



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,124	01/23/2006	6838618	17242US01	8553

7590 01/28/2013
JEFFREY J. HOWELL
ROYLANCE ABRAMS BERDO & GOODMAN LLP
1300 19TH STREET, NW
SUITE 600
WASHINGTON, DC 20036

EXAMINER

RUBIN, MARGARET R

ART UNIT	PAPER NUMBER
----------	--------------

3992

MAIL DATE	DELIVERY MODE
-----------	---------------

01/28/2013

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KONINKLIJKE PHILIPS ELECTRONICS, N.V.
Requester, Appellant, and Respondent

v.

HUBBELL INCORPORATED
Patent Owner, Appellant, and Respondent

Appeal 2012-010410
Reexamination Control 95/000,124
Patent US 6,838,618 B2
Technology Center 3900

Before HOWARD B. BLANKENSHIP, JUSTIN T. ARBES, and THOMAS
L. GIANNETTI, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*

DECISION ON APPEAL

STATEMENT OF THE CASE

Owner appeals under 35 U.S.C. § 134(b) (2002) from the final decision of the Examiner unfavorable to the patentability of claims 1, 2, 10-13, 15-24, and 35. Requester appeals under 35 U.S.C. § 134(c) (2002) from the final decision of the Examiner favorable to the patentability of claims 3-9, 14, and 25-34.¹ Oral hearing was on October 17, 2012. We have jurisdiction under 35 U.S.C. § 315 (2002).

We affirm.

Invention

The '618 patent relates to a fire assembly that can be used for installing recessed electrical fixtures into various structures. '618 patent col. 1, ll. 13-15. “[A] housing wall can contain at least one generally fire-resistant material. Examples of generally fire-resistant materials include, but are not limited to, dry wall or wallboard (e.g. sheet rock, plywood, asbestos cement sheets, gypsum plasterboard, laminated plastics, etc.), and plaster.” *Id.*, col. 2, ll. 33-37.

Figure 2 of the patent is reproduced below.

¹ However, Requester does not contest the Examiner’s determination that claims 5, 8, 9, and 25-34 are patentable.

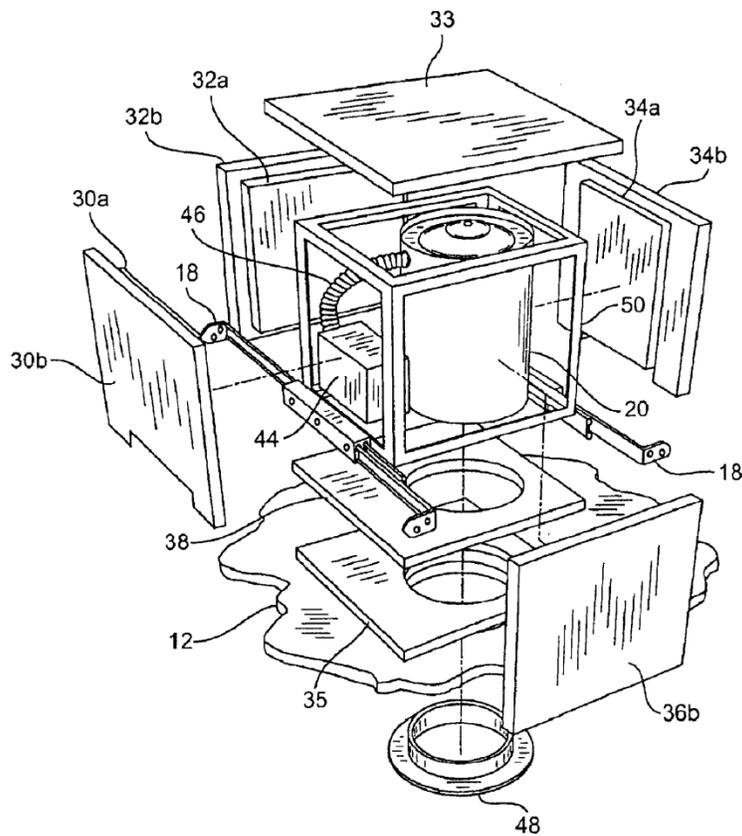


FIG. 2

Figure 2 depicts a fire box having walls made from two layers of dry wall. Side wall outer layers 30b, 32b, 34b, and 36b can be attached to dry wall, side wall inner layers 30a, 32a, 34a, and 36a (not shown), respectively. *Id.*, col. 6, ll. 7-12. A top wall 33 can be placed above light fixture 20. A bottom wall 38 can be placed under light fixture 20 and further attached to the side walls. *Id.*, col. 5, ll. 28-32. Wires from light fixture 20 can be placed in electrical communication with junction box 44 through conduit 46. *Id.*, col. 7, ll. 49-51.

