

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALGIMANTAS GABRIUS, PETER F. WACHTER and FRANKLIN FONG

Appeal No. 1999-2443
Application No. 08/857,144¹

ON BRIEF

Before CALVERT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 19, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed May 15, 1997 (Attorney Docket No. 3416-126).

BACKGROUND

The appellants' invention relates to an internally illuminated sign that may be selectively positioned on a lighting track (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Mabrey 1971	3,562,942	Feb. 16,
Boshear et al. Sept. 9, 1997 (Boshear) 1994)	5,665,938	(filed July 21, 1994)

Claims 1 to 3 and 6 to 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mabrey.

Claims 4, 5 and 9 to 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mabrey in view of Boshear.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed March 17, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 20, filed February 16, 1999) and reply brief (Paper No. 22, filed May 3, 1999) 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 references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We will not sustain the rejection of claims 1 to 3 and 6 to 8 under 35 U.S.C. § 102(b).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 1 recites an internally illuminated sign for mounting on a lighting track comprising, inter alia, an adapter for mechanical and electrical connection to a lighting track, a display housing connected to the adapter, a translucent message assembly removably mounted in the housing and an illumination source mounted in the housing.

Mabrey discloses a display sign. As shown in Figure 1, the display sign includes two main separable elements, namely a housing 9 and a chassis 11. The housing 9 includes a cabinet 10 and windows 10a and 10b. Display assemblies 21 and 25 are removably mounted in the housing 9. The chassis includes a frame 32 and fluorescent tubes 38 and 39. Mounted on top 12 of the cabinet 10 is a ballast 26 onto which are fed wires 27 which are connected to a source of electricity (not shown) for energizing the light source (i.e., fluorescent tubes 38 and 39). Mabrey teaches (column 2, lines 69-72) that the top of the ballast 26 is provided with apertures 26a for receiving bolts to secure the entire sign to a ceiling. Mabrey also discloses (column 1, lines 69-70) that the sign is adapted to be mounted to a ceiling or wall.

The examiner has taken the position (answer, pp. 3 and 4) that the claimed "adapter for mechanical and electrical connection to a lighting track" is readable on the wires 27 of Mabrey. The appellants have taken the position (brief, pp. 38-42, and reply brief, pp. 4-7) that the claimed "adapter for

mechanical and electrical connection to a lighting track" is not readable on the wires 27 of Mabrey.

In proceedings before the Patent and Trademark Office (PTO), the PTO applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Furthermore, a technical term is interpreted as having the meaning that it would be given by persons experienced in the field of the invention, unless it is apparent from the application and the prosecution history that the inventor used the term with a different meaning. See Hoechst Celanese Corp. v. BP Chemicals Ltd., 78 F.3d 1575, 1578, 38 USPQ2d 1126, 1129 (Fed. Cir. 1996).

In applying the above-noted guidance, we reach the conclusion that the examiner's position that the claimed "adapter for mechanical and electrical connection to a lighting track" is readable on the wires 27 of Mabrey is in error for the reasons set forth by the appellants (brief, pp. 38-42, and reply brief, pp. 4-7). Specifically, we agree with the appellants that the term "adapter" has a special meaning in the art. Moreover, in our view the wires 27 of Mabrey are not for mechanical and electrical connection to a lighting track.

Since each and every element of claim 1 is not found in Mabrey for the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2, 3 and 6 to 8 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

We will not sustain the rejection of claims 4, 5 and 9 to 19 under 35 U.S.C. § 103.

Claims 4, 5 and 9 to 19 all include the limitation "adapter for mechanical and electrical connection to a lighting track." As set forth above, this limitation is not taught by Mabrey. We have also reviewed the reference to Boshear additionally applied in this rejection under 35 U.S.C. § 103² but find nothing therein which teaches or would have suggested providing Mabrey with an "adapter for mechanical and electrical connection to a lighting track." Since the combined teachings of the applied prior art would not have suggested the claimed subject for the reasons set forth above, the decision of the examiner to reject claims 4, 5 and 9 to 19 under 35 U.S.C. § 103 is reversed.

² The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3 and 6 to 8 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 4, 5 and 9 to 19 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/857,144

APJ NASE

APJ CALVERT

APJ McQUADE

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: Jan 31, 2000

FINAL TYPED: