

PRIOR OR CONCURRENT PROCEEDINGS:

Pursuant to 37 C.F.R. § 1.985, the Patent Owner previously notified the Examiner of the following litigation proceedings that involved the subject patent:

1. Civil Action No. 4:05-CV-00373, *World Factory, Inc. v. Southern Sales & Marketing Group, Inc.*, United States District Court for the Northern District of Texas, Fort Worth Division.

2. Civil Action No. 4:05-CV-374-A, *World Factory, Inc. v. Bond Manufacturing Co.*, United States District Court for the Northern District of Texas, Fort Worth Division.

The following changes have taken place in the foregoing litigation proceedings:

1. Civil Action No. 4:05-CV-00373, *World Factory, Inc. v. Southern Sales & Marketing Group, Inc.*, United States District Court for the Northern District of Texas, Fort Worth Division, was dismissed without prejudice on 9 January 2006.

2. Civil Action No. 4:05-CV-374-A, *World Factory, Inc. v. Bond Manufacturing Co.*, United States District Court for the Northern District of Texas, Fort Worth Division, was dismissed without prejudice on 21 November 2005.

The Patent Owner is not aware of any other litigation proceedings involving the subject patent.

IN THE CLAIMS:

The Patent Owner submits that the following amendments add no new matter to the patent and do not broaden the scope of the patent. Statements of support for each claim amendment are set forth below. Please amend the claims as follows:

1. (Amended) An umbrella apparatus comprising:
 - a base support portion;
 - a pole portion coupled to the base support portion;
 - a canopy portion hingedly coupled to the pole portion, the canopy portion having a plurality of rib members;
 - a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
 - a solar energy system carried by the pole portion above the canopy portion, the solar energy system comprising a module releasably coupled to the pole portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
 - [and]
 - a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system, the lighting system having a light subassembly positioned along at least one of the rib members; and
 - an electromechanical opening and closing system for opening and closing the canopy portion, the electromechanical opening and closing system being conductively coupled to and powered by the rechargeable electrical power system
 - [an electrical charging system for recharging the rechargeable electrical power system, the electrical charging system being adapted to receive power from an AC power outlet].

2. (Allowed) An umbrella apparatus comprising:
- a base support portion;
 - a pole portion coupled to the base support portion;
 - a canopy portion hingedly coupled to the pole portion;
 - a power module carried by the pole portion above the canopy portion, the power module having an upper portion and a lower portion;
 - a rechargeable electrical power system for providing electrical power to the umbrella apparatus, the rechargeable electrical power system being disposed in the lower portion of the power module;
 - a solar energy system carried by the [pole portion above the canopy portion] upper portion of the power module, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and
 - a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system.

3. (Allowed) [The] An umbrella apparatus [according to claim 2,] comprising:
- a base support portion;
 - a pole portion coupled to the base support portion;
 - a canopy portion hingedly coupled to the pole portion;
 - a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
 - a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
 - and
 - a lighting system carried by the canopy portion, the lighting system being

conductively coupled to and powered by the rechargeable electrical power system;

wherein the lighting system comprises:

a plurality of rib members coupled to the canopy portion;

and

a plurality of cold cathode tube elements carried by the rib members, each cold cathode tube element being conductively coupled to and powered by the rechargeable electrical power source.

4. (Allowed) The umbrella apparatus according to claim 2, wherein the lighting system comprises:

a plurality of rib members coupled to the canopy portion; and

a plurality of light emitting diode elements carried by the rib members, each light emitting diode element being conductively coupled to and powered by the rechargeable electrical power source.

5. (Allowed) The umbrella apparatus according to claim 2, wherein the lighting system comprises:

a plurality of rib members coupled to the canopy portion; and

a plurality of fluorescent light elements carried by the rib members, each fluorescent light element being conductively coupled to and powered by the rechargeable electrical power source.

6. (Amended) An umbrella apparatus comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by a disc-shaped power unit, the power unit being carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical

energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; [and]

an electromechanical opening and closing system for opening and closing the canopy portion, the electromechanical opening and closing system being conductively coupled to and powered by the rechargeable electrical power system; and

a light subassembly carried by the canopy portion.

7. (Original) The umbrella apparatus according to claim 6, wherein the electromechanical opening and closing system comprises:

an electric motor carried by the pole portion; a control system for controlling the electric motor; a gear system coupled to the electric motor; and

a cable and pulley system coupled to the gear system and the canopy portion; wherein the opening and closing of the canopy portion is achieved by the electric motor in response to selective operation of the control system.

8. (Allowed) [The] An umbrella apparatus [according to claim 7,] comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and

an electromechanical opening and closing system for opening and closing the canopy portion, the electromechanical opening and closing system being conductively coupled to and powered by the rechargeable electrical power system;

wherein the electromechanical opening and closing system comprises:

an electric motor carried by the pole portion;

a control system for controlling the electric motor;

a gear system coupled to the electric motor; and

a cable and pulley system coupled to the gear system and the canopy portion;

wherein the opening and closing of the canopy portion is achieved by the electric motor in response to selective operation of the control system; and

wherein the control system comprises:

a receiver conductively coupled to the electric motor;

a remote transmitter for transmitting an encoded signal to the receiver;

and

a decoder conductively coupled to the receiver for decoding the encoded signal from the transmitter.

9. (Amended) An umbrella apparatus comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion hingedly coupled to the pole portion, the canopy portion having a plurality of rib members;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;

and

a cooling system carried by the canopy portion, the cooling system being conductively coupled to and powered by the rechargeable electrical power system, the cooling system comprising;

a fluid reservoir operably associated with the umbrella apparatus;
at least one mist nozzle coupled to the canopy portion and carried by a rib member, each mist nozzle being in fluid communication with the fluid;
a conduit creating fluid communication between the fluid reservoir and each mist nozzle; and
a pump for pumping the fluid from the reservoir through each mist nozzle.

10. (Allowed) An umbrella apparatus comprising:

a base support portion;
a pole portion coupled to the base support portion;
a canopy portion hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and

a combination of two or more of the following modular systems:

a lighting system carried by the canopy portion;
an electromechanical opening and closing system for opening and closing the canopy portion; or
a cooling system;

wherein each modular system is configured to be interchanged with each other, each modular system being conductively coupled to and powered by the rechargeable electrical power system.

11. (Allowed) The umbrella apparatus according to claim 10, wherein the lighting system comprises:

a plurality of rib members coupled to the canopy portion; and

a plurality of cold cathode tube elements carried by the rib members, each cold cathode tube element being conductively coupled to and powered by the rechargeable electrical power source.

12. (Allowed) The umbrella apparatus according to claim 10, wherein the lighting system comprises:

a plurality of rib members coupled to the canopy portion; and

a plurality of light emitting diode elements carried by the rib members, each light emitting diode element being conductively coupled to and powered by the rechargeable electrical power source.

13. (Allowed) The umbrella apparatus according to claim 10, wherein the cooling system comprises:

a fluid reservoir operably associated with the umbrella apparatus;

at least one mist nozzle coupled to the canopy portion, each mist nozzle being in fluid communication with the fluid;

a conduit creating fluid communication between the fluid reservoir and each mist nozzle; and

a pump for pumping the fluid from the reservoir through each mist nozzle.

14. (Confirmed) The umbrella apparatus according to claim 10, wherein the electromechanical opening and closing system comprises:

an electric motor carried by the pole portion; a control system for controlling the electric motor;

a gear system coupled to the electric motor; and

a cable and pulley system coupled to the gear system and the canopy portion;

wherein the opening and closing of the canopy portion is achieved by the electric motor in response to selective operation of the control system.

Claims 15-44. (Previously Cancelled).

45. (New) A patio umbrella apparatus, comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion hingedly coupled to the pole portion;
a power system charger carried by the pole portion above the canopy portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
a solar cell carried by an upper cap portion of the power system charger, the solar cell being adapted to collect solar energy and convert the solar energy into electrical energy, the solar cell being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and
an electrical charging system for recharging the rechargeable electrical power system, the electrical charging system being adapted to receive power from an AC power outlet.

46. (New) The patio umbrella apparatus according to claim 45, further comprising:
an external power system charger.

47. (New) A patio umbrella apparatus, comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion hingedly coupled to the pole portion, the canopy portion being operable between an opened position and a closed position;
a power unit carried by the pole portion above the canopy portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus, the rechargeable electrical power system being carried by a bottom portion of the power unit;
a solar energy system adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and

converted into electrical energy recharges the rechargeable electrical power system, the solar energy system being carried by an upper portion of the power unit; and
a lighting system carried by the canopy portion and being conductively coupled to the rechargeable electrical power system;
wherein the power unit is carried by the pole portion such that the solar energy system is fixed relative to the pole portion when the canopy is operated between the opened position and the closed position.

48. (New) A patio umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion hingedly coupled to the pole portion, the canopy portion having a plurality of rib members and being operable between an opened position and a closed position;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and

a light subassembly carried by the rib members, the light subassembly being conductively coupled to the rechargeable electrical power system;

wherein the rechargeable electrical power system and the solar energy system each form a component part disposed in a power unit carried by the pole portion such that the power unit is fixed relative to the pole portion when the canopy is operated between the opened position and the closed position.

49. (New) An umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;

wherein the lighting system includes multiple discrete lighting elements positioned along a rib member, each lighting element being recessed within the rib member and being conductively coupled to the rechargeable electrical power system by an electrical conductor, the electrical conductor also being recessed within the rib member.

50. (New) The umbrella apparatus according to claim 49, wherein the lighting system includes multiple discrete lighting elements along each rib member.

51. (New) An umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by a power unit coupled to and carried by the pole portion above the canopy portion, the solar energy system being adapted to collect

solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system, the power unit being releasably coupled to the pole portion; and

a light subassembly carried by the canopy portion, the light subassembly being conductively coupled to and powered by the rechargeable electrical power system, the light subassembly being positioned along a rib member;

wherein the light subassembly extends beyond the corresponding rib member.

52. (New) An umbrella apparatus comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;

wherein the lighting system includes multiple discrete lighting elements positioned along a rib member; and

wherein each lighting element is fully recessed within the corresponding rib member.

53. (New) The umbrella apparatus according to claim 52, further comprising:
a translucent cover over the lighting elements.
54. (New) The umbrella apparatus of claim 49, wherein the multiple discrete lighting elements are cold cathode tube bulbs.
55. (New) The umbrella apparatus according to claim 52, further comprising:
wires for conductively coupling the lighting elements to the rechargeable electrical power source, the wires being fully recessed within the rib members.
56. (New) An umbrella apparatus, comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
a solar energy system adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system, the lighting system comprising a plurality of lighting elements carried by the rib members, each lighting element being conductively coupled to and powered by the rechargeable electrical power system;
wherein the rechargeable electrical power system and the solar energy system each form a separate component part of a power module that is carried by the pole portion above the canopy portion.

57. (New) A patio umbrella apparatus, comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion hingedly coupled to the pole portion, the canopy portion having
a plurality of rib members;
a crank housing coupled to the pole portion, the crank housing being adapted to
partially house a system for opening and closing the canopy portion;
a rechargeable electrical power system for providing electrical power to the
umbrella apparatus, the rechargeable electrical power system being disposed below the
canopy portion;
a solar energy system carried by the pole portion above the canopy portion, the
solar energy system being adapted to collect solar energy and convert the solar energy
into electrical energy, the solar energy system being conductively coupled to the
rechargeable electrical power system, such that the solar energy collected and
converted into electrical energy recharges the rechargeable electrical power system;
and
a lighting system carried by the canopy portion, the lighting system being
conductively coupled to and powered by the rechargeable electrical power system, the
lighting system comprising a plurality of lighting elements carried by the rib members,
each lighting element being conductively coupled to and powered by the rechargeable
electrical power system via conductors, the conductors being recessed within the rib
members.

58. (New) The patio umbrella apparatus according to claim 57, further comprising:
a switch carried by the crank housing for controlling the system for opening and
closing the canopy portion.

59. (New) An umbrella apparatus, comprising:
a pole portion;
a base support portion for supporting the umbrella apparatus in an upright
orientation, the base support portion being coupled to the pole portion;

a canopy portion hingedly coupled to the pole portion;

a crank housing coupled to the pole portion, the crank housing being adapted to partially house a system for opening and closing the canopy portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a switch carried by the crank housing for controlling the system for opening and closing the canopy portion;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system, the lighting system being recessed in the rib members;

wherein the rechargeable electrical power system is carried by the pole portion and the solar energy system is fixed relative to the pole portion when the canopy is operated between an opened position and a closed position.

60. (New) An umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and

converted into electrical energy recharges the rechargeable electrical power system;
and

a lighting system carried by the canopy portion, the lighting system being
conductively coupled to and powered by the rechargeable electrical power system;

wherein the lighting system includes a plurality of lighting elements, each lighting
element being recessed within a corresponding rib member and being covered by a
translucent cover carried by the corresponding rib member.

61. (New) An umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion having a plurality of rib members, the canopy portion being
hingedly coupled to the pole portion;

a power unit carried by the pole portion above the canopy portion;

a rechargeable electrical power system for providing electrical power to the
umbrella apparatus, the rechargeable electrical power system forming a component
part of the power unit;

a solar energy system for collecting solar energy and converting the solar energy
into electrical energy, the solar energy system being conductively coupled to the
rechargeable electrical power system, such that the solar energy collected and
converted into electrical energy recharges the rechargeable electrical power system,
the solar energy system also forming a component part of the power unit; and

a lighting system carried by the canopy portion, the lighting system being
conductively coupled to and powered by the rechargeable electrical power system and
having a plurality of lighting elements, each lighting element being carried by a rib
member and being conductively coupled to the rechargeable electrical power system
via a conductor carried by the corresponding rib member.

62. (New) An umbrella apparatus, comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and
lighting elements disposed within cavities in the rib members, the lighting elements being conductively coupled to and powered by the rechargeable electrical power system.

63. (Cancelled).

64. (Cancelled).

65. (New) A patio umbrella apparatus, comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
a solar energy system contained in a discus-shaped module, the discus-shaped module being carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable

electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;
wherein the discus-shaped module is releasably coupled to the pole portion.

66. (New) A patio umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion hingedly coupled to the pole portion, the canopy portion having a plurality of rib members and being operable between an opened position and a closed position;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system via electrical conductors extending along the rib members;

wherein the rechargeable electrical power system forms a bottom portion of a power unit and the solar energy system forms a top portion of the power unit, the power unit being carried by the pole portion above the canopy portion, such that the power unit remains in a fixed orientation relative to the pole portion when the canopy is operated between the opened position and the closed position.

67. (New) A patio umbrella apparatus, comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
an electromechanical opening and closing system for opening and closing the canopy portion, the electromechanical opening and closing system being powered by the rechargeable electrical power system;
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;
a crank housing coupled to the pole portion, the crank housing being adapted to partially house the electromechanical opening and closing system; and
a switch carried by the crank housing for controlling the electromechanical opening and closing system.

68. (Cancelled).

69. (Cancelled).

70. (New) An umbrella apparatus, comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion being hingedly coupled to the pole portion, the canopy portion having a plurality of rib members, each rib member having a recessed longitudinal channel;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system, the lighting system comprising a plurality of lighting elements carried by the rib members, each lighting element being disposed within the channel and being conductively coupled to and powered by the rechargeable electrical power source.

71. (New) The umbrella apparatus according to claim 70, further comprising:
a transparent cover disposed over each channel.

72. (New) An umbrella apparatus, comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion being hingedly coupled to the pole portion, the canopy portion having a plurality of rib members;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and

a lighting system carried by the canopy portion, the lighting system being

conductively coupled to and powered by the rechargeable electrical power system, wherein the lighting system comprises:

a plurality of discrete lighting elements carried by each rib member;

wherein each discrete lighting element is conductively coupled to and powered by the rechargeable electrical power source and is recessed within a corresponding rib member, the discrete lighting elements being conductively coupled to the rechargeable electrical power system by electrical conductors, the electrical conductors also being recessed within the rib members.

73. (New) A patio umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and

an external power system charger carried by the pole portion for recharging the rechargeable electrical power system, the external power system charger being adapted to receive power from an AC power outlet;

wherein the solar energy system and the external power system charger remain carried by the pole portion when the rechargeable electrical power system is removed from the patio umbrella apparatus.

74. (New) An umbrella apparatus comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion hingedly coupled to the pole portion;
a power module carried by the pole portion above the canopy portion, the power module having an upper portion and a lower portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus, the rechargeable electrical power system being disposed in the lower portion of the power module;
a solar energy system disposed in the upper portion of the power module, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system.

REMARKS:

Status:

Claims 1-14 and 45-74 are currently pending in the subject reexamination. Claims 15-44 were previously cancelled. Claims 4, 5, and 10-14 are confirmed. Amended Claims 2, 3, and 8 are patentable. New Claims 49, 50, 52, 53, 55-58, 60, 61, 65, 70-72, and 74 are patentable. Claims 1, 6, 9, 45-48, 51, 54, 59, 62, 65, 66, and 73 are hereby amended under 37 C.F.R. §§ 1.116 and 1.951. Claim 65 is hereby amended by making it an independent claim and by adding all of the limitations of Claim 64. Claim 7 is not hereby amended, but remains dependent upon Claim 6, which is hereby amended. Claims 15-44 were previously cancelled. Claims 63, 64, 68, and 69 are hereby cancelled.

The Patent Owner submits that the amendments and remarks set forth herein *prima facie* place the claims in condition for allowance.

The following remarks, along with the section below entitled "Statements of Support for Amendments to the Claims," explain and set forth the support in the Specification for the foregoing amendments on a claim-by-claim basis. In addition, the Patent Owner reiterates here and incorporates by reference as if set forth fully herein all of the remarks, comments, and distinguishing arguments set forth in the Patent Owner's previously filed papers.

Rejections Under 35 U.S.C. § 314:

Claims 1, 9, 45-48, 51, and 63 stand rejected under 35 U.S.C. § 314(a) as enlarging the scope of the claims. Claim 63 is hereby cancelled. Claims 1, 9, 45-48, and 51 are hereby amended to bring the scope of the claims back into the scope of the issued claims. Claim 1 is hereby amended by adding the limitation that the solar energy system is carried by the pole portion. Claim 9 is hereby amended by adding the limitation that the at least one mist nozzle is coupled to the canopy portion and carried by a rib member. Claim 45 is hereby amended by adding the limitation that the power system charger is carried by the pole portion above the canopy portion. Claim 46 is

hereby amended by adding the limitation of an external power system charger. Claim 47 is hereby amended by adding the limitations of a lighting system carried by the canopy portion, and that the solar energy system is carried by an upper portion of a power unit that is carried by the pole portion above the canopy portion. Claim 48 is hereby amended by adding the limitation that the light subassembly is conductively coupled to the rechargeable electrical power system. Claim 51 is hereby amended by adding the limitation that the solar energy system is coupled to and carried by the pole portion above the canopy portion. The Patent Owner submits that the amendments to Claims 1, 9, 45-48, and 51 overcome the Examiner's rejections under 35 U.S.C. § 314.

Rejections Under 35 U.S.C. § 112, First Paragraph:

Claims 1, 45, 46, 48, 51, 54, 59, 62, 63, 66, and 73 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claim 63 is hereby cancelled. Claims 1, 45, 46, 48, 51, 54, 59, 62, 66, and 73 are hereby amended to comply with the written description requirement. The Patent Owner submits that the amendments to Claims 1, 45, 46, 48, 51, 54, 59, 62, 66, and 73 overcome the Examiner's rejections under 35 U.S.C. § 112, first paragraph.

