

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte EDWARD F. ALLINA

Appeal No. 95-1546  
Application 08/014,377<sup>1</sup>

ON BRIEF

MAILED

MAR 5 - 1996

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before THOMAS, HAIRSTON and JERRY SMITH, 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 rejections of claims 1-25, which constitute all the claims in the application. The examiner withdrew the

<sup>1</sup> Application for patent filed February 5, 1993. According to applicant, the application is a continuation of Application 07/532,397, filed June 1, 1990, which is a continuation-in-part of Application 06/923,524, filed October 28, 1986, now Patent No. 4,931,895, granted June 5, 1990.

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rejections against claims 18-20 in the answer. Accordingly, the rejections against claims 1-17 and 21-25 are on appeal before us.

The claimed invention pertains to a method and apparatus for protecting an electric watt-hour meter and electrical apparatus connected downstream therefrom from the potential damage caused by transient voltage surges. A varistor is used to conduct the current resulting from a transient voltage surge safely to ground.

Representative claim 1 is reproduced as follows:

1. Method of protecting from transient voltage surges both a watt-hour meter pluggable into a utility box or panel meter socket and downstream electrical apparatus powered by power lines from an external power source and subject to surges, commonly resulting from lightning strikes or switching malfunctions, comprising the steps of

interposing solid-state non-linear resistance means, being at most minimally conductive at normal power-line voltages but readily conductive at surge voltages,

electrically between the external power source and ground,

physically located between the meter and its socket, and

including varistors but excluding spark gaps as components;

clipping voltage surges exceeding a preselected level above the normal maximum power-line voltage, and shunting the resulting surge currents to an external ground via the utility box or panel.

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The examiner relies on the following references:

St. John	2,606,232	Aug. 05, 1952
Melanson	3,914,657	Oct. 21, 1975
Dell Orfano	4,089,032	May 09, 1978

Claims 1-17 and 21-25 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers St. John in view of Melanson or Dell Orfano.

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 and evidence set forth in the brief 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 collective evidence relied upon and the level of skill in the particular art would have suggested to one of

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ordinary skill in the art the obviousness of the invention as set forth in claims 1-17 and 21-25. Accordingly, we affirm.

Appellant has nominally indicated that the claims do not stand or fall together, but he has not specifically argued the limitations of each of the claims. Simply pointing out what a claim requires with no attempt to point out how the claims patentably distinguish over the prior art does not amount to a separate argument for patentability. In re Nielson, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987). To the extent that appellant has properly argued the reasons for independent patentability of specific claims, we will consider such claims individually for patentability. To the extent that appellant has made no separate arguments with respect to some of the claims, such claims will stand or fall with the claims from which they depend. Note In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

The examiner's statement of the rejections appears in the final rejection, and the examiner's response to arguments made by appellant appears on pages 5-9 of the answer. Appellant makes several arguments in opposition to the rejections made by the examiner which we will address in turn.

Appellant's arguments begin by noting what is taught by each of the references individually and by noting the distinctions between the features of the claims and the individual

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references [brief, pages 5-12]. In noting the distinctions between the claims and the references, appellant makes the following points:

1. ST. JOHN discloses **neither** varistors **nor** grounding, ... .
2. MELANSON'S spark gap, **not** his varistor clips the surges.
3. DELL ORFANO'S varistors are **not** between the meter and socket, ... .
4. MELANSON'S cylindrical module housing is not similar radially and axially to a conventional watt-hour meter ... .
5. DELL ORFANO does **not** disclose a cylindrical housing member similar radially and axially to a conventional watt-hour meter; ... .
6. MELANSON'S varistors are ... **not** between meter and socket.

In the case of each point made above, the designated reference was not relied on to provide the noted teaching. For example, it does not matter that St. John does not disclose varistors or grounding because Melanson and Dell Orfano were relied on to provide that teaching. Appellant cannot show non-obviousness by attacking the references individually where, as here, the rejections are based on a combination of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). St. John was cited for one purpose only and that was to demonstrate the obviousness of attaching a circuit protection device in modular fashion at the location of the watt-hour meter. Melanson and Dell Orfano were cited only to show that it was well known to seek to protect electric circuits against the damage caused by

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transient voltage surges. It is this combination of teachings that the examiner relies on to support the rejections of the claims. We will discuss the obviousness of combining the reference teachings infra.

