

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(2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE E. SAKOSKE et al.

Appeal No. 96-2682
Application 08/145,269¹

ON BRIEF

Before THOMAS, KRASS and FLEMING, **Administrative Patent Judges**.
FLEMING, **Administrative Patent Judge**.

¹ Application for patent filed October 29, 1993.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 20, all of the claims pending in the application.

The invention relates to electrical leads for lamps comprised of an alloy of molybdenum and tungsten. Appellants disclose on page 9 of the specification that Figure 3 shows a halogen lamp 1 comprised of an outer envelope 3 and electrode leads 5a, 5b and 5c extending through the envelope into a hollow portion of the envelope 3. Appellants disclose that a pinch seal 13 is formed between the electrode leads 5a, 5b and 5c which hermetically seals the lamp. Appellants disclose that the electrode leads 5a, 5b and 5c are comprised of an alloy of molybdenum and tungsten.

The only independent claims 1 and 6 present in the application are reproduced as follows:

1. An electrode lead for a lamp comprised of an alloy comprised of between about 10 to 90 percent by weight tungsten and about 10 to 90 percent by weight molybdenum.

6. An electric lamp comprising a sealed vitreous envelope defining a hollow portion and at least one electrode lead extending through said envelope into said hollow portion,

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said lead comprised of an alloy comprised of about 10 to 90 percent by weight tungsten and about 10 to 90 percent by weight molybdenum.

The reference relied on by the Examiner is as follows:

Driessen et al. (Driessen)	4,160,930	July 10, 1979
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Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Driessen.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the brief² and the answers³ for the details thereof.

OPINION

² Appellants filed an appeal brief on July 28, 1995. We will reference this appeal brief as simply the brief. Appellants filed a reply appeal brief on October 11, 1995. We will reference this appeal reply brief as simply the reply brief. We note that the Examiner has responded to the reply brief with a supplemental answer and the reply brief has been entered into the record.

³ The Examiner responded to the brief with an Examiner's answer dated September 7, 1995. We will refer to the Examiner's answer as simply the answer. The Examiner responded to the reply brief with a supplemental Examiner's answer dated January 23, 1996. We will refer to the Supplemental Examiner's answer as simply the supplemental answer.

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After a careful review of the evidence before us, we agree with the Examiner that claims 1 through 5, 19 and 20 are properly rejected under 35 U.S.C. § 103. Thus, we will sustain

the rejection of these claims but we will reverse the rejection of remaining claims on appeal for the reasons set forth *infra*.

At the outset, we note that Appellants have indicated on pages 3 and 4 of the brief the groupings of the claims. In particular, Appellants state that claims 1 through 20 are considered a first group, claims 2 and 3 are considered a second group, claims 7 and 8 are considered a third group and claim 15 is considered a fourth. On pages 4 through 13 of the brief, we note that Appellants argue claims 1 through 20 as a group and claims 2, 3 and 6 through 20 as a group. In particular, Appellants argue that claims 2, 3 and 6 through 20 are patentable over Driessen because these claims recite a hermetic seal between a tungsten/molybdenum alloy lead and a lamp envelope. 37 CFR § 1.192(c)(7) (July 1, 1995) **as amended at** 60 Fed. Reg. 14518 (March 17, 1995), which was controlling at the time of Appellants' filing the brief, states:

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For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of

the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Appellants have grouped the claims, as stated on pages 3 and 4 of the brief, in a manner that is inconsistent because the first group includes all of the claims of the remaining groups. Furthermore, Appellants argue the grouping of claims 2, 3 and 6 through 20 in a manner that is not consistent with the claimed limitations because claims 2, 3, 19 and 20 do not recite a hermetic seal. However, claims 6 through 18 do recite the hermetic seal limitation. As per 37 CFR § 1.192(c)(7), which was controlling at the time of Appellants filing the brief, we will, thereby, consider Appellant's claims 1 through 5, 19 and 20 to stand or fall together, with claim 1 being considered the

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representative claim and claims 6 through 18 to stand or fall together, with claim 6 being considered the representative claim.