On page 61 of the Action Closing Prosecution, the Examiner states that the Patent Owner presented no arguments with regard to the prior rejection of claims 51, 55, 60, and 62 as encompassing "partially recessed" wiring or lighting elements. The patent owner respectfully disagrees with this statement. The Examiner's original rejection read:

In like manner, although claims 51, 55, 60 and 62 do not exclude an arrangement where each lighting element or wires coupling the lighting elements are fully recessed within the rib members, they also encompass a partially recessed arrangement. Insofar as the base patent specification does not support partially recessed lighting elements or partially recessed wires, claims 51, 55, 60 and 62 are rejected.

Page 12 of 5 December 2006 Office Action. On page 56 of the Patent Owner's 17 April 2009 Amendment (which the Examiner refers to as the "amendment of April 21, 2009"), the Patent Owner states:

The Patent Owner directs the Examiner's attention to column 12, line 58-column 13, line 3, in which the patent clearly states that other low power lighting systems, such as "an LED or fluorescent lighting subassembly may be utilized instead" of the cold cathode tube light assembly shown in the embodiment of Figure 6. Thus, the Patent Owner submits that any reference to a cold cathode tube lighting subassembly may be replaced by an LED or fluorescent lighting subassembly.

This argument appears throughout the Patent Owner's 17 April 2009 Amendment, including on pages 58 and 63. Although the Patent owner amended the claims to advance prosecution of the patent, the Patent Owner submits that such amendment did not and does not constitute an agreement with the Examiner's position on this point. The Patent Owner submits that the patent should be read in its entirety to find support for the claims, and that the different drawings and embodiments of the patent may be combined to support the claims, particularly when there is express language instructing those of ordinary skill in the art to do so.

The Patent Owner submits that the patent supports lighting systems, including both lighting elements and wiring, that are fully recessed and partially recessed with respect to the rib members. For example, in Figure 6, the light subassembly 721 is shown as being recessed relative to the rib member and extending beyond the rib member. Likewise, the wiring 709 is also shown being recessed relative to the rib member and extending beyond the rib member. In addition, in the embodiments of Figures 1, 2A, and 3A, the light strands are attached to the rib members. Furthermore, in Figures 4A, 4B, and 4C, the lighting elements are "recessed into" the rib members. This is evidence that "recessed" can mean partially recessed or fully recessed. As such the Patent Owner disagrees that "recessed" should be construed as being "fully recessed," and hereby reserves the right to argue this point further at a later time.

Rejections Under 35 U.S.C. § 103(a):

I. Claim 73 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 93/00840 and Valdner.

Claim 73 is hereby amended by adding the limitations of an external power system charger carried by the pole portion and being adapted to receive power from an

AC power outlet, and that the solar energy system and the external power system charger remain carried by the pole portion when the rechargeable electrical power system is removed from the patio umbrella apparatus. This combination of features is not disclosed in the cited references. Additional support for the foregoing amendments is set forth herein in the section entitled "Statements of Support for Amendments to the Claims." The Patent Owner submits that the combination of WO 93/00840 and Valdner does not disclose the umbrella apparatus of Claim 73, as amended, and that the foregoing amendments to Claim 73 overcome the Examiner's rejections under 35 U.S.C. 103(a). For these reasons set forth herein, the Patent Owner submits that Claim 73, as amended, is now patentable.

II. Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 93/00840, Small and Pan or Wu or JP 9-168415 or Mai or Yang.

Claim 1 is hereby amended by adding the limitations of an electromechanical opening and closing system for opening and closing the canopy portion, the electromechanical opening and closing system being conductively coupled to and powered by the rechargeable electrical power system, that the solar energy system is carried by the pole portion above canopy portion and comprises a module releasably coupled to the pole portion, and that the lighting system has a light subassembly positioned along at least one of the rib members. This combination of features is not disclosed in the cited references. Additional support for the foregoing amendments is set forth herein in the section entitled "Statements of Support for Amendments to the Claims." The Patent Owner submits that the combination of WO 93/00840, Small and Pan or Wu or JP 9-168415 or Mai or Yang does not disclose the umbrella apparatus of Claim 1, as amended, and that the foregoing amendments to Claim 1 overcome the Examiner's rejections under 35 U.S.C. 103(a). For the foregoing reasons, the Patent Owner submits that Claim 1, as amended, is now patentable.

III. Claim 63 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 93/00840, Valdner and Phyle.

Claim 63 is hereby cancelled. As such, the Patent Owner submits that the Examiner's rejection of Claim 63 is now moot.

IV. Claims 6, 7, 59, 64, 67, 68, and 69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Phyle and Small.

Claim 6 is hereby amended by adding the limitation of a light subassembly carried by the canopy portion. This combination of features is not disclosed in the cited references. Additional support for the foregoing amendments is set forth herein in the section entitled "Statements of Support for Amendments to the Claims." The Patent Owner submits that the combination of Phyle and Small does not disclose the umbrella apparatus of Claim 6, as amended, and that the foregoing amendments to Claim 6 overcome the Examiner's rejections under 35 U.S.C. 103(a). For the foregoing reasons, the Patent Owner submits that Claim 6, as amended, is now patentable.

Claim 7 is not hereby amended, but remains dependent upon Claim 6, which is hereby amended. As such, the Patent Owner submits that Claim 7 is now patentable.

Claim 59 is hereby amended by adding the limitations that the switch is carried by the crank housing, and that the lighting system is recessed in the rib members. This combination of features is not disclosed in the cited references. Additional support for the foregoing amendments is set forth herein in the section entitled "Statements of Support for Amendments to the Claims." The Patent Owner submits that the combination of Phyle and Small does not disclose the umbrella apparatus of Claim 59, as amended, and that the foregoing amendments to Claim 59 overcome the Examiner's rejections under 35 U.S.C. 103(a). For the foregoing reasons, the Patent Owner submits that Claim 59, as amended, is now patentable.

Claim 64 is hereby cancelled. As such, the Patent Owner submits that the Examiner's rejection of Claim 64 is now moot. However, all of the limitations of Claim 64 have been incorporated into amended Claim 65. Therefore, the Patent Owner submits that Claim 65 remains patentable.

Claim 67 is hereby amended by adding the limitation of a crank housing coupled to the pole portion, the crank housing being adapted to partially house the electromechanical opening and closing system, and a switch carried by the crank housing for controlling the electromechanical opening and closing system. This combination of features is not disclosed in the cited references. Additional support for the foregoing amendments is set forth herein in the section entitled "Statements of Support for Amendments to the Claims." The Patent Owner submits that the combination of Phyle and Small does not disclose the umbrella apparatus of Claim 67, as amended, and that the foregoing amendments to Claim 67 overcome the Examiner's rejections under 35 U.S.C. 103(a). For the foregoing reasons, the Patent Owner submits that Claim 67, as amended, is now patentable.

Claim 68 is hereby cancelled. As such, the Patent Owner submits that the Examiner's rejection of Claim 68 is now moot.

Claim 69 is hereby cancelled. As such, the Patent Owner submits that the Examiner's rejection of Claim 69 is now moot.

V. Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Phyle and Farr.

Claim 9 is hereby amended by adding the limitation that the at least one mist nozzle is coupled to the canopy portion and carried by a rib member. This combination of features is not disclosed in the cited references. In particular, on page 47 of the Action Closing Prosecution, the Examiner states that Farr teaches "at least one mist nozzle carried by a rib member, each mist nozzle being in fluid communication with the fluid (31 is carried by rib 30 of Farr)" The Patent Owner submits that this characterization of Farr is not well taken. The "rib 30" in Farr is actually "tubular branch members" (paragraph 0035). These tubular branch members 30 are separate from the "collapsible canopy 14 being conventionally mounted upon a top end 13 of the elongate tubular support member 11 and to the sleeve 15" (paragraph 33). Farr does not include the tubular branch members in his discussion of the general umbrella assembly (see paragraph 0033). The tubular branch members 30 do not contact the canopy 14 and

do not extend along the radial the length of the canopy 14. The purpose of the tubular branch members 30 is to rigidly support the fluid conduit 29 and the nozzles 31 in a position between the canopy 14 and the elongate tubular support member 11 (see paragraph 0035). For at least these reasons, the Patent Owner submits that the tubular branch members 30 of Farr are not rib members, as in the claimed invention. Additional support for the foregoing amendments is set forth herein in the section entitled "Statements of Support for Amendments to the Claims." The Patent Owner submits that the combination of Phyle and Farr does not disclose the umbrella apparatus of Claim 9, as amended, and that the foregoing amendments to Claim 9 overcome the Examiner's rejections under 35 U.S.C. 103(a). For the foregoing reasons, the Patent Owner submits that Claim 9, as amended, is now patentable.

Confirmation of Claims:

Claims 4, 5, and 10-14 stand confirmed and are not hereby amended.

Patentability of Claims:

Claims 2, 3, 8, 49, 50, 52, 53, 55-58, 60, 61, 70-72, and 74 are patentable and are not hereby amended. Claim 65 is patentable, and is hereby amended by adding all of the limitations of Claim 64, thereby making Claim 65 an independent claim.

STATEMENTS OF SUPPORT FOR AMENDMENTS TO THE CLAIMS:

Claims 1-14 and 45-74 are currently pending in the subject reexamination. Claims 15-44 were previously cancelled. Claims 1, 6, 9, 45-48, 51, 54, 59, 62, 65, 66, and 73 are hereby amended under 37 C.F.R. §§ 1.116 and 1.951. Claim 65 is hereby amended by making it an independent claim and by adding all of the limitations of Claim 64. Claim 7 is not hereby amended, but remains dependent upon Claim 6, which is hereby amended. Claims 15-44 were previously cancelled. Claims 63, 64, 68, and 69 are hereby cancelled.

The Patent Owner submits that support for each element and feature of each and every claim in the patent, may be found in the various embodiments of the invention disclosed in the patent. The following are statements for support of each amended claim.

Support for all of the elements of amended Claim 1 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1-3C and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the solar energy system and the rechargeable electrical power system being carried by a module that is releasably coupled to the pole portion is shown in Figures 6-9 and described at column 11, lines 48-59 and at column 12, lines 26-57. Support for the lighting system carried by the canopy portion and being conductively coupled to the rechargeable electrical power system is shown in Figures 1-

3C and described at column 3, lines 48-59, at column 5, lines 31-48, at column 7, lines 45-62, and is shown in Figure 6 and described at column 12, line 26-column 13, line 3. Support for the lighting system having a light subassembly positioned along at least one of the rib members is shown in Figure 6 and described at column 12, line 26-column 13, line 3.

Support for all of the elements of amended Claim 6 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1-3C and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the solar energy system being carried by a disc-shaped power unit is shown in Figures 1-3C and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59 and at column 12, lines 26-57. Support for the electromechanical opening and closing system being conductively coupled to and powered by the rechargeable electrical power system is shown Figures 1, 2A, and 3A and is described at column 3, line 60-column 4, line 22, at column 5, line 49-column 6, line 11, and at column 7, line 63-column 8, line 25, is shown in Figures 5A and 5B and is described at column 11, lines 10-47, and is shown in Figure 9 and described at column 11, line 48-column 12, line 25, and at column 14, lines 3-37. Support for the light subassembly carried by the canopy portion is shown in Figure 6 and described at column 12, line 26-column 13, line 3. Support for the combination of various electrical subassemblies is described at column 11, line 66-column 12, line 25.

Support for all of the elements of amended Claim 9 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1-3C and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the cooling system coupled to the canopy portion and carried by the rib members of the canopy portion is shown in Figures 4B and 4C and described at column 9, line 65-column 10, line 67, and in Figures 7 and 8 and described at column 13-column 14, line 2.

Support for all of the elements of amended Claim 45 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for a power system charger carried by the pole portion above the canopy portion is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60. Support for the solar cell carried by an upper cap portion of the power system charger is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43,

and at column 8, lines 42-60. In addition, the Patent Owner reiterates here all of the supporting comments from the Patent Owner's previously filed responses.

Support for all of the elements of amended Claim 46 may be found at various locations throughout the patent, including the figures. Claim 46 is dependent upon Claim 45. Support for the elements of amended Claim 45 are set forth above. In addition, support for the external power system charger is shown in Figure 1 and described at column 4, lines 23-44.

Support for all of the elements of amended Claim 47 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the solar energy system and the rechargeable electrical power system being carried by a power unit carried by the pole portion is shown in Figures 6-9 and described at column 11, lines 48-59 and at column 12, lines 26-57. Support for the solar energy system being carried by the upper portion of the power unit and the rechargeable electrical power system being carried by the bottom portion of the power unit is shown in Figures 6-9 and described at column 12, lines 26-35. Support for the power unit being fixed relative to the pole portion when the canopy is operated is shown in Figure 6 and described at column 11, lines 48-59 and at column 12, lines 26-57. Support for the lighting system carried by the canopy portion and being conductively coupled to the rechargeable electrical power system is shown in Figures 1-

3C and described at column 3, lines 48-59, at column 5, lines 31-48, at column 7, lines 45-62, and is shown in Figure 6 and described at column 12, line 26-column 13, line 3.

Support for all of the elements of amended Claim 48 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the solar energy system and the rechargeable electrical power system forming component parts of a power unit coupled to the pole portion is shown in Figures 6-9 and described at column 11, lines 48-59 and at column 12, lines 26-57. Support for the power unit being fixed relative to the pole portion when the canopy is operated is shown in Figure 6 and described at column 11, lines 48-59 and at column 12, lines 26-57. Support for the light subassembly carried by the rib members and being conductively coupled to the rechargeable electrical power system is shown in Figure 6 and described at column 12, line 26-column 13, line 3.

Support for all of the elements of amended Claim 51 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines

48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the solar energy system being carried by a power unit coupled to the pole portion is shown in Figures 6-9 and described at column 11, lines 48-59 and at column 12, lines 26-57. Support for the solar energy system being carried by a power unit that is releasably coupled to and carried by the pole portion is shown in Figures 6-9 and described at column 11, lines 48-59 and at column 12, lines 26-57. Support for the light subassembly carried by the canopy portion, positioned along a rib member, and being conductively coupled to the rechargeable electrical power system is shown in Figure 6 and described at column 12, line 26-column 13, line 3. Support for light subassembly extending beyond the corresponding rib member is shown in Figure 6 and described at column 12, line 26-column 13, line 3.

Support for all of the elements of amended Claim 54 may be found at various locations throughout the patent, including the figures. Claim 54 is dependent upon Claim 49. Support for the elements of Claim 49 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the lighting system carried by the canopy portion and having multiple discrete lighting elements positioned along the rib members is shown in Figures 1, 2A, and 3A and described at column 3, lines 48-59, at column 5, lines 31-48, at column 7, lines 45-62, and is shown

in Figure 6 and described at column 12, line 26-column 13, line 3. Support for the multiple discrete lighting elements being carried by the rib members and being conductively coupled to the rechargeable electrical power system by wires that are also recessed within the rib member is shown in Figures 1, 2A, and 3A and described at column 3, lines 48-59, at column 5, lines 31-48, at column 7, lines 45-62, and is shown in Figures 4A-4C and described at column 7, lines 45-62 and at column 9, line 40-column 10, line 67. In addition, support for the lighting system having cold cathode tube bulbs carried by the rib members and being conductively coupled to the rechargeable electrical power system is shown in Figures 1-3C and described at column 3, lines 48-59, at column 5, lines 31-48, and at column 7, lines 45-62, and is shown in Figure 6 and described at column 12, line 26-column 13, line 3.

Support for all of the elements of amended Claim 59 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32. Support for the solar energy system is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60. Support for the crank housing coupled to the pole portion is shown in Figures 1, 2A, and 3A and is described at column 3, line 60-column 4, line 22, at column 5, line 49-column 6, line 11, and at column 7, line 63-column 8, line 25. Support for the switch carried by the crank housing for controlling the system for opening and closing the canopy is shown in Figures 1, 2A, and 3A and described at column 3, line 60-column 4, line 22, at column 5, line 49-column 6, line 11, and at column 7, line 63-column 8, line 25, and in Figures 5A and 5B and at column 11, lines 10-47. Support for the lighting system being recessed in the rib members is shown in Figures 1, 2A, and 3A and described at column 3, lines 48-59, at column 5, lines 31-48, at column 7, lines 45-62, and is shown in Figure 6 and described at column 12, line 26-column 13, line 3, and shown in Figures 4A-4C and described at column 7, lines 45-62 and at column 9, line 40-column 10, line

67. Support for the rechargeable electrical power system being carried by the pole portion is shown in Figure 1 and described at column 4, lines 23-63. Support for the solar energy system remaining fixed relative to the pole portion when the canopy is operated is shown in Figures 1, 2A, and 3A and is described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57.

Support for all of the elements of amended Claim 62 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the lighting elements disposed within cavities in the rib members and being conductively coupled to the rechargeable electrical power system is shown in Figures 1, 2A, and 3A and described at column 3, lines 48-59, at column 5, lines 31-48, at column 7, lines 45-62, is shown in Figures 4A-4C and described at column 7, lines 45-62 and at column 9, line 40-column 10, line 67, and is shown in Figure 6 and described at column 12, line 26-column 13, line 3.

Support for all of the elements of amended Claim 65 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in

Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the solar energy system being contained in a discus-shaped module carried by the pole portion above the canopy portion is shown in Figures 1-3C and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59 and at column 12, lines 26-57. Support for the discus-shaped module being releasably coupled to the pole portion is shown in Figures 6-9 and described at column 11, lines 48-59 and at column 12, lines 26-57.

Support for all of the elements of amended Claim 66 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the lighting system carried by the canopy portion being conductively coupled to the rechargeable electrical power system via electrical conductors extending along the rib members is shown in Figures 1, 2A, and 3A and described at column 3, lines 48-59, at column 5, lines 31-48, at column 7, lines 45-62, and is shown in Figure 6 and described at column 12, line 26-column 13, line 3, and

shown in Figures 4A-4C and described at column 7, lines 45-62 and at column 9, line 40-column 10, line 67. Support for the solar energy system and the rechargeable electrical power system being carried by a power unit coupled to the pole portion is shown in Figures 6-9 and described at column 11, lines 48-59 and at column 12, lines 26-57. Support for the solar energy system being carried by the top portion of the power unit and the rechargeable electrical power system being carried by the bottom portion of the power unit is shown in Figures 6-9 and described at column 12, lines 26-35. Support for the solar energy system remaining fixed relative to the pole portion when the canopy is operated is shown in Figures 1, 2A, and 3A and is described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57.

