

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK GOTTLIEB

Appeal No. 97-0655
Application 08/294,913¹

ON BRIEF

Before URYNOWICZ, JERRY SMITH and GROSS, 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 1-17, which constitute all the claims in the application.

¹ Application for patent filed August 24, 1994.

The disclosed invention pertains to a deadbolt receptacle unit for receiving a deadbolt cylinder in a deadbolt receiving slot. The receptacle unit has a detecting unit formed therein for detecting the presence of the deadbolt cylinder in the receiving slot. A non-audible signal is generated to indicate that the deadbolt cylinder is present in the receiving slot. The signals can be monitored for a plurality of receptacle units so each of the dead-bolts can be monitored from a single location.

Representative claim 1 is reproduced as follows:

1. A dead-bolt receptacle unit, comprising:

a dead-bolt receiving slot into which a dead-bolt cylinder is inserted;

a dead-bolt detecting unit formed in the dead-bolt receptacle unit, the dead-bolt detecting unit detecting a presence of the dead-bolt cylinder in the dead-bolt receiving slot, and generating a non-audible dead-bolt detecting signal based on the detected presence of the dead-bolt cylinder in the dead-bolt receiving slot.

The examiner relies on the following references:

Jamison	4,178,587	Dec. 11, 1979
Heaton et al. (Heaton)	5,111,184	May 05, 1992
Pease, Jr. et al. (Pease)	5,311,168	May 10, 1994
Greenwaldt	5,499,014	Mar. 12, 1996

(filed July 01,
1994)

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The following rejections have been maintained from the final rejection:

1. Claims 1, 4 and 13-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Pease taken alone.

2. Claims 2, 3 and 5-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Pease in view of Heaton.

The following new rejections were made in the examiner's answer:

3. Claims 13-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Pease in view of Greenwaldt.

4. Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Jamison.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs 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

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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 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 obviousness 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 obviousness of the invention as set forth in claims 1-17. However, we are also of the view that the invention as broadly recited in claim 1 is fully met by the disclosure of Jamison. Accordingly, we affirm-in-part.

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

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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.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); 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).

1. The rejection of claims 1, 4 and 13-17 under

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35 U.S.C. § 103 as unpatentable over Pease taken alone.

With respect to this rejection, appellant has indicated that claims 1 and 4 stand or fall together as one group and claims 13-17 stand or fall together as a second group [brief, page 4]. Therefore, we will consider this rejection only with respect to independent claims 1 and 13.

With respect to independent claim 1, the examiner observes that Pease discloses an alarm in which a non-audible indicator displays the status of the alarm as well as the position of the deadbolt. For purposes of this observation, it should be noted that the non-audible indicator of Pease is considered to be the flashing circuit 26 and light source 32 [answer, page 4]. The examiner also notes that the embodiment of Pease's invention shown in Figure 5 shows the use of a magnet mounted in doorframe 80 for detecting the presence of the deadbolt. Figure 5 of Pease illustrates that the magnet 80 is located in a recess of the door frame which is aligned with the deadbolt lock assembly. The examiner also observes that Pease discloses one deadbolt detector located in the lock assembly (deadbolt mechanism 16) and a second deadbolt

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detector located in the receptacle unit (magnet 80) [answer, page 5]. Regardless of these teachings just noted, the examiner also maintains that any location of the deadbolt detecting unit would have been obvious. Appellant devotes a large portion of the brief to arguing that the objectives of Pease and appellant's invention are substantially different. Although we recognize the different circumstances for which appellant's invention and Pease's device were designed, a case for obviousness cannot be overcome by simply noting the different intended uses for a claimed invention and the prior art. Appellant does ultimately assert that the different objectives between the present invention and the system of Pease result in two significant structural differences between Pease and the present invention.

First, appellant argues that Pease does not teach that the deadbolt detecting unit is formed in the deadbolt receptacle unit as claimed [brief, pages 8-9]. As we noted above, the examiner has viewed the magnet 80 of Pease as

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satisfying this limitation of the claim. After a careful consideration of the disclosure and drawings of Pease, we agree with appellant that magnet 80 cannot meet the recitations of claim 1. First, it can be seen from Figure 5 of Pease that magnet 80 only works with switch 22' when the deadbolt is outside the receptacle (unlocked condition). That is, when the deadbolt is in the locked position, switch 14 is in the dashed position of Figure 5 and switch 22' and magnet 80 are disconnected from the device. Second, magnet 80 works in conjunction with switch 22' and not with deadbolt 18. Figure 7B of Pease clearly shows that the switch 22' and the deadbolt 18 are not axially aligned. Therefore, magnet 80 only determines when switch 22' is near the magnet and is not related in any way to the condition of the deadbolt in the receptacle unit. Basically, magnet 80 only determines if the door has been opened from its closed condition when the deadbolt is in the unlocked position.

