Paper No. 17

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES H. KING,
WAYNE F. BULTEMEIER
and JAMES L. ROUSSEY

Appeal No. 1997-3121
Application 07/987,048

HEARD: MARCH 9, 2000

Before JERRY SMITH, LALL and FRAHM, 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 final rejection of claims 1-15, which constituted all the claims in the application. A first amendment after final rejection was filed on June 29, 1996 but was denied entry by the examiner. A second amendment after final rejection was filed on August 29, 1996 and was entered by the examiner.

This amendment cancelled claims 1 and 12 and resulted in an indication by the examiner that claims 6 and 7 were directed to allowable subject matter. Accordingly, this appeal is directed to claims 2-5, 8-11 and 13-15 which are the only claims still rejected by the examiner.

The invention pertains to a heating element for removing snow and ice from the windshield of an automotive vehicle. The heating element is disposed on the windshield of the vehicle. An ambient temperature sensor determines the temperature of the ambient air outside the vehicle, and the heating element is prevented from operating when the ambient air temperature exceeds some predetermined value.

Representative claim 5 is reproduced as follows:

5. An automotive vehicle having a passenger compartment with window glass that separates the inside of the passenger compartment from the outside environment, an electric heating element disposed on said window glass for heating the same by means of electric power, an electric power source for providing electric power, and a control circuit for controlling the delivery of electric power from said electric power source to said electric heating element, characterized in that said control circuit comprises selectively operable conducting means connected between said electric power source and said electric heating element, and means for operating said selectively operable conducting means comprising an on-off switch means that is accessible to an operator of the vehicle, a temperature sensing switch means that is disposed in non-thermal sensing relationship to said electric heating element to reliably sense temperature indicative of the ambient temperature of the outside environment, and means operatively relating said on-off switch means and said

temperature sensing switch means with said selectively operable conducting means for allowing electric power to be delivered from said electric power source through said selectively operable conducting means to said electric heating element responsive to said on-off switch means being on and said temperature sensing switch means indicating that the ambient temperature of the outside environment is below a certain threshold and for disallowing electric power to be delivered from said electric power source through said selectively operable conducting means to said electric heating element either responsive to said on-off switch means being off or said temperature sensing switch means indicating that the ambient temperature of the outside environment is above said threshold, characterized further in that said selectively operable conducting means is a relay having a coil and normally open contacts that are operated by said coil, said means operatively relating said on-off switch means and said temperature sensing switch means with said selectively operable conducting means comprises means connecting said coil in series with said on-off switch means and said temperature sensing switch means, and said contacts are connected between said electric power source and said electric heating element.

The examiner relies on the following references:

Marriott	3,982,092	Sep. 21, 1976
Jones	4,277,672	July 07, 1981
Heuser et al. (Heuser) (German)	35 13 157 A1	Oct. 16, 1986

Claims 2-5, 8-11 and 13-15 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on an inadequate disclosure. Claims 2, 5, 9-11 and 13 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Marriott in view of Jones or Heuser.

Rather than repeat the arguments of appellants 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, the arguments in support of the rejections and the evidence of obviousness relied upon by the examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' 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 disclosure in this application describes the claimed invention in a manner which complies with the requirements of 35 U.S.C. § 112. We are also of the view that the collective 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 2, 5, 9-11 and 13. Accordingly, we reverse.

We consider first the rejection of claims 2-5, 8-11 and 13-15 under the first paragraph of 35 U.S.C. § 112. The claims are rejected as “containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention” [answer, page 4]. This rejection relates to the written description requirement of 35 U.S.C. § 112.

The rejection is particularly addressed to the amendment of independent claims 5 and 13 which recites that the ambient temperature sensing switch is disposed “in non-thermal sensing relationship to said electric heating element” [final rejection, page 1]. The examiner considers this amendment to introduce new matter into the specification because the original disclosure was not so limited. In other words, other forms of temperature sensing means also fell within the scope of the invention as originally described. Appellants argue that the original disclosure provides clear support for the scope of the invention now being claimed [brief, pages 6-7; reply brief, pages 2-4].

The purpose of the written description requirement is to ensure that the applicants convey with reasonable clarity to those skilled in the art that they were in possession of the

invention as of the filing date of the application. For the purposes of the written description requirement, the invention is "whatever is now claimed." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1564,
19 USPQ2d 1111, 1117 (Fed. Cir. 1991). We agree with appellants that the artisan would have recognized possession of the presently claimed invention within the original disclosure.

The examiner has erred in basing this rejection on a consideration of whether the present claims exclude embodiments which were within the scope of the original specification. The original disclosure simply describes an ambient temperature sensor. The artisan would not have interpreted the disclosed ambient temperature sensor to be in thermal relationship with the heating element because that would distort any measurements of ambient temperature. The broad recitation of the ambient temperature sensor being disposed in non-thermal sensing relationship to the electric heating element would be exactly what the artisan would have assumed from reading the original disclosure. The examiner’s attempt to read the original disclosure on another imagined embodiment makes no sense.

In summary, we agree with appellants that the original disclosure supports the recitations now appearing in independent

claims 5 and 13. Therefore, we do not sustain the examiner's rejection of claims 2-5, 8-11 and 13-15 under the first paragraph of 35 U.S.C. § 112.

We now consider the rejection of claims 2, 5, 9-11 and 13 under 35 U.S.C. § 103. 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 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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make
in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to independent claim 5, the examiner cites Marriott as teaching a vehicle windshield heater which is switched on and off by means of a temperature sensor. The examiner notes that Marriott does not teach the sensing of ambient temperature. The examiner cites Jones or Heuser as teaching that it was well known to sense ambient temperature in

an electrically heated transparency. The examiner concludes that it would have been obvious within the meaning of 35 U.S.C. § 103 to replace the temperature sensor of Marriott with an ambient temperature sensor as taught by Jones or Heuser so that freezing conditions may be determined [final rejection, page 2].

Appellants argue that the substitution of an ambient temperature sensor in the Marriott device would render Marriott's device inoperable for its intended purpose [brief, pages 8-10; reply brief, page 4]. We agree with the position argued by appellants.

The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Since appellants are correct that an ambient temperature sensor would serve no useful purpose in the Marriott device, the only basis for the examiner's proposed modification of Marriott to have an ambient temperature sensor is based on an improper attempt to reconstruct the invention in hindsight.

For the reasons just discussed, we do not sustain the obviousness rejection of independent claim 5 or of claims 2 and 9-11 which depend therefrom. With respect to independent claim 13, this claim recites limitations similar to the limitations of claim 5. Therefore, we also do not sustain the obviousness rejection of claim 13.

The examiner's rejections of claims 2-5, 8-11 and 13-15 are reversed.

REVERSED

Jerry Smith Administrative Patent Judge	)	
Parshotam S. Lall Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Eric S. Frahm Administrative Patent Judge	)	

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