Support for all of the elements of amended Claim 67 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the electromechanical opening and closing system being conductively coupled to and powered by the rechargeable electrical power system and being controlled by a switch is shown Figures 1, 2A, and 3A and is described at column 3, line 60-column 4, line 22, at column 5, line 49-column 6, line 11, and at column 7, line 63-column 8, line 25, is shown in Figures 5A and 5B and is described at column 11, lines 10-47, and is shown in Figure 9 and described at column

11, line 48-column 12, line 25, and at column 14, lines 3-37. Support for the lighting system carried by the canopy portion being conductively coupled to the rechargeable electrical power system is shown in Figures 1, 2A, and 3A and described at column 3, lines 48-59, at column 5, lines 31-48, at column 7, lines 45-62, and is shown in Figure 6 and described at column 12, line 26-column 13, line 3. Support for the crank housing coupled to the pole portion and being adapted to partially house the electromechanical opening and closing system is shown in Figures 1, 2A, and 3A and is described at column 3, line 60-column 4, line 22, at column 5, line 49-column 6, line 11, and at column 7, line 63-column 8, line 25. Support for the switch carried by the crank housing for controlling the system for opening and closing the canopy is shown in Figures 1, 2A, and 3A and described at column 3, line 60-column 4, line 22, at column 5, line 49-column 6, line 11, and at column 7, line 63-column 8, line 25, and in Figures 5A and 5B and at column 11, lines 10-47.

Support for all of the elements of amended Claim 73 may be found at various locations throughout the patent, including the figures. In particular, support for the base, the pole, and the canopy is shown in Figures 1-3C and described at column 3, lines 12-47, at column 5, lines 15-31, and at column 7, lines 29-45, and is shown in Figures 6-9 and described at column 11, lines 48-59, and is further described at column 12, lines 26-57. Support for the rechargeable electrical power system is shown in Figures 1-3C and described at column 4, lines 23-44, at column 6, lines 12-24, at column 8, lines 26-32, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 51-53, column 13, lines 26-28, column 13, lines 50-52, and column 14, lines 21-23. Support for the solar energy system is shown in Figures 1, 2A, and 3A and described at column 4, lines 45-63, at column 6, lines 25-43, and at column 8, lines 42-60, and is shown in Figures 6-9 and described at column 11, lines 48-59, at column 12, lines 26-57. Support for the external power system charger carried by the pole portion and being adapted to receive power from an AC power outlet is shown in Figure 1 and described at column 4, lines 23-44. Support for the solar energy system and the external power system charger remaining carried by the pole portion when the rechargeable electrical power system is removed from the umbrella apparatus is shown

in Figure 1 and described at column 4 line 23-column 5, line 14.

The Patent Owner submits that, pursuant to 37 C.F.R. § 1.530(e), the foregoing explains and sets forth the support in the disclosure of the patent for change to the claims made by this amendment paper.

The Patent Owner submits that the foregoing changes to the claims do not broaden the scope of the patent.

REQUEST FOR REOPENING OF PROSECUTION:

The Patent Owner respectfully requests that the Examiner reopen prosecution of the subject patent.

Pursuant to MPEP § 2673(III), the Patent Owner respectfully requests that the Examiner consider reopening prosecution of the subject patent and entering the foregoing amendments. No new references have been cited. Because no new references have been cited, and because certain claims are hereby cancelled, the Patent Owner submits that the entirety of this amendment paper would result only in additional claims being found patentable. The Patent Owner submits that entry of the amendments set forth herein would not cause any undue burden on the Examiner. The features changed and/or added by the amendments have already been exhaustively reviewed and examined. As such, only a cursory review of the amended claims would be necessary. Some of the claim amendments are merely adopting the Examiner's suggestions.

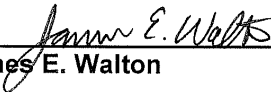
In the Action Closing Prosecution, the Examiner modified her position on many of the claims. The Examiner withdrew her rejections on some of the claims and asserted new rejections on other claims. The Examiner rejected some of the claims on new grounds of rejection, thereby raising new issues. In addition, the Examiner found the Patent Owner's evidence in the Kuelbs Declaration to be insufficient to swear behind the listed references. Therefore, pursuant to MPEP § 2673.01(I), the Patent Owner respectfully requests that the Examiner reopen prosecution of the subject patent to provide the Patent Owner this opportunity to adequately address the Examiner's comments and rejections.

In addition, the Patent Owner submits that all of the amended claims are now patentable. The Patent Owner has merely made minor amendments to the claims to obviate the Examiner's rejections and make the claims patentable. Pursuant to MPEP § 2673.01(II), it would be inequitable to send the claims to appeal based on minor points that can be easily corrected. Therefore, the Patent Owner respectfully requests that, in the interest of equity, the Examiner reopen prosecution of the subject patent and

enter the foregoing amendments to provide the Patent Owner this opportunity to adequately address the Examiner's rejections.

PROOF OF SERVICE:

Pursuant to 37 C.F.R. § 1.903, a true and correct copy of this Comments and Proposed Amendment Under 37 C.F.R. § 1.951 to Action Closing Prosecution in *Inter Partes* Reexamination was served on the third-party requester. Pursuant to 37 C.F.R. § 1.248(a)(4), the undersigned hereby certifies that a true and correct copy of this Comments and Proposed Amendment Under 37 C.F.R. § 1.951 to Action Closing Prosecution in *Inter Partes* Reexamination was served on the third-party requester's attorney of record, John S. Pratt, by First Class Mail with sufficient postage at Kilpatrick Stockton LLP, 1100 Peachtree Street, Suite 2800, Atlanta, Georgia 30309 on **18 January 2010**.



James E. Walton

1/18/10
Date

CONCLUSION:

The Patent Owner submits that the amendments and remarks set forth herein *prima facie* place the claims in condition for allowance. Therefore, the Patent Owner respectfully requests that the Examiner reopen prosecution, enter the amendments set forth herein, consider the remarks set forth herein, and issue an appropriate Office Action in which all of the claims are found to be patentable.

The Patent Owner submits that this paper is less than fifty pages, excluding the pages containing the amended claims.

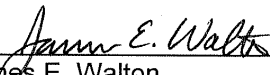
No new claims have been added. One claim has been changed from a dependent claim to an independent claim. Four independent claims are hereby cancelled. Therefore, no fees are due.

No other fees are deemed to be necessary; however, the undersigned hereby authorizes the Director to charge any additional fees that may be required, or credit any overpayments, to **Deposit Account No. 502806**.

Please link this reexamination proceeding to Customer No. 50779 so that its status may be checked via the PAIR System.

Respectfully submitted,

1/18/10
Date



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CUSTOMER NO. 50779

ATTORNEY FOR PATENT OWNER

Electronic Acknowledgement Receipt	
EFS ID:	6827547
Application Number:	95000104
International Application Number:	
Confirmation Number:	5847
Title of Invention:	UMBRELLA APPARATUS
First Named Inventor/Applicant Name:	6612713
Customer Number:	38441
Filer:	James Edward Walton
Filer Authorized By:	
Attorney Docket Number:	45639-316477
Receipt Date:	18-JAN-2010
Filing Date:	12-AUG-2005
Time Stamp:	12:46:39
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		AmendmentAfterACP20100118.pdf	2890063 1f760c71552bc99aa91e241ad609b34766c7ca4	yes	48

YOT-1003-1193

Multipart Description/PDF files in .zip description		
Document Description	Start	End
Miscellaneous Incoming Letter	1	2
Amendment After Final	3	48
Warnings:		
Information:		
Total Files Size (in bytes):		2890063
<p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p><u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p>		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 0664MH-40982-REX

In re Reexamination of:

GREGORY G. KUELBS

Control No. 95/000,104

Patent No. 6,612,713

Issued: 2 SEPTEMBER 2003

For: **UMBRELLA APPARATUS**

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§

Examiner: **MARGARET WAMBACH**

Art Unit: 3992

Conf. No.: 5847

TRANSMITTAL

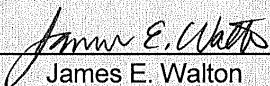
Filed via EFS-Web

Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Please file the following enclosed documents in the subject reexamination proceeding:

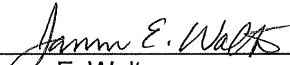
1. This Transmittal with Certificate of Transmission; and
2. Comments and Proposed Amendments Under 37 C.F.R. § 1.951 to Action Closing Prosecution.

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8(a)(1)(i)(C)	
Date of Transmission:	<u>1/18/10</u>
I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office (USPTO) via the USPTO electronic filing system (EFS-Web) on the date shown above.	
By:	<u></u> James E. Walton

The foregoing documents are being filed via the U.S. Patent and Trademark Office's EFS-Web electronic filing system. No fees are deemed to be necessary; however, the undersigned hereby authorizes the Director to charge any other fees that may be required, or credit any overpayments, to **Deposit Account No. 502806**.

Respectfully submitted,

1/18/10
Date



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CUSTOMER NO. 38441

ATTORNEY FOR PATENT OWNER



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,104	08/12/2005	6612713	45639-316477	5847
38441	7590	03/01/2010	EXAMINER	
LAW OFFICES OF JAMES E. WALTON, PLLC 1169 N. BURLESON BLVD. SUITE 107-328 BURLESON, TX 76028			ART UNIT	PAPER NUMBER

DATE MAILED: 03/01/2010

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



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROBERT E. RICHARDS
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET, SUITE 2800
ATLANTA, GA 30309

Date:

MAILED

MAR 01 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000104
PATENT NO. : 6612713
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)

YOT-1003-1198



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LAW OFFICES OF JAMES E. WALTON, PLLC
1169 N. BURLESON BLVD.
SUITE 107-328
BURLESON TX 76028

(For Patent Owner)

MAILED

MAR 01 2010

CENTRAL REEXAMINATION UNIT

Robert E. Richards
KILPATRICK STOCKTON, LLP
1100 Peachtree Street, Suite 2800
Atlanta, GA 30309

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,104
Filed: August 12, 2005
For: US Patent No. 6,612,713

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the third party requester petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND THE RULES WITH RESPECT TO THE 50-PAGE LIMIT FOR REQUESTER'S COMMENTS," filed on November 16, 2009.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration for consideration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to third party requester's Deposit Account No. 11-0855, as authorized on page 4 of the petition.

The petition under 37 CFR 1.183 is dismissed as to the September 14, 2009 third party requester comments under 37 CFR 1.947, for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,612,713 (the '713 patent) issued on September 2, 2003.
2. On August 12, 2005, a request for *inter partes* reexamination of the '713 patent was filed by a third party requester, and assigned Reexamination Control No. 95/000,104 (the '104 proceeding).

YOT-1003-1199

3. On September 28, 2005, the Office issued an order granting *inter partes* reexamination in the '104 proceeding with an accompanying first Office action on the merits.
4. On November 21, 2005, patent owner filed a response to the first Office action on the merits.
5. On December 5, 2005, the Office issued a notice of defective paper indicating that patent owner's November 21, 2005 response was improper and setting a time period for resubmission.
6. On December 19, 2005, patent owner submitted a corrected response to the first Office action, addressing the issues raised by the Office in the December 5, 2005 notice of defective paper.
7. On December 21, 2005, the requester submitted a comments paper in response to patent owner's November 21, 2005 response and the first Office action.
8. On January 13, 2006, the requester submitted a new comments paper in response to patent owner's December 19, 2005 corrected response and the first Office action.
9. On December 5, 2006, the Office issued a non-final Office action.
10. On February 7, 2007, patent owner filed a paper in response to the December 5, 2006 non-final Office action.
11. On March 9, 2007, the requester submitted a comments paper in response to patent owner's February 7, 2007 response paper and the December 5, 2006 non-final Office action.
12. On July 25, 2008, the Office issued a notice of defective paper indicating that patent owner's February 7, 2007 response paper was improper and setting a time period for resubmission.
13. On August 25, 2008, patent owner submitted a corrected paper in response to the December 5, 2006 non-final Office action, addressing the issues raised by the Office in the July 25, 2008 notice of defective paper.
14. On March 20, 2009, the Office issued a notice of defective paper indicating that patent owner's August 25, 2008 response paper was improper and setting a time period for resubmission.
15. On April 21, 2009, patent owner submitted a second corrected paper in response to the December 5, 2006 non-final Office action, addressing the issues raised by the Office in the March 20, 2009 notice of defective paper.

16. On May 18, 2009, the requester submitted a comments paper in response to patent owner's April 21, 2009 response paper and the December 5, 2006 non-final Office action.
17. On August 28, 2009, the Office issued a notice of defective paper indicating that requester's May 18, 2009 comments paper was improper due to the addition of new proposed grounds of rejection and setting a time period for resubmission.
18. On September 14, 2009, requester submitted a corrected comments paper in response to patent owner's April 21, 2009 response paper and the December 5, 2006 non-final Office action, addressing the issues raised by the Office in the August 28, 2009 notice of defective paper.
19. On October 22, 2009, the Office issued a decision *sua sponte* "returning" requester's September 14, 2009 papers. The decision noted that requester did not remove the inappropriately added new grounds of rejection. Furthermore, the September 14, 2009 requester response was found facially non-compliant with the 50-page regulatory page limit requirement set for by 37 CFR 1.943(b).
20. On November 16, 2009, requester filed the instant petition paper in the '104 proceeding entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND THE RULES WITH RESPECT TO THE 50-PAGE LIMIT FOR REQUESTER'S COMMENTS."
21. Also on November 16, 2009, requester filed four additional petitions all under 37 CFR 1.181 requesting supervisory review.
22. On December 18, 2009, the Office issued an Action Closing Prosecution (ACP) in the '104 proceeding.
23. This decision addresses the requester petition under 37 CFR 1.183 requesting waiver of the page limit requirement for third party requester comments in an *inter partes* reexamination proceeding.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In *an extraordinary situation, when justice requires*, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

Discussion

On September 14, 2009, third party requester filed corrected comments under 37 CFR 1.947 responsive to the December 5, 2006 Office action and to the patent owner's April 21, 2009 response. The Office expunged the September 14, 2009 corrected comments as improper on October 22, 2009 in a *sua sponte* decision expunging ("returning") the improper papers. In response to the October 22, 2009 Office decision, third party requester petitions the Office under 37 CFR 1.183 to suspend the 50-page limit for period of 37 CFR 1.943(b) to accept as compliant requester's revised comments submitted on September 14, 2009.

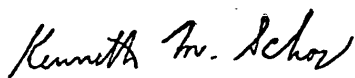
In support of waiver of the rule, third party requester asserts that the comments are in substantial compliance with the 50-page limit requirement of 37 CFR 1.943(b). Requester points out that the comments only facially exceed the 50-page limit by 5 pages and that this *de minimus* overage is due to the use of margins and font size that exceeds the standards of 37 CFR 1.52. Furthermore, requester notes that the comments incorporated several prior art drawings that are of record, which could have been cited to instead of duplicated in the comments, but were included for the convenience of examination.

Third party requester did not make a showing in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and providing an explanation of how the submitted response economizes, excludes extraneous material, and is arranged so as not to repeat information already of record and submitting the resulting comments, which are in excess of 50 pages. By third party requester's own admission, the comments could have been submitted in compliance with the 50-page limit regulatory requirement. However, third party requester asserts "In the interest of justice, suspension of the 50-page limit for the Replacement Comments Of Third Party Requester to Patent Owner's Response In *Inter Partes* Reexamination And To Office Action, which was filed September 14, 2009, and entry of the comments are respectfully requested."

Based on the specific facts set forth in the instant petition under 37 CFR 1.183, third party requester's own admission that comments in compliance with the 50-page limit of 37 CFR 1.943(b) could have been readily drafted and submitted, it is deemed inequitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Waiver of the rules under 37 CFR 1.183 requires an *extraordinary situation when justice requires* waiver, because the relief requested cannot be attained under the existing rules. Third party requester's petition states that, by using any one of three different minor formatting choices, compliance with the rules could be readily achieved. Requester does not point to any facts and circumstances unique to the present proceeding that precluded requester from compliance with the 50-page limit regulatory requirement. The failure of patent owner to comply with the rules, in the form of submitting non-compliant comments by choice, does not present an *extraordinary situation* under 37 CFR 1.183 to justify suspension of the rules. Therefore, justice does not require suspension of 37 CFR 1.943(b). Accordingly, the present petition is DISMISSED.

CONCLUSION

1. Third party requester's November 16, 2009 petition under 37 CFR 1.183 is dismissed.
2. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).
3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet7/IP/length



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,104	08/12/2005	6612713	45639-316477	5847
38441	7590	03/01/2010	EXAMINER	
LAW OFFICES OF JAMES E. WALTON, PLLC 1169 N. BURLESON BLVD. SUITE 107-328 BURLESON, TX 76028			ART UNIT PAPER NUMBER	

DATE MAILED: 03/01/2010

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROBERT E. RICHARDS
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET, SUITE 2800
ATLANTA, GA 30309

Date:

MAILED

MAR 01 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000104
PATENT NO. : 6612713
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)

YOT-1003-1205



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LAW OFFICES OF : (For Patent Owner)
JAMES E. WALTON, PLLC :
1169 N. BURLESON BLVD. :
SUITE 107-328 :
BURLESON, TX 76028 :

MAILED

MAR 01 2010

CENTRAL REEXAMINATION UNIT

ROBERT E. RICHARDS : (For Third Party Requester)
KILPATRICK STOCKTON, LLP :
1100 PEACHTREE STREET, SUITE 2800 :
ATLANTA, GA 30309 :

In re: Kuelbs :
Inter Partes Reexamination Proceeding : DECISION ON PETITIONS
Control No.: 95/000,104 : UNDER 37 CFR § 1.181
Deposited: 12 August 2005 :
For: U.S. Patent No.: 6,612,713 :

This is a decision on four¹ petitions filed by the third party requester on 16 November 2009. The petitions are entitled:

- (1) "PETITION UNDER 37 CFR § 1.181 TO ENTER THE THIRD-PARTY REQUESTER'S REPLACEMENT COMMENTS ON THE BASIS OF THE EXAMINER'S NONCOMPLIANCE WITH MPEP § 2617" [hereinafter "Petition (1)"];
- (2) "PETITION UNDER 37 CFR § 1.181 TO ENTER THIRD PARTY REQUESTER'S REPLACEMENT COMMENTS FOR FAILURE OF THE EXAMINER TO COMPLY WITH MPEP § 2667" [hereinafter "Petition (2)"];
- (3) "PETITION UNDER 37 CFR § 1.181 TO ENTER THIRD PARTY REQUESTER'S REPLACEMENT COMMENTS BECAUSE THE FIFTY-PAGE LIMIT HAS BEEN PROPERLY MET" [hereinafter "Petition (3)"]; and

¹ A fifth petition was filed on the same date, entitled "PETITION UNDER 37 CFR § 1.183 TO SUSPEND THE RULES WITH RESPECT TO THE 50-PAGE LIMIT FOR REQUESTER'S COMMENTS." This petition will be decided separately.

(4) "PETITION UNDER 37 CFR § 1.181 TO FIND THE THIRD PARTY REQUESTER'S REPLACEMENT COMMENTS IN COMPLIANCE WITH 37 CFR 1.948" [hereinafter "Petition (4)"].

The petitions are a request to the Director to invoke his supervisory authority pursuant to 37 CFR 1.181 and enter the "REPLACEMENT COMMENTS OF THIRD PARTY REQUESTER TO PATENT OWNER'S RESPONSE IN *INTER PARTES* REEXAMINATION AND TO OFFICE ACTION" [hereinafter "the Replacement Comments"] submitted on 14 September 2009. The Replacement Comments were filed in response to a Notice re: Defective Paper to replace the "COMMENTS OF THIRD PARTY REQUESTER TO PATENT OWNER'S RESPONSE IN *INTER PARTES* REEXAMINATION AND TO OFFICE ACTION" [hereinafter "the Original Comments"] submitted on 18 May 2009.

The petitions are before the Director of the Central Reexamination Unit.

