applied prior art. We note for the record that claim 3 depends from claims 5, 6 and 4 in order, and each of those claims has been indicated as containing allowable subject matter by the examiner. The inclusion of claim 3 in the rejection, therefore, appears to be an inadvertent mistake.

Appeal No. 95-1472  
Application 07/511,248

In summary, the rejections of the examiner under 35  
U.S.C. §§ 102 and 103 have not been sustained and, accordingly,  
the decision of the examiner is reversed.

*Kenneth W. Hairston*  
REVERSED  
KENNETH W. HAIRSTON  
Administrative Patent Judge )

*Errol A. Krass*  
ERROL A. KRASS  
Administrative Patent Judge )

*Jerry Smith*  
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) BOARD OF PATENT  
) APPEALS AND  
) INTERFERENCES

Appeal No. 95-1472  
Application 07/511,248

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