

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 95-4589
Application 08/042,888¹

ON BRIEF

Before COHEN, MEISTER and McQUADE, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Thurman Q. Poling (the appellant) appeals from the final rejection of claims 1-20, the only claims present in the application.² We affirm-in-part.

¹ Application for patent filed April 5, 1993.

² In the advisory action dated August 8, 1994 (Paper No. 10) the examiner stated that the amendment after final

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The appellant's invention pertains to a safety light. Independent claim 1 is further illustrative of the appealed subject matter and reads as follows:

1. A safety light comprising:

at least one primary lighting element for directing light energy outward in a particular direction;

at least one group of secondary lighting elements arranged substantially around said primary lighting element for directing light energy outward in said particular direction;

a translucent face lying substantially on a plane perpendicular to said particular direction comprising a central portion overlying said primary lighting element and at least one group of colored elements, each color element of said at least one group of colored elements overlying each secondary lighting element of said at least one group secondary lighting elements, such that when said secondary lighting elements are illuminated, light emitting from said secondary lighting element appears to a viewer in a color corresponding to one of said colored elements;

circuit means for illuminating said primary lighting element and said secondary lighting elements, said secondary lighting elements being illuminated in a particular sequence;

and

housing means for housing said lighting elements, said translucent face and said circuit means of said safety light.

rejection filed July 18, 1994 (Paper No. 9) would be entered for purposes of appeal. We observe, however, that no clerical entry of this amendment (which amends claims 1, 4, 9, 11 and 18) has in fact been made.

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The references relied on by the examiner are:

| | | |
|----------------------|-----------|----------------|
| McComb | 926,956 | July 6, 1909 |
| Swanson | 2,612,548 | Sept. 30, 1952 |
| Turner, Jr. (Turner) | 3,706,968 | Dec. 19, 1972 |
| Barbour | 3,868,501 | Feb. 25, 1975 |
| Forrest | 4,809,584 | Mar. 7, 1989 |

Claim 11 stands rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.³

Claims 1-3, 5-8, 11, 12, 14-16 and 18-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over McComb in view of Forrest and Swanson.

Claims 4 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over McComb in view of Forrest, Swanson and Barbour.⁴

³ This rejection was set forth as a new ground of rejection in the answer.

⁴ This rejection was set forth as a new ground of rejection in the answer. In the final rejection claims 4 and 13 were rejected under 35 U.S.C. § 103 as being unpatentable over McComb in view of Swanson, Forrest and McDermott. In view of the lack of any mention of this rejection in the answer, we presume that the examiner has withdrawn the final rejection of claims 4 and 13 on this ground. **See Ex parte Emm**, 118 USPQ 180 (Bd. App. 1957).

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Claims 9, 10 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over McComb in view of Forrest, Swanson and Turner.

The examiner's rejections are explained on pages 3-5 of the answer. Rather than reiterate the arguments of the appellant and examiner in support of their respective positions, reference is made to pages 3-6 of the brief, pages 1-3 of the reply brief, pages 5-8 of the answer and pages 1-3 of the supplemental answer for the details thereof.

OPINION

As a preliminary matter we note that (a) on page 3 of the brief the appellant has stated that the "groups of claims as present in the rejections of the Examiner can be included together in the groups as specified in [sic] the Examiner" and (b) the examiner has stated on page 2 of the answer that claims 1-3, 5-8, 11, 12, 14-16 and 18-20 stand or fall together as a first group, claims 4 and 13 stand or fall together as a second group and claims 9, 10 and 17 stand or fall together as a third group. Accordingly, with respect to the rejections under 35 U.S.C. § 103 (1) claims 1-3, 5-8, 11, 12, 14-16 and 18-20 will stand or fall with representative

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claim 1, (2) claims 4 and 13 will stand or fall with representative claim 4 and (3) claims 9, 10 and 17 will stand or fall with representative claim 9. See 37 CFR 1.192(c)(7).

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and reply brief and by the examiner in the answer and supplemental answer. As a consequence of this review, we will sustain the rejections under 35 U.S.C. § 103 of (1) claims 1-3, 5-8, 11, 12, 14-16 and 18-20 based on the combined disclosures of McComb, Forrest and Swanson and (2) claims 4 and 13 based on the combined disclosures of McComb, Forrest, Swanson and Barbour. We will not, however, sustain the rejections of claim 11 under 35 U.S.C. § 112, second paragraph, or claims 9, 10 and 17 under 35 U.S.C. § 103 based on the combined teachings of McComb, Forrest, Swanson and Turner.

Considering first the rejection of claim 11 under 35 U.S.C. § 112, second paragraph, the examiner is of the opinion that "said secondary elements" lacks a clear antecedent basis. We will not support the examiner's position. The purpose of

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the second paragraph of § 112 is to basically insure, with a **reasonable** degree of particularity, an **adequate** notification of the metes and bounds of what is being claimed. **See In re Hammack**, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). When viewed in light of this authority, we cannot agree with the examiner that the metes and bounds of claim 11 cannot be determined. A degree of **reasonableness** is necessary. As the court stated in **In re Moore**, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of Section 112 is

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a **reasonable** degree of precision and particularity. It is here where the definiteness of language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [Emphasis ours; footnote omitted.]

