

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion (1) was not written for publication and (2) is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLE K. NILSSEN

Appeal No. 96-3090
Application 08/287,409

ON BRIEF

Before CALVERT, THOMAS, and TORCZON, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

BACKGROUND

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 44-65,¹ all of the pending claims.

(Paper 29 at 1.) We affirm in part.

Appellant filed the subject application on 8 August 1994. Appellant claims the benefit of United States patent application number 06/717,441, filed 28 March 1985, now abandoned. (Paper 25 at 1.)

¹ Canceled claims 1-43 were the subject of an earlier appeal to the Board. (Papers 17, 23 and 25.)

Appellant entitled his application "Programmable wall switch actuator/timer". (Paper 1.) According to the abstract, this "actuator/timer unit can easily be mounted directly to the outside of the face plate of a standard wall switch [and] can be programmed to operate the lever of a wall switch in accordance with a program that automatically repeats on a diurnal, weekly or other cyclical basis." Claim 50 is representative of the claim subject matter (Paper 28):

50. An arrangement comprising:

a wall switch having a face plate and a switch lever protruding through an aperture in the face plate; the face plate being of ordinary size and shape; and

a programmable actuator mounted onto the wall switch in engagement with the switch lever; the programmable actuator being further characterized by causing repetitive and periodic reciprocating movement of the switch lever in accordance with a pre-established program.

REJECTIONS

The examiner rejected claims 44-65 under 35 U.S.C. § 112[1] as lacking a basis in the specification. The examiner also objected to the specification on the same basis. (Paper 29 at 2.)² The examiner rejected claims 44-49 under

² The examiner failed to repeat this ground of rejection in his answer (Paper 32 at 2-3), but did defend the rejection in his response to Appellant's argument (Paper 32 at 6).

section 112[2] as indefinite. (Paper 29 at 2.) The examiner also relied on the following references in rejecting the claims:

Schneidinger	3,740,680	19 June 1973
Augustyniak	3,818,156	18 June 1974
Angott	4,041,325	9 Aug. 1977
Pfeiffer et al. (Pfeiffer)	4,508,943	2 Apr. 1985 (filed 28 Mar. 1983)

The examiner rejected claims 44, 46, 48-50, 52, 54, 55, 57-61, and 63-65 under 35 U.S.C. § 102(b) as anticipated by Schneidinger. (Paper 29 at 3.) The examiner rejected claims 44-46, 48-52, 54, 55, and 57-65 under section 102(e) as anticipated by Pfeiffer. (Paper 29 at 3.) The examiner rejected claims 45, 47, 51, 53, 56, and 62 under 35 U.S.C. § 103 as unpatentable over Schneidinger in view of Augustyniak or Angott. (Paper 29 at 4.)

The examiner rejected claims 47 and 53³ under section 103 as unpatentable over Pfeiffer in view of Augustyniak or Angott. (Paper 29 at 4.)

³ We note there is no corresponding rejection of claim 56 relying on Pfeiffer.

INDEFINITENESS

We treat the rejection of claims 45-49 for indefiniteness first since it has bearing on the other rejections directed against these claims. Claims 44-49 stand or fall together for the purposes of the indefiniteness rejection. (Paper 31 (Brief) at 3.) Claims 45-49 each depend directly from claim 44. Claim 44 recites (Paper 28, emphasis added):

44. An assembly mounted at the location of an ordinary wall switch and characterized by including:

a pair of terminals connected with a pair of power line conductors as well as with a load; the terminals being so arranged that: (i) when they are electrically connected together, a power line voltage is applied to the load; and (ii) when they are electrically disconnected from each other, the power line voltage is removed from the load; and

a sub-assembly connected with the terminals and operative to cause these terminals to be shorted together at certain pre-determined points in time and to be disconnected from each other at certain other pre-determined points in time; the sub-assembly being further characterized in that:

(i) the pre-determined points in time repeat in a substantially periodic manner; (ii) a wall switch face plate is interposed between the sub-assembly and the terminals; and (iii) it⁴ will function to cause the pre-programmed points in time to occur irrespective of the presence of a power line voltage

at the power line conductors.

⁴ We assume that by "it" Appellant means "the sub-assembly". Appellant should clarify this point in further prosecution.

