

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAYUKI UMEHARA,
KAZUMASA SUGIYAMA and HITOSHI KAWASAKI

Appeal No. 2000-2020

Application 09/050,558

HEARD: May 22, 2002

Before KRASS, RUGGIERO and DIXON, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-7, which are all of the claims pending in the present application.

The claimed invention relates to the mounting of an electric light bulb having a positioning ring to the base of the bulb and secured by welding. Elastic pieces and weld pieces are formed on a fitting hole of the positioning ring through which the base of the bulb is inserted. The elastic pieces resiliently abut against an outer peripheral surface of the base and the weld

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pieces are welded to the peripheral surface of the base after the elastic pieces have positioned the base.

Claim 1 is illustrative of the invention and reads as follows:

1. An electric light bulb with a base, comprising a positioning ring adapted to be mounted in externally fitted fashion to the base which holds a glass bulb enclosing therein filaments, said positioning ring comprising elastic pieces and weld pieces formed on a fitting hole, through which said base is inserted, said elastic pieces being adapted to resiliently abut against an outer peripheral surface of said base, said weld pieces being adapted to be welded to the outer peripheral surface of said base, and wherein said weld pieces are securely welded to the outer peripheral surface of said base after said elastic pieces are made to abut against the outer peripheral surface of said base to be positioned.

The Examiner relies on the following prior art:

Wakimizu	4,547,838	Oct. 15, 1985
Van Heeswijk	5,216,319	Jun. 01, 1993

Claims 1-7 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Heeswijk in view of Wakimizu.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

¹ The Appeal Brief was filed October 26, 1999 (Paper No. 16). In response to the Examiner's Answer dated December 23, 1999 (Paper No. 17), a Reply Brief was filed February 3, 2000 (Paper No. 18), which was acknowledged and entered by the Examiner in the communication dated February 22, 2000 (Paper No. 20).

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection 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 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 1-7. 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, 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

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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).

With respect to independent claims 1 and 6, the Examiner, as the basis for the obviousness rejection, proposes to modify the electric light bulb disclosure of Van Heeswijk. According to the Examiner (Answer, page 3), Van Heeswijk discloses the claimed invention except for "...elastic pieces that [sic, are] resilient about an outer peripheral surface of the base and extend towards

an opposite end to that of the bulb(2).” To address this deficiency, the Examiner turns to Wakimizu which, in the Examiner’s view (id., at 3 and 4), “... discloses an electric lamp assembly with a positioning ring (16) that comprises elastic pieces (46, 48) which resiliently abut an outer peripheral surface of a base (24) of the lamp....” In the Examiner’s analysis (id., at 4),

it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the resilient elastic pieces of Wakimizu onto the positioning ring (20) of Van Heeswijk for the purpose of easily aligning the filaments with the main conductors by simply revolving the base unit relative to the positioning ring.

Appellants’ arguments in response to the obviousness rejection focus on the contention that a prima facie case of obviousness has not been established since there is no suggestion or motivation in the disclosures of the Van Heeswijk and Wakimizu references for the Examiner’s proposed combination. In particular, Appellants assert (Brief, page 5) that no motivation exists for adding the elastic pawls of Wakimizu to the fixation member 20 of Van Heeswijk since the bulb in Van Heeswijk is already held in place by the welding of the tongues 21 to the bulb clamping member 10.

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Upon careful review of the applied prior art in light of the arguments of record, we are in agreement with Appellants' stated position in the Briefs. 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).

As alluded to by Appellants (Brief, pages 5 and 6; Reply Brief, page 4), it is apparent that Van Heeswijk and Wakimizu teach alternative techniques, i.e. a welding of tongue 21 to clamping member 10 (Van Heeswijk) and elastic pawls 46 and 48 (Wakimizu), for securing a positioning member to a lamp bulb structure. We find no support in the disclosure of either of the disclosures of Van Heeswijk or Wakimizu for the Examiner's proposed combination. In our opinion, motivation is lacking for the skilled artisan to add the elastic pawl members of Wakimizu to the device of Van Heeswijk to aid in securing the bulb to the clamping member 10 since Van Heeswijk already provides for a procedure, i.e. the welding of tongue 21 to the clamping member 10, to secure the bulb. From the above discussion, we can only

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conclude that any suggestion to modify the disclosure of Van Heeswijk by adding the elastic pawls of Wakimizu, could not have come from the references themselves but, rather, only from Appellants' own disclosure.

In conclusion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of independent claims 1 and 6, as well as claims 2-5 and 7 dependent thereon, is not sustained. Therefore, the decision of the Examiner rejecting claims 1-7 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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