

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHIO OKAMURA

Appeal No. 1998-0456
Application No. 08/454,706

Heard: November 7, 2001

Before FLEMING, GROSS, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 9, 12, and 13, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a storage capacitor power supply. An understanding of the invention can be derived from a reading of exemplary claim 9, which is reproduced as follows:

9. A storage capacitor power supply adapted to store electricity in a capacitor block consisting of a plurality of capacitors connected in series, in parallel or in any combination of series and parallel and to supply electric power to a load, said power supply comprising a residual electricity-detecting circuit which takes the voltage developed across the power supply and, applies the voltage to a series combination of a voltage regulator circuit and a detector device for detecting a current corresponding to the residual electric power.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Meinhold	4,303,877	Dec. 1, 1981
Barthel	4,364,396	Dec. 21, 1982
Metroka et al.	5,121,288	Jun. 9, 1992

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Metroka in view of Barthel.

Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Metroka in view of Barthel and Meinhold.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the final rejection (paper

No. 6, mailed September 25, 1996), examiner's answer (Paper No. 9, mailed April 23, 1997), supplemental examiner's answer (Paper No. 14, mailed March 28, 2000, and second supplemental examiner's answer (Paper No. 16, mailed December 8, 2000) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 8, filed February 21, 1997) and reply brief (Paper No. 10, filed June 25, 1997) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, 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 answers.

At the outset, we note that the final rejection, in addition to including a rejection of claims 9, 12, and 13

under 35 U.S.C. § 103(a), also included a rejection of claims 9, 12, and 13 under 35 U.S.C. § 112, second paragraph. The rejection, however, only made specific reference to independent claim 9, and was silent as to the reasons for rejecting independent claims 12 and 13. In the brief (page 18), appellant "agreed" to make an amendment to claim 9 "upon return of the file to the Examiner" to overcome the rejection under 35 U.S.C. § 112, second paragraph, and listed the specific wording of the proposed amendment. In the examiner's answer, the examiner maintained each of the rejections set forth in the final rejection and added a new ground of rejection (pages 3 and 4) of claims 12 and 13 under 35 U.S.C. § 112, second paragraph, in which the reasons for rejecting claims 12 and 13 under 35 U.S.C. § 112, second paragraph were provided. In the reply brief (pages 1 and 2) appellant "agreed" to make an amendment in response to the new ground of rejection set forth in the examiner's answer, and provided the specific language of the proposed amendment to claims 12 and 13. The supplemental examiner's answer only included the rejection of the claims under 35 U.S.C. § 103(a), and did not refer to either the proposed amendment included with the reply

brief, or the proposed amendment found in the brief. In a second supplemental examiner's answer the examiner again repeated the rejection of claims 9, 12, and 13 under 35 U.S.C. § 103(a) and stated (page 4) that "[i]n order to clarify the record, the Examiner hereby states that the amendment to claims 12 and 13 in Appellant's Reply Brief (Paper No. 10) has overcome the new ground of rejection raised in the Examiner's Answer (Paper No. 9). Therefore, the examiner is officially withdrawing the 35 U.S.C.

§ 112, second paragraph rejection." Although the examiner has not specifically referred to the rejection of claim 9 under 35 U.S.C. § 112, second paragraph, as the examiner has not repeated this rejection, we consider the rejection of claim 9 under 35 U.S.C. § 112, second paragraph, to also be withdrawn. However, we note that the proposed amendments to claims 9, 12, and 13 have not been followed up with actual amendments to the claims. It appears that the examiner has withdrawn the rejection of claims 9, 12, and 13 under 35 U.S.C. § 112, second paragraph based upon amendments that have not in fact been made.

Accordingly, we institute the following rejection under 37 CFR 1.196(b) of claims 9, 12, and 13 under 35 U.S.C. § 112, second paragraph:

Claims 9, 12, and 13 stand rejected under 35 U.S.C. § 112, second paragraph, for the reasons advanced by the examiner in the final rejection (page 2), and the new ground of rejection found in the examiner's answer (page 4). We note that appellant has not argued the propriety of the rejection, and that the examiner and appellant are in agreement that appellant's proposed changes will overcome the rejection. Nevertheless, the rejection should be maintained until such time as the actual amendments have been made to the claims.

The final rejection additionally included a rejection of claim 9 under the doctrine of obviousness-type double patenting.

Appellant additionally proposed (brief, page 18) withdrawing claim 9 of copending application 08/041,543 "should the claim in this application be allowed" in order to overcome the obviousness-type double patenting rejection. The examiner stated

in the final rejection (page 7) that "[c]oncerning the withdrawal of claim 9 in the copending application, the provisional double patenting rejection will be overcome after the claim is canceled from the copending application. Since the claim currently remains [sic, in] the copending application, the provisional double patenting rejection remains." This rejection was maintained in the examiner's answer, but was not repeated in either the first or second supplemental examiner's answers. There is nothing in the record to indicate that this rejection has been withdrawn. However, since this rejection has not been repeated, we consider the rejection to have been withdrawn by the examiner.