The examiner urges that claim 44 is indefinite because the phrase "the location of an ordinary wall switch" lacks an antecedent basis. (Paper 32 at 6-7.) To avoid indefiniteness, claims must (1) reasonably apprise those skilled in the art both of the use and the scope of the invention and (2) use language that is as precise as the subject matter permits. Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985). While we agree that, strictly speaking, "the location" lacks an antecedent basis, we do not believe that failing renders the claim imprecise or incomprehensible for those skilled in the art. Certainly the simplest alternative--"a location of an ordinary wall switch"--would do little to improve this particular claim. Consequently, we will not sustain the rejection for this reason.

The examiner also urges that it is not clear how the sub-assembly is connected to the terminals. We too are uncertain what Appellant intends to encompass with the term "sub-assembly". The underlined portions of claim 44 are not consistent. This inconsistency is best illustrated when Appellant explains what he means by "sub-assembly" (Paper 31 (Brief) at 4, emphasis in original):

[Als interpreted in light of the specification and the rest of claim 44, the recited "sub-assembly" must clearly include the following elements: (i) the mechanical switch inherently associated with the switch lever SL of Fig. 1 (which mechanical switch provides for connection with the "pair of terminals" recited in line 3 of claim 44, which "pair of terminals" must inherently be present "at the location of an ordinary wall switch"); (ii) face plate FP of Fig. 1; and (iii) the actuator/timer unit ATU of Figs. 2a, 2b, 3 and 5.

If the face plate is interposed between the sub-assembly and the terminals, then how can the sub-assembly include (a) the face plate and (b) the mechanical switch, which must be between the face plate and the terminals in order to connect the rest of the sub-assembly to the terminals? These limitations are logically inconsistent. Yet if the sub-assembly does not include the mechanical switch, we agree with the examiner (Paper 32 at 7) that it is not clear how the sub-assembly is connected to the terminals to turn the power on and off. Given the uncertainty surrounding claim 44, both as written and as argued, we conclude that we must sustain the rejection of claims 44-49 under section 112[2] as indefinite.

We reverse all of the remaining rejections of claims 44-49 without saying anything about the merits of these rejections because the meaning of these claims is so uncertain that we cannot find facts based on the language of the claims. Cf. In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295

(CCPA 1962) (reversing a prior art rejection); In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (reversing a prior art rejection); In re Dossel, 115 F.3d 942, 946, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997) (reversing a written description rejection). For the purposes of the other rejections, claims 44-49 are no longer on appeal.

WRITTEN DESCRIPTION

We reverse the rejection of the remaining claims under section 112[1]. The examiner grounds this rejection on the failure of the specification to support the term "sub-assembly". (Paper 32 at 6.) Whatever the merits of such a rejection as applied to claim 44, it has no applicability to claims 50-65, which do not use the offending term.

ANTICIPATION - SCHNEIDINGER

Appellant groups together all of the claims rejected under section 102 over Schneider. (Paper 31 (Brief) at 3; see also 37 CFR § 1.192(c) (1995) (requiring separate grouping and separate arguments).) We choose claim 50 as the broadest of the remaining claims in this group.

Schneider teaches an arrangement comprising an ordinary wall switch **10** and face plate **12** with a switch lever **18** protruding through the face plate. (2:32-37; Figs. 1

& 3.) An actuator **24** is mounted on the wall switch and engages the switch lever. (Fig. 3.) The actuator toggles the switch lever to turn the light on and off. (1:50-61.)

We find that Schneidinger teaches the actuator is programmable since it has "means to adjust the time cycle". (6:10-12.) See "²program" in Webster's New Collegiate Dictionary 912 (1979) (attached) ("**2**: to work out a sequence of operations to be performed by (a mechanism)"). The actuator can be set to turn the lights on and off "intermittently". (2:1-3.) We find "intermittently" to include both repetitive action and periodic action. See "intermittent" in Webster's at 598 ("coming and going at intervals" and "**syn** INTERMITTENT, RECURRENT, PERIODIC, ALTERNATE"). We note in support of this finding that Schneidinger points out that "the timer may be so constructed as to be only actuated once and in its own mechanism (not shown) to reverse its actuation after a given elapsed time. Likewise, there may be two or more control dials or settings for control of the timing device." (3:15-18.) Two or more settings implies repeated actuations. The actuations may also be light-triggered. (5:8-11.) If natural light is the trigger, then the dominant actuation pattern would inherently

be repetitive and periodic (corresponding to sunrise and sunset).