It is at this same portion of the appeal brief that appellant makes brief reference to the dependent claims. The extent of appellant's discussion of the dependent claims is to simply state what is recited in each of the dependent claims. There is no analysis provided by appellant as to why the specific recited features of the dependent claims would not have been obvious to one having ordinary skill in the art. This mere statement of what is recited in the dependent claims is insufficient to support the separate patentability of these claims. In re Nielson, supra. Accordingly, the dependent claims are presumed to stand or fall with the claims from which they respectively depend.

Appellant's next argument is that the final rejection failed to give an obviousness analysis on a claim by claim and element by element basis [brief, pages 13-14]. While the final rejection did indeed lump all the claims together under the umbrella of a single rejection, the examiner did analyze the obviousness of several features appearing in various ones of the claims. If appellant thought that the final rejection was insufficient to convey the bases for rejection of any of the

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claims, then appellant could have petitioned the Commissioner for clarification of the final rejection. Appellant did not avail himself of this option. Appellant also has not specifically argued the lack of obviousness of the invention on a claim by claim basis so that we have not been provided a record by which to evaluate the respective positions of the examiner and appellant for each individual claim. Appellant, therefore, has failed to properly make an issue of the claims on a claim by claim basis.

With respect to the combination of St. John in view of Melanson, appellant argues that the feature of a varistor working in the absence of a spark gap is not suggested. We note that the examiner interprets Melanson as suggesting a varistor alone as one of three possible alternatives [column 1, lines 39-41]. Appellant strongly disputes that this portion of Melanson suggests the varistor working without the spark gap. We also note that in the parent application to this application, a different panel of the Board hinted that the presence or absence of the spark gap would not have been a patentable distinction [page 7 of decision in appeal no. 92-2977]. Appellant also strenuously disputes this suggestion by the Board in the prior appeal.

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Although we come to the same conclusion as the panel of the Board did in the previous appeal, we do so primarily based upon appellant's own description of the prior art in the specification. In describing the operation of the Dell Orfano device as a transient surge suppressor which uses a varistor but no spark gap, appellant states that:

In this regard a varistor selected to conduct minimally at normal power voltage has taken on the primary function (formerly performed by a spark gap) of clipping the surge above a preselected higher voltage, and a modified function of minimal conduction (substantial non-conduction) at power voltages [specification, page 3, lines 38-42].

In our view, this passage represents a clear recognition by appellant that the prior art had already taught that a transient voltage surge could be suppressed by a varistor acting in the absence of a spark gap. Thus, this particular feature, such as recited in claim 1, does not in and of itself provide patentability to what would otherwise be an unpatentable combination of features.

With respect to the combination of St. John in view of Dell Orfano, appellant argues that the potting of Dell Orfano's transient voltage surge suppression device in epoxy resin and the molding of a housing around this potted structure are incompatible with St. John's removable compartment. This argument ignores the purpose for which each of the references was

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used as discussed above. It is the teachings rather than the structures of the references which are combinable within 35 U.S.C. § 103 from the references' teachings. In re Keller, supra; In re Nievelt, 482 F.2d 965, 179 USPQ 224 (CCPA 1973). Skill is presumed to be possessed by the artisan. In re Sovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). The artisan would have recognized that the combined teachings of St. John and Dell Orfano would not have required the specific housing of Dell Orfano to be attached to the St. John modular assembly, but rather, only that the electrical circuit connections be added to suppress transient voltage surges in St. John.

Appellant also argues that the proposed combination of references by the examiner produces an unpredictable result. Obviousness does not require absolute predictability. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); In re Lamberti, 545 F.2d 747, 192 USPQ 278 (CCPA 1976). Only a reasonable expectation that the beneficial result will be achieved is necessary to show obviousness. In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Merck & Co. Inc., supra. In our view, the artisan would have expected the transient voltage surge suppression concepts of Melanson or Dell Orfano to have desirable application as an attachment to a watt-hour meter such as taught by St. John.

