

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CLIFF SCAPELLATI

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Appeal No. 97-0315  
Application 08/336,181<sup>1</sup>

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ON BRIEF

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Before KRASS, BARRETT and LALL, Administrative Patent Judges.  
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection<sup>2</sup> of all the pending claims 1 through 17.

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<sup>1</sup> Application for patent filed November 8, 1994.

<sup>2</sup> An amendment after the final rejection was filed on Feb. 15, 1996, [paper no. 6], however, it was not entered in the record.

The disclosed invention relates to a high voltage power supply that includes a high voltage output terminal and an input terminal for receiving power for the power supply. A voltage multiplier is provided for operating on an alternating voltage signal to generate high voltage across positive and negative polarity terminals. Means are provided for physically moving the whole multiplier circuit in response to an electrical instruction signal between a first position where the positive terminal is electrically connected to the high voltage output terminal, and a second position where the negative polarity is electrically connected to the high voltage terminal.

Representative claim 1 is reproduced as follows:

1. A high voltage power supply, comprising:

a high voltage output terminal;

input means for providing a voltage signal;

a rotatable plate;

a unitary voltage multiplier circuit mounted on said plate, said voltage multiplier circuit having an input terminal means and an output terminal means including a positive and a negative terminal for operating on said voltage signal to generate a high voltage between said positive and negative terminals; and

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a motor for rotating said plate in response to an electrical instruction signal between a first position wherein said positive terminal is electrically connected to said high voltage output terminal, and a second position wherein said negative terminal is electrically connected to said high voltage output terminal.

The references relied on by the examiner are:

Admitted Prior Art: Appellant's Disclosure, particularly figures 1 A - 1C. (APA).

Claims 1 through 17 stand rejected under 35 U.S.C. § 103 over APA.

Reference is made to Appellant's brief and the Examiner's answer for their respective positions.

#### **OPINION**

We have considered the record before us, and we will reverse the rejection of claims 1 through 17.

With respect to claims 1 through 17, the Examiner has failed to set forth a prima facie case of obviousness. 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 express teachings or suggestions found in the art, or by implications contained in such teachings or suggestions. In re Sernaker, 702 F.2d 989, 995, 217 USPQ 1, 6

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(Fed. Cir. 1983). "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 Importer 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 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to claim 1, we have reviewed the Examiner's rejection [answer, pages 3 to 4], the Examiner's response to Appellant's arguments [answer, pages 4 to 5] and Appellant's corresponding arguments [brief, pages 3 to 6]. We agree with the Examiner that APA shows the voltage multiplier circuit in figures 1A - 1C. However, the claimed limitation: "means for moving said voltage multiplier circuit in an intact condition in response to an electrical instruction signal between a first position ... and a second position ... ." [claim 1, lines 10 to 16] is not shown by APA. The Examiner contends that it would have been obvious, to one of ordinary skill in the art at the time of the invention, to automate the switching operation of the power supply polarity, since "it

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has been held that broadly providing a mechanical or automatic means to replace the manual activity which has accomplished the same result involves routine skill in the art." The Examiner relies on In re Venner and Bowser, 262 F.2d 91, 95, 120 USPQ 192, 194 (CCPA 1958), for authority. [Answer, page 4]. However, the Examiner does not shed any light on how the facts of this case fit those in Venner, and we also do not see how. We note that one of the very objects of the invention is to provide a power supply that does not require manual switching of the high voltage terminals. To design the voltage multiplier circuit as a unitary structure and to provide means so that it can be moved in an intact condition between a first position and a second position would have involved using the blueprint of Appellant's invention. That is impermissible. 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 Fitch, 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.

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1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor."  
Para-Ordnance Mfg. V. SGS Importers Int'l, 73 F.3d at 1087, 37 USPQ2d at 1239, citing W. L. Gore & Assocs., v. Garlock, Inc., 721 F.2d at 1553, 220 USPQ at 312-13 (Fed. Cir. 1983).

Therefore, we conclude that the obviousness rejection of claim 1 over APA is not sustainable. Since claims 2 through 17 all depend on claim 1 and hence each have at least the limitation discussed above, their obviousness rejection over APA is also not sustainable.

**DECISION**

The decision of the Examiner rejecting claims 1 through 17 under 35 U.S.C. § 103 over APA is reversed.

**REVERSED**

ERROL A. KRASS )  
Administrative Patent Judge )  
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	LEE E. BARRETT	)	BOARD OF
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	Administrative Patent Judge	)	APPEALS AND
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	PARSHOTAM S. LALL	)	
	Administrative Patent Judge	)	

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