Claims

Claims 1-35 are subject to reexamination. Claims 3-9, 14, and 25-34 have been determined patentable. Claims 1, 2, 10-13, 15-24, and 35 are rejected.

Claim 3, as amended, is illustrative.

3. A light assembly comprising:

a light fixture adapted to be positioned relative to an opening defined in a surface of a structure, and further adapted to allow light to be projected through said opening; and

a housing substantially enclosing said light fixture, said housing and said light fixture forming a preassembled integral unit, said housing including at least one generally fire-resistant material, said at least one generally fire-resistant material forming a substantially continuous surface with said surface of said structure,

wherein said housing includes a bottom wall and another wall, a portion of said bottom wall extending beyond an intersection of said bottom wall and said another wall of said housing, said portion having upper and lower surfaces and a junction box positioned on said upper surface of said portion.

Prior Art

The prior art references are as follows:

Monson	US 6,105,334	Aug. 22, 2000
Montanez	US 4,910,651	Mar. 20, 1990
Ward	GB 2326467 A	Dec. 23, 1998
Hubbell Lighting, 1992 Buyer's Guide ("Hubbell")		

Owner's Contentions

Owner contends that the Examiner erred in entering the following grounds of rejections against claims 1, 2, 10-13, 15-24, and 35:

I. Claims 1, 2, 10-13, 15-19, and 35 are rejected under 35 U.S.C. § 314(a) (2002) as enlarging the scope of the claims of the patent;²

II. Claims 1, 2, 10-13, 15-24, and 35 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;

III. Claims 1, 2, 10-13, 15-24, and 35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;

IV. Claim 35 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward.

Requester's Contentions

Requester contends that the Examiner erred in not entering rejections under 35 U.S.C. § 103(a) against claims 1-4, 6, 7, 10-17, 20, 21, 23, and 35. Req. App. Br. 10.

² The Examiner and both parties refer to § 305, which is the corresponding statute for ex parte reexamination.

ANALYSIS

Section 314(a)

Owner has submitted proposed amendments to independent claims 1 and 16 of the patent. The Examiner submits:

Claim 1 has been amended such that it no longer recites a “housing including at least one generally fire-resistant material” but instead now recites a “housing forming a support for at least one generally fire-resistant material”. Claim 16 has been amended such that it no longer recites a “housing including a generally fire-resistant material” but instead now recites a “housing forming a support for a generally fire-resistant material”.

Right of Appeal Notice, Nov. 19, 2009, (RAN) at 4.

Claim 35 is a proposed new claim. The Examiner compares the claim to the original independent patent claims:

With regard to independent claim 35, insofar as this claim is most similar in scope to original claim 1, a comparison will be made primarily on that basis. However, it is also noted that claim 35 also lacks, at least, the “method of installing a light assembly” of claim 16 and “a recessed light fixture” of claim 20 and “a plurality of side walls, a top wall, and a bottom wall” of claim 25. Claim 35 also does not recite a “housing including at least one generally fire-resistant material” as recited in claim 1 but instead recites a “housing forming a support for at least one generally fire-resistant material”. Such changes represent a broadening of the scope of the claim language.

Id.

Owner submits that additional elements have been added to claims 1 and 16 that result in narrowing, including “a structural relationship in claims 1 and 16, from a housing that only ‘included’ the generally fire resistant

material (in any structural form or relationship) to one in which the housing structure is a combination in which the generally fire resistant material is supported by the housing.” Owner App. Br. 17. Owner submits similar arguments with respect to claim 35. According to Owner, when “viewed as a whole,” the “added element” related to “forming a support for” means that the claim has been narrowed, citing *Mentor Corp. v. Coloplast Inc.*, 998 F.2d 992, 996 (Fed. Cir. 1993). *Id.* at 18.