The four petitions under 37 CFR 1.181 to invoke the supervisory authority of the Director dated 16 November 2009 are denied with respect to entry of the Replacement Comments filed on 14 September 2009.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,612,713 issued on 2 September 2003.
2. A request for *inter partes* reexamination proceeding, assigned control No. 95/000,104 was filed by a third party requester on 12 August 2005.
3. *Inter partes* reexamination was ordered for the proceeding on 28 September 2005 with a non-final Office action attached.
4. On 5 December 2006, a second non-final Office action was mailed.
5. After two improper proposed amendments and respective Notices re: Defective Paper, patent owner submitted a response on 21 April 2009.
6. On 18 May 2009, the third party submitted the Original Comments to the above response.

7. On 28 August 2009, the examiner issued a Notice re: Defective paper as to the Original Comments.
8. On 14 September 2009, the third party submitted the Replacement Comments at issue here.
9. On 22 October 2009, the Office issued a decision expunging the Replacement Comments from the record.
10. On 16 November 2009, the instant petitions were submitted for consideration.
11. On 18 December 2009, the examiner issued an Action Closing Prosecution. The Replacement Comments, being expunged from the record, were not considered.
12. On 18 January 2010, Patent owner responded to the Action Closing Prosecution.

DECISION

Petition (1)

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

...

II. Content

...

[W]here a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.<

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior

art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper. If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper**>; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester.

...

Any replacement comments submitted in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

MPEP § 2617 Statement in the Request Applying Prior Art (in part)

35 U.S.C. 311(b)(2) states that the request for *inter partes* reexamination must “set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.” 37 CFR 1.915(b)(3) requires that the request include “[a] statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.”

...

Any failure to provide the required explanation for any document, combination, or claim will be identified in a “Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements” (see MPEP § 2627). If a requester receives such a notice that identifies one or more documents, combinations, or claims for which an explanation was not given, the requester has the option to respond by either:

- (A) providing a separate explanation for each combination, document, and claim identified in the notice as lacking explanation; or
- (B) explicitly withdrawing any document, combination, or claim for which reexamination was requested for which there is no explanation.

Petitioner argues that MPEP § 2617 allows petitioner to provide a separate explanation to cure the defective submission, therefore the examiner failed to comply with section 2617 in requiring the petitioner to remove the improper rejections, rather than allowing for such separate explanation.

The record shows that the Office did allow the petitioner to “rectify and refile” in the notice of defective paper dated 28 August 2009. Petitioner, however, did not fully comply with the requirement to set forth “a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim” in the Replacement Comments.

Examples of proposed rejections which do not fully comply with the requirements of MPEP § 2617 and 35 USC § 311(b)(2) are found in the Replacement Comments pages 52 through 54. The proposed rejections for claims 64, 65, 66, 70, 71 and 72 lack the detailed explanation for each of the distinct permutations of proposed rejections. Specifically, the petitioner proposed rejections of claim 64 under 35 USC § 103 over Mueller or Valdner and Phyle or Rushing and alternatively further in view of Hung. This statement identifies multiple distinct proposed rejections for which a separate explanation must be provided for each proposed rejection. In other words, there must be a separate detailed explanation for each of the following identified proposed rejections:

- Claim 64 is unpatentable based on § 103 over Mueller and Phyle
- Claim 64 is unpatentable based on § 103 over Mueller and Rushing
- Claim 64 is unpatentable based on § 103 over Mueller and Phyle further in view of Hung
- Claim 64 is unpatentable based on § 103 over Mueller and Rushing further in view of Hung
- Claim 64 is unpatentable based on § 103 over Valdner and Phyle
- Claim 64 is unpatentable based on § 103 over Valdner and Rushing
- Claim 64 is unpatentable based on § 103 over Valdner and Phyle further in view of Hung
- Claim 64 is unpatentable based on § 103 over Valdner and Rushing further in view of Hung

The brief discussion on page 52 of the Replacement Comments lacks the required pertinency and manner of applying the cited prior art for each and every proposed rejection because it fails to provide a separate explanation for each proposed rejection. Accordingly, the Replacement Comments did not fully comply with the requirements and was properly not entered in the record in accordance with MPEP 2666.05.

In addition, the Replacement Comments exceeded the 50 page limit of 37 CFR 1.943. For this reason, the paper was properly expunged in the decision dated October 22, 2009.

The petition is denied for the above reasons.

Petition (2)

37 CFR § 1.947 Comments by third party requester to patent owner's response in *inter partes* reexamination. (in part)

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

...

II. Content

...

If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper**>; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester. The notification to the third party requester is to provide a time period of fifteen (15)< days for the third party requester to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party >requester< with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. The loss of right to submit further comments applies only to the patent owner response at hand. See MPEP § 2666.20. >To the extent that 37 CFR 1.947 provides that the third party requester "may once" file written comments, that provision is hereby waived to the extent of providing the third party requester the one additional opportunity to remedy a comments paper containing merits-content that goes beyond what is permitted by the rules; 37 CFR 1.947 is not waived to provide any further opportunity in view of the statutory requirement for special dispatch in reexamination.

MPEP § 2667 Handling of Inappropriate or Untimely Filed Papers (in part)

...

2. Response Is Too Long

Where the length of the third party requester submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, a Notice will be issued by the examiner and mailed to the third party requester permitting the third party requester to exercise one of the following two options:

- (A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or
- (B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.

Petitioner argues that, because the objection to the Replacement Comments as exceeding the 50-page limit was raised for the first time in the October 22, 2009 decision, the petitioner should have been afforded an opportunity to correct the defect under MPEP § 2667. Petitioner further argues that, while MPEP § 2666.05 provides only a single opportunity to correct a defect, nothing in the rules or MPEP indicates section 2666.05 “trumps” section 2667. Petitioner further argues that nothing in the original notice of defect informed the petitioner that resubmitted comments could not exceed 50 pages, and to impose such a limit denies the petitioner due process.

Upon review of the record, the Replacement Comments exceeded the 50-page limit requirement of 37 CFR 1.943. The Original Comments did not exceed the page limit, and therefore, the 28 August 2009 notice did not state that the comments failed to comply with this requirement. The 28 August 2009 notice clearly stated the Office policy in MPEP 2666.06 that the requester is only given one opportunity to fully comply with all the requirements. 37 CFR 1.947 explicitly allows only for one filing of written comments after a patent owner’s response. As stated in MPEP § 2666.05, to the extent that the examiner allows an additional opportunity to correct a defective reply, this is a waiver of this rule. Section 2666.05 goes on to state that, to further the statutory requirement of special dispatch, the rule will not be waived more than once. In other words, Office policy, as stated in MPEP § 2666.05, is balancing the need to provide a recourse to rectify unintentional error(s) in the comments with the statutory requirement of special dispatch by permitting a single waiver of this rule. The due process argument is wholly unpersuasive for these reasons. Thus, it is not really a case of section 2666.05 “trumping” section 2667. It is a case of the petitioner failing to comply with the rules, the Office waiving 37 CFR 1.947 to allow correction of errors, petitioner failing to comply again, and the Office following its established policy that 37 CFR 1.947 will not be waived again.

It should be noted that the need for special dispatch is especially relevant here. The examiner has already issued an ACP in this proceeding after the improper comments, and the Patent Owner has already responded to this action. Entry of the Replacement Comments would require withdrawal of the ACP and subsequent Owner comments, and thus, further delaying the proceeding. This proceeding has already been pending for over four years; and in light of the statutory mandate for special dispatch, it is proper for the Office to prevent further delay by following its rules and procedures, which were established through notice and comment in order to achieve special dispatch in a reasonable manner.

For all these reasons, this petition is denied.

Petition (3)

37 CFR § 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination. (in part)

(b) Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

The Replacement Comments were 55 pages in length, therefore clearly exceeding the page limit required by the rules. Petitioner argues that portions of the Replacement Comments were excerpts of prior art references, therefore these portions fall within the exclusion of the rule and are not subject to the page limit. When these portions are excluded from the page limit requirement the Replacement Comments do not exceed 50 pages, therefore petitioner argues the Replacement Comments are proper under Rule 1.943(b).

It is clear that the exception to the rule, excluding “reference materials such as prior art references” from the page limit, concerns the filing of the references themselves. An excerpt that is included in the text of the comments is not a “reference material;” it is a part of the comments. By placing these excerpts part of the argument, and thus, subject to the page limit. It is true that petitioner “could have appended these drawings as exhibits,” but this is not what petitioner did. Therefore, the excerpts are subject to the page limit requirement. Accordingly, the petition is denied.

Petition (4)

37 CFR § 1.948 Limitations on submissions of prior art by third party requester following the order for *inter partes* reexamination.

- (a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
- (1) which is necessary to rebut a finding of fact by the examiner;
 - (2) which is necessary to rebut a response of the patent owner; or
 - (3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

...

II. Content

...

As to [Rule 1.948(a)(1)-(3)] where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.<

Petitioner argues that both the Original Comments and the Replacement Comments included new prior art filed under 37 CFR 1.948(a)(2). The original notice of defective paper mailed August 28, 2009 did not state that the Original Comments failed to comply with Rule 1.948. The Decision mailed October 22, 2009, expunging the Replacement Comments, stated the Replacement Comments did not comply with Rule 1.948. Petitioner argues that since the Original Comments included new prior art, and the original notice did not object to the new art under Rule 1.948, then it is improper for the Decision to object to the Replacement Comments under this ground.

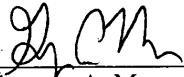
Upon review of the record, it is appropriate for the Decision to object to the filing of the Replacement Comments under 37 CFR 1.948. The original notice mailed August 28, 2009 cited to MPEP § 2666.05, which is clearly discussing the requirements of a submission under 37 CFR 1.948. Therefore it is clear that, while she may not have explicitly said so, the examiner found the Original Comments noncompliant with 37 CFR 1.948. It is permissible for the 22 October 2009 Decision to explicitly state what was already implied—that the Replacement Comments were not compliant with Rule 1.948.

More importantly, as described above in discussing Petition (1), petitioner did not fully correct all of the defects in the original comments. As the Replacement Comments did not comply with all of the requirements, these comments were not entered in the record but “returned” to the requester, in accordance with the policy set forth in MPEP § 2666.05.

For these reasons, the petition arguing the Replacement Comments are compliant with Rule 1.948 is denied.

CONCLUSION

1. The petitions under 37 CFR 1.181 for reconsideration of the decision to not enter of the Replacement Comments are denied.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.



Gregory A. Morse
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,104	08/12/2005	6612713	45639-316477	5847
38441 7590 03/02/2010 LAW OFFICES OF JAMES E. WALTON, PLLC 1169 N. BURLESON BLVD. SUITE 107-328 BURLESON, TX 76028			EXAMINER RUBIN, MARGARET R	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			03/02/2010	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.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Robert E. Richards

KILPATRICK STOCKTON, LLP

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Atlanta, GA 30309

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/000,104.

PATENT NUMBER 6,612,713.

TECHNOLOGY CENTER 3900.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

YOT-1003-1218

ACTION CLOSING PROSECUTION (37 CFR 1.949)	Control No.	Patent Under Reexamination	
	95/000,104	6612713	
	Examiner	Art Unit	
	MARGARET RUBIN	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:

Patent Owner on 21 April 2009

Third Party(ies) on _____

Patent owner may once file a submission under 37 CFR 1.951(a) within 2 month(s) from the mailing date of this Office action. Where a submission is filed, third party requester may file responsive comments under 37 CFR 1.951(b) within 30-days (not extendable- 35 U.S.C. § 314(b)(2)) from the date of service of the initial submission on the requester. **Appeal cannot be taken from this action.** Appeal can only be taken from a Right of Appeal Notice under 37 CFR 1.953.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

PART II. SUMMARY OF ACTION:

- 1a. Claims 1-14 and 45-74 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims 15-44 have been canceled.
3. Claims 4,5,10-14 are confirmed. [Unamended patent claims]
4. Claims See Continuation Sheet are patentable. [Amended or new claims]
5. Claims 1,6,7,9,45-48,51,54,59,62-64,66-69 and 73 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable are not acceptable.
8. The drawing correction request filed on _____ is: approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has: been received. not been received. been filed in Application/Control No _____
10. Other _____

Continuation of SUMMARY OF ACTION: 4. Claims patentable. [Amended or new claims] are 2,3,8,49,50,52,53,55-58,60,61,65,70-72 and 74.

INTER PARTES ACTION CLOSING PROSECUTION ("ACP")

This reissued-Action Closing Prosecution (ACP) is identical to the December 18, 2009 ACP. Therefore, in the interests of special dispatch, patent owner is given 15-days from the mail date of this reissued-ACP to either submit substitute comments or submit a positive statement ratifying the January 18, 2010 comments as being responsive to this reissued-ACP. After the 15-day time period for response has expired, without a response, it will be deemed that a ratification of the January 18, 2010 patent owner comments has been made. Third party requester has thirty days from the earliest of: (1) the date of service of any substitute patent owners comments; (2) the date of service of an explicit statement of ratification by the patent owner; or (3) the last day of patent owner's 15-day time period for response to this action.

This is a reexamination of United States Patent Number 6,612,713 ("the base patent".) Claims 1-14 and 45-74 are pending and under reexamination. Claims 15-44 are cancelled. Informal amendments were submitted by Patent Owner on February 7, 2007 and August 25, 2008. Although the April 21, 2009 amendment neglected to underline the numerals of the new claims and Patent Owner was notified on December 5, 2005 that 37 CFR 1.530(f)(2) requires the underlining of new claims, in the interest of moving forward, the legal staff of the CRU made appropriate corrections in this instance but Patent Owner's cooperation in avoiding such errors in future communications is necessary to prevent further delay. It is also noted that the statement of support for amendments inaccurately states that

claim 58 was not amended; however, since a citation of support for claim 58 is thereafter suggested, this inaccuracy doesn't necessitate issuing a PTO-2069.

Accordingly, this ACP is responsive to the amendment of April 21, 2009, which amended claims 1-3, 6, 8, 9, 45-49, 51, 52, 55-70 and 72-74. Requester submitted comments on March 9, 2007 and May 18, 2009 in response to Patent Owner's amendments of February 7, 2007 and April 21, 2009, respectively. Further, Requester filed corrected comments on September 14, 2009 in response to a Notice of Informality mailed on August 28, 2009. Insofar as only the April 21, 2009 amendment is presently compliant with 37 CFR 1.530, Requester's comments responsive to the earlier amendments are immaterial - the earlier Requester comments are deemed premature due to the defects in Patent Owner's earlier amendments. See MPEP 2667(I)(B). Also, please note that 37 CFR 1.939 authorizes the Office to merely not consider untimely papers and makes discretionary the question of whether they will be returned. The reasons that the May 18, 2009 comments were deemed improper was explained in the August 28, 2009 Notice of Informality and such explanations are incorporated herein by reference. In that Office Communication, Requester was also directed to "rectify and refile" the improper

comments by "removing the improper proposed rejections" in accordance of MPEP 2666.05 which was quoted in pertinent part.

In contrast, Requester did not remove the improper rejections as instructed. Moreover, Requester added more text to the original comments such that the 50 page limit set by 37 CFR § 1.943 was exceeded.

As stated in the August 28, 2009 Notice of Informality:
"Requester should take note of the following provision of MPEP 2666.05: 'If, upon the second submission, the comments are still not proper, the comments will be returned to third party requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. The loss of right to submit further comments applies only to the patent owner response at hand. See MPEP § 2666.20'" Accordingly, Requester's September 14, 2009 comments will not be considered and are not addressed below.

I.) Information Submissions

The IDS submissions of March 21, 2007, February 19, 2008, May 12, 2008, September 29, 2008 and October 27, 2009 have been considered. Insofar as the IDS submission of November 30, 2009 only contains documents taken from the prosecution history rather than patents and printed publications, it has been lined-through in its entirety although the documents have been reviewed. Further, it is to be noted that where patents, publications, and other such items of information are submitted by a patent owner in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be limited by the degree to which the patent owner has explained the content and relevance of the information. In instances where no explanation of citations (items of information) is required and none is provided for an information citation, only a cursory review of that information is required. The examiner need only perform a cursory evaluation of each unexplained item of information, to the extent that the he/she needs in order to determine whether he/she will evaluate the item further. If the cursory evaluation reveals the item not to be useful, the examiner may simply stop

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looking at it. This review may often take the form of considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner, in this proceeding, placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent, without an indication in the record to the contrary in the record, do not signify that the information has been considered by the examiner any further than to the extent noted above. The same degree of consideration was provided for citations on earlier information submissions. See MPEP 609, seventh paragraph, Revision 5, Aug. 2006 [page 600-141].

II.) Claim Rejections - 35 USC § 314(a)

Claims 1, 9, 45-48, 51 and 63 are rejected under 35 U.S.C. 314(a) as enlarging the scope of the claims of the patent being reexamined¹. 35 U.S.C. 314(a) states that "no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted" in an *inter partes* reexamination proceeding. A claim presented in a reexamination "enlarges the scope" of the patent claims where the claim is broader than the claims of the patent. A claim is broadened if it is broader in any one respect, even though it may be narrower in other respects.

MPEP 2658 states the following criteria for enlargement of the scope of the claims:

A claim presented in a reexamination proceeding enlarges the scope of the claims of the patent being reexamined where the claim is broader than each and every claim of the patent. See MPEP § 1412.03 for

¹ Claim 62 is not rejected as broadening the scope of the base patent claims even though "subassembly" has been substituted for "system" in the claim language because a subassembly is interpreted as a particular type of system when one employs the broadest reasonable interpretation of the terms. In

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guidance as to when the presented claim is considered to be a broadening claim as compared with the claims of the patent, i.e., what is broadening and what is not. If a claim is considered to be a broadening claim for purposes of reissue, it is likewise considered to be a broadening claim in reexamination.

Accordingly, MPEP 1412.03 is determinative regarding the analysis that must be undertaken in deciding whether a claim in a reexamination proceeding enlarges the scope of patent claims. A test offered therein requires observing whether any amended or newly added claim in a reexamination proceeding includes subject matter not covered by the original patent claims.

A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement.

Applying this test to the amendatory matter introduced by Patent Owner on April 21, 2009, in comparison to original claim 1, amended claim 1 lacks "an electrical charging system for recharging the rechargeable electrical power system, the

other words, the substitution in question is seen as a narrowing of the claim language rather than a broadening.

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electrical charging system being adapted to receive power from an AC power outlet." With regard to original claims 2-5, amended Claim 1 lacks "a solar energy system carried by the pole portion." Instead, amended Claim 1 requires only that the solar energy system be "carried by a module coupled to the pole." Thus a device according to amended claim 1 could include a module sitting on the ground beside the umbrella, coupled to the pole portion above the canopy portion but without the weight of the module being borne by the pole portion. A device according to amended Claim 1 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6-8. A device according to amended Claim 1 lacks a cooling system as required by patent Claim 9. A device according to amended Claim 1 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10-14.

With regard to amended claim 9, it is noted that the text "coupled to the canopy portion" has been replaced by "carried by a rib member". Accordingly, amended claim 9 is broadened in comparison to original claim 9 if at least one mist nozzle carried by a rib member is not also inherently be coupled to the canopy portion. Insofar as a mist nozzle could simply be balanced on top of a rib member without a coupling to join the

elements, it isn't even clear that the mist nozzle is coupled to the rib member, much less the canopy portion. Thus, amended claim 9 is broadened in comparison to amended claim 9 and original claim 9 which is the original independent claim which it most closely resembles.

With regard to claim 45, it is noted that the text requiring that the solar energy system is "carried by the pole portion above the canopy portion" as recited in original claims 1, 2, 6, 9 and 10 (all of the original independent claims) has been replaced by "carried by a top portion of the power unit". Accordingly, claim 45 is broadened if a solar energy system being carried by a top portion of the power unit is not also inherently carried by the pole portion above the canopy portion. Insofar as a claim 45 does not specify that the power unit is carried by the pole portion, the solar energy system could be carried by the power unit but not the pole portion. Further, simply because the power unit is coupled to the pole portion above the canopy portion doesn't mean that the power unit is above the canopy portion. The structures could be connected by a tether that is only above the canopy portion on one end.

Claim 46 depends from claim 45 and is broadened for the same reason.

With regard to claim 47, a device according to new Claim 47 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1; lacks a lighting system carried by the canopy portion, as required by patent Claims 2-5; lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6-8; lacks a cooling system as required by patent Claim 9 and lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10-14.

It is also noted that claim 47 lacks "a solar energy system carried by the pole portion above the canopy portion" as recited in all of the original independent claims.

With regard to claim 48, a device according to new Claim 48 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 48 does not infringe patent Claim 1. A device according to new Claim 48 lacks a lighting system "being conductively coupled to and powered by the rechargeable electrical power system," as required by patent Claims 2-5. A device according to new Claim 48 lacks an electromechanical opening and closing system for opening and

closing the canopy portion, as required by patent Claims 6-8. A device according to new Claim 48 lacks a cooling system as required by patent Claim 9. A device according to new Claim 48 lacks a combination of two or more modules as required by patent Claims 10-14.

With regard to claim 51, a device according to new Claim 51 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1, lacks Patent Claims 2-5 recite "a solar energy system carried by the pole portion above the canopy portion" as required by original claims 2-5; lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6-8; lacks a cooling system as required by patent Claim 9; and lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10-14.

With regard to amended Claim 63, a device according to new Claim 63 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1; lacks "a solar energy system carried by the pole portion above the canopy portion" as required by original patent Claims 2-5; lacks an electromechanical opening and closing

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system for opening and closing the canopy portion, as required by patent Claims 6-8; lacks a cooling system as required by patent Claim 9 and lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10-14.

III.) Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 45, 46, 48, 51, 54, 59, 62, 63, 66 and 73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claim 1, the base patent does not support an arrangement where a solar energy system is carried by a module (power unit 725) on the same umbrella apparatus having "multiple discrete lighting elements positioned along at least one of the rib members" because only one light subassembly 721 is disclosed as being placed on an individual rib (Figure 6). Although there

is disclosure that the single subassembly placed on each rib could use cold cathode, LED or fluorescent technology, whatever technology employed would be included within a "subassembly" to provide an aspect of the "modularity" feature included with Figures 6-9. Pages 46 and 47 of Patent Owner's Comments have been reviewed with respect to this issue and it is not agreed that the citations included therein provide support for this particular feature.

Independent claim 45 and, implicitly, dependent claim 46 require "an electrical charging system for recharging the rechargeable electrical power system, the electrical charging system being adapted to receive power from an AC power outlet". Such an electrical charging system is disclosed in the specification and depicted in Figure 1 as "external power system charger 51", in Figure 3C as "external power system charger and transformer 251" and in Figure 5A as "external power system charger 610". Figures 1, 3C and 5A appear to be the only Figures that include this arrangement.

More particularly, Figs. 2A-2C rely on battery pack 155a. For the embodiments of Figs. 4, and 6-9 the specification states that a "rechargeable power source, such as power sources 50, 150 and 250" may be used (column 9, lines 61 and 62, column 12, lines 51 and 52, column 13, lines 26-28, column 13, lines 50-52,

and column 14, lines 21 and 22) and no mention of an electrical charging system is made. Moreover, power sources 50 and 250 do not include an electrical charging system as chargers 51 and 251 are described as being "electrically coupled" to power system 50 (column 4, lines 33-36) and power system 250 (column 8, lines 32-35), respectively, so they are not contained within these power systems. Power system 150 relies on a battery pack of "the type of rechargeable battery that is used with most modern cordless power drills" (column 6, lines 16-18) instead of an electrical charging system. For the embodiments of Figures 10 and 11, there is no mention of an electrical charging system and, in fact, col. 14, lines 46-49 state that the system "does not require any household power for operation, or charging".

It is noted that Patent Owner seems to imply on pages 51-53 that the embodiments depicted in Figures 6-9 inherently include power system charger 51 which connects to an AC power outlet. Insofar as the base patent does not state the same, conjecture is necessary to reach that conclusion.

Similarly, independent claims 48 and 51 recite "a power unit" which corresponds to the embodiments depicted in Figures 6-9; however, these embodiments do not include "recessed"

lighting elements²; more than one discrete lighting element positioned along a rib member³ or "translucent covers". It is not permissible to blend distinct embodiments to produce an amalgamation that was not disclosed in the base patent as it was originally filed.

Claim 51 also recites that "at least a portion of each lighting element extends beyond the corresponding rib member" which covers a partially recessed arrangement that is unsupported by the base patent.

Claim 54 depends from claim 49 which now recites recessed multiple discrete lighting elements. Because of that amendatory change to claim 49, the recitation of claim 54 that the multiple discrete lighting elements are each an LED is unsupported because only the embodiments of Figures 4A, 4B and 4C teach recessed multiple discrete lighting elements and the "preferred" lighting elements described for use are cold cathode tube bulbs with no mention made of LEDs. Although the summary of the invention does describe LEDs used with a cooling system and cooling systems are depicted in Figures 4B and 4C, there is no

² An arrangement in which "at least a portion of each lighting element extends beyond the corresponding rib member", as recited in claim 51, encompasses both a recessed and a partially recessed arrangement. Insofar as the base patent does not disclose a partially recessed arrangement, claim 51 is also rejected for this reason.

³ By using the language "at least", claim 51 encompasses more than one discrete lighting element per rib member.

mention in the indicated text of a "recessed" feature or "multiple discrete elements" so it is more likely that this text refers to the embodiment of Figures 6-9 for which the use of LEDs is expressly disclosed within the accompanying description.

With regard to claim 59, the base patent does not appear to disclose a switch disposed in the crank housing. Claim 58 more accurately describes the switch as being carried by the crank housing.

As mentioned in the last Office action, claim 62 recites recessed LEDs and, as explained above with reference to claim 54, the base patent as originally filed does not support the same.

With regard to claim 63, there is no support for a "pole portion being separable into at least two separate sections". The specification refers to upper and lower portions of the pole but does not indicate that they are separable.

With regard to claim 66, insofar as a "power unit" is recited, this feature clearly relates to the embodiments of Figures 6-9; however, Figures 6-9 do not depict nor are they described as depicting recessed electrical conductors.

With regard to claim 73, insofar as an electrical charging system carried by the pole portion receiving power from an AC outlet is claimed, this limitation appears to refer to elements

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51 and 60 of Figure 1; however, the base patent does not disclose that these elements remain carried by the pole portion when the rechargeable electrical power system is removed from the umbrella apparatus.

IV.) The References

Rejections of the base patent incorporating the following references are applied or addressed in this Office action:

- 1.) U.S. Patent No. 5,911,493 to Walker et al. (hereafter "Walker");
- 2.) PCT Patent Document WO 93/00840 (hereafter "WO 93/00840");
- 3.) U.S. Patent No. 5,349,975 to Valdner;
- 4.) U.S. Patent No. 6,126,293 to Wu;
- 5.) U.S. Patent No. 5,584,564 to Phyle;
- 6.) U.S. Patent No. 6,439,249 to Pan et al (hereafter "Pan")¹;
- 7.) U.S. Patent No. 5,611,614 to Morgan;
- 8.) U.S. Patent No. 5,053,931 to Rushing;
- 9.) U.S. Patent No. 6,499,856 to Lee (hereafter "Lee '856")
patented December 31, 2002 and filed May 22, 2001;
- 10.) Japanese Patent Document JP 9-168415 (hereafter "JP 9-168415");
- 11.) U.S. Patent No. 6,341,873 to Yang;
- 12.) U.S. Patent No. 6,270,230 to Mai;
- 13.) U.S. Patent No. 5,126,922 to Andreasen;
- 14.) U.S. Patent No. 5,463,536 to Chou;

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- 15.) U.S. Patent No. 2,960,094 to Small;
- 16.) U.S. Patent No. 5,664,874 to Winterer;
- 17.) U.S. Patent No. 6,299,325 to Cathel;
- 18.) U.S. Patent Application Publication No. 2002/0078985 to Farr;
- 19.) U.S. Patent No. 6,666,224 to Lee (hereafter "Lee '224") patented on Dec. 23, 2003 and filed on November 7, 2001;
- 20.) U.S. Patent No. 6,017,188 to Benton;
- 21.) U.S. Patent Application Publication No. 2005/0072451 to Vivian;
- 22.) U.S. Patent No. 6,298,866 to Molnar;
- 23.) U.S. Patent No. 6,182,917 to Lai; and
- 24.) U.S. Patent No. 6,058,951 to Wilson.

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V.) Claim Rejections - 35 USC § 103

Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840 and Valdner.

With regard to Claim 73 and referring to Figure 1 of WO 93/00840, a patio umbrella apparatus (1) comprising:

- a base support portion (4);
- a pole portion (9) coupled to the base support portion;
- a canopy portion (8) coupled to the pole portion;
- a rechargeable electrical power system for providing electrical power to the umbrella apparatus (rechargeable batteries 3);
- a solar energy system (2) carried by the pole portion above the canopy portion (2 covers at least part of the top of the canopy (8) thus it is above it and, given that it is carried by the canopy, it is also carried by the pole portion (9) which carries the canopy), the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system (by electrical wires 22), such that the solar energy collected and

converted into electrical energy recharges the rechargeable electrical power system (page 2, line 10 of the translation provided by requester); and

an electrical charging system (power cord 14) carried by the pole portion (insofar as power cord 14 hangs from pole portion 9, pole portion 9 carries power cord 14 in the sense that it sustains the weight of power cord 14) , the electrical charging system being adapted to receive power from a power outlet (via power cord 14);

wherein the electrical charging system remains carried by the pole portion when the rechargeable electrical power system is removed from the patio umbrella apparatus (one can see from Figure 1 that after removing batteries 3, the position of power cord 14 would remain unchanged.

With regard to the limitation of claim 73 that the canopy portion is "hingedly" coupled to the pole portion, it is noted that a hinge at the apex of umbrella apparatus (1) is not expressly shown in the Figures (although Figure 2 does show some sort of wire or circular member threading through two openings under the umbrella cap) nor expressly identified in the disclosure of WO 93/00840. Nevertheless, it can be shown that WO 93/00840 does operate in the manner recited in claims 1 and

73 and, thus, meets these limitations based on the principle of inherency:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)

In the instant case, a full reading of the disclosed form and function of WO 93/00840 shows that recitation of a canopy portion hingedly coupled to a pole portion is implicitly taught. That is to say, the movement of WO 93/00840's components described in its disclosure are necessarily arrived upon through the hinged coupling described in claim 73. More particularly, WO 93/00840 discloses that the canopy (8) has associated mechanisms for opening it (page 1, line 6 of the translation provided by the requester.) WO 93/00840 further discloses that the fabric of which canopy 8 is composed (page 2, lines 4 and 5) is attached to stays 15 (page 2, line 9). Stay 15 includes short and long sections. The short section of 15 (labeled in Figure 1) is hinged to a longer section at a midpoint. Although the longer section is not labeled in the Figures, it is implicitly referenced as "15" in claim 3 by the process of elimination. To wit, no other element holds valence

(23) and is attached to supports (24.) Even the hinge connecting the two sections of 15 would serve to "hingedly" couple the canopy portion to the pole portion, but, beyond this point, by virtue of the placement of stay 15 against the pole 19, one end of the shorter section of 15 must pivot on the longer section of 15 while its other end slides down the pole. Such movement necessitates a hinge under the cap at the top of the pole. Additional evidence that umbrella apparatus (1) opens and closes conventionally (via a hinge at its apex) is provided by the disclosure of "a pin 18 for locking the hub 20 housed in a traverse guide 21" (page 2, lines 17 and 18.) Here again we see that hub 20 slides down guide 21 unless locked by pin 18 in the manner of an umbrella closing "hingedly" at a coupling of a canopy portion and a central shaft.

What WO 93/00840 fails to show is an electrical charging system for recharging the rechargeable electrical power system with power from an AC power outlet. Further, although it is most likely that power cord 14 of WO 93/00840 does receive AC power, this point cannot be determined with absolute certainty. This difference is taught by Valdner.

More particularly, Valdner teaches an umbrella apparatus (10) including an electrical charging system for recharging a rechargeable electrical power system (column 2, lines 31-44)

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with power from an AC power outlet (an "electric house wall socket" (column 2, line 41) receives AC power).

To produce the structure recited in claim 73, WO 93/00840 must be altered to incorporate the portion of Valdner's electrical charging system which permits a rechargeable battery to be recharged from either a solar energy system or an AC power outlet. The power cord of WO 93/00840 could be retained if it was compatible with an AC power outlet or else it would be replaced by a cord possessing such compatibility.

Motivation for the first alteration is provided by the increased reliability implicit in having potential access to an alternate source of power on days when the potential of the solar energy system to provide all necessary power is strained or exceeded. Further, it is noteworthy that Valdner discloses that such alternate AC/solar recharging systems for batteries are "well known in the art" (column 2, line 42.)

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840, Small and Pan or Wu or JP 9-168415 or Mai or Yang.

Referring to Figure 1 of WO 93/00840, an umbrella apparatus (1) comprising:

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a base support portion (4);

a pole portion (9) coupled to the base support portion;

a canopy portion (8) coupled to the pole portion, the canopy portion having a plurality of rib members (15);

a rechargeable electrical power system for providing electrical power to the umbrella apparatus (rechargeable batteries 3);

a solar energy system (2) coupled to the pole portion above the canopy portion (2 is supported by the top of the canopy (8) thus it is coupled to it and, given that it is coupled to the canopy; it is also coupled to the pole portion (9) which is coupled to the canopy), the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system (by electrical wires 22), such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system (page 2, line 10 of the translation provided by Requester); and

a lighting system being conductively coupled to and powered by the rechargeable electrical power system (12 and 25 are powered by rechargeable battery 3).

With regard to the limitation of claim 1 that the canopy portion is "hingedly" coupled to the pole portion, this feature is inherent for the reasons explained above with regard to the rejection of claim 73 with reliance on WO 93/00840 and Valdner which are incorporated by reference herein.

What WO 93/00840 fails to show is a module carrying the solar energy system that is releasably coupled to the pole portion and a lighting system carried by the canopy portion, the lighting system having multiple discrete lighting elements positioned along at least one of the rib members. These differences are obvious in light of the teachings of Small and Pan or Wu or JP 9-168415 or Yang or Mai.

Addressing first the limitations drawn to a module carrying the solar energy system that is releasably coupled to the pole portion, it is noted that making a structure portable or movable is not sufficient to patentably distinguish over an otherwise old device. Likewise, making an old device separable has not been found to be an obvious modification. (See *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952) and *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961).) Furthermore, with regard to simply the teaching of a module carrying a solar energy system, Small teaches a solar panel on top of a disc

shaped housing that could fairly be termed a module assuming the definition of "self-contained unit".

Regarding the limitation of a lighting system, Fig. 1 of Pan teaches a lighting system (the system of lighting devices 5) carried by the canopy portion (lighting devices 5 are carried by ribs 3 which form a portion of a canopy which is not depicted but the fabric portion is mentioned on column 1, line 59) and comprising a plurality of multiple discrete elements (column 3, line 3) carried by the rib members (lighting devices 5 are shown as being carried by rib members in Figure 1), the lighting system being conductively coupled to and powered by an electrical power system (switchable power supply 11).

Figure 1 of Wu teaches a lighting system (lights 32) carried by the canopy portion (lights 32 are carried by ribs which form a portion of a canopy) and comprising a plurality of multiple discrete elements (throughout the text, reference numbers beginning with 32 are identified as LEDs) carried by the rib members (shown in Figure 1), the lighting system being conductively coupled to and powered by an electrical power system (batteries are mentioned in column 3, lines 44-46).

Figure 2a of JP 9-168415 teaches a lighting system (lights 7) carried by the canopy portion (lights 7 are carried by ribs multiple discrete elements (throughout the text, reference

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numbers beginning with 7 are identified as LEDs) carried by the rib members (shown in Figure 2a), the lighting system being conductively coupled to and powered by an electrical power system (batteries are shown in Figure 4).

Figures 1 and 13 of Yang teaches a lighting system (Figure 13 of Yang shows LED 42 attached to the tip of a rib 16) carried by the canopy portion (LEDs 42 are carried by the ribs which form part of the canopy portion) and comprising a plurality of multiple discrete elements, the lighting system being conductively coupled to and charged by an electrical power system (battery 52).

Figure 6 of Mai teaches a lighting system carried by the canopy portion (LEDs 83 are carried by the ribs which form part of the canopy portion) and comprising a plurality of multiple discrete elements, the lighting system being conductively coupled to and charged by an electrical power system (battery 82). It is noteworthy that, although LEDs are mounted on top of the umbrella ribs 20 in the Figure 6, Mai discloses that gores 30 may be formed of translucent material and that transparent strips 84 may be installed on the underside of the umbrella (col. 4, lines 30-39), thus, illuminating the area beneath the dome.

To produce the structure recited in claim 1, WO 93/00840 must be altered to substitute the lighting system of Pan (the system of lighting devices 5) or Wu (LEDs 32) or JP 9-168415 (elements 7) or Yang (LEDs 42) or Mai (LEDs 83) for its lighting system (12 and 25). WO 93/00840 must also be altered to substitute the solar module of Small for solar collector 2. The first alteration could be accomplished by attaching the wiring derived from rechargeable batteries 3 of WO 93/00840 to the wiring bringing power to lighting devices 5 or LEDs 32 or LEDs 7 or LEDs 42 or LEDs 83 once they are secured to the ribs of the WO 93/00840 canopy portion.

Motivation for the first alteration is provided by the fact that much of the light provided by element 12 of WO 93/00840 would be directed away from user because his or her head would be positioned below it (in a single plane, from Figure 1 it appears as if roughly only 45 degrees of a 180 degree range would be directed immediately toward the user.) Likewise, element 25 would similarly direct light away from a user who would be positioned to the side if the canopy base was attached to a table or diagonally above if the canopy base was placed at ground level in which case radiated light would originate at the level of the user's feet. In contrast the overhead light system of either Pan or Wu or JP 9-168415 or Yang or Mai directs less

light at the canopy and provides for having many overhead elements. Substituting the lighting system of Pan or Wu or JP 9-168415 or Yang or Mai for the lighting system taught by WO 93/00840 would provide more direct overhead lighting.

Motivation for the second alteration comes from the fact that the solar collector of Small is entirely supported by the pole and, accordingly, would not interfere with the opening and closing of the canopy.

Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840, Valdner and Phyle.