We turn next to the rejection of claims 9, 12, and 13 under 35 U.S.C. § 103(a). We note that the second supplemental answer refers to the final rejection for a statement of the rejection, and refers to the supplemental examiner's answer for response to the arguments found in the brief.

We begin with the rejection of claim 9 based upon the teachings of Metroka and Barthel.

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. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); 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. 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).

The examiner's position (final rejection, page 3) is that Metroka does not disclose the detecting of residual voltage of the capacitor block. To overcome this deficiency of Metroka, the examiner turns to Barthel for a teaching of a circuit for measuring the output voltage of an output capacitor. In the examiner's opinion, it would have been obvious to "combine the references in order to take advantage of the additional function of determining residual capacity of a capacitive power supply as taught by Barthel in order to warn an operator of an inadequate power level."

Appellant asserts (brief, page 6) that Metroka and Barthel, either singly or in combination, do not teach or suggest a voltage regulator circuit. The examiner responds

(supplemental answer, page 3) by asserting that Metroka shows a voltage regulator circuit in col. 9, lines 38-50. We find in the disclosure of Metroka (col. 9, lines 43-47) that "[s]witching power supplies are well known per se in the art and function to generate a constant voltage output responsive to application of a wide range of voltages across an input thereof." From this teaching of Metroka, we find that Metroka discloses a voltage regulator circuit, as advanced by the examiner.

Appellant responds to the examiner's finding of a voltage regulator circuit in Metroka (reply brief, page 3) by asserting that even if Metroka teaches or suggests a voltage regulator circuit, that Barthel and Metroka do not teach or suggest a series combination of a voltage regulator and a detector device. We find that the examiner has not addressed the limitation of a series combination of a voltage regulator circuit and a detector device for detecting a current corresponding to residual electrical power. We agree with appellant (reply brief, page 3) that in Metroka, switching power supply 400 is in parallel with five volt detector 406. In the rejection, (final rejection, page 3) the examiner

states that the five volt detector 406 is connected to the switching power supply 400, but does not address whether they are in series or parallel with each other. The portion of Metroka referred to by the examiner (figure 9 and col. 9, line 60 et seq.) provides no disclosure or suggestion of connecting the switching power supply 400 in series with the five volt detector 406. In addition, appellant's argument that this feature is missing from Metroka and Barthel has not been addressed by the examiner.

In addition, we note that as asserted by appellant (brief, page 5), Barthel discloses output capacitors 10 and 24 which are grounded to provide a stimulation pulse to the atrium or ventricle of stimuable heart tissue. The output capacitors 10 and 24 each have a value of approximately 10 microfarads.

We find that Barthel does disclose detecting the residual voltage after the output capacitors have been discharged. However, the residual voltage is detected as part of the process of determining the energy of the stimulation pulse, in which the voltage across the output capacitor is measured directly before and immediately after the stimulation pulse

(col. 5, lines 53-57 and col. 6, lines 37-39). Metroka, in contrast, is directed to a power supply for a radiotelephone. The storage capacitor power supply for the radiotelephone of Metroka has an equivalent capacitance of eight 6000 farad capacitors (col. 8, lines 12-16). Because the residual voltage of the output capacitors 10 and 24 of Barthel are used in determining the amount of energy of the stimulation pulse to a patient's heart atrium or ventricle, we find no suggestion to have combined the teachings of Metroka and Barthel, except from a reading of appellant's disclosure. As stated by our reviewing court, "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

From all of the above, we find that the examiner has failed to establish a prima facie case of obviousness of claim 9. Accordingly, the rejection of claim 9 under 35 U.S.C. § 103(a) is reversed.

We turn next to the rejection of claims 12 and 13 under 35 U.S.C. § 103(a) based upon the teachings of Metroka, Barthel, and Meinhold. This rejection is also reversed because Meinhold does not make up for the deficiencies of the basic combination of Metroka and Barthel with respect to the claimed residual electricity-detecting circuit.

CONCLUSION

To summarize, the decision of the examiner to reject claims 9, 12, and 13 under 35 U.S.C. § 103(a) is reversed.

This decision contains a new ground of rejection of claims 9, 12, and 13 under 35 U.S.C. § 112, second paragraph, 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."

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 (§ 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. . . .

REVERSED

MICHAEL R. FLEMING)
Administrative Patent Judge)
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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STUART S. LEVY)	
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