However, *Mentor Corp.* is a reissue recapture case in which a claim amendment submitted during prosecution of the reissue rendered the claim broader than the corresponding patent claims. The inquiry was thus into whether other limitations added to the claim “materially narrow the claim” so as to avoid recapture of surrendered subject matter. *See In re Clement*, 131 F.3d 1464, 1469-70 (Fed. Cir. 1997); *Mentor Corp.* at 993, 995-97. Reissue recapture is an issue that arises only in *broadening* reissues -- where claims are *broadened* with respect to patent claims. *See, e.g., Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1371 (Fed. Cir. 2001) (describing the three-step process in applying the recapture rule).

On the other hand, during reexamination, “[t]he test for when a new claim enlarges the scope of an original claim . . . is the same as that under the two-year limitation for reissue applications adding enlarging claims under 35 U.S.C. § 251, last paragraph.” *In re Freeman*, 30 F.3d 1459, 1464 (Fed. Cir. 1994). In reexamination, as in prosecution of a reissue, a claim is broader in scope than the original claims “if it contains within its scope any conceivable apparatus or process which would not have infringed the original patent. . . . A claim that is broader in any respect is considered to be

broader than the original claims even though it may be narrower in other respects.” *Id.* (quoting *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2 (Fed. Cir. 1987)).

Even though each of amended claims 1 and 16, and new claim 35, contains limitations such that the claim is narrower in some respects with respect to the patent claims, the amended and new claims are broader than the original claims because they are broader in at least one respect. Each of original claims 1 and 16 requires a housing that includes a generally fire-resistant material. In the amended and new claims, the housing is recited as “forming a support for” a generally fire-resistant material. The claims no longer require that a “generally fire-resistant material” be part of the housing, such that the amended and new claims are broader in that respect. A housing that lacks a generally fire-resistant material as forming part of the housing would not infringe the original claims, but would infringe the amended and new claims.³

Owner does not separately argue any of the dependent claims that are subject to the § 314(a) rejection. Accordingly, we sustain the rejection of claims 1, 2, 10-13, 15-19, and 35 under 35 U.S.C. § 314(a). We do not reach the additional rejections applied against these claims because the claims are barred by § 314(a).

³ We observe that the '618 patent discloses embodiments in which the housing is made up of layers of fire-resistant materials (e.g., col. 6, ll. 3-16; Fig. 2) and embodiments in which the housing consists of a metal (aluminum) that provides a support for fire-resistant materials (e.g., col. 6, ll. 20 - 34; col. 6, l. 54 - col. 7, l. 4; Fig. 3).

Section 112, First Paragraph

To comply with the “written description” requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the “written description” inquiry, whatever is now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). One shows “possession” by descriptive means such as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). It is not sufficient for purposes of the written description requirement that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose. *Id.*

The Examiner rejects claims 20 through 24 as failing to comply with the written description requirement. The Examiner finds that the '618 patent describes a floor-ceiling assembly as passing ANSI/UL 263 (ASTM E 119), but using a fire-resistant material in only one layer, whereas base claim 20 recites “at least one of said first layer and said second layer being formed from a generally fire-resistant material.” RAN 8; *see also* '618 patent col. 10, l. 39 - col. 11, l. 17. The Examiner further finds that '618 patent Figure 6 depicts the floor-ceiling assembly that is described as passing the relevant test, but shows only one layer, the outer layer, forming a substantially continuous surface with the surface of the adjacent structure when installed. However, claim 20 recites “at least one of said first layer and said second

Appeal 2012-010410
Reexamination Control 95/000,124
Patent US 6,838,618 B2

layer” being adapted to form a substantially continuous surface with the surface of the adjacent structure. RAN 8.

Owner’s response to the § 112, first paragraph rejection of claim 20 appears to be at page 22 of its Appeal Brief. Owner submits that “examples are not necessary to support the adequacy of a written description.” Owner App. Br. 22. In particular, our reviewing court has instructed that:

A claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language. That is because the patent specification is written for a person of skill in the art, and such a person comes to the patent with the knowledge of what has come before. Placed in that context, it is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention and to enable such a person to make and use the invention without undue experimentation.

LizardTech, Inc. v. Earth Resource Mapping, PTY, Inc., 424 F.3d 1336, 1345 (Fed. Cir. 2005) (citing *Union Oil Co. v. Atl. Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000)); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995)).

