

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(2) is not binding precedent of the Board.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. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** TYRA N. EVANS and JOSEPH L. HALLOCK

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Appeal No. 1998-1651  
Application No. 08/594,964

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ON BRIEF

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Before JERRY SMITH, FLEMING, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-15,  
which are all of the claims pending in this application.

We REVERSE.

## BACKGROUND

The appellants' invention relates to a lamp with mercury release structure and method for dispensing mercury into a lamp. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A lamp comprising:
  - a sealed transparent elongated envelope containing a gas fill;
  - a coil at each of two ends of said elongated envelope, said coils extending widthwise of said envelope;
  - first and second lead-in wires connected to each of said coils and connectable to an external source of electric current; and
  - a capsule containing mercury and mounted within said envelope at one of said ends of said envelope, said capsule being connected to one of said first and second lead-in wires of one of said coils, said capsule being disposed adjacent to a center portion of said one coil and having a body portion extending axially in said envelope toward the other of said coils;
  - said other coil being adapted, upon energization by said current, to emit electrons toward said capsule to heat and burst said capsule, to release said mercury into said envelope.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Parks, Jr. et al. (Parks)	5,278,473	Jan. 11, 1994
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Claims 1-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Parks.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 8, mailed Dec. 19, 1997) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 7, filed Nov. 12, 1997) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). We find that the examiner has not provided a teaching or convincing line of reasoning why one skilled in the art would have desired to modify the teachings of Parks to achieve the invention as recited in claim 1. Therefore, the examiner has not provided a *prima facie* case of obviousness with respect to claims 1 and 9.

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“To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. **See In re Deuel**, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.” **In re Rouffet**, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (CAFC 1998). Here, we find that appellants have overcome the *prima facie* case of obviousness by the examiner by showing sufficient evidence of nonobviousness. Therefore, we will not sustain the rejection of independent claims 1 and 9.

Appellants argue that Parks fails to teach or suggest the claimed invention. (See brief at page 5.) We agree with appellants. Appellants argue that Parks does not suggest to skilled artisans to move the metal capsule to the middle of the coil as suggested by the examiner. We agree with appellants. Appellants argue that the only way for the examiner to reach the conclusion of maximum bombardment of the capsule by placing it in the middle is through improper hindsight. (See brief at page 5.) We

agree with appellants. From our review of Parks, Parks teaches the use of a coating on at least a portion of the capsule to focus the stream of electrons to reduce the time necessary to rupture. (See Parks at abstract.) Furthermore, Parks discloses that its positioning of the capsule is so as to be a direct target for electron bombardment. (See Parks at Col. 3, lines 60-63.) With this teaching alone<sup>1</sup>, it is our view that skilled artisans would have been motivated to use the coating rather than move the capsule. The examiner provides no other line of reasoning for moving the capsule beyond the examiner's statement that the middle would be "bombarded with the maximum amount of electrons possible." (See answer at page 5.) Further, Parks teaches the distribution of the electrons arriving at the anode is initially random. (See Parks at Col. 4, lines 44-45.) Therefore, we disagree with the examiner's conclusion concerning the mere design choice for the placement of the capsule relying on Parks alone and we cannot sustain the rejection of independent claims 1 and 9 and their dependent claim 2-8 and 10-15 on Parks alone.

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<sup>1</sup> We note that the examiner has cited to a number of other prior art references to support the examiner's position that the placement of the capsule is no more than a mere design choice. While we agree that these references do teach variations in the placement of the capsule, the examiner has not included these teachings in the combination with Parks under 35 U.S.C. § 103 including a motivation to combine the teachings. Therefore, we will not consider them in the above rejection. As set forth in **In re Hoch**, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n. 3 (CCPA 1970), "[w]here a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection." We leave it to the examiner to apply any or all of the references in response to this decision, if the examiner deems it appropriate and finds proper motivation to combine the teachings.

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**CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-15 under 35 U.S.C. §  
103 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

jld/vsh

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