

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLE K. NILSSEN

MAILED

JUN 28 1995

Appeal No. 95-2161
Application 08/008,093¹

PAT. & TM. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before HARKCOM, Vice Chief Administrative Patent Judge, and
JERRY SMITH and BARRETT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 29-41, 44, and 45.

¹ Application for patent filed January 22, 1993, entitled "Frequency, Voltage and Waveshape Converter for a Three Phase Induction Motor," which is a continuation of Application 07/643,169, filed January 22, 1991, now abandoned, which is a continuation of Application 07/243,246, filed September 8, 1988, now abandoned, which is a continuation of Application 07/014,353, filed February 13, 1987, now abandoned.

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Claims 29-41 stand rejected under 35 U.S.C. § 112, second paragraph, as being an impermissible single means.

Claims 29-41, 44, and 45 stand rejected under 35 U.S.C. § 102(e)² as being anticipated by JaQuay.

We refer to appellant's Brief and the Examiner's Answer for the respective positions of appellant and the examiner.

OPINION

We affirm-in-part.

35 U.S.C. § 112, first paragraph

The written description rejection under § 112, first paragraph, is used when a claim is amended to recite elements thought to be without support in the original disclosure.

In re Rasmussen, 650 F.2d 1212, 1214-15, 211 USPQ 323, 326 (CCPA 1981). "[C]laimed subject matter need not be described in haec verba in the specification to satisfy the description requirement." In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973). "The specification as originally filed must convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed." Id.

² Technically, since JaQuay issued before the filing date of the earliest application to which appellant claims priority, the better ground of rejection would be 35 U.S.C. § 102(a) rather than § 102(e). Section 102(e) is usually reserved for the situation where a patent has a filing date before, and an issue date after, the filing date of an application.

We reverse the rejection based on lack of written description for the terms "absolute magnitude" and "extensive duration," which describe the voltage at the output terminals, e.g., between JQ and DC center tap DCCT in figure 3. The term "absolute magnitude" would be interpreted as the absolute value of a quantity, that is, the magnitude of a quantity without regard to its sign. The voltage at the output terminals is at either the positive or negative DC voltage. Because the DC voltages have the same magnitude, but different sign, the absolute magnitude will be constant. Appellant describes the DC voltages as having "substantially constant magnitude" (specification, page 2, lines 10 and 23). Thus, there is support for the term extensive duration as defined in the claims. The rejection of claims 29-37, 40, 41, 44, and 45 is reversed.³

We will sustain the rejection of claims 38 and 39 because appellant has not stated where the specification supports the limitation of "substantially void of third harmonic distortion" or "third harmonic distortion under ten percent," and because our own inspection of the specification as originally filed finds no support for these limitations.

³ Claims 44 and 45 do not contain any of the terms "absolute magnitude", "extensive duration", or "third harmonic distortion." It is not clear why these claims have been included in the § 112 rejection.

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35 U.S.C. § 112, second paragraph

Technically, the proper ground for rejection of a single means claim is the enablement requirement of 35 U.S.C. § 112, first paragraph, not second paragraph. In re Hyatt, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983). However, considering the single means rejection on the merits, claims 29, 34, and 40 are to a combination of an AC source and a voltage conditioning circuit, so a single means rejection is not proper. Accordingly, the single means rejection of claims 29-41 is reversed.

35 U.S.C. § 102

In addressing the § 102 rejection and appellant's arguments, we rely on the requirements of an appeal brief under 37 CFR § 1.192(c)(6)(iii) (1994) (in effect at the time the appeal brief was filed), which states:

(iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

Therefore, we are not looking at the claims for differences that appellant has not argued. If appellant has not argued a limitation it is assumed to be admitted. Cf. In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the

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claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); In re Wiseman, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (arguments must first be presented to the Board).

With respect to claim 29, appellant argues the limitation of "a voltage conditioning circuit . . . characterized by drawing current from the power line terminals during at least half of the total duration of each half-cycle of the AC power line voltage" is "neither described nor even faintly suggested by JaQuay" (Brief, page 5). Claims 34 and 40 have similar limitations. Thus, claims 29-37, 40, and 41 will stand or fall together with claim 29. Figure 1 of JaQuay shows a half-wave bridge circuit 12. This is officially a full-wave rectifier circuit, since it has two half-wave rectifiers and both halves of the input waveform are used. Thus, as would be apparent to one skilled in the art, the rectifier draws power during the total duration of each half cycle of the AC power line voltage. Additionally, JaQuay expressly states that a full wave rectifier can be used (column 3, line 34). Because JaQuay anticipates the only limitation argued, we sustain the § 102 rejection of claims 29-37, 40, and 41.

Appellant argues that the limitation "substantially void of third harmonic distortion" in claim 38 and the limitation "third harmonic distortion under ten percent" in claim 39 is "neither

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described nor even faintly suggested by JaQuay" (pages 5 and 6). We agree that these limitations are not expressly disclosed by JaQuay. The examiner points to JaQuay having an AC line current (Examiner's Answer, page 9), but not where the third harmonic distortion limitation is disclosed. If such limitations were known to be inherent in alternating line currents, then it would be expected that JaQuay would inherently satisfy the third harmonic distortion limitations; however, there is no such finding or evidence of record. Accordingly, we reverse the § 102 rejection of claims 38 and 39. However, as noted in the § 112, first paragraph, discussion, appellant, likewise, fails to disclose these limitations of claims 38 and 39.

With respect to claim 44, appellant argues (Brief, page 6) that JaQuay does not disclose the limitation of an "AC-to-DC conversion circuitry . . . operative to provide a DC voltage at a pair of DC terminals; the AC-to-DC conversion circuitry being characterized by including a periodically conducting transistor." The examiner finds that "[c]learly, the prior art figure 1 and figures 7, 8 elements 32, 34 show switching transistors driven by pulse with [sic, width] modulation ie. pulse control as illustrated in figures 2a-2c" (Examiner's Answer, page 9). The transistors 32 and 34 are in the DC-to-AC inverter section of the circuit, not in the AC-to-DC circuit as claimed. JaQuay shows diodes 18, 20 in the AC-to-DC circuit. While the base-emitter

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and base-collector circuits of a transistor behave like diodes, and while it might be possible to say that a transistor in the prior art anticipates a diode, because it has two diodes, the converse is not true: a diode does not anticipate a transistor because its structure is less than is required for a transistor. Thus, we reverse the § 102 rejection of claim 44 and also claim 45, which depends therefrom.

Although we have reversed the rejection of claim 45 because it depends on claim 44, we note that JaQuay does not disclose control of an AC electric motor as recited in claim 45. We do find where JaQuay supports the examiner's position that "JaQuay states that a dc or ac inductive load is to be connected to the power supply" (Examiner's Answer, page 9). In any case, however, such teaching of a generic class of device would not anticipate the species of a particular kind of inductive load, although it would provide motivation for an obviousness rejection.

CONCLUSION

The § 112, first paragraph, written description rejection: (1) of claims 38 and 39 is sustained; and (2) of claims 29-37, 40, 41, 44, and 45 is reversed.

The § 112, second paragraph, (treated under § 112, first paragraph, enablement) rejection of claims 29-41 is reversed.

The § 102 rejection: (1) of claims 29-37, 40, and 41 is sustained; and (2) of claims 38, 39, 44, and 45 is reversed.

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