

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLE K. NILSSEN

Appeal No. 96-2673
Application 07/851,887¹

ON BRIEF

Before HAIRSTON, KRASS, and CARMICHAEL, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed March 16, 1992. According to appellant, this application is a continuation of Application 07/819,655, filed January 13, 1992; which is a continuation of Application 07/643,023, filed January 18, 1991; which is a continuation-in-part of Application 06/787,692, filed October 15, 1985; which is a continuation of Application 06/644,155, filed August 27, 1984; which is a continuation of Application 06/555,426, filed November 23, 1983; which is a continuation of Application 06/178,107, filed August 14, 1980, said 06/555,426, filed November 23, 1983; which is a continuation-in-part of Application 06/330,159, filed December 14, 1981, now Patent No. 4,430,628; which is a division of Application 05/973,741, filed December 28, 1978, now abandoned; which is a continuation-in-part of Application 05/890,586, filed March 20, 1978, now Patent No. 4,184,128.

This is a decision on appeal from the final rejection of claims 15 through 43, all of the claims pending in the application.

The invention pertains to an inverter driven gas discharge lamp arrangement.

Representative independent claim 15 is reproduced as follows:

15. An arrangement comprising:

a pair of power line terminals at which is provided a power line voltage;

rectification and filtering circuitry connected with the power line terminals and operative to provide a DC supply voltage at a set of DC terminals; the absolute magnitude of the DC supply voltage being substantially constant; and

inverter and load circuitry connected with the DC terminals and operative to provide an AC voltage at a pair of AC terminals with which is connected a gas discharge lamp; thereby to cause an alternating lamp current to flow through the lamp; the alternating lamp current having a peak magnitude and an RMS magnitude; the AC voltage being of a frequency substantially higher than that of the power line voltage on an ordinary electric utility power line; the inverter and load circuitry being additionally characterized by causing the peak magnitude of the alternating lamp current to be distinctly lower than twice its RMS magnitude.

The examiner relies on the following references:

Elms	3,733,541	May 15, 1973
Nilssen	4,513,364	Apr. 23, 1985
Nilssen	4,857,806	Aug. 15, 1989
Nilssen	5,047,690	Sep. 10, 1991

Claims 15 through 17 and 32 through 43 stand rejected under 35 U.S.C. ' 112, first paragraph, as relying on an inadequate

written description because the original specification does not provide support for the invention as is now claimed in amended claim 15. Claims 24, 25 and 29 through 31 stand rejected under 35 U.S.C. ' 112, second paragraph, as being indefinite. Claims 15, 16, 32, 33, 35, 37 through 41 and 43 stand rejected under 35 U.S.C. '' 102(b)/103 as anticipated by, or alternatively unpatentable over, Elms. Finally, claims 15 through 43 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 through 6 of U.S. Patent No. 4,513,364 and claims 1 through 21 of U.S. Patent No. 4,857,806 and claims 1 through 20 of U.S. Patent No. 5,047,690.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

We will not sustain any of the rejections of claims 15 through 43 because the examiner has utterly failed to present any reasoning with regard to the rejections made in any manner which can be rationally addressed by appellant on rebuttal. At best, the examiner has failed to present a prima facie case with respect to any rejection.

With regard to the rejection of claims 15 through 17 and 32 through 43 under 35 U.S.C. ' 112, first paragraph, the examiner merely states [answer, page 3] that the "specification fails to support the elements now recited in amended claim 15" and that

the claims stand rejected "for the reasons set forth in the objection to the specification."

