

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. DECICCO

Appeal No. 2001-0013
Application 08/936,222

ON BRIEF

Before JERRY SMITH, DIXON and GROSS, 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 3, 4, 6-10 and 13-17, which constitute all the claims remaining in the application. An

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The disclosed invention pertains to an open mounting frame of a recessed lighting fixture for supporting the recessed lighting fixture in a fixture aperture formed in a ceiling.

Representative claim 3 is reproduced as follows:

3. An open mounting frame of a recessed lighting fixture for supporting the recessed lighting fixture in a fixture aperture formed in a ceiling having a lower surface and upper surface, said frame having an annular base ring, said base ring adapted to engage the lower surface of the ceiling, a pair of spaced apart columnar uprights connected to the base ring, each upright having one end connected to the base ring, said uprights being substantially diametrically opposed to each other, said columnar uprights connected to each other by a bridge, said bridge connected to ends of the columnar uprights opposite the ends connected to the base ring, a lock connected to each of the uprights, each of the locks being adapted to engage the upper surface of the ceiling to hold the frame in the fixture aperture in cooperation with the base ring, said bridge includes a pair of sloped supports, each of the supports having one end fixed to a respective columnar upright, and a span connecting the sloped supports at their respective ends opposite to the end fixed to the columnar uprights, said span adapted to support a lamp socket.

The examiner relies on the following references:

Williams et al. (Williams)	4,232,362	Nov. 04, 1980
Webb	5,122,944	June 16, 1992
Winkelhake	5,868,493	Feb. 09, 1999

(effective filing date of May 2, 1994)

The pending rejection of claims 7-13 and 17 under 35

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examiner offers Webb in view of Winkelhake with respect to claims 4, 6 and 13, and Webb in view of Official Notice with respect to claims 3, 7-10 and 14-17.

Rather than repeat the arguments of appellant 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 appellant's 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 and the level of skill in the particular art would not have suggested to one of ordinary skill

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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

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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 appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 4, 6 and 13 based on Webb and Winkelhake. It is the position of the examiner that Webb discloses the light fixture of these claims except for torque spring receptacles mounted on the columnar uprights and torque springs connected to the receptacles and to the baffle. The examiner cites Winkelhake as teaching a recessed light fixture having torque spring receptacles and torque springs which are connected to the torque receptacles and to a baffle. The

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Appellant argues that there is no motivation to combine the teachings of Webb and Winkelhake because they are directed to different types of lighting fixtures. With respect to claims 4 and 6, appellant argues that Webb does not show a bridge, a torque spring receptacle or a baffle. Appellant also argues that Winkelhake does not have uprights and that the baffle in Winkelhake is held in position by a tension spring member [brief, pages 56-59]. With respect to claim 13, appellant additionally argues that Webb does not teach a short crown formed integral with the flat annulus. Appellant argues that the Winkelhake fixture does not require the type of support which is required in Webb [id., pages 60-61].

The examiner has carefully responded to each of appellant's arguments, and the examiner has explained how the invention of claims 4, 6 and 13 would have been obvious to the artisan despite the arguments made by appellant in the brief [answer, pages 5-10]. We note that appellant did not further challenge the examiner's position as set forth in the response to

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of these claims that are argued by appellant is met by corresponding features of Webb and Winkelhake when the claims are given their broadest reasonable interpretation. We find the examiner's arguments made in the response to arguments section of the answer to be persuasive, and these arguments have not been further addressed by appellant. Therefore, we agree with the examiner that Webb and Winkelhake can be considered to broadly teach the claimed bridge, torque spring receptacle, baffle and the short crown with the flat annulus.

We are not persuaded by appellant's argument that there is no motivation to combine the teachings of Webb and Winkelhake because they are directed to different types of light fixtures. Webb needs to provide some type of arrangement to hold the light fixture tightly and securely in place. Winkelhake is cited only to show that torque springs with receptacles were conventionally used for providing such attachment. We agree with the examiner that it would have been obvious to broadly use the attachment teachings of Winkelhake to attach the fixture in Webb to the

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except for explicitly teaching a bridge shaped with sloped supports. The examiner takes Official Notice that bridges with sloped supports for supporting a light socket were well known and were use for the purpose of increasing the strength of the support while also reducing the weight of the supports. The examiner finds that, as a result, the claimed invention would have been obvious to the artisan [answer, pages 4-5].

Appellant argues that the use of Official Notice as a principal element in a combination rejection is improper. Although the examiner cited Williams to support his Official Notice, appellant argues that there is no suggestion to make the combination. Appellant argues that since no bridge is taught in Webb anyway, there can be no Official Notice for modification. Appellants also make the same arguments considered above. Additionally, appellant argues that the reflector of Webb is not a baffle. Appellant argues that there is no ballast mount as such taught by Webb [brief, pages 61-71].

The examiner responds by confirming his reliance on

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features that were mentioned above. We note that appellant again did not further challenge the examiner's position as set forth in the response to arguments section of the answer.

We will not sustain the rejection of these claims because the examiner has failed to establish a prima facie case of obviousness. In the case of In re Sang-Su Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), the court set forth the standards the Patent and Trademark Office ("PTO") must adhere to when rejecting a claim under 35 U.S.C. § 103. Specifically, when rejecting a claim for obviousness, the PTO must articulate the reasons for its decision. Id. at 1342. In particular, the PTO must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The responsibility of the Board is not only to assure that the requisite findings are made, based on evidence of record, but also to explain the reasoning by which the findings are deemed to support the agency's conclusion. Id. at 1342.

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Notice is known to the artisan. The MPEP states that the examiner may take Official Notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" [MPEP § 2144.03]. Although the examiner may be convinced that he need not find a feature which he considers to be well-known in this art, appellant challenges this finding, and we find that this is not the type of finding which can be unquestionably and instantly demonstrated. Official Notice may not be substituted for facts which cannot be instantly and unquestionably demonstrated. Therefore, the examiner's rejection fails to establish a prima facie case of obviousness.

In summary, the examiner' rejection of claims 3, 4, 6-10 and 13-17 is sustained with respect to claims 4, 6 and 13, but is not sustained with respect to claims 3, 7-10 and 14-17. Therefore, the decision of the examiner rejecting claims 3, 4, 6-10 and 13-17 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JERRY SMITH)	
Administrative Patent Judge)	
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JOSEPH L. DIXON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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