From the above discussion, it is clear that Pease does not teach a unit formed in the receptacle unit for detecting

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the presence of the deadbolt cylinder in the deadbolt receiving slot as recited in claim 1. The examiner has also essentially concluded that the location of the detecting unit is an obvious design choice and that there is no disclosed advantage to the placement within the receptacle unit as claimed. Appellant responds that he has disclosed the benefits of placing the detecting unit within the deadbolt receptacle unit, and the examiner has pointed to no teaching which suggests this placement [reply brief, pages 2-3].

We agree with appellant. The examiner has dismissed a key feature of appellant's claimed invention as being obvious even though there is not the slightest hint in the applied prior art that the claimed feature would have been desirable or advantageous. We are not inclined to permit the examiner to dispense with the requirement that the examiner present evidence to support conclusions of obviousness. It appears to us that the examiner has decided that the invention is so simple that any related prior art teaching would be sufficient to support a holding of obviousness. Although we agree that the claimed invention is relatively simple, the examiner has

simply failed to address the specific limitations of the invention as set forth in independent claim 1. Therefore, we do not sustain this rejection of claims 1 and 4.

With respect to independent claim 13, this claim is similar to independent claim 1 except that it recites a plurality of deadbolt receiving units and an RF transmitter for sending sensed deadbolt signals to a single indicator. The examiner essentially applies Pease in the same manner as considered above and asserts that plural devices and wireless transmission would have been obvious to the artisan [answer, page 8].

Pease fails to teach or suggest the invention of claim 13 for the same reasons discussed above with respect to claim 1. Additionally, there would be no basis to add plural devices or wireless transmission to the Pease device. The Pease device is designed to alert an intruder at the location of the lock that the alarm system is present. A plurality of such devices and a central indicator would defeat the very purpose for which Pease was designed. Therefore, we do not sustain this rejection of claims 13-17.

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2. The rejection of claims 2, 3 and 5-12 under 35 U.S.C. § 103 as unpatentable over Pease in view of Heaton.

These claims all recite the feature of the deadbolt detecting unit located within the deadbolt receptacle unit for detecting the presence of the deadbolt cylinder in the deadbolt receptacle unit. As discussed above, Pease alone does not teach or suggest this feature of the claimed invention. Heaton was cited by the examiner as a teaching of an optical receiver. Since Heaton does not overcome the deficiencies of Pease discussed above, we do not sustain this rejection of the claims.

3. The rejection of claims 13-17 under 35 U.S.C. § 103 as unpatentable over Pease in view of Greenwaldt.

This rejection was added as a new ground of rejection in the examiner's answer. Greenwaldt was added to the previous rejection based on Pease taken alone to support the examiner's position that a plurality of transmitters would have been obvious. Greenwaldt does not overcome the deficiencies of Pease discussed above. Additionally, a plurality of RF transmitters

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as recited in independent claim 13 would destroy the very purpose for which Pease was designed as discussed above.

Therefore, we do not sustain this rejection of claims 13-17.

4. The rejection of claim 1 under 35 U.S.C.
§ 102(b) as being anticipated by Jamison.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, 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., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner indicates how he "reads" claim 1 on Jamison on page 10 of the answer. Appellant argues that Jamison is similar to Pease and suffers the same deficiencies [reply brief]. Appellant also argues that Jamison is directed

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to an alarm system and, therefore, has a different operation than the claimed invention.

At the outset, we observe that any differences between Jamison and the disclosed invention based on purpose and function are not relevant to this rejection under 35 U.S.C. § 102. The only question we must consider is whether all the structural details of claim 1 are present in the disclosure of Jamison. We

note that switch body 28 of Jamison is designed to receive a deadbolt cylinder therethrough [column 3, lines 50-52]. Therefore, switch body 28 is a deadbolt receptacle unit. State control means 26 is formed in switch body 28 and detects the presence of the deadbolt in switch body 28. The signal in Jamison is disclosed to be either audible or silent (non-audible) [column 1, line 25]. Thus, we agree with the examiner that all the details of independent claim 1 are fully met by the structure disclosed by Jamison. Appellant's reply brief does not point to any limitation of claim 1 which is not met by the disclosure of Jamison. Therefore, we sustain the

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rejection of claim 1 based on Jamison.

In summary, we have not sustained any of the examiner's obviousness rejections of the claims based on Pease, Heaton and Greenwaldt. However, we have sustained the rejection of claim 1 based on Jamison. Therefore, the decision of the examiner rejecting claims 1-17 is affirmed-in-part.

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

STANLEY M. URYNOWICZ, JR.)
Administrative Patent Judge)

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