Schneidinger teaches all of the limitations of claim 50 so we affirm the rejection of claim 50 under section 102 over Schneidinger. We also affirm the rejection of all remaining claims grouped with claim 50, i.e., claims 52, 54, 55, 57-61, and 63-65.

OBVIOUSNESS - SCHNEIDINGER

Appellant relies on his arguments regarding anticipation to address the rejections under section 103. (Paper 31 (Brief) at 9.) Since we affirm the anticipation rejection based on Schneidinger, we also affirm the related obviousness rejections of remaining claims 51, 53, 56, and 62.

ANTICIPATION - PFEIFFER

Appellant groups together all of the claims rejected under section 102 over Pfeiffer. (Paper 31 (Brief) at 3.) We choose claim 50 as the broadest of the remaining claims in this group.

Pfeiffer teaches an arrangement comprising a wall switch **10** (2:47-53; Fig. 1) with a conventional face plate **50** (3:27-31). The operation of the programmed actuator is described in patent application 06/408,330, which issued as

United States Patent 4,521,843. (2:53-56.) The examiner identifies switch **52** as protruding through the face plate. (Paper 32 at 11.) While this is true, switch **52** does not reciprocate "in accordance with a pre-established program" as claim 50 requires. The only other independent claim, claim 60, has a corresponding limitation.

Pfeiffer does not teach all of the limitations of claim 50 so we reverse the rejection of claim 50 under section 102 over Pfeiffer. We also reverse this rejection for all remaining claims grouped with claim 50, i.e., claims 51, 52, 54, 55, and 57-65.

OBVIOUSNESS - PFEIFFER

Claim 53 is the only remaining claim⁵ rejected over the combination of Pfeiffer and either Angott or Augustyniak. It depends from claim 50 and requires, in addition, an electric motor included with the programmable actuator.

Angott teaches an external thermostat timer for use with an existing wall-mounted thermostat. He does not teach a switch lever that protrudes through a conventional face plate and that reciprocates according to a pre-determined pattern.

⁵ The obviousness rejection of claim 47 has been reversed pro forma. See page 5.

Angott uses a motor **158** to adjust the thermostat switch.

(8:56-9:11.)

Augustyniak suggests a switch lever that protrudes through a conventional face plate and that reciprocates in response to an actuator. (Fig. 1; 1:50-58; 3:3-19.) He also teaches a motorized time-keeping mechanism **28**. (1:59-2:13.) Augustyniak provides motivation for a simple actuator that uses an existing toggle switch. (1:29-34.)

Pfeiffer provides motivation for a computerized actuator. A person having ordinary skill in the art would have been motivated to use a computerized actuator with Augustyniak's simpler mechanism. An artisan implementing this combination would not, however, need to retain Augustyniak's motor or be motivated to use the motor as the actuator in this combination. Angott does not provide a reason to include a motor with the actuator either. Consequently, neither combination would produce a programmable actuator with an electric motor as claim 53 requires. We cannot, therefore, conclude that the subject matter of claim 53 would have been obvious in view of Pfeiffer and either Angott or Augustyniak.

DECISION

We affirm the rejection of claims 44-49 under section 112[2] as indefinite; consequently, we reverse pro forma the other rejections of claims 44-49. We reverse the rejection of claims 50-65 under section 112[1] as lacking support in the disclosure. We affirm the rejection of claims 50, 52, 54, 55, 57-61, and 63-65 under section 102 over Schneidinger. We reverse the rejection of claims 50-52, 54, 55, and 57-65 under section 102 over Pfeiffer. We affirm the rejection under section 103 of claims 51, 53, 56, and 62 over Schneidinger in view of Augustyniak or Angott. We reverse the rejection of claim 53 over Pfeiffer in view of Augustyniak or Angott.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(b).

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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Administrative Patent Judge)	AND
)	INTERFERENCES
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