

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 DANNY W. GILLIAM and WADE C. PATTERSON

Appeal No. 97-1177
Application 08/368,026¹

ON BRIEF

Before CALVERT, Administrative Patent Judge, McCANDLISH, Senior Administrative Patent Judge, and MEISTER, Administrative Patent Judge.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3, 6 and 8 to 20, all the claims remaining in the application.

The appealed claims are drawn to a system for, and method of, controlling the

¹ Application for patent filed January 3, 1995.

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flow of water to a water rinsing device, such as a faucet or urinal, and are reproduced in the appendix to appellants' brief.

The reference applied in the final rejection is:

Shiba et al. (Shiba)	5,133,095	Jul. 28, 1992
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The appealed claims stand finally rejected on the following grounds:

(1) Claims 1, 15 and 19, unpatentable for failing to comply with 35 U.S.C. § 112, second paragraph.²

(2) Claims 1, 3, 6, 8 to 11 and 14 to 16, anticipated by Shiba, under 35 U.S.C. § 102(b).

(3) Claims 6, 8, 12 to 14 and 17 to 20, unpatentable over Shiba, under 35 U.S.C. § 103.

Rejection Under 35 U.S.C. § 112, Second Paragraph

This rejection is not mentioned in appellants' brief. Under normal circumstances, we would remand the application to the examiner to provide appellants with a one-month period to file a supplemental brief. See M.P.E.P. § 1206, third paragraph of "APPEAL BRIEF CONTENT" section.

However, in the present case, we are entering pursuant to 37 CFR § 1.196(b) a

² In an advisory action dated October 7, 1996 (Paper No. 13), the examiner stated that the rejection of claims 12 and 14 on this ground was overcome by the amendment filed September 3, 1996.

new ground of rejection, also under 35 U.S.C. § 112, second paragraph. Therefore, in the interest of administrative efficiency, we will sustain the examiner's § 112 rejection, pro forma, and incorporate the grounds of that rejection in our own rejection under 37 CFR § 1.196(b). Appellants will then have the opportunity to respond as specified in parts (1) and (2) of § 1.196(b).

The fact that we find a number of the claims to be indefinite does not here preclude our consideration of the merits of the rejections of those claims under 35 U.S.C. §§ 102 or 103. Cf. Ex parte Saceman, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993).

Rejections Under 35 U.S.C. § § 102(b) and 103

We will not sustain either of these rejections. The independent claims recite, inter alia, the following:

Claim 1: “visible light intensity sensor means positioned to sense a decrease of visible light responsive to said object approaching said water rinsing device and for generating an electrical signal indicative of said decrease of visible light;”

Claim 11: “visible light sensor means for generating an electrical current responsive to the presence of said user;”

Claim 12: “a visible light sensor to detect an object in substantial proximity to said water rinsing device,”

Claim 19: “(1) testing, at said predetermined intervals, visible light sensor means for sensing the approach of said user to said faucet;”

Shiba does not disclose a visible light sensor as recited in these claims. The visible light sensor of Shiba, element 5a, is not responsive to an object or user as recited in these claims, but rather is used “to detect a brightness of the place surrounding the urinal basin 1, such as the interior of a bathroom or toilet” (col. 1, lines 57 to 59). The examiner’s statement at page 6 of the answer that Shiba’s photocell is operable for generating an electrical signal due to a shadow is not borne out by the reference’s disclosure that the sensor 5a does not provide a signal when the area is dark, “for example while a light of a bathroom or toilet is kept turned off,” but does provide a signal when it detects “brightness” of the area, “such as when the bathroom light is turned on” (col. 2, lines 42 to 53). There is no disclosure that element 5a detects the approach, presence or proximity of any person or object.

Since Shiba does not disclose, expressly or inherently, the above-noted limitations of claims 1 and 11, it cannot constitute an anticipation of them; likewise, since there is no evidence that the above-noted limitations of claims 12 and 19 which are not present in Shiba would have been obvious therefrom, the rejection of those claims under § 103 is untenable. The rejections of the claims dependent on claims 1, 11, 12 or 19 under § 102(b) or § 103 (as applicable) likewise cannot stand.

Rejection Under 37 CFR 1.196(b)

Pursuant to 37 CFR 1.196(b), claims 1, 3, 6, 8 to 10, 12, 13, 15 and 17 to 20 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out

and distinctly claim the subject matter which appellants regard as their invention, for the following reasons:

(1) A number of terms lack antecedent basis in the claims: “said water rinsing system” (claim 1, line 4; claim 8, line 1; claim 9, line 1; claim 10, line 4);³ “said infrared sensor” (claim 1, line 22); “said urinal” (claim 15, lines 3 and 5); “said predetermined levels” (claim 19, lines 4, 7 and 20).

(2) The examiner found claim 1 to be indefinite because it was unclear whether the “water flow control means” (line 2) and “water rinsing device” (lines 2 and 3) were intended to be part of the claimed combination (answer, page 5). Looking at claim 1 in isolation, we consider that since these elements are recited in the preamble of the claim, it might well be assumed that they are not claimed. However, each of dependent claims 6, 8 and 9 contains only limitations relating to the preamble of claim 1; for example, claim 8 defines the water rinsing system [sic] as a faucet. Since a dependent claim must further limit a claim from which it depends, see 37 CFR § 1.75(c) and Ex parte Hansen, 99 USPQ 319, 321 (Bd. App. 1953), the existence of claims 6, 8 and 9 would seem to indicate that the elements recited in the preamble of claim 1 do form a part of the combination claimed. This lack of precision as to the scope of claim 1 causes it to be indefinite. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754,

³ All references herein to particular lines of claims are to the claims as reproduced in the appendix to appellants’ brief.

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1759 (Fed. Cir. 1994).

(3) Claim 12 recites a paired infrared transmitter and receiver in lines 8 and 9, and then recites in lines 26 and 27 (step (4)) testing “a” receiver of said paired infrared transmitter and receiver. The term “a receiver” implies that the paired transmitter and receiver includes more than one receiver, but only one receiver is recited, thus rendering the language of the claim indefinite and inconsistent. Apparently “a” should have been --said-- or --the--.

Conclusion

The examiner’s decision to reject the claims on appeal under § 102(b) or § 103 is reversed, and to reject claims 1, 15 and 19 under § 112, second paragraph, is affirmed. Claims 1, 3, 6, 8 to 10, 12, 13, 15 and 17 to 20 are rejected pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner’s rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that “[a] new ground of rejection shall not be considered final for purposes of judicial review.”

Regarding any affirmed rejection, 37 CFR § 1/197(b) provides:

(b) Appellant may file a single request for rehearing

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within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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

AFFIRMED-IN-PART, 37 CFR § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	APPEALS AND
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