However, “[c]ompliance with the written description requirement is essentially a fact-based inquiry that will ‘necessarily vary depending on the nature of the invention claimed.’” *Enzo Biochem v. Gen-Probe, Inc.*, 323 F.3d 956, 963 (Fed. Cir. 2002) (citations omitted). While Owner responds to the § 112, first paragraph rejection of claim 20 with bare allegations and statements of law, Owner does not point to anything in the '618 patent or in the prior art to show that the inventors possessed the invention set forth by

the claim. That is, Owner has not pointed to any evidence in the record, or provided any further evidence, to demonstrate that the '618 patent's disclosure is sufficient to convince a person of skill in the art that the inventors possessed the invention now claimed.

Being not persuaded of error in the Examiner's finding of inadequate written description support, we sustain the § 112, first paragraph rejection of claims 20 through 24.

Section 112, Second Paragraph

The Examiner also rejects claims 20 through 24 as being indefinite. Independent claim 20 recites "a small scale floor-ceiling assembly comprising said preassembled integral unit *in accordance with* standard ANSI/UL 263 (ASTM E 119)" (emphasis added). According to the Examiner, ANSI/UL 263 (ASTM E 119) is a standard measuring how well a structure performed in fire-testing, not a standard for forming an assembly. RAN 10.

Owner responds to the § 112, second paragraph rejection applied against other claims (Owner App. Br. 23-25), but we find no arguments that specifically address the rejection for indefiniteness of claims 20 through 24. However, Owner alleges that the ANSI/UL standard is "familiar" to those in the art and makes general allegations that the claimed subject matter passes muster under the second paragraph of Section 112.

However, the Examiner does not allege that the relevant ANSI/UL standard was not well known to the artisan. We find no satisfactory response from Owner with respect to the Examiner's reasoning in support of

the rejection. Claim 20 as amended sets forth a housing and a light fixture that form a preassembled integral unit, “whereby a small scale floor-ceiling assembly comprising said preassembled integral unit in accordance with standard ANSI/UL 263 (ASTM E 119).” The claim thus appears to define the assembly comprising the preassembled integral unit in terms of a standard for forming an assembly, while Owner seems to agree the ANSI/UL 263 is not such a standard.

In view of the Examiner’s reasonable basis for the rejection and the lack of an adequate response from Owner, we sustain the § 112, second paragraph rejection of claims 20 through 24.

Proposed Rejections -- Claims 3, 4, 6, 7, 14, 20, 21, and 23

Independent claims 3, 6, 14, and 20 (and dependent claims 4, 7, 21, and 23) have not been rejected under 35 U.S.C. § 314(a) and the Examiner has not entered any prior art rejections against these claims.

In Requester’s Notice of Appeal (filed Dec. 18, 2009), Requester submits that it is appealing the “final decisions” favorable to patentability of claims of the '618 patent, but only lists Office Actions that are non-final (which Requester separates into ten entries). Both the Notice of Appeal and Requester’s Appeal Brief make reference to the original *inter partes* reexamination request (Jan. 23, 2006), which proposed rejections over Ward (Request 5-10) and submitted that isolated claim elements were shown by various pieces of prior art (*id.* at 10-13).

From the Table of Contents of Requester’s Appeal Brief, Requester seems to contend that independent claims 3, 6, 14, and 20 should have been

However, Requester does not respond to the Examiner's findings related to why modifying Ward consistent with the requirements of claims 3, 6, and 14 would not represent an "obvious design choice." The Examiner finds that it would not have been obvious to include (in accordance with claim 3) a junction box on an upper surface of the bottom wall (whether inside or outside the housing) because there would not be sufficient room for a junction box. RAN 21. The Examiner further finds that it would not have been obvious to modify Ward to include a bar hanger (in accordance with claim 14) because it is unclear how a bar hanger could securely be fastened to a conical device covered with a fabric. *Id.* at 22.

The Examiner's stated reason in the RAN with respect to the patentability of claim 6 over Ward appears to be insufficient on its face for not entering a rejection under § 103(a). "Ward does not disclose including a support structure formed from aluminum as recited in claim 6." RAN 22. However, as pointed out by Owner in its Rebuttal Brief, the Examiner provided other reasons in the Action Closing Prosecution (mailed June 19, 2009) (ACP). The Examiner finds that it would not have been obvious to form the rigid straps (7) of Ward from metal, and further that doing so would not result in a metal housing. ACP 36.