With regard to Claim 63 and referring to Figure 1 of WO 93/00840, a patio umbrella apparatus (1) comprising:

a base support portion (4) adapted to maintain the umbrella in an upright position;

a pole portion (9 and the wider tube which extends upward from base 4) coupled to the base support portion; the pole portion being separable into at least two separate sections (although there isn't an explicit disclosure that 9 is separable from the tube which extends upward from base 4, Figure 1 shows what appears to be a clamp holding the together; however, even assuming that these two structures were not separable, it would

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be obvious to make them so because making a component separable has been found to be an obvious modification (In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961));

a canopy portion (8) coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus (rechargeable batteries 3);

a solar energy system (2) coupled to the pole portion above the canopy portion (2 covers at least part of the top of the canopy (8) thus it is above it and, given that it is carried by the canopy, it is also carried by the pole portion (9) which carries the canopy), the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system (by electrical wires 22), such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system (page 2, line 10 of the translation provided by requester);

a lighting system being conductively coupled to and powered by the rechargeable electrical power system (abstract) and

an electrical charging system (power cord 14) carried by the pole portion (insofar as power cord 14 hangs from pole

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portion 9, pole portion 9 carries power cord 14 in the sense that it sustains the weight of power cord 14) , the electrical charging system being adapted to receive power from a power outlet (via power cord 14).

With regard to the limitation of claim 63 that the canopy portion is "hingedly" coupled to the pole portion, this feature is inherent for the reasons explained above with regard to claim 73 which are incorporated by reference herein.

What WO 93/00840 fails to show that is required by claim 63 are (1) an electrical charging system for recharging the rechargeable electrical power system with power from an AC power outlet and (2) a lighting system carried by the canopy portion. Further, although it is most likely that power cord 14 of WO 93/00840 does receive AC power, this point cannot be determined with absolute certainty. These differences are taught or suggested by Valdner and Phyle.

More particularly, Valdner teaches an umbrella apparatus (10) including an electrical charging system for recharging a rechargeable electrical power system (column 2, lines 31-44) with power from an AC power outlet (an "electric house wall socket" (column 2, line 41) receives AC power) and Phyle teaches a lighting system carried by the canopy portion (lights 12 are carried by ribs 22.)

To produce the structure recited in claim 63, WO 93/00840 must be altered to incorporate the portion of Valdner's electrical charging system which permits a rechargeable battery to be recharged from either a solar energy system or an AC power outlet. The power cord of WO 93/00840 could be retained if it was compatible with an AC power outlet or else it would be replaced by a cord possessing such compatibility. Further, WO 93/00840 must be altered to include lights carried by the umbrella ribs in the manner taught by Phyle.

Motivation for the first alteration is provided by the increased reliability implicit in having potential access to an alternate source of power on days when the potential of the solar energy system to provide all necessary power is strained or exceeded. Further, it is noteworthy that Valdner discloses that such alternate AC/solar recharging systems for batteries are "well known in the art" (column 2, line 42.)

Motivation for the second alteration is provided by the fact that attaching lighting elements to the ribs of an umbrella permits the light to be directed at a variety of angles.

Claims 6, 7, 59, 64, 67, 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phyle and Small.

With regard to claims 6 and 7, referring to Figures 1 and 2 of Phyle, an umbrella apparatus (1) comprising:

a base support portion (the patio table which does not carry a reference number);

a pole portion (20) coupled to the base support portion;
and

a canopy portion (2) hingedly coupled to the pole portion (column 2, lines 58-67.

What Phyle fails to teach is a rechargeable power system, a solar energy system and an *electromechanical* opening and closing system (Phyle teaches a *mechanical* opening and closing system).

These limitations are taught by Small.

Referring to Figures 1-3 of Small, an umbrella apparatus is taught comprising:

a rechargeable electrical power system for providing electrical power to the umbrella apparatus (35);

a solar energy system (34) carried by a discus-shaped power unit (the discus-shaped housing of solar energy system 34 can be viewed as the power unit or, alternatively, a battery such as 35 is discus-shaped; however, it should be noted that aesthetic design changes and changes in shape have been found to constitute unpatentable subject matter - see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) and *In re Seid*, 161 F.2d 229,

73 USPQ 431 (CCPA 1947)), the power unit being carried by the pole portion above the canopy portion (Fig. 1), the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system(see column 2, lines 53-72);

and an electromechanical opening and closing system for opening and closing the canopy portion, the electromechanical opening and closing system being conductively coupled to and powered by the rechargeable electrical power system (shown in Figs, 1-6), the electromechanical opening and closing system comprising;

an electric motor carried by the pole portion (29);

a control system for controlling the electric motor (shown in Fig. 3);

a gear system coupled to the electric motor (21);

a cable and pulley system coupled to the gear system and the canopy portion (cable 15 and pulley 14;

wherein the opening and closing of the canopy portion is achieved by the electric motor in response to selective operation of the control system (col. 2, lines 42-52).

To achieve the structure recited in claims 6 and 7, Phyle must be altered to augment its structure with the rechargeable electrical power system, solar energy system and electromechanical opening and closing system of Small.

Motivation for such a substitution is provided by the fact that less exertion is required on the part of a user when an electromechanical systems assists in the opening and closing of the umbrella and the advantage provided by solar systems which recharge batteries without the need for the involvement of a human operator.

With regard to claim 59, referring to Figures 1 and 2 of Phyle, an umbrella apparatus (1) comprising:

a base support portion for supporting the umbrella apparatus in an upright orientation, the base support portion being coupled to the pole portion (the patio table which does not carry a reference number);

a pole portion (20);

a canopy portion (2) hingedly coupled to the pole portion (column 2, lines 58-67);

a crank housing coupled to the pole portion, the crank housing being adapted to partially house a system for opening and closing the canopy portion (housing 10 encompasses the pole

20 which inherently includes a mechanical connector impacting slide 26) and

a lighting system carried by the canopy portion (lighting devices 12).

What Phyle fails to teach is a rechargeable power system, a switch disposed in the crank housing and a solar energy system.

These limitations are taught by Small.

Referring to Figures 1-3 of Small, an umbrella apparatus is taught comprising:

a rechargeable electrical power system for providing electrical power to the umbrella apparatus (35);

a switch (32) disposed in a crank housing (31) for controlling the system for opening and closing the canopy portion; and

a solar energy system (34) carried by the pole portion above the canopy portion (Fig. 1), the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system (see column 2, lines 53-72).

To achieve the structure recited in claim 59, Phyle must be altered to augment its structure with the rechargeable electrical power system, solar energy system and a switch (32) disposed in a crank housing of Small. Motivation for such a substitution is provided by the fact that less exertion is required on the part of a user when an electromechanical systems assists in the opening and closing of the umbrella and the advantage provided by solar systems which recharge batteries without the need for the involvement of a human operator. It should be noted that if Phyle was modified to include solar energy system 34 in the manner of Small, the location of 34 on the top of the central pole of the umbrella would remain fixed relative to the pole portion when the canopy is operated between an opened and a closed positioned as recited in claim 59.

With regard to claim 64, referring to Figures 1 and 2 of Phyle, an umbrella apparatus (1) comprising:

- a base support portion (the patio table which does not carry a reference number);
- a pole portion (20) coupled to the base support portion;
- a lighting system carried by the canopy portion (lighting devices 12) and
- a canopy portion (2) hingedly coupled to the pole portion (column 2, lines 58-67.

What Phyle fails to teach is a rechargeable power system and a solar energy system.

These limitations are taught by Small.

Referring to Figures 1-3 of Small, an umbrella apparatus is taught comprising:

a rechargeable electrical power system for providing electrical power to the umbrella apparatus (35); and

a solar energy system (34) contained by a discus-shaped power unit (the discus-shaped housing of solar energy system 34 can be viewed as the power unit or, alternatively, a battery such as 35 is discus-shaped; however, it should be noted that aesthetic design changes and changes in shape have been found to constitute unpatentable subject matter - see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) and *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)), the power unit being carried by the pole portion above the canopy portion (Fig. 1), the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system(see column 2, lines 53-72).

To achieve the structure recited in claim 64, Phyle must be altered to augment its structure with the rechargeable electrical power system and solar energy system of Small.

Motivation for such a substitution is provided by the advantage provided by solar systems which recharge batteries without the need for the involvement of a human operator rather than the continual waste of using disposable batteries or the inconvenience of removing batteries such as 60 to recharge them.

With regard to claim 67, referring to Figures 1 and 2 of Phyle, an umbrella apparatus (1) comprising:

a base support portion (the patio table which does not carry a reference number);

a pole portion (20) coupled to the base support portion;

a canopy portion (2) hingedly coupled to the pole portion (column 2, lines 58-67);

a lighting system carried by the canopy portion (lighting devices 12)

What Phyle fails to teach is a rechargeable power system, a solar energy system and an *electromechanical* opening and closing system controlled by a switch (Phyle teaches a *mechanical* opening and closing system).

These limitations are taught by Small.

Referring to Figures 1-3 of Small, an umbrella apparatus is taught comprising:

a rechargeable electrical power system for providing electrical power to the umbrella apparatus (35);

a solar energy system (34) carried by the pole portion above the canopy portion (Fig. 1), the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system(see column 2, lines 53-72);

and an electromechanical opening and closing system for opening and closing the canopy portion, the electromechanical opening and closing system being powered by the rechargeable electrical power system (shown in Figs, 1-6), and a switch (32) for controlling the electromechanical opening and closing system.

To achieve the structure recited in claim 67, Phyle must be altered to augment its structure with the rechargeable electrical power system, solar energy system and electromechanical opening and closing system of Small.

Motivation for such a substitution is provided by the fact

that less exertion is required on the part of a user when an electromechanical systems assists in the opening and closing of the umbrella and the advantage provided by solar systems which recharge batteries without the need for the involvement of a human operator.

With regard to claims 68 and 69, referring to Figures 1 and 2 of Phyle, an umbrella apparatus (1) comprising:

a base support portion (the patio table which does not carry a reference number);

a pole portion (20) coupled to the base support portion;

a canopy portion (2) hingedly coupled to the pole portion (column 2, lines 58-67);

a lighting system carried by the canopy portion (lighting devices 12);

What Phyle fails to teach is a rechargeable power system, a solar energy system and an *electromechanical* opening and closing system controlled by a switch carried by the housing or located on the pole portion (Phyle teaches a *mechanical* opening and closing system).

These limitations are taught by Small.

Referring to Figures 1-3 of Small, an umbrella apparatus is taught comprising:

a rechargeable electrical power system for providing electrical power to the umbrella apparatus (35);

a solar energy system (34) carried by the pole portion above the canopy portion (Fig. 1), the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system(see column 2, lines 53-72);

and an electromechanical opening and closing system for opening and closing the canopy portion, the electromechanical opening and closing system being powered by the rechargeable electrical power system (shown in Figs, 1-6), the electromechanical opening and closing system being partially housed in a housing coupled to the pole portion (31); and a switch (32) carried by the housing located on pole portion 10 for controlling the electromechanical opening and closing system.

To achieve the structure recited in claims 68 and 69, Phyle must be altered to augment its structure with the rechargeable electrical power system, solar energy system and electromechanical opening and closing system of Small.

Motivation for such a substitution is provided by the fact that less exertion is required on the part of a user when an electromechanical system assists in the opening and closing of the umbrella and the advantage provided by solar systems which recharge batteries without the need for the involvement of a human operator.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phyle and Farr.

Referring to Figures 1 and 2 of Phyle, an umbrella apparatus (1) comprising:

a base support portion (the patio table which does not carry a reference number);

a pole portion (20) coupled to the base support portion;
and

a canopy portion (2) hingedly coupled to the pole portion (column 2, lines 58-67), the canopy portion having a plurality of rib members (22).

What Phyle fails to teach is a rechargeable power system, a solar energy system and a cooling system.

These limitations are taught by Farr.

Referring to Figures 1-6 of Farr, an umbrella apparatus is taught comprising:

a rechargeable electrical power system for providing electrical power to the umbrella apparatus (19);

a solar energy system (28) carried by the pole portion above the canopy portion (Fig. 1), the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system (see paragraph 0034);

and a cooling system carried by the canopy portion the cooling system being conductively coupled to and powered by the rechargeable electrical power system (shown in Figs, 1-6), the cooling system comprising;

a fluid reservoir operably associated with the umbrella apparatus (20);

at least one mist nozzle carried by a rib member, each mist nozzle being in fluid communication with the fluid (31 is carried by rib 30 of Farr);

a conduit creating fluid communication between the fluid reservoir and each mist nozzle (29); and

a pump for pumping the fluid from the reservoir through each mist nozzle (23).

To produce the structure recited in claim 9, Phyle must be altered to augment its structure with the rechargeable electrical power system, solar energy system and cooling system of Farr. That would include attaching the water conduits taught by Farr conduits to the ribs of Phyle.

Motivation for such a substitution is provided by the fact solar systems recharge batteries without the need for the involvement of a human operator and the advantages of a cooling mist for "soothing and cooling" are cited by Farr in paragraph 0020.

VI.) Status of the Previous Objection and Rejections

The objection to claim 72 is withdrawn.

The following rejections were previously made by the Office:

1.) Claims 59, 61, 73 and 74 are rejected under 35 U.S.C. 314(a) as enlarging the scope of the claims of the patent being reexamined (page 4).

The rejection of claims 59, 61, 73 and 74 under 35 U.S.C. 314(a) as enlarging the scope of the claims of the patent being reexamined is withdrawn. The amendments to these claims have overcome this prior rejection.

2.) Claims 45-48, 51, 55-71 and 73-74 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement (page 8).

The rejection of claims 45, 46, 48, 51, 59, 62, 63, 66 and 73 under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement is maintained for reasons explained in section III above.

The rejection of claims 47, 55-58, 60, 61, 64, 65, 67-71 and 74 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn. The amendments to these claims have overcome this prior rejection.

3.) Claim 56 is 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 (page 15).

The rejection of claim 56 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 is withdrawn. The amendment to this claim has overcome this prior rejection.

4.) Claims 1 and 73 are rendered obvious by WO 93/00840 and Valdner under 35 USC § 103 (page 22).

The rejection of claim 1 as being rendered obvious by WO 93/00840 and Valdner under 35 USC § 103 is withdrawn. The rejection of claim 1 as being rendered obvious by WO 93/00840 and Valdner under 35 USC § 103 is withdrawn because it is agreed that WO 93/00840 does not teach "a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system, the lighting system having multiple discrete lighting elements positioned along at least one of the rib members". Valdner also does not teach the same.

The rejection of claim 73 as being rendered obvious by WO 93/00840 and Valdner under 35 USC § 103 is maintained because WO 93/00840 is seen as teaching the newly added features as explained in section V.

5.) Claims 2 and 5 are rendered obvious by WO 93/00840 and Phyle under 35 USC § 103 (page 27).

The rejection of claims 2 and 5 as being rendered obvious by WO 93/00840 and Phyle under 35 USC § 103 is withdrawn. The rejection of claims 2 and 5 as being rendered obvious by WO 93/00840 and Phyle under 35 USC § 103 is withdrawn because it is

agreed that WO 93/00840 does not teach "a power module carried by the pole portion above the canopy portion, the power module having an upper portion and a lower portion", "the rechargeable electrical power system being disposed in the lower portion of the power module" and the "solar energy system carried by the upper portion". Phyle also does not teach the same.

6.) Claims 2, 5 and 74 are rendered obvious by Phyle and Valdner under 35 USC § 103 (page 31).

The rejection of claims 2, 5 and 74 as being rendered obvious by Phyle and Valdner under 35 USC § 103 is withdrawn. The rejection of claims 2 and 5 as being rendered obvious by Phyle and Valdner under 35 USC § 103 is withdrawn because it is agreed that Phyle does not teach "a power module carried by the pole portion above the canopy portion, the power module having an upper portion and a lower portion", "the rechargeable electrical power system being disposed in the lower portion of the power module" and the "solar energy system carried by the upper portion". Valdner also does not teach the same.

7.) Claims 2 and 4 are rendered obvious by WO 93/00840 and Pan or Wu or JP 9-168415 or Mai or Yang under 35 USC § 103.

The rejection of claims 2 and 4 as being rendered obvious by WO 93/00840 and Pan or Wu or JP 9-168415 or Mai or Yang under 35 USC § 103 is withdrawn. The rejection of claims 2 and 4 as being rendered obvious by WO 93/00840 and Pan or Wu or JP 9-168415 or Mai or Yang under 35 USC § 103 is withdrawn because it is agreed that WO 93/00840 does not teach "a power module carried by the pole portion above the canopy portion, the power module having an upper portion and a lower portion", "the rechargeable electrical power system being disposed in the lower portion of the power module; a solar energy system carried by the upper portion of the power module". Pan, Wu, JP 9-168415, Mai and Yang also do not teach the same.

8.) Claim 4 is rendered obvious by Phyle and Valdner and Wu or Pan or JP 9-168415 or Yang or Mai under 35 USC § 103 (page 31).

The rejection of claim 4 as being rendered obvious by Phyle and Valdner and Wu or Pan or JP 9-168415 or Yang or Mai under 35 USC § 103 is withdrawn. The rejection of claim 4 as being rendered obvious by Phyle and Valdner and Wu or Pan or JP 9-

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168415 or Yang or Mai under 35 USC § 103 is withdrawn because it is agreed that Phyle does not teach "a power module carried by the pole portion above the canopy portion, the power module having an upper portion and a lower portion", "the rechargeable electrical power system being disposed in the lower portion of the power module" and the "solar energy system carried by the upper portion". Valdner, Wu, Pan, JP 9-168415, Yang and Mai also do not teach the same.

9.) Claims 6 and 7 are rendered obvious by Phyle and Small (page 41).

The rejection of claims 6 and 7 as rendered obvious by Phyle and Small under 35 USC § 103 is maintained because Small is seen as teaching the newly added features as explained in section V.

10.) Claim 9 is rendered obvious by Phyle and Farr (page 44).

The rejection of claim 9 as rendered obvious by Phyle and Farr under 35 USC § 103 is maintained because the combination of Phyle and Farr is seen as teaching the newly added features as explained in section V.

11.) Claims 49, 50 and 72 are rendered obvious by WO 93/00840 and Morgan or Rushing or Pan or JP 9-168415 or Mai under 35 USC § 103 (pages 46-51).

The rejection of claims 49, 50 and 72 as being rendered obvious by WO 93/00840 and Morgan or Rushing or Pan or JP 9-168415 or Mai under 35 USC § 103 is withdrawn. The rejection of claims 40, 50 and 72 as being rendered obvious by WO 93/00840 and Morgan or Rushing or Pan or JP 9-168415 or Mai under 35 USC § 103 is withdrawn because it is agreed that WO 93/00840 does not teach "each lighting element being recessed within the rib member and being conductively coupled to the rechargeable electrical power system by an electrical conductor, the electrical conductor also being recessed within the rib member". Morgan, Rushing, Pan, JP 9-168415 and Mai also do not teach the same.

12.) Claims 51 and 55 are rendered obvious by WO 93/00840 and Lee '856 under 35 USC § 103 (pages 46-51).

The rejection of claims 51 and 55 as being rendered obvious by WO 93/00840 and Lee '856 under 35 USC § 103 is withdrawn.