There is no further explanation, anywhere, by the examiner as to the particular language for which, allegedly, there is no support. The "written description" portion of 35 U.S.C. ' 112 requires an inquiry to be made pertaining to whether the disclosure (specification, claims and drawings) as originally filed reasonably conveys to the journeyman practitioner in the art that the inventor had possession at that time of that which he now claims. See In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). The examiner has not referred to anything specifically for which there is no original description. The initial burden of showing unpatentability is always on the examiner. Absent a reasonable basis, by the examiner, for concluding that there is an inadequate written description, appellant is under no duty to establish patentability. In the instant case, the examiner has established absolutely no basis, reasonable or not, for attacking the adequacy of the written description. Accordingly, appellant should not be put in a position to speculate as to exactly what claim language the examiner finds a lack of support. Even so, appellant has speculated, and, in our view, reasonably so, that the language being attacked by the examiner is the language at the end of claim 15 that was added by amendment, i.e., "the inverter and load circuitry being additionally characterized by causing the

peak magnitude of the alternating lamp current to be distinctly lower than twice its RMS magnitude." Even though appellant then makes a good faith effort, at pages 4-5 of the principal brief, to respond to the non-explained rejection, the examiner's response is complete silence. Thus, we have an unexplained outstanding rejection under 35 U.S.C. ' 112, first paragraph, applied by the examiner, an unnecessary, but good faith, effort by appellant to respond to that rejection and no explanation by the examiner as to why, if appellant's speculation as to the grounds of the rejection is correct, appellant's response does not overcome the rejection. If, in fact, it is the last four lines of claim 15 which the examiner contends has no support in the original disclosure, the examiner had every opportunity to explain exactly why this language has no such support. No explanation is given by the examiner.

Accordingly, the examiner's rejection of claims 15 through 17 and 32 through 43 under the first paragraph of 35 U.S.C. ' 112, as being based on an inadequate written description, is reversed for failure to present any reasonable basis therefor.

We now turn to the rejection of claims 24, 25 and 29 through 31 under the second paragraph of 35 U.S.C. ' 112 as being indefinite. The examiner's rationale is stated, in toto, at pages 3-4 of the answer:

With respect to claims 24-25, indefiniteness arises as to the subject matter encompassed by cancelled claim 7 relative to claim language much like

that which appears in cancelled claim 5 (see 35 U.S.C (sic, U.S.C.) 112, second paragraph, Board of Patent Appeal rejection, page 9, mailed May 31/1994).

With respect to claims 29-31, still 112 rejection as noted by B.P.A. rejection, page (sic, pages) 12-15. There is still a lack of consistency as between the disclosure and the apparent subject matter of claims 17 and 31. (see 35 U.S.C 112, Board of Patent Appeals rejection, page 15, mailed May 31/1994).

The examiner has failed to establish indefiniteness in any meaningful way to which appellant is able to respond. The examiner has not pointed to any particular language in the claims which the examiner regards as "indefinite" or inconsistent with the disclosure. A general reference to various pages of this Board's previous decision of May 31, 1994 does not alleviate the examiner of the burden to particularly point out what, exactly, the examiner considers to be the offending claim language within the meaning of 35 U.S.C. ' 112, second paragraph. It is especially important for the examiner to be precise in identifying the allegedly indefinite language here, rather than merely point to a previous decision, because the instant claims now on appeal differ, in some aspects, from the claims at issue in that previous decision.

Moreover, to whatever extent the examiner's rejection of claims under 35 U.S.C. ' 112 might be considered initially reasonable (and we do not so consider the rejection as being reasonable since there is no explanation at all with regard to

the claim language now before us), appellant has responded, at page 5 of the principal brief, with an explanation as to why appellant fails to find any "inconsistency" between the disclosed and claimed subject matter and the examiner has, again, responded with silence. Therefore, we have no idea what, exactly, is the examiner's position with regard to the rejection of claims 24, 25 and 29 through 31 under the second paragraph of 35 U.S.C. ' 112 and, accordingly, we will not sustain this rejection.

Turning now to the rejection of claims 15, 16, 32, 33, 35, 37 through 41 and 43 under 35 U.S.C. ' 102(b)/103 as being anticipated by, or, alternatively, unpatentable over, Elms, we also will not sustain this rejection because the examiner has failed to establish a prima facie case of anticipation or obviousness of the claimed subject matter.

The examiner's whole rationale in making and sustaining this rejection is to point to our decision of May 31, 1994, wherein we entered a new ground of rejection, in accordance with 37 CFR 1.196(b), relying on Elms in a prior art rejection made therein. While the examiner may have been justified in relying on the rationale in our earlier decision where the claimed subject matter is identical in both cases, such is not the case here and the examiner should not blindly parrot a previous decision unless the basis for that decision still exists.

