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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 BOARD OF PATENT APPEALS
AND INTERFERENCES

LIGHT & MOTION INDUSTRIES, INC.
Requester

v.

Patent of SARTEK, LLC
Patent Owner and Appellant

Appeal 2010-009569
Reexamination Control 95/000,060
Patent 6,679,619 B2
Technology Center 3900

Before JAMESON LEE, ROMULO H. DELMENDO, and
KARL EASTHOM, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ If appropriate, the one-month time period for filing a request for rehearing, as recited in 37 C.F.R. § 41.79, and the two-month time period for filing an appeal, as recited in 37 C.F.R. § 1.304 (*see* 37 C.F.R. § 1.983(b)(1)), both begin to run from the “MAIL DATE” shown on the PTOL-90A cover letter attached to this decision.

Sartek, LLC, the owner of the patent under reexamination, appeals from the Examiner's final decision to reject claims 3, 4, 6, 7, 9, 10, and 12-14 (Patent Owner's Appeal Brief filed September 23, 2009, hereinafter "App. Br."; Right of Appeal Notice mailed June 12, 2009, hereinafter "RAN"). The Third-Party Requester, Light & Motion Industries, Inc., did not file a respondent brief or an appeal brief in support of its cross-appeal. We have jurisdiction under 35 U.S.C. §§ 134(b) and 315(a).

We REVERSE.

STATEMENT OF THE CASE

The Patent Owner informs us that the Requester is one of the named defendants in a patent infringement action involving the patent under reexamination (hereinafter "'619 Patent"), captioned *Sartek LLC et al. v. Lamartek, Inc., d/b/a Dive-Rite, et al.*, Civil Action 3:04-CV-0098 (S.D. Ohio). According to the Patent Owner, that action has been stayed pending the outcome of the current reexamination (App. Br. 2).

The '619 Patent states that "[t]he invention relates to lamps and lighting systems for use underwater by divers" (col. 1, ll. 13-14).

Claim 3 on appeal reads as follows (Claims App'x, App. Br. 19-20; bracketing and underlining relative to the original patent omitted):

3. A high intensity discharge lamp assembly, comprising:

a high intensity discharge lamp comprising a hermetically sealed glass envelope containing a mixture of ionizable elements and/or compounds;

a sealed ballast container mounted adjacent to said glass envelope and including a support base adapted to receive and support said lamp, said ballast container being potted with a material to eliminate vacant spaces therein so that said potting material is in direct contact with the interior of said ballast container;

an electronic ballast within said ballast container, said ballast having an input and an output;

an anode disposed in said envelope and electrically coupled to one pole of said ballast output;

a cathode disposed in said envelope and electrically coupled to another pole of said ballast output;

coupling means for coupling said input of said ballast to a DC power source, said coupling means being a cable with a wet pluggable plug at one end for coupling/uncoupling to/from a battery pack while under water;

heat sink means in said ballast container for extracting heat from said ballast and transferring said extracted heat to an exterior of said ballast container; and

a waterproof protective container covering said envelope and said ballast container; said waterproof protective container having a transparent window to transmit light from said lamp.

The Examiner relied upon the following as evidence of unpatentability (Examiner's Answer mailed March 30, 2010, hereinafter "Ans.," 3):

Payne	4,947,304	Aug. 7, 1990
Graham	5,144,201	Sep. 1, 1992
Frick	6,467,930 B1	Oct. 22, 2002

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ADVANCE[®]: Pocket Guide to High Intensity Discharge Lamp Ballasts, Advance Transformer Co. (exact publication date unknown) (hereinafter “Pocket Guide reference”).

Light & Motion Industries, Inc. 1997 Catalog & Selection Guide (exact publication date unknown) (hereinafter “Light Catalog”).