The rejection of claim 51 as being rendered obvious by WO 93/00840 and Lee '856 under 35 USC § 103 is withdrawn because it is agreed that WO 93/00840 does not teach "translucent covers for covering the lighting elements" or "a power unit coupled to the pole portion above the canopy portion" that is "releasably coupled to the pole portion". Lee '856 also does not teach the same. It is noted that Walker teaches translucent covers as recited. Further, claim 55 requires that each of the multiple discrete lighting elements positioned along a rib member are fully recessed and neither WO 93/00840 nor Lee '856 teach the same.

13.) Claim 54 is rendered obvious by WO 93/00840 and Pan or JP 9-168415 or Mai under 35 USC § 103 (pages 46-51).

The rejection of claim 54 as being rendered obvious by WO 93/00840 and Pan or JP 9-168415 or Mai under 35 USC § 103 is withdrawn. The rejection of claim 54 as being rendered obvious by WO 93/00840 and Pan or JP 9-168415 or Mai under 35 USC § 103 is withdrawn for the same reason that claim 49 has not been rejected using these same references.

15.) Claims 49, 50 and 72 are rendered obvious by Phyle and Valdner, and Morgan or Rushing or Pan or JP 9-168415 or Mai under 35 USC § 103 (pages 52-55).

The rejection of claims 49, 50 and 72 as being rendered obvious by Phyle and Valdner, and Morgan or Rushing or Pan or JP 9-168415 or Mai under 35 USC § 103 is withdrawn. The rejection of claims 49, 50 and 72 as being rendered obvious by Phyle and Valdner, and Morgan or Rushing or Pan or JP 9-168415 or Mai under 35 USC § 103 is withdrawn because it is agreed that Phyle and Valdner does not teach "each lighting element being recessed within the rib member and being conductively coupled to the rechargeable electrical power system by an electrical conductor, the electrical conductor also being recessed within the rib member". Morgan, Rushing, Pan, JP 9-168415 and Mai also do not teach the same.

16.) Claims 51 and 55 are rendered obvious by Phyle and Valdner, and Lee '856 under 35 USC § 103 (pages 52-55).

The rejection of claims 51 and 55 as being rendered obvious by Phyle and Valdner and Lee '856 under 35 USC § 103 is withdrawn. The rejection of claim 51 as being rendered obvious

by Phyle and Valdner and Lee '856 under 35 USC § 103 is withdrawn because it is agreed that Phyle and Valdner do not teach "translucent covers for covering the lighting elements" or "a power unit coupled to the pole portion above the canopy portion" that is "releasably coupled to the pole portion". It is noted that Walker teaches translucent covers as recited. Lee '856 also does not teach the same. Further, claim 55 requires that each of the multiple discrete lighting elements positioned along a rib member are fully recessed and Phyle, Valdner and Lee '856 do not teach the same.

17.) Claim 54 is rendered obvious by Phyle and Valdner, and Pan or JP 9-168415 or Mai under 35 USC § 103 (pages 52-55).

The rejection of claim 54 as being rendered obvious by Phyle and Valdner, and Pan or JP 9-168415 or Mai under 35 USC § 103 is withdrawn. The rejection of claim 54 as being rendered obvious by Phyle and Valdner, and Pan or JP 9-168415 or Mai under 35 USC § 103 is withdrawn for the same reason that claim 49 has not been rejected using these same references.

18.) Claims 57 and 58 are rendered obvious by Phyle, Small and Valdner under 35 USC 103 (pages 55-58).

The rejection of claims 57 and 58 as being rendered obvious by Phyle, Small and Valdner under 35 USC § 103 is withdrawn. The rejection of claim 54 as being rendered obvious by Phyle, Small and Valdner under 35 USC § 103 is withdrawn at least for the reason that "the conductors being recessed within the rib members". Lee '224 is not available as prior art for claims 57 and 58 because it appears that these claims are entitled to the filing dates of the provisional applications.

VII.) Response to Patent Owner's Arguments⁴

Patent Owner's arguments that the objection to claim 72, the rejection of claim 56 under 35 USC 112, second paragraph and the rejection of claims 59, 61, 73 and 74 under 35 USC 314 should be withdrawn are accepted.

With regard to the rejections under 35 USC 112, first paragraph, Patent Owner states that "the amendments to Claims 45-48, 51, 55-57, 59-70, 73, and 74 overcome the Examiner's rejections under 35 U.S.C. § 112, First Paragraph." Arguments were presented only for claim 59 insofar as Patent Owner asserted that a base member when present is not always coupled to a pole member. In support of that position, Figures 2A-2C and column 6, line 44-column 7, line 28, column 8, line 61-column 9, line 39 are cited by Patent Owner as evidence that the pole portion is removable from the base member. Although it is noted that the Figures cited are not very informative regarding this issue and the cited text does not expressly state that the pole portion is removable from the base, insofar as col. 6 lines 46-48 disclose that the pole is only secured to the base by

⁴ Unless otherwise noted, the arguments addressed are taken from Patent Owner's April 21, 2009 response.

screw clamps 174 and 176, this feature is believed inherent and Patent Owner's point is well taken. That said, the amendatory language newly added to claim 59 raises further issues under 35 USC 112, first paragraph.

No arguments are presented with regard to the prior rejection of claims 51, 55, 60 and 62 as encompassing "partially recessed" wiring or lighting elements. Instead the claims have been amended such that the term "partially recessed" is no longer used albeit claims 51 and 62 are still rejected as new language was inserted into claim 51 which covers "partially recessed" elements and the issue with regard to a lack of support for recessed LED elements was not addressed in claim 62. Accordingly, lighting elements or wiring that are referenced as being "recessed" will be construed as being fully recessed.

The argument that the rejection of claims 1 and 73 with reliance on WO 93/00840 and Valdner should be withdrawn is accepted only with regard to claim 1 although it is noted that claim 1 is now rejected with reliance on WO 93/00840, Small and Pan or Wu or JP 9-168415 or Mai or Yang. In contrast, the amendatory language added to claim 73 does not overcome the prior rejection with reliance on WO 93/00840 and Valdner for reasons explained in section V.

The argument that the rejection of claims 2, 5 and 74 with reliance on Phyle and Valdner should be withdrawn is accepted for reasons explained in section VI.

The argument that the rejection of claims 2 and 5 with reliance on WO 93/00840 and Phyle should be withdrawn is accepted for reasons explained in section VI.

The argument that the rejection of claims 2 and 4 with reliance on WO 93/00840 and Pan or Wu or JP 9-168415 or Mai or Yang should be withdrawn is accepted for reasons explained in section VI.

The argument that the rejection of claim 4 with reliance on Phyle and Valdner and Wu or Pan or JP 9-168415 or Yang or Mai should be withdrawn is accepted for reasons explained in section VI.

The argument that the rejection of claims 6 and 7 with reliance on Phyle and Small should be withdrawn is not accepted for reasons explained in section V.

With regard to claim 9, Patent Owner proposes to overcome the previous rejection with reliance on Phyle and Farr by adding to claim 9 the limitations "the canopy having a plurality of rib members" and that at least one mist nozzle "carried by a rib member". The combination of Phyle and Farr renders obvious claim 9 for the reasons explained in section V.

The argument that the rejection of claims 49, 50 and 72 with reliance on WO 93/00840 and Morgan or Rushing or Pan or JP 9-168415 or Mai should be withdrawn is accepted for reasons explained in section VI.

On the first paragraph of page 39 of Patent Owner's remarks, a number of rejections are grouped together for traversal. It is agreed that the rejections mentioned therein should be withdrawn but for reasons explained in section VI.

The argument that the rejection of claims 57 and 58 with reliance on Phyle, Small and Valdner should be withdrawn is accepted for reasons explained in section VI.

Patent Owner statement that claims 10-14 stand confirmed is correct. Claims 3 and 8 have also been found to be patentable.

Claims 52 and 53 were formerly found to be patentable as noted by Patent Owner on page 43 of the remarks.

Patent Owner points out that page 77 of the December 5, 2006 Office action erroneously stated "The proposed rejection of claim 52 as being unpatentable under 35 USC 112, first paragraph is adopted." Patent Owner is correct that there was no intention to reject claim 52 under 35 USC 112, first paragraph and that the quoted text was in error.

In the Second Declaration under 37 CFR 1.131 (hereafter "the Kuelbs declaration", the inventor of the base patent,

Gregory G. Kuelbs, attempts to establish invention of the claimed subject matter prior to April 30, 1999. According to Patent Owner's Communication, the Kuelbs declaration seeks to disqualify as prior art at least the following references:

Cathel, Lee '856, Mai, Pan, Lee '224, Yang, Molnar, Vivian, Farr, and Lai.

It is first noted that patent application publication Vivian was published on April 7, 2005 and filed on August 31, 2004, accordingly, it already does not qualify as prior art under 35 USC 102 whether or not the base patent is entitled to either of the filing dates of the related provisional applications. In contrast, Mai is a divisional of U.S. Patent No. 5,954,417 filed September 3, 1998 which shares the same specification and has a patent date of September 21, 1999 and this parent patent is available as prior art even if Patent Owner successfully disqualifies Mai as prior art. Also, claims 1, 45, 46, 48, 51, 54, 59, 62, 63, 66 and 73 have been rejected above as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is further noted that provisional applications

60/335,933 and 60/267,018 also do not support the subject matter in these claims. Accordingly, the effective filing date of the base patent, for those particular claims, is February 7, 2002. Likewise, claims 1, 2, 4-7, 45-48, 51, 56, 61, 64-66 and 74 are not supported by provisional application 60/267,018. Claims 1, 2, 4-7, 45-48, 51, 56, 61, 64-66, and 74 recite a module or a power unit which carries the solar energy system and provisional application 60/267,018 does not disclose a "module" or "power unit". Rather, the solar cell is carried directly atop the pole.

Although it is seen that the provisional application 60/267,018 does not provide support for a "module" or "power unit", it is also noted that provisional application 60/335,933 does. Accordingly, claims 2, 4-7, 47, 56, 61, 64, 65 and 74 are entitled to an effective filing date no earlier than November 2, 2001 for the foregoing reasons. The reasons that claims 1, 45, 46, 48, 51, 54, 59, 62, 63, 66 and 73 are entitled to an effective filing date no earlier than February 7, 2002 have already been explained.

Since Wu was patented on October 3, 2000, a statutory bar exists for this reference with respect to at least claims 1, 2, 4-7, 45-48, 51, 54, 56, 59, 61-66, 73 and 74. Since Lai was

patented on February 6, 2001, a statutory bar exists for this reference with respect to at least claims 1, 45, 46, 48, 51, 54, 59, 62, 63, 66 and 73 and a declaration under 37 CFR 1.131 is not appropriate.

With regard to Lee '856 (filed 5/22/01), this reference qualifies as prior art with regard to at least claims 1, 2, 4-7, 45-48, 51, 54, 56, 59, 61-66, 73 and 74 which are not supported by provisional application 60/267,018 (and in some case, unsupported by 60/335,933 but the effective filing date of Lee '856 proceeds the effective filing date of 60/335,933.) With regard to Lee '224 (filed 11/7/01), this reference only qualifies as prior art with regard to claims 1, 45, 46, 48, 51, 54, 59, 62, 63, 66 and 73 which are not supported by either of provisional applications 60/335,933 and 60/267,018.

Returning to the references that the Kuelbs declaration seeks to disqualify as prior art - Cathel, Lee '856, Mai, Pan, Lee '224, Yang, Molnar, Vivian, Farr, and Lai - certain of these references were previously used to reject claims 2, 4, 9, 49, 50, 51, 54, 55 and 72. It is noted that claim 2 requires that the canopy is "hingedly" connected to the pole, that a power module has an upper and lower portion with a rechargeable power system in the lower portion and the solar system in the upper portion that a solar energy system recharges a rechargeable

electrical power system (the Exhibits dated April 1999 only suggest that the solar panel powers LED or cold cathode lights.) Claim 4 depends from claim 2 and implicitly includes the same limitations as well as LEDs that are powered by the rechargeable electrical power source. Claims 49, 51 and 72 also requires that the canopy is "hingedly" connected to the pole and a solar energy system that recharges a rechargeable electrical power system. Claims 50 and 54 depend from claim 49 and implicitly include the same limitations. Claim 55 now depends from claim 52 which requires that the canopy is "hingedly" connected to the pole and a solar energy system that recharges a rechargeable electrical power system. Exhibits A-E and V, which appear to be addressed to the issues of proving conception of the invention and actual reduction to practice, don't address the before mentioned features. In fact, hinges, a canopy (the claims distinguish the canopy from the umbrella ribs) or modules are not mentioned therein. The fact that the Declaration does not properly address the conception and actual reduction to practice of the whole claimed invention for which the references in question were applied is problematic unless the claimed material left unaddressed is obvious. More specifically, MPEP states the following: "Even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can

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still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity." Thus, if Patent Owner wishes to make an admission on the record that the claimed subject matter which is not properly addressed in the Declaration is obvious, then the absence of the same subject matter from the submitted evidence potentially could be overcome as a barrier. However, Patent Owner is advised that there are several other deficiencies within the Declaration that would not be overcome by making such an admission.

MPEP 715.07(III) lists three ways in which an affidavit or declaration may be successful under 37 CFR 1.131:

"(A) actual reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent actual reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice)."

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Here, Patent Owner alleges actual reduction to practice of the invention prior to the effective dates of the references in question. In undertaking the approach referred to above in paragraph "A", Patent Owner, if successful, would not be required to show due diligence. Further, even if the approach in paragraph A failed, Patent Owner would still be able to pursue the approaches of paragraphs B and C above providing, as a new starting point, that "conception of the invention prior to the effective date of the reference" is shown.

Regarding the question of whether the declaration shows "conception of the invention prior to the effective date of the reference", it is noted that in order to prove the same there must be a showing that, before the relevant dates, there was "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice..." *Townsend v. Smith*, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930).

Regarding the question of whether the Declaration shows "actual reduction to practice of the invention prior to the effective date of the reference", it is noted that in order to prove actual reduction to practice, there must be a showing "that the apparatus actually existed and worked for its intended purpose" MPEP 715.07 (III.) The Declaration must provide such a

showing through statements of fact, not opinions, and must produce documentary evidence and exhibits in support thereof (MPEP 715.07 III.)

Turning to exhibit A, the passport copies merely shows that Mr. Kuelbs traveled to China. Exhibit B doesn't show all of the features alleged in the Declaration. Firstly, it is not agreed that the drawing and text is "clearly seen and labeled". Also, this exhibit includes many cryptic comments that the exhibit attempts to supplement." For instance, "What size?" is translated to "What size batteries?" Rather than portraying the idea of the invention as a "definite and permanent idea", such questions suggest a great deal of uncertainty regarding how the invention could take form as of the date of this exhibit. Certainly, the invention could not have been reduced to practice if the inventor was unknowledgeable regarding fundamental questions such as what type of light was "better to use" and how to meet the power requirements of the lights.

Similar problems are present with regard to exhibit C and, in addition, the declaration argues that this diagram supports "partially recessed" LED bulbs even though there is no disclosure of the same in the base patent. Thus, the inventor made a major alteration to the design after April 1999 by substituting fully recessed cold cathode bulbs for the partially

recessed LED bulbs depicted in Exhibit C. Likewise, Exhibit D states "Let LED stick out", suggesting that a partially recessed LED is depicted therein although the base patent does not support the same. Turning to Exhibit V, it is noted that, although MPEP 715.07 does allow as evidence "attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon" Ex parte *Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989), Ms. Kao does not include a statement attesting to the truth of her recollections nor does paragraph 32 of the Declaration provided by Mr. Kuelbs cover her statements. In other words, it does not appear that anyone, even Mr. Kuelbs, has attested to the accuracy of the recollections within Exhibit V. Further, even accepting *arguendo* the accuracy of Ms. Kao's recollections, they reflect uncertainty on the part of the inventor regarding the form the invention should take, for example - "The batteries and charging circuit board were to be mounted in the same housing as the solar panel or just under the fabric cover near or where the umbrella ribs connected at the top. We were to considered benefits and tooling costs of both."

As admitted in the Declaration, exhibit E truly does include "a crude sketch" and it is impossible to be certain regarding what the inventor intended to show therein. Likewise,

the handwriting is difficult to decipher and seems to only indicate the presence of an "up-down" motor, a battery, and wire and a water supply in the ribs but there is no indication that the inventor had conceived of the manner of accomplishing the few broad objectives suggested.

Exhibits F-N appear to have been submitted to show that the inventor was "diligently working"; however, insofar as the Declaration has not shown "conception of the invention prior to the effective date of the reference" prior to the date of these notes, the Declaration cannot be successful without that key component. Further, even assuming arguendo that the Declaration had established conception of the invention on the dates alleged in the Declaration (i.e., April or June of 1999), it is not agreed that there is sufficient evidence to show diligence from the substantial time periods between the dates of the exhibit. For example, what activities did the inventor pursue that show diligence between the July 1999 trip until the September note shown in Exhibit I or the October 1999 activities to November 2000 work with Mr. Quillen and Mr. Hunn?

The former gap of time covers approximately a year during the critical period at issue here. The entire time period where diligence is required, i.e. the critical period, must be

accounted for by either acts or acceptable excuses. *Gould v. Schawlow*, 150 USPQ 634, 643 (CCPA 1966). The USPTO will not speculate on possible explanations for any inactivity. *In re Nelson*, 164 USPQ 458 (CCPA 1970). "[I]t is not enough merely to allege that applicant or patent owner had been diligent. Rather, applicant must show evidence of facts establishing diligence." MPEP 715.07(a) (citation omitted); see also *Smollar v. Cawley*, 31 USPQ2d 1506, 1508 (B.P.A.I. 1993) (citing *Wiesner v. Weigert*, 212 USPQ 721 (CCPA 1981)).

Relevant to the facts of this case are *D'Amico v. Koike*, 146 USPQ 132 (CCPA 1965) and *Bey v. Kollonitsch*, 231 USPQ 967, 970 (Fed. Cir. 1986). In *D'Amico v. Koike*, an unexplained one month period of time during the critical period was found to be excessive. Furthermore, even a 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983.)

The Declaration filed on February 7, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Cathel, Lee '856, Mai, Pan, Lee '224, Yang, Molnar, Vivian, Farr, and Lai references.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a

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NAFTA or WTO member country prior to the effective date of the Cathel, Lee '856, Mai, Pan, Lee '224, Yang, Molnar, Vivian, Farr, and Lai references. See the discussion above.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Cathel, Lee '856, Mai, Pan, Lee '224, Yang, Molnar, Vivian, Farr, and Lai references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). See also the discussion above.

The evidence submitted is insufficient to establish diligence from a date prior to the date of the Cathel, Lee '856, Mai, Pan, Lee '224, Yang, Molnar, Vivian, Farr, and Lai references to either a constructive reduction to practice or an actual reduction to practice. See the discussion above.

Lastly, it is noted that the Declaration seeks to establish invention of the claimed subject matter prior to April 30, 1999 but the earliest dated exhibit depicting claimed subject matter is dated "4-99". Since only the month and year are given,

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clearly this document could have been written on the last day of the month - April 30, 1999.

Patent Owner states that "Claim 55 remains dependent upon claim 51" (page 41); however, claim 55 now depends from claim 52. Accordingly, Patent Owners arguments regarding claim 55 are not well-taken because such arguments incorrectly assume that claim 55 incorporates the limitations of claim 51.

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VIII.) Reasons for Confirmation/Patentability

Claim 2 is patentable because none of the art of record teach an umbrella apparatus including "a power module carried by the pole portion above the canopy portion, the power module having an upper portion and a lower portion", "the rechargeable electrical power system being disposed in the lower portion of the power module" and "a solar energy system carried by the upper portion of the power module".