On pages 4 through 13 of the brief, Appellants do not specifically argue that Driessen fails to teach or suggest an electrode lead for a lamp comprised of an alloy comprised of between about 10 to 90 percent by weight tungsten and about 10 to 90 percent by weight molybdenum as recited in Appellants' claim 1. As pointed out above, Appellants only argue that Driessen does not teach a lamp including a hermetic seal between a tungsten and molybdenum alloy as recited in Appellants' claim 6.

The Examiner states on page 3 of the answer that the prior office action, paper number 3, sets forth the rejection of claim 1. We note that the prior office action is actually paper number 4, since paper number 3 is the Appellants' transmittal of the declaration paper. On page 2 of the office action, the Examiner argues that Driessen teaches a lamp electrode lead made of an alloy of tungsten and molybdenum. The Examiner notes that Driessen does not teach the specific portions of tungsten and molybdenum but argues that it would have been obvious to one of ordinary skill in the art to provide an alloy comprised of

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between 10 to 90 percent by weight tungsten and about 10 to 90 percent by weight molybdenum.

As noted above, Appellants have chosen not to argue any of these specific limitations of claim 1 as a basis for patentability or to argue specifically the Examiner's rejection of claim 1. We are not required to raise and/or consider such issues. As stated by our reviewing court in ***In re Baxter Travenol Labs.***, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." 37 CFR 1.192(a) as amended at 58 Fed. Reg. 14518 (Mar. 17, 1995), which was controlling at the time of Appellants' filing the brief, states as follows:

The brief . . . must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief may be refused consideration by the Board of [P]atent Appeals and Interferences, unless good cause is shown.

Also, 37 CFR § 1.192(c)(8)(iv) states:

For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the

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rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

Thus, 37 CFR § 1.192 provides that just as the court is not under any burden to raise and/or consider such issues, this board is also not under any greater burden.

Therefore, we affirm the Examiner's rejection of claims 1 through 5, 19 and 20. Furthermore, beyond the Appellants' failure to argue the limitation recited in claim 1, we further note that Appellants' claim 1 recites a wide range of percentages of tungsten and molybdenum that can form the alloy. In particular, claim 1 recited "an alloy comprised of between about 10 to 90 percent by weight tungsten and about 10 to 90 percent by weight molybdenum." In addition, we find that Driessen

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teaches in column 3, lines 33-43, an electrode lead for a lamp comprised of an alloy of tungsten and molybdenum.

It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. **In re Sernaker**, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). In addition, the Federal Circuit states that "[t]he 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 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

"Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.**, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **cert. denied**, 117 S.Ct. 80 (1996), **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d

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1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In addition, the Federal Circuit reasons in **Para-Ordnance Mfg.**, 73 F.3d at 1087-88, 37 USPQ2d at 1239-40, that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem, and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants.

We find that those skilled in the art having the teachings of Driessen before them would have made an alloy that would have been within the ranges of the percentages of tungsten and molybdenum as recited in Appellants' claim 1 because the breadth of the claimed ranges would include many possible alloys as well those suggested by Driessen. Therefore, we find that it would have been obvious to one skilled in the art in view of the teachings of Driessen to make an electrode lead for a lamp comprised of an alloy comprised of between about 10 to 90 percent by weight tungsten and about 10 to 90 percent by weight molybdenum as recited in Appellants' claim 1.

Appellants argue that Driessen does not teach a lamp including a hermetic seal between a tungsten and molybdenum alloy

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lead and a lamp envelope. We note that Appellants' claim 6 recites an electric lamp comprising a sealed vitreous envelope defining a hollow portion and at least one tungsten molybdenum alloy electrode lead extending through said envelope into said hollow portion, a hermetic seal being formed between said lead and said envelope. Upon a closer review of Driessen, we find that Driessen shows in figures 2 through 4 a sealed envelope defining a hollow portion but does not teach or suggest at least one tungsten molybdenum alloy electrode lead extending through said envelope into said hollow portion.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 5, 19 and 20 under 35 U.S.C. § 103

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is affirmed; however, the decision of the Examiner rejecting claims 6 through 18 under 35 U.S.C. § 103 is reversed.

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

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS AND
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