

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD H. NORTRUP

Appeal No. 96-3038
Application No. 08/372,069¹

ON BRIEF

Before URYNOWICZ, HAIRSTON and CARMICHAEL, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 5.

The disclosed invention relates to an arc tube.

¹ Application for patent filed January 12, 1995.

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Claim 1 is illustrative of the claimed invention, and it
reads as follows:

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1. An arc tube comprising: a light transmissive body containing an arc generating and sustaining medium; a press seal formed at one end of said body, said press seal comprising a planar portion separating opposed edges; a first foil sealed in said planar portion; a lead-in conductor attached to said foil and extending outside of said body and an electrode attached to said foil and extending inside said body; a first cavity formed on a first of said edges and a second cavity formed on a second of said edges; a fill in each of said cavities for supporting emission of ultra-violet radiation; and a second foil sealed in said planar portion and being attached to said first foil, said second foil having a first end terminating in said first cavity and a second end terminating in said second cavity.

The reference relied on by the examiner is:

Morris	5,323,091	June 21,
1994		

Claims 1 through 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morris.

Reference is made to the briefs and the answer for the respective positions of the appellants and the examiner.

OPINION

Morris discloses a single cavity 62 (Figure 4), and one end of the second foil 60 terminates in this cavity. According to the examiner (Answer, page 4), the claimed "second cavity" is a "mere duplication of parts for a multiple effect," and "is not patentably distinct where the operation of the device would not thereby be modified (see St. Regis

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Paper Co. v. Bemis Co., Inc., 193 USPQ 8, 11 (7th Cir. 1977))."

Appellants argue (Brief, page 3) that:

The Examiner's reliance on St. Regis Paper Co. V. Bemis Co. is misplaced. The St. Regis case is inapposite in that it dealt with duplicating what had previously existed in the prior art. In the instant case, the claims define an invention that **has not** previously existed and that has increased benefits, untaught by the prior art, when multiplied in a particular way.

We agree with appellants that the St. Regis case is inapposite to the facts before us on appeal. The examiner's mere conclusion that it would have been obvious to place a second cavity on Morris' pinched seal, and then terminate the other end of the second foil 60 in this cavity is too much for us to believe in the absence of evidence in the record or a convincing line of reasoning by the examiner. Since neither evidence nor a convincing line of reasoning has been presented by the examiner, we will reverse the 35 U.S.C. § 103 rejection of claims 1 through 5.

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DECISION

The decision of the examiner rejecting claims 1 through 5 under 35 U.S.C. § 103 is reversed.

REVERSED

STANLEY M. URYNOWICZ, Jr.)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
KENNETH W. HAIRSTON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JAMES T. CARMICHAEL)	
Administrative Patent Judge)	

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JENINE GILLIS

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Judge HAIRSTON

Judge CARMICHAEL

Judge URYNOWICZ

Typed: 20 Jul 98

DECISION: REVERSED

Send Reference(s): Yes No
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Heard: Yes No

Remanded: Yes No

Index Sheet-2901 Rejection(s): _____

Acts 2: _____

Palm: _____

Mailed:

Updated Monthly Disk: _____

Updated Monthly Report: _____