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Appellant's next argument concerns the filing of Exhibits B, C and D to demonstrate the differences between fuses and varistors [brief, pages 21-22]. The purpose of these exhibits is apparently to support an argument that the overcurrent protection device of St. John, which uses fuses or circuit breakers, would not have suggested a transient voltage surge suppression device as claimed. This argument would be more compelling if there were no teachings at all of the need to protect circuits against transient voltage surges. To the contrary, however, both of the "secondary" references teach the need to protect household appliances and electric watt-hour meters against the damage caused by such transient voltage surges. Thus, although the prior art clearly recognizes the difference between overcurrent and transient voltage protection, the prior art clearly suggests that both types of protection are desirable.

Appellant's next arguments deal with the question of commercial success. With respect to the graph of Exhibit E showing the number of sales of appellant's devices, there is no evidence submitted that the specific claimed features were the cause of the number of sales. There must be a nexus between the claimed invention and the purported success in the market place. Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015,

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226 USPQ 881 (Fed. Cir. 1985); Stratoflex Inc. v. Aeroquip Corp.,  
713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). The evidence  
submitted by appellant fails to establish the required nexus  
between the claimed invention and the purported success.

With respect to Exhibits G and H, we agree with the  
examiner that these exhibits provide "no probative evidence that  
the claims have anything to do with the question of what it was  
that enjoyed commercial success" [answer, page 7]. Commercial  
success and its relationship to the claimed invention are issues  
of fact which the appellant has not demonstrated in a persuasive  
manner.

Appellant next argues that his invention was copied by  
others as evidenced by Exhibit F which is a portion of a  
deposition taken in a related civil action proceeding. We find  
bits and pieces of a deposition which are not included within  
full context to be unpersuasive. We also agree with the examiner  
that the "thing" that was copied by the deposed appears to be the  
form of marketing of a device as much as the specific device  
itself. There is also no evidence submitted that the particular  
invention claimed on appeal represents the same device that was  
copied. We are left to speculate as to what relationship the  
copied device has to each of the specific claims on appeal before  
us. In view of this, appellant has failed to meet his burden of  
proof on the issue of secondary considerations of nonobviousness.

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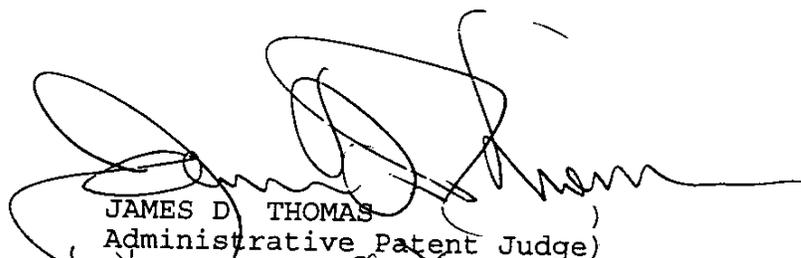
We have carefully considered the cases cited by appellant, but we find the facts of this case to require that the rejections posed by the examiner be sustained. The reasons to combine the applied prior art are properly articulated by the examiner as amplified by our comments above. The nexus between the asserted commercial success and the specific claimed invention has not been established as discussed above. The assertion of copying of the claimed invention is not properly supported by factual evidence in support of whether this copying relates to the issue of obviousness of the claimed subject matter for reasons discussed above. Accordingly, the rejections of claims 1-17 and 21-25 as unpatentable over the teachings of St. John in view of Melanson or Dell Orfano are sustained.

The examiner's decision rejecting claims 1-17 and 21-25 is affirmed.

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

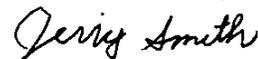
AFFIRMED



JAMES D. THOMAS  
Administrative Patent Judge)



KENNETH W. HAIRSTON  
Administrative Patent Judge)



JERRY SMITH  
Administrative Patent Judge)

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