The language of independent claim 15 has been amended, as mentioned supra, when discussing the rejection of claims under

the first paragraph of 35 U.S.C. ' 112. Therefore, claim 15 before us now is not the same as the claim 15 before us in the previous decision. While we are not saying that a case could not be made for still applying Elms, under either 35 U.S.C. ' 102 or ' 103, against the new claim 15 and/or its dependent claims, we are saying that the examiner has simply not made that case. The examiner has completely ignored the claim language, "the inverter and load circuitry being additionally characterized by..." and, as such, has failed to consider the claimed subject matter as a whole. Accordingly, no prima facie case has been established and we will not sustain the rejection of claims 15, 16, 32, 33, 35, 37 through 41 and 43 under 35 U.S.C. '' 102(b)/103.

A similar problem exists with regard to the rejection of claims 15 through 43 under obviousness-type double patenting. Even though the claims have changed since our previous decision suggested that the examiner might want to consider the applicability of a rejection under obviousness-type double patenting, the examiner entered such a rejection and entered it without so much as an explanation as to specifically why the instant claims are considered patentably indistinct from the myriad of claims in related applications. Again, we do not say that an obviousness-type double patenting rejection may not, in fact, be appropriate. We merely contend that the examiner has failed to establish a basis for this rejection. The instant claim language must be measured against specific claim language

in the related applications and a determination of obviousness-type double patenting may then be made from that measurement, or consideration. Moreover, to the extent that our previous decision was specific as to any particular rejection which might be made under obviousness-type double patenting, there are now different claims before us and the examiner has not specified how even a single claim might be held to be obvious over any particular claim of the related applications.

The burden is clearly on the examiner to establish unpatentability and we must agree with appellant, at page 8 of the principal brief, that the examiner "utterly failed to provide any kind of reasonable explanation with respect to how each and every one of Applicant's various pending claims is obvious over the claims in the three. . . patents." Accordingly, we will not sustain the rejection of claims 15 through 43 under obviousness-type double patenting.

It appears that the examiner has treated this Board's rejections under 37 CFR 1.196(b) in the previous decision as being written in stone and handed down from Mount Sinai, refusing to budge one iota from, or to offer the examiner's own reasoning in addition to, that decision. The examiner must understand that a rejection made under 37 CFR 1.196(b) affords an appellant an opportunity to elect to have further prosecution before the examiner in response to the new ground by way of amendment or a

showing of facts, or both, not previously of record.² Appellant chose the path of further prosecution before the examiner by amending the claims. However, the examiner, in fact, denied appellant the opportunity of further prosecution, even though appellant amended the claims in response to the new ground of rejection, by merely referring to the Board's previous decision and, without explanation and without a clear consideration of the newly amended claims or of how they might differ from the claims previously before the Board, holding the claims to be unpatentable for the reasons stated in the previous decision.

If the examiner feels that a rejection against any of the pending claims legitimately lies, the examiner, in any possible further prosecution of this case, is to specifically point out exactly what claim language is considered non-supportable and why this is so under any rejection based on 35 U.S.C. ' 112, first paragraph; is to specifically point out any claim language the examiner believes to be indefinite and why this is so under any rejection based on the second paragraph of 35 U.S.C. ' 112; is to specifically point out how each and every claimed element corresponds to an element in the prior art reference(s) and/or is taught or suggested or would have been obvious over the prior art teachings under any rejection based on 35 U.S.C. ' 102 or ' 103; and is to specifically point out how each and every claim

² Of course an appellant may also choose to request reconsideration or modification of a decision under 37 CFR

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is patentably indistinct over a particular claim or claims of related applications or patents under any rejection based on obviousness-type double patenting.

The examiner's decision is reversed.

REVERSED

Kenneth W. Hairston)	
Administrative Patent Judge))	
)	
)	
Errol A. Krass)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
)	
James T. Carmichael)	
Administrative Patent Judge))	

1.196(b) by the Board.

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