

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN T. SCHNEBLY, KEVIN C. MARTIN,  
RANDY KOLEDA and LEO LITTO

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Appeal No. 1999-0574  
Application No. 08/583,588

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ON BRIEF

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Before HAIRSTON, JERRY SMITH, and LEVY, 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 1-38. Added claim 39 stands withdrawn from consideration as being directed to a different invention from the invention already examined. An amendment after final rejection was filed on April 27, 1998 but was denied entry by the examiner.

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The disclosed invention pertains to a window covering and lighting system for a window which are independently controllable.

Representative claim 1 is reproduced as follows:

1. A window covering and lighting system for a window in a room comprising:
  - a cornice mounted to a wall supporting a window covering movable between an open position and a closed position,
  - an actuator operatively associated with the cornice for moving the window covering between the open position and the closed position,
  - a lighting system operatively associated with the cornice; and
  - a programmable logic control unit for operating the actuator and the lighting system independently from one another upon demand.

The examiner relies on the following references:

Clemmons et al. (Clemmons)	4,544,866	Oct. 01, 1985
Zerillo	4,958,112	Sep. 18, 1990
Lin	5,247,232	Sep. 21, 1993

The admitted prior art set forth in appellants' specification.

Claims 1-6, 8, 10-15 and 20-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Zerillo and the admitted prior art. Claims 7, 9 and 16-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Zerillo and the admitted prior art in view of Lin. Claims 24-38 stand rejected under 35 U.S.C. §

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103 as being unpatentable over the teachings of Zerillo and the admitted prior art in view of Clemmons.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief 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 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, the appellants' arguments set forth in the brief 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 evidence relied upon does not support the rejections as formulated by the examiner. Accordingly, we reverse.

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,

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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

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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 1, the examiner cites Zerillo as teaching a drapery actuator controlled by wireless remote. The examiner cites the admitted prior art as teaching lighting associated with a window covering. The examiner asserts "[t]hus, it would have been obvious to one of ordinary skill in the art to utilize the admitted prior art with Zerillo as it is stated as known within the art" [answer, pages 6-7].

Appellants argue that Zerillo does not teach or suggest a system utilizing a cornice or a lighting system

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operatively associated with the cornice. Appellants also argue that they have not identified or admitted to prior art directed to the claimed combination. Finally, appellants argue that persons skilled in this art could not combine the teachings of Zerillo with the admitted prior art unless improper hindsight is applied [brief, pages 5-6]. The examiner simply disagrees.

We will not sustain the rejection of the claims based on Zerillo and the admitted prior art as formulated by the examiner because the examiner has failed to establish a prima facie case of obviousness. As noted above, the examiner has the burden of initially presenting a prima facie case of obviousness. The examiner cannot satisfy this burden by simply dismissing differences between the claimed invention and the teachings of the prior art as being obvious. The examiner cannot identify individual features of the claimed invention in the prior art and simply assert obviousness based on combining these individual features. In this case, the examiner must either present a cogent rationale why the artisan would have been motivated to combine the teachings of the individual prior art, or the examiner must present us with

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an evidentiary record which supports the finding of obviousness. It does not matter how strong the examiner's convictions are that the claimed invention would have been obvious, or whether we might have an intuitive belief that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103. Neither circumstance is a substitute for evidence lacking in the record. Whether there is prior art available which would render these appealed claims unpatentable we cannot say. Whether the examiner could have developed a reasonable basis for asserting the obviousness of the claimed invention based on the present record we will not speculate. We can say, however, that the record presently before us does not support the rejection as formulated by the examiner. Therefore, we do not sustain the examiner's rejection of independent claim 1 based on Zerillo and the admitted prior art.

With respect to the claims which depend from claim 1, the examiner has simply asserted the obviousness of these claims without any cogent rationale. Also, since Lin does not overcome the basic deficiencies in the record with respect to Zerillo and the admitted prior art, we also do not sustain the

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rejection of any claims based on the additional teachings of Lin. Accordingly, we do not sustain the rejection of any of appealed claims 1-23.

With respect to independent claim 24, the examiner cites Zerillo and the admitted prior art in the same manner discussed above. Clemmons is cited as teaching the obviousness of providing multiple controllers for multiple actuators. The examiner finds that it would have been obvious to combine the teachings of Clemmons with the teachings of Zerillo and the admitted prior art.

This rejection fails for the same reason discussed above with respect to claim 1. Clemmons does not overcome the basic deficiencies in the record with respect to Zerillo and the admitted prior art. Therefore, we do not sustain the rejection of claims 24-38 as formulated by the examiner based on Zerillo, the admitted prior art and Clemmons.

In summary, we have not sustained any of the rejections of the appealed claims as formulated by the examiner. Accordingly, the decision of the examiner rejecting claims 1-38 is reversed.

REVERSED

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KENNETH W. HAIRSTON )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
JERRY SMITH ) APPEALS  
Administrative Patent Judge ) AND  
 ) INTERFERENCES  
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STUART S. LEVY )  
Administrative Patent Judge )

JS/sld

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APJ JERRY SMITH

APJ

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