Here, we do not believe that it can seriously be contended that the artisan, consistent with the appellant's specification, would not understand that "said secondary elements" refers to -- said secondary lighting elements --.

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This being the case, we will not sustain the rejection of claim 11 under 35 U.S.C. § 112, second paragraph.

Turning to the rejection of claims 1-3, 5-8, 11, 12, 14-16 and 18-20 under 35 U.S.C. § 103 as being unpatentable over McComb in view of Forrest and Swanson, the answer states that:

McComb discloses an electric illuminating display device which is comprised of a housing, a central primary lighting element (15, page 2, column 1, lines 44 to 45, figure 1, and the light source in the center, figure 7) which may continuously illuminate (also page 2, column 1, lines 42 to 45), and a plurality of groups (2 to 14, figure 1 and 22 to 24, figure 7) of secondary lighting elements (17) with one group of secondary lighting elements surround[ing] another group of secondary lighting elements. McComb further discloses that the housing includes a translucent face (29, page 2, column 2, lines 85 to 87) which lies over the primary and groups of secondary lighting elements in a plane perpendicular to a direction of light emitting from the primary and groups of secondary lighting elements. McComb also shows that central portion of this translucent face overlies the central primary lighting element, and a plurality of color[ed] elements may overlies the groups of secondary lighting elements (page 1, column 2, lines 65 to 66). These groups of secondary lighting elements may also be comprised of different colors (page 1, column 2, lines 63 to 64) to provide different color of light intensities. McComb additionally discloses circuit means (thermo flashers) to energize the primary and groups of secondary lighting elements. [Pages 3 and 4.]

Page 4 of the answer then states that it would have been obvious to (1) arrange the circuit of McComb "to provide a clockwise and counterclockwise illuminated rotating sequence"⁵ as shown by Forrest and (2) enclose the circuit means of McComb within the housing in view of the teachings of Swanson.

The appellant does not identify any specific errors with respect to the above-noted findings by the examiner as to the content of McComb. Instead, the appellant merely broadly asserts that

it is not even clear that there is a central lighting element and the secondary lighting elements do not appear to include the kinds of color sequencing and safety features present in applicant's device. McComb merely shows an illuminating device having areas of color overlays and with the flashing of various lights to make an attractive sign. This is quite different from applicant's safety light as present in the claims. [Brief, pages 3 and 4.]

We are unpersuaded by the appellant's arguments. As the examiner has noted with respect to McComb, the central lighting element 15 is continuously illuminated and may be considered to be "at least one primary lighting element" and

⁵ We observe, however, that there is no limitation in representative claim 1 which requires such a sequence.

the light groups 2-14 of Fig. 1 may be considered to form "at least one group of secondary lighting elements. As the examiner has also noted, McComb additionally teaches that a translucent face 29 may be provided and discloses that a plurality of color elements may overlie the groups of secondary lighting elements (page 1, lines 65 and 66). Figs. 1, 4-6 and 8 clearly depict a housing means for the lighting elements and the translucent face. McComb additionally discloses a circuit means which may include thermo flashers (Fig. 3) or a clock mechanism (page 1, lines 69-77); however, the **schematic** illustration of the circuitry in Fig. 3 does not depict the circuitry to be contained within the housing.

Accordingly, we find response in McComb for all the structure set forth in representative claim 1 with the exception of the limitation that the circuit is housed in the housing.

However, even with respect to this limitation, we observe that artisans must be presumed to know something about the art apart from what the references disclose (*see In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the

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conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (*see In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is presumed on the part of those practicing in the art. *See In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Therefore, although McComb in Fig. 3 schematically shows the circuitry to be outside the housing for the apparent purpose of ease illustration, we perceive that the artisan would have been well aware of the commonplace expedient of enclosing the circuitry for controlling the operation of a light within the housing of the light for the purpose of protecting the circuitry from damage (e.g., exposure to the elements or from being hit by a foreign object) and would have found it obvious as a matter of common sense to house the circuitry of McComb within the housing.

Moreover, as the examiner has observed, Swanson in Fig. 2 depicts a light wherein the circuit which controls the light is enclosed within the same housing as the light for the self-evident purposes of providing protection for the circuit and

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to provide for a more compact device, thus fairly suggesting to the artisan to enclose the circuit of McComb within the housing in order to achieve these self-evident advantages.

As to the recitation of "safety" in the preamble of representative claim 1, it is well settled that a preamble generally does not limit the scope of a claim if it merely states the invention's purpose or intended use. *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994)). While no litmus test can be given with respect to when the introductory words of a claim constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim (*Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)), in a case such as this where the light of McComb has the **capability** of functioning as a "safety" light (indeed, it appears to us that most lights in general have the capability of broadly functioning as a "safety" light), we are of the opinion that the recitation of a safety light in the preamble of representative claim 1 is merely a statement of intended purpose or use which may not be

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relied on to distinguish structure from the prior art. **See In re Pearson**, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974), **In re Yanush**, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973), **In re Casey**, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967) and **Loctite Corp. v. Ultraseal, Ltd.**, 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985). Note also **LaBounty Manufacturing v. International Trade Commission**, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992). In this regard, we observe that the light of McComb, by its very nature, can be considered to provide a safety function inasmuch as it would provide at least some illumination for a surrounding area or, at the very least, provide a location "marker" for whatever object it rested on (or was attached to), thus providing a warning of the presence of that object.

