

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAREN P. SHRIER, GERALD R. BEHLING,
KAILASH C. JOSHI, and WILLIAM W. ALSTON

Appeal No. 1998-2975
Application No. 08/790,250

HEARD: April 12, 2001

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 12, 14 through 18, 43, 51, and 52, which are all of the claims pending in this application.

Appellants' invention relates to a variable voltage protection device which includes a voltage variable material with a uniform thickness reinforcing layer embedded therein and a compressible ground plane. Claim 12 is illustrative of the claimed invention, and it reads as follows:

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12. A variable voltage protection component for placement between a ground and an electronic circuit comprising:

a voltage variable material;

a reinforcing layer having a substantially constant thickness embedded in the voltage variable material; and

a compressible conductive ground plane contacting said variable voltage protection component.

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

Schurter et al. (Schurter) 3,813,639 May 28,
1974

Admitted Prior Art found on pages 1-4 of the specification (APA)

Claims 12, 14 through 18, 43, 51, and 52 stand rejected under 35 U.S.C. § 103 as being unpatentable over APA in view of Schurter.

Reference is made to the Examiner's Answer (Paper No. 22, mailed April 13, 1998) for the examiner's complete reasoning in support of the rejection, and to appellants' Brief (Paper No. 21, filed January 15, 1998) and Reply Brief (Paper No. 23, filed June 12, 1998) for appellants' arguments thereagainst.

OPINION

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We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 12, 14 through 18, 43, 51, and 52.

Claims 12, 14 through 18, and 51 recite, in pertinent part, "a voltage variable material" and "a reinforcing layer having a substantially constant thickness embedded in the voltage variable material" (underlining added for emphasis). The examiner points to the admitted prior art to Collins (APA, pages 3-4), describing an insulating sheet with plural holes filled with variable voltage materials, as being a reinforcing layer impregnated with voltage variable material. The examiner (Answer, page 3) then relies on the disclosure at page 8, lines 8-11 of the specification, wherein appellants seem to equate a reinforcing layer embedded in a voltage variable material with a reinforcing layer impregnated with the voltage variable material. The examiner asserts that since Collins discloses a reinforcing layer impregnated with voltage variable material and appellants' statement on page 8 of the specification makes such a layer interchangeable with a

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reinforcing layer embedded in the voltage variable material, Collins meets the claim limitation. We disagree.

Collins' variable voltage material clearly is not embedded with a reinforcing layer, according to the normal usage of the word embedded. Further, in normal usage, the word "impregnate" means to saturate or permeate throughout. On page 8, line 16-page 9, line 9, appellants disclose that the reinforcing layer can be a porous polymer material, fibrous pieces of insulating material forming a mat, or particulate pieces of insulating material pressed or bonded together to form a sheet, which are all materials or structures that could be impregnated with a voltage variable material according to its normally accepted definition. On page 9, lines 10-22, appellants describe the material shown in Figures 1 and 2 as a variable voltage material impregnating such a reinforcing layer. The voltage variable material clearly permeates through or saturates the reinforcing layer, as opposed to Collins which merely fills mechanically or chemically formed voids. Thus, even interpreting "embedded in" as meaning "being impregnated with," as the examiner has done, we find that Collins fails to meet the claim limitation.

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Accordingly, we cannot sustain the rejection of claims 12, 14 through 18, and 51.

Claims 12, 17, 18, 43, 51, and 52 require a compressible conductive ground plane. APA includes a ground plane, but not a compressible one. Recognizing this, the examiner (Paper No. 16) applies Schurter. Specifically, the examiner points to Schurter's disclosure (column 3, lines 43-49) of a ground shield of semi-conductive elastomer in an electrical connector as a teaching for a compressible ground plane. Appellants (Brief, pages 7-8) argue that there is no motivation to combine APA with Schurter. We agree.

Nothing in Schurter suggests a reason why one would want a compressible ground plane in a voltage protection device. The examiner contends (Answer, page 6) that "having a compressible ground plane as opposed to a rigid ground plane would be desirable for mating or for fitting purposes," but fails to provide any evidence to support this statement. Merely that Schurter discloses a similar element and that APA can 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,

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972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-4 (Fed. Cir. 1992).

"There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

We find no such suggestion or motivation in the prior art applied in this case. Consequently, the examiner has failed to establish a prima facie case of obviousness, and we cannot sustain the rejection of claims 12, 17, 18, 43, 51, and 52.

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CONCLUSION

The decision of the examiner rejecting claims 12, 14 through 18, 43, 51, and 52 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
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)	
Administrative Patent Judge)	

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