The Examiner rejected 3, 4, 6, 7, 9, 10, and 12-14 under U.S.C. § 103(a) as follows (Ans. 4-10):

- I. Claims 3, 4, 6, 7, 9, 10, and 12-14 as unpatentable over the combined teachings of Frick, Graham, and Payne;
- II. Claims 6 and 12 as unpatentable over the combined teachings of Frick, Graham, Payne, and the Pocket Guide reference; and
- III. Claims 3 and 9 as unpatentable over the combined teachings of Frick, Graham, Payne, and Light Catalog.

ISSUE

Both the Examiner and the Patent Owner agree that the propriety of the rejections turns on whether the subject matter of the appealed claims is entitled to 35 U.S.C. § 119(e)(1) priority based on earlier-filed United States Provisional Application 60/183,767 (hereinafter “‘767 Provisional Application”), which was filed before Frick’s effective date for purposes of 35 U.S.C. § 102 (Ans. 4-5; App. Br. 11).

The Examiner asserts that the ‘767 Provisional Application does not provide written description support for the invention recited in claim 3 with respect to two limitations: (i) “said ballast container

being potted with a material to eliminate vacant spaces therein to so that said potting material is in direct contact with the interior of said ballast container”; and (ii) “a waterproof protective container covering said envelope and said ballast container” (Ans. 5). The Examiner asserts that independent claims 4 and 7 contain similar unsupported limitations (*see* Ans. 5, 7.) The Patent Owner disputes the Examiner’s findings (App. Br. 14-18).

Thus, the sole issue on appeal is:

Did the Examiner provide a sufficient reason to support a finding that the ‘767 Provisional Application does not disclose contested claim limitations recited in claim 3 and similar limitations recited in claims 4 and 7 in the manner required by 35 U.S.C. § 112, ¶ 1?

FINDINGS OF FACT (“FF”)

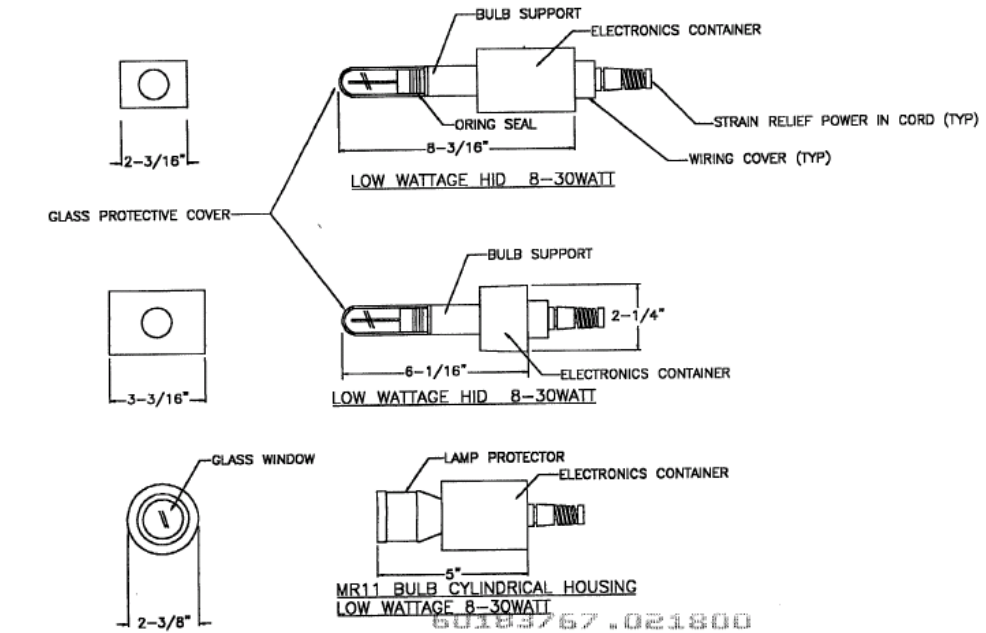
1. The ‘767 Provisional Application describes a portable battery-powered high intensity lighting system for “extremely harsh environments” such as for underwater exploration (second page starting from the “Title” page, “Abstract” and “Field of the invention”).
2. Specifically, the ‘767 Provisional Application discloses that “[t]he system is comprised of a heat resistant glass cover *which is sealed by ‘O’ rings* to a support base, this base hold[ing] the lamp in position under the glass cover” (third page, “Summary of the invention,” italics added).