Requester does not address the relevant findings with respect to straps 7 of Ward. Moreover, Requester does not properly identify any factual support for the alleged "obvious design choice" for claim 6. *See* Req. App. Br. 43 n. 162. Apparently, footnote 162 in Requester's Appeal Brief was intended to refer to Monson, which in column 1, lines 46 through 63 describes prior art, preformed insulation barriers constructed from aluminum

sheet metal, which Monson teaches did not conform with applicable building codes and in addition resulted in expensive structures such that the sheet metal should be avoided. In any event, Requester does not specify how the teachings of Monson might demonstrate that modifying Ward's housing to include a support structure formed from aluminum would represent an "obvious design choice."

We are thus not persuaded that the Examiner erred in not entering rejections under 35 U.S.C. § 103(a) against claims 3, 4, 6, 7, and 14. Further, because we have sustained the Examiner's rejections of claims 20 through 24 under 35 U.S.C. § 112, first and second paragraphs, we also sustain the Examiner's decision not to enter rejections under 35 U.S.C. § 103(a) against claims 20, 21, and 23.

Therefore, to the extent that Requester may present proposed rejections in the Appeal Brief that do not represent new grounds of rejection, we are not persuaded that the Examiner erred in not entering the rejections.

Summary/Conclusion

We sustain the rejection of claims 1, 2, 10-13, 15-19, and 35 under 35 U.S.C. § 314(a). We do not reach consideration of the other applied or proposed rejections against these claims.

We sustain the 35 U.S.C. § 112, first paragraph, rejection of claims 20-24.

We sustain the 35 U.S.C. § 112, second paragraph, rejection of claims 20-24.

Appeal 2012-010410
Reexamination Control 95/000,124
Patent US 6,838,618 B2

rejected under § 103(a) over Monson in combination with Ward, Hubbell, or Montanez, over Ward alone, or over Ward in view of Monson, Montanez, and Hubbell. Requester does not, however, point out where Requester proposed such rejections. *See* 37 C.F.R. § 41.67(c)(1)(vi) (“No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.”).

In response to the Examiner’s April 17, 2008 Office Action, Requester may be regarded as proposing rejections based on Monson, Ward, Montanez, and Hubbell in Requester’s Comments (filed June 16, 2008), at pages 7 to 15, but none of claims 3, 6, and 14 are included. *See* Manual of Patent Examining Procedure (MPEP) §§ 2666.05 and 2617, Eighth Ed., Rev. 7, July 2008 (a newly proposed ground of rejection in the written comments must comply with the guidelines for an original request for *inter partes* reexamination). Although Requester’s Comments (at 5 and 6) appear to address the Examiner’s reasons for confirmation of claims 3 and 14, neither Requester’s Appeal Brief nor the Comments point out where appropriate grounds of rejection have been proposed by Requester against claims 3, 6, and 14, other than the original reexamination request’s proposal of rejections based on Ward.

In any event, Requester acknowledges that Ward does not disclose all elements of any of claims 3, 6, and 14, but submits that the missing elements would have been “obvious design choice[s].” Req. App. Br. 41-42, 43-44.

Appeal 2012-010410
Reexamination Control 95/000,124
Patent US 6,838,618 B2

We sustain the Examiner's decision not to enter rejections under 35 U.S.C. § 103(a) against claims 3, 4, 6, 7, 14, 20, 21, and 23.

DECISION

The Examiner's decision unfavorable to the patentability of claims 1, 2, 10-13, 15-24, and 35 is affirmed.

The Examiner's decision favorable to the patentability of claims 3-9, 14, and 25-34 is affirmed.

Requests for extensions of time in this proceeding are governed by 37 C.F.R. §§ 1.956 and 41.79(e).

AFFIRMED

alw

Patent Owner:
JEFFREY J. HOWELL
ROYLANCE ABRAMS BERDO & GOODMAN LLP
1300 19TH STREET, NW
SUITE 600
WASHINGTON DC 20036

Third Party Requester:
JAMES R. NUTTAL
MCANDREWS, HELD & MALLOY, LTD
550 WEST MADISON STREET, SUITE 3400
CHICAGO, IL 60661