The appellant has also made the broad allegation that the examiner has combined references (e.g., Swanson) from non-analogous arts. In our view, the appellant has an overly narrow view of what constitutes analogous art. It is well settled that the prior art relevant to an obviousness determination encompasses not only the field of the inventor's

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endeavor, but also any analogous arts. **Heidelberger Druckmaschinen AG v. Hantscho Commercial Products Inc.**, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994). The test of whether a reference is from a non-analogous art is first, whether it is within the field of the inventor's endeavor, and second, if it is not, whether it is reasonably pertinent to the particular problem with which the inventor was involved. **In re Wood**, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it is one which because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. **In re Clay**, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). Here, the problems of providing a control circuit for a light and enclosing that control circuitry within a housing for the light are not unique to just "safety" lights. By the very nature of such problems one of ordinary skill in this art would have consulted lights in general for such features and,

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accordingly, the second prong of **Wood** is satisfied and Swanson is analogous art.

While the examiner (as we have noted above) has additionally relied on the teachings Forrest for a limitation not found in representative claim 1, we are of the opinion that the subject matter defined by representative claim 1 is unpatentable over the combined teachings of McComb and Swanson taken alone. This being the case, we will sustain the examiner's rejection of claims 1-3, 5-8, 11, 12, 14-16 and 18-20 under 35 U.S.C. § 103 based on the combined teachings of McComb, Swanson and Forrest.

Considering next the rejection of claims 4 and 13 under 35 U.S.C. § 103 as being unpatentable over McComb in view of Forrest, Swanson and Barbour, we are of the opinion that the artisan as a matter of "common sense" (**see Bozek**, 416 F.2d at 1390, 163 USPQ at 549) would have found it obvious to make the centrally located light 15 of McComb (which burns continuously) of greater intensity than the surrounding flashing or blinking lights if, for no other reason, than to make the center of the illuminating display the focal point

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when viewed by the eye of an observer. In any event, the appellant does not dispute the examiner's finding with respect to Barbour that "each of the secondary lighting elements (44) has less intensity and is smaller in size than the central primary lighting element (41)" (see answer, page 5). Instead, the appellant argues that Barbour is directed to a light box whose functions are "essentially aesthetic or decorative" rather than safety (reply brief, page 2). It is true that the light box of Barbour (much like the light box of the primary reference to McComb) is primarily concerned with producing decorative effects. We must point out, however, that "[a]s long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor" (*In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)) and all the utilities or benefits of the claimed invention need not be explicitly disclosed by the prior art references to render the claim unpatentable under section 103 (*see In re Dillon*, 919 F.2d 688, 692, 696, 16 USPQ2d 1897, 1901, 1904 (Fed. Cir.

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1990) (in banc), **cert. denied**, 500 U.S. 904 (1991)). Here, we share the examiner's view that Barbour's teaching of a centrally located large white bulb 41 surrounded by smaller blinker lights 44 would have fairly suggested to the artisan to make centrally located light 15 of McComb of greater intensity than the surrounding flashing or blinking lights. Accordingly, we will sustain the rejection of claims 4 and 13 under 35 U.S.C. § 103 based on the combined disclosures of McComb, Forrest, Swanson and Barbour.

Considering last the rejection of claims 9, 10 and 17 as being unpatentable over McComb in view of Forrest, Swanson and Turner, the examiner has relied upon the teachings of Turner for a suggestion to rotate the secondary lighting elements of McComb about the primary light element. We will not support the examiner's position. Turner is directed to an entirely different type of device from that of McComb, namely, a beacon for aircraft. To that end, Turner rotates a cylindrically-shaped filter having colored filter segments about two centrally located lights in such a manner so as to create colored flashes of light. Absent the appellant's own

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disclosure we can think of no cogent reason why one of ordinary skill in this art would have been motivated to single out the disparate teachings of Turner and combine them with McComb in the manner proposed by the examiner. Accordingly, we will not sustain the rejection of claims 9, 10 and 17 based on the combined teachings of McComb, Forrest, Swanson and Turner.

In summary:

The rejection of claim 11 under 35 U.S.C. § 112, second paragraph, is reversed.

The rejections of 1-8, 11-16 and 18-20 under 35 U.S.C. § 103 are affirmed.

The rejection of claims 9, 10 and 17 under 35 U.S.C. § 103 is reversed.

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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| | IRWIN CHARLES COHEN |) | |
| | Administrative Patent Judge |) | |
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| | JAMES M. MEISTER |) | BOARD OF |
| PATENT | Administrative Patent Judge |) | APPEALS |
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