3. According to the '767 Provisional Application, "[t]his entire assembly is sized to fit existing incandescent lighting system components" (*id.*).
4. The '767 Provisional Application further states (*id.*; italics added):

At the other end of the lamp holder base is a container that houses the electronic ballast. This container is *waterproof and pressure proof*, either by mechanically pressure resistant walls or a container *whose interior has been filled with a material to eliminate vacant spaces within*.

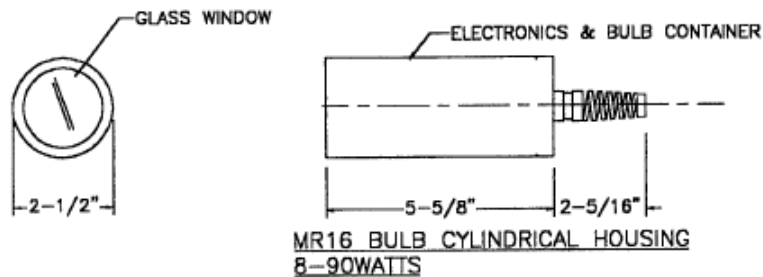
5. The figures on the fifth page of the '767 Provisional Application are reproduced below:

DIFFERENT CONFIGURATIONS OF BULB/BALLAST ASSEMBLIES



These figures depict different configurations of bulb/ballast assemblies, wherein the first figure shows a glass protective cover sealed by an o-ring to a bulb support and an electronics container (i.e., a container that houses an electronic ballast).

6. The figures in the middle of the sixth page of the '767 Provisional Application are reproduced below:



These figures depict an additional configuration in which the bulb and the electronic ballast are enclosed with an “ELECTRONICS & BULB CONTAINER,” identified as “MR16 BULB CYLINDRICAL HOUSING 8-90WATTS” (also shown in the figure on the left, i.e., the figure with a label “GLASS WINDOW”).

7. The '619 Patent under reexamination informs one skilled in the relevant art that the ballast container “is preferably potted with a thermally conductive (electrically-non conductive) epoxy insulator . . . which serves as a heat sink to discharge heat from the unit” (col. 3, l. 66 to col. 4, l. 3).

PRINCIPLES OF LAW

For a claim in a non-provisional application to be entitled to the filing date of an earlier-filed provisional application, the provisional application must, inter alia, provide a written description of the claimed invention. *New Railhead Mfg. LLC v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1296 (Fed. Cir. 2002).

“[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure [of the earlier application] a description of the invention defined by the claims.” *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976).

“It is not necessary that the [earlier] application describe the claim limitations exactly . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations.” *Id.* at 262.

ANALYSIS

Neither of the two reasons given by the Examiner for denying 35 U.S.C. § 119(e)(1) priority is persuasive.

Regarding the limitation “said ballast container being potted with a material to eliminate vacant spaces therein so that said potting material is in direct contact with the interior of said ballast container,”² the Patent Owner has relied on the description in the

² Both the Examiner and the Patent Owner appear to have interpreted the recitation “interior of said ballast container” to mean the interior *surface* of said ballast container (App. Br. 14; Ans. 6).

“Summary of the invention” of the ‘767 Provisional Application (App. Br. 15). There, the ‘767 Provisional Application explicitly discloses that the ballast container “has been filled with a material to eliminate vacant spaces within” (FF 4). The Examiner argues, however, that “this single disclosed sentence does not guarantee that the potting material is in *direct contact* with the interior of the ballast container” (Ans. 6). According to the Examiner, a hypothetical “scenario” includes an insulation layer between the container surface and the potting material that precludes “direct contact” (*id.*).

The Examiner’s argument fails because the question is not whether the earlier disclosure “guarantee[s]” the now claimed subject matter, but rather whether persons of ordinary skill in the art will recognize from the disclosure that the Patentee invented the system including the contested limitations. The ‘767 Provisional Application plainly discloses that the interior of the ballast container “has been filled with a material to eliminate vacant spaces within.” Such a disclosure reasonably conveys to persons skilled in the art that the inventor had possession of an embodiment in which only the ballast container and the filling material are used – i.e., where the filling material is in “direct contact” with the interior surface of the ballast container, as required in claim 3. That the ‘767 Provisional Application did not explicitly exclude or might generically encompass the use of an insulating layer of the Examiner’s hypothetical “scenario” is not dispositive of whether the earlier disclosure provides

sufficient descriptive support. *Cf. Wertheim*, 541 F.2d at 263 (specification disclosing a broader range supported a specific range).

Even if the description in the '767 Provisional Application was limited to an embodiment in which an insulating layer is present between the interior surface of the ballast container and the "material," that would not save the Examiner's stated position. The '619 Patent informs one skilled in the relevant art that the potting material is preferably an insulator (FF 7). Hence, when the claim term "potting material" is properly construed in light of the '619 Patent disclosure, the Examiner's hypothetical insulating layer would be considered as part of the "potting material." Thus, again, the "potting material," which would include the Examiner's hypothetical insulating layer, would be in "direct contact" with the interior surface of the ballast container.

Turning to the limitation "a waterproof protective container covering said envelope and said ballast container," the Examiner does not assert that the '767 Provisional Application fails to disclose a protective container that covers both "a hermetically sealed glass envelope" for the lamp and "a sealed ballast container" (Ans. 8-10). Rather, the Examiner argues that "[m]erely looking at the fifth of the six figures on the third and fourth [sic, fifth and sixth] pages of the '767 provisional patent application, one cannot tell whether the container labeled 'ELECTRONICS & BULB CONTAINER' is waterproof" (Ans. 8-9). The Examiner concedes, however, that "one

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can assume that the need to waterproof the container which covers the lamp envelope and the ballast container is optional” (Ans. 8).

As we discussed above, an earlier disclosure need not recite the claimed subject matter *in haec verba* to satisfy the written description requirement. The Examiner’s own finding that “one can assume that the need to waterproof the container [of the ‘767 Provisional Application] which covers the lamp envelope and the ballast container is optional” defeats the Examiner’s argument that the ‘767 Provisional Application does not reasonably convey to persons skilled in the art that the inventor had possession of the now claimed subject matter.

Moreover, the ‘767 Provisional Application discloses that the “ELECTRONICS & BULB CONTAINER” is made of cylindrical glass (FF 6). Therefore, a person of ordinary skill in the art would have drawn a reasonable inference that the disclosed “ELECTRONICS & BULB CONTAINER” made of glass is intended to be present during use. Given that the ‘767 Provisional Application discloses that the system is designed for use in harsh underwater environments and glass covers in alternative embodiments were hermetically sealed using o-rings for protection against water ingress, a person of ordinary skill in the art would have understood that the inventor had possession of an “ELECTRONICS & BULB CONTAINER” (a type of glass cover) that is also hermetically sealed with an o-ring (FF 1-3).

For these reasons, we cannot uphold any of the Examiner’s stated rejections.

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CONCLUSION

On this record, Examiner failed to provide a sufficient reason in support of a finding that the '767 Provisional Application does not disclose the contested claim limitations recited in claim 3 and similar limitations recited in claims 4 and 7 in the manner required by 35 U.S.C. § 112, ¶ 1.

DECISION

The Examiner's decision to reject claims 3, 4, 6, 7, 9, 10, and 12-14 is reversed.

REVERSED

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