Claims 4 and 5 are confirmed insofar as they depend from confirmed claim 2.

Claim 3 is patentable because none of the art of record teach "a plurality of cold cathode tube elements" and there is no evidence of record that the use of such tubes attached to the ribs of an umbrella is well-known.

Claim 8 is patentable because of the limitations of "an electromechanical opening and closing system" that is "conductively coupled to and powered by the rechargeable electrical power system" which is recharged by a solar energy system and includes "a control system" comprising "a receiver", "a remote transmitter" and "a decoder". It should be noted that Small teaches "an electromechanical opening and closing system"

that is "conductively coupled to and powered by the rechargeable electrical power system" which is recharged by a solar energy system. Thus, the limitations of "a control system" comprising "a receiver", "a remote transmitter" and "a decoder" are necessary for a finding of patentability.

Claim 10 is confirmed because none of the art of record teach "a combination of two or more of the following modular systems: a lighting system carried by the canopy portion; an electromechanical opening and closing system for opening and closing the canopy portion; or a cooling system; wherein each modular system is configured to be interchanged with each other, each modular system being conductively coupled to and powered by the rechargeable electrical power system."

Claim 11 is confirmed insofar as it depends from confirmed claim 10.

Claim 12 is confirmed insofar as it depends from confirmed claim 10 but it is noted that Figure 1 of Pan et al. teaches a plurality of light emitting diode elements (5) carried by the rib elements (3).

Claim 13 is confirmed insofar as it depends from confirmed claim 10.

Claim 14 is confirmed insofar as it depends from confirmed claim 10.

Claim 49 is patentable because none of the art of record which qualify as prior art under 35 USC 102 for this claim teach an umbrella apparatus including multiple discrete lighting elements positioned along a rib member wherein each lighting element is recessed within the rib member and being conductively coupled to the rechargeable electrical power system by an electrical conductor, the electrical conductor also being recessed within the rib member.

Claim 50 is patentable insofar as it depends from patentable claim 49.

Claim 52 is patentable insofar as it requires multiple discrete lighting elements positioned along a rib member wherein each lighting element is fully recessed within the corresponding rib member. None of the references of record which qualify as prior art under 35 USC 102 for this claim teach the same.

Claims 53 and 55 depend from claim 52 and, accordingly, are patentable for at least the same reasons.

Claim 56 is patentable insofar as it requires an umbrella apparatus in which "the rechargeable electrical power system and the solar system each form a separate component part of a power module that is carried by the pole portion above the canopy portion.

Claim 57 is patentable insofar as it requires an umbrella apparatus including "a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system, the lighting system comprising a plurality of discrete lighting elements carried by the rib members, each lighting element being conductively coupled to and powered by the rechargeable electrical power system via conductors, the conductors being recessed within the rib members" and the references which qualify as prior art under 35 USC 102 for this claim do not teach the same.

Claim 58 depends from claim 57 and is patentable for at least the same reasons.

Claim 60 is patentable because none of the art of record which qualify as prior art under 35 USC 102 for this claim teach an umbrella apparatus including a plurality of lighting elements, each lighting element being recessed within a corresponding a rib member and being covered by a translucent cover carried by the corresponding rib member.

Claim 61 is patentable insofar as it requires an umbrella apparatus including "a power unit carried by the pole portion above the canopy portion", "the rechargeable electrical power

system forming a component part of the power unit" and "the solar energy system also forming a component part of the power unit".

Claim 65 is patentable insofar as it requires an umbrella apparatus including "a solar energy system contained in a discus-shaped module, the discus-shaped module being carried by the pole portion above the canopy portion" as recited in claim 64 from which it depends with the addition of the limitation of "wherein the discus-shaped module is releasably coupled to the pole portion".

Claim 70 is patentable insofar as it requires an umbrella apparatus including "a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system, the lighting system comprising a plurality of lighting elements carried by the rib members, each lighting element being disposed within the channel and being conductively coupled to and powered the rechargeable electrical power source" and the references which qualify as prior art under 35 USC 102 for this claim do not teach the same.

Claim 71 depends from claim 70 and is patentable for at least the same reasons.

Claim 72 is patentable insofar as it requires an umbrella apparatus including "a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system, wherein the lighting system comprises: a plurality of discrete lighting elements carried by each rib member, wherein each lighting element is conductively coupled to and powered by the rechargeable electrical power system via conductors and is recessed within a corresponding rib member" and the references which qualify as prior art under 35 USC 102 for this claim do not teach the same.

Claim 74 is patentable insofar as it requires an umbrella apparatus including "a power module carried by the pole portion above the canopy portion, the power module having an upper portion and a lower portion, a rechargeable electrical power system for providing electrical power to the umbrella apparatus, the rechargeable electrical power system disposed in the lower portion of the power module; a solar system disposed in the upper portion of the power module".

IX.) Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

The patent owner is reminded of the continuing responsibility under 37 CFR 1.985(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 6,612,713 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP 2686 and 2686.04.

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building

YOT-1003-1301

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401 Dulany Street
Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.


/Margaret Rubin/

Margaret Rubin
Primary Examiner
Central Reexamination Unit 3992

/My-Trang N. Ton/
Primary Examiner, CRU 3992

conferee


MARK J. REINHART
CRU SPE-AU 3992

Reexamination 	Application/Control No.	Applicant(s)/Patent Under Reexamination 6612713
	Certificate Date	Certificate Number

Requester	Correspondence Address:	<input type="checkbox"/> Patent Owner	<input type="checkbox"/> Third Party
<p>John S. Pratt, Esq. Kilpatrick Stockton LLP 1100 Peachtree St Ste 2800 Atlanta, GA 30309</p>			

LITIGATION REVIEW <input checked="" type="checkbox"/>	MR (examiner initials)	3/1/2010 (date)
Case Name		Director Initials
World Factory Inc v. Southern Sales and Marketing Group Inc U.S. District Court - Texas Northern (Fort Worth) 4:05cv373		MR for G M
World Factory Inc v. Bond Manufacturing Co U.S. District Court - Texas Northern (Fort Worth) 4:05cv374		b

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
1. NONE	
2.	
3.	
4.	

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 0664MH-40982-REX

In re Reexamination of:

GREGORY G. KUELBS

Control No. 95/000,104

Patent No. 6,612,713

Issued: 2 SEPTEMBER 2003

For: **UMBRELLA APPARATUS**

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Examiner: **MARGARET WAMBACH**

Art Unit: **3992**

Conf. No.: **5847**

TRANSMITTAL

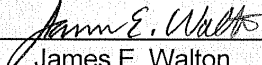
Filed via EFS-Web

Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Please file the following enclosed documents in the subject reexamination proceeding:

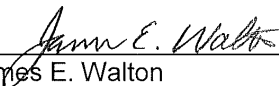
1. This Transmittal with Certificate of Transmission; and
2. Response to Reissued Action Closing Prosecution in *Inter Partes* Reexamination.

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8(a)(1)(i)(C)	
Date of Transmission:	<u>3/9/10</u>
I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office (USPTO) via the USPTO electronic filing system (EFS-Web) on the date shown above.	
By:	<u></u> James E. Walton

The foregoing documents are being filed via the U.S. Patent and Trademark Office's EFS-Web electronic filing system. No fees are deemed to be necessary; however, the undersigned hereby authorizes the Director to charge any other fees that may be required, or credit any overpayments, to **Deposit Account No. 502806**.

Respectfully submitted,

3/9/10
Date



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CUSTOMER NO. 38441

ATTORNEY FOR PATENT OWNER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 0664MH-40982-REX

In re Reexamination of:

GREGORY G. KUELBS

Control No. 95/000,104

Patent No. 6,612,713

Issued: 2 SEPTEMBER 2003

For: **UMBRELLA APPARATUS**

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Examiner: **MARGARET WAMBACH**

Art Unit: **3992**

Conf. No.: **5847**

**RESPONSE TO REISSUED ACTION CLOSING PROSECUTION
IN INTER PARTES REEXAMINATION**

MAIL STOP: INTER PARTES REEXAM

Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Response to Reissued Action Closing Prosecution in *Inter Partes* Reexamination is being filed in response to the Reissued Action Closing Prosecution that was mailed to the undersigned on 2 March 2010.

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8(a)(1)(i)(C)	
Date of Transmission:	<u>3/9/10</u>
I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office (USPTO) via the USPTO electronic filing system (EFS-Web) on the date shown above.	
By:	<u>James E. Walton</u> James E. Walton

RATIFICATION OF PRIOR RESPONSE:

On 18 January 2010, the Patent Owner filed Comments and Proposed Amendments Under 37 C.F.R. § 1.951 to Action Closing Prosecution ("Response to ACP").

The Patent Owner hereby positively states and ratifies that the Response to ACP is responsive to and should be treated as being responsive to the Reissued Action Closing Prosecution.

PROOF OF SERVICE:

Pursuant to 37 C.F.R. § 1.903, a true and correct copy of this Response to Reissued Action Closing Prosecution in *Inter Partes* Reexamination was served on the third-party requester. Pursuant to 37 C.F.R. § 1.248(a)(4), the undersigned hereby certifies that a true and correct copy of this Response to Reissued Action Closing Prosecution in *Inter Partes* Reexamination was served on the third-party requester's attorney of record, John S. Pratt, by First Class Mail with sufficient postage at Kilpatrick Stockton LLP, 1100 Peachtree Street, Suite 2800, Atlanta, Georgia 30309 on **9 March 2010**.



James E. Walton

3/9/10

Date

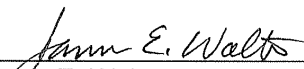
CONCLUSION:

No other fees are deemed to be necessary; however, the undersigned hereby authorizes the Director to charge any additional fees that may be required, or credit any overpayments, to **Deposit Account No. 502806**.

Please link this reexamination proceeding to Customer No. 50779 so that its status may be checked via the PAIR System.

Respectfully submitted,

3/9/10
Date



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CUSTOMER NO. 50779

ATTORNEY FOR PATENT OWNER

Electronic Acknowledgement Receipt	
EFS ID:	7167721
Application Number:	95000104
International Application Number:	
Confirmation Number:	5847
Title of Invention:	UMBRELLA APPARATUS
First Named Inventor/Applicant Name:	6612713
Customer Number:	38441
Filer:	James Edward Walton
Filer Authorized By:	
Attorney Docket Number:	45639-316477
Receipt Date:	09-MAR-2010
Filing Date:	12-AUG-2005
Time Stamp:	10:40:43
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		ResponseToReissuedACP.pdf	198533 6b197077051ac64d5b9c14c4feb9099f72b a778	yes	6

YOT-1003-1310

Multipart Description/PDF files in .zip description		
Document Description	Start	End
Miscellaneous Incoming Letter	1	2
Applicant Arguments/Remarks Made in an Amendment	3	6
Warnings:		
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Total Files Size (in bytes):		198533
<p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p><u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p>		

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

PTO/SB/08a (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95000104	
	Filing Date		2003-09-02	
	First Named Inventor	GREGORY G. KUELBS		
	Art Unit	3992		
	Examiner Name	Margaret Wambach		
	Attorney Docket Number	0664MH-40982-REX		

U.S.PATENTS						
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95000104
	Filing Date	2003-09-02
	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret Wambach
	Attorney Docket Number	0664MH-40982-REX

1	Office Action dated 2010-01-13 from 12/240,845	<input type="checkbox"/>
2	Examiner's Answer dated 2009-12-09 from 10/650,537	<input type="checkbox"/>
3	Reply Brief dated 2010-02-09 from 10/650,537	<input type="checkbox"/>
4	Notice of Allowance dated 2010-03-09 from 12/255,255	<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

EXAMINER SIGNATURE

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95000104
	Filing Date	2003-09-02
	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret Wambach
	Attorney Docket Number	0664MH-40982-REX

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

Fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

None

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/jamesewaltonpat/	Date (YYYY-MM-DD)	2010-03-15
Name/Print	James E. Walton	Registration Number	47,245

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Electronic Acknowledgement Receipt	
EFS ID:	7211276
Application Number:	95000104
International Application Number:	
Confirmation Number:	5847
Title of Invention:	UMBRELLA APPARATUS
First Named Inventor/Applicant Name:	6612713
Customer Number:	38441
Filer:	James Edward Walton
Filer Authorized By:	
Attorney Docket Number:	45639-316477
Receipt Date:	15-MAR-2010
Filing Date:	12-AUG-2005
Time Stamp:	17:43:25
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		IDS20100315.pdf	315164 <small>dcfad52804c28f680cae0ce358c4fa712e007086</small>	yes	9

YOT-1003-1315

Multipart Description/PDF files in .zip description					
Document Description			Start	End	
Miscellaneous Incoming Letter			1	2	
Transmittal Letter			3	6	
Information Disclosure Statement (IDS) Filed (SB/08)			7	9	
Warnings:					
Information:					
2	NPL Documents	OfficeAction20100113.pdf	410474	no	10
			8ff39ad98da2d14fb675ed11957ca867b6c9a8adb		
Warnings:					
Information:					
3	NPL Documents	ExaminersAnswer20091209.pdf	4425425	no	55
			67f2e270d8e19ed305b621a9dc7cb6fb805d23a9		
Warnings:					
Information:					
4	NPL Documents	ReplyBrief20100209.pdf	952628	no	22
			31fb6198ed1609edecabf48c92cf0c7362ab7da79		
Warnings:					
Information:					
5	NPL Documents	NoticeofAllowance20100309.pdf	1631702	no	32
			87c834ce5360a8bf3007864028c97fa4b28b842d		
Warnings:					
Information:					
Total Files Size (in bytes):			7735393		

YOT-1003-1316

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 0664MH-40982-REX

In re Reexamination of:

GREGORY G. KUELBS

Control No. 95/000,104

Patent No. 6,612,713

Issued: 2 SEPTEMBER 2003

For: **UMBRELLA APPARATUS**

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Examiner: **MARGARET WAMBACH**

Art Unit: **3992**

TRANSMITTAL

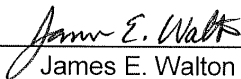
Filed via EFS-Web

Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Please file the following enclosed documents in the subject reexamination proceeding:

1. This Transmittal with Certificate of Transmission; and
2. Information Disclosure Statement, including Form PTO/SB/08a.

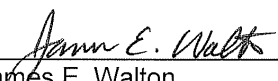
CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8(a)(1)(i)(C)	
Date of Transmission:	<u>3/15/10</u>
I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office (USPTO) via the USPTO electronic filing system (EFS-Web) on the date shown above.	
By:	<u></u> James E. Walton

The foregoing documents are being filed via the U.S. Patent and Trademark Office's EFS-Web electronic filing system. No fees are deemed to be necessary; however, the undersigned hereby authorizes the Director to charge any other fees that may be required, or credit any overpayments, to **Deposit Account No. 502806**.

Please link this application to **Customer No. 50779** so that its status may be checked via the PAIR System.

Respectfully submitted,

3/15/10
Date



James E. Walton
Reg. No. 47,245
Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
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(817) 447-9954 (Facsimile)
jim@waltonpllc.com

CUSTOMER NO. 38441

ATTORNEY FOR PATENT OWNER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 0664MH-40982-REX

In re Reexamination of:

GREGORY G. KUELBS

Control No. 95/000,104

Patent No. 6,612,713

Issued: 2 SEPTEMBER 2003

For: **UMBRELLA APPARATUS**

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§

Examiner: **MARGARET WAMBACH**

Art Unit: **3992**

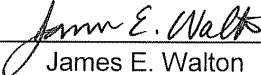
**INFORMATION DISCLOSURE STATEMENT
IN INTER PARTES REEXAMINATION**

Filed via EFS-Web

Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

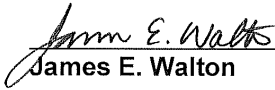
In accordance with 37 C.F.R. § 1.56, the references listed on the attached forms PTO/SB/08A are being brought to the attention of the Examiner for consideration in connection with the subject reexamination application.

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8(a)(1)(i)(C)	
Date of Transmission:	<u>3/15/10</u>
I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office (USPTO) via the USPTO electronic filing system (EFS-Web) on the date shown above.	
By:	<u></u> James E. Walton

The filing of this Information Disclosure Statement shall not be construed to be a representation that a search has been conducted, nor shall it be construed as an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 C.F.R. §1.56(b).

Proof of Service:

Pursuant to 37 C.F.R. § 1.903, a true and correct copy of this Information Disclosure Statement has been served on the third-party requester. Pursuant to 37 C.F.R. § 1.248(a)(4), the undersigned hereby certifies that a true and correct copy of this Information Disclosure Statement was served on the third-party requester's attorney of record, Larry A. Roberts, by First Class Mail with sufficient postage at Kilpatrick Stockton LLP, 1100 Peachtree Street, Suite 2800, Atlanta, Georgia 30309-4530 on **15 March 2010**.



James E. Walton

3/15/10

Date

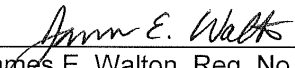
Conclusion:

No fees are deemed to be necessary; however, the undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 502806**.

Please link this application to Customer No. 50779 so that its status may be checked via the PAIR System.

Respectfully submitted,

3/15/10
Date



James E. Walton, Reg. No. 47,245
Law Offices of James E. Walton, P.L.L.C.
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(817) 447-9955 (Voice)
(817) 447-9954 (Facsimile)
jim@waltonpllc.com

CUSTOMER NO. 50779

ATTORNEY FOR PATENT OWNER

Litigation Search Report CRU 3999

Reexam Control No. 95/000,104

To: Margaret Rubin

Art Unit: 3992

Date: 07/30/10

Case Serial Number: 95/000,104

From: Karen L. Ward

Location: CRU 3999

Mdw 7C76

Phone: (571) 272-7932

Karen.Ward@uspto.gov

Search Notes

Litigation was found involving U.S. Patent No. 6,612,713.

4:05CV373- YES

4:05CV374 – YES

- 1) I performed a KeyCite Search in Westlaw, which retrieves all history on the patent including any litigation.
- 2) I performed a search on the patent in Lexis CourtLink for any open dockets or closed cases.
- 3) I performed a search in Lexis in the Federal Courts and Administrative Materials databases for any cases found.
- 4) I performed a search in Lexis in the IP Journal and Periodicals database for any articles on the patent.
- 5) I performed a search in Lexis in the news databases for any articles about the patent or any articles about litigation on this patent.

YOT-1003-1324



Date of Printing: Jul 30, 2010

KEYCITE

C US PAT 6612713 UMBRELLA APPARATUS, Assignee: World Factory, Inc. (Sép 02, 2003)

History

Direct History

=> 1 **UMBRELLA APPARATUS**, US PAT 6612713, 2003 WL 22044809 (U.S. PTO Utility Sep 02, 2003) (NO. 10/068424)

Patent Family

2 **UMBRELLA APPARATUS FOR LAWNS, HAS SOLAR ENERGY SYSTEM CONDUCTIVELY COUPLED TO RECHARGEABLE ELECTRICAL POWER SYSTEM FOR CONVERTING SOLAR ENERGY INTO ELECTRICAL ENERGY AND CHARGER FOR RECHARGING POWER SYSTEM**, Derwent World Patents Legal 2003-895364

Assignments

3 **ACTION: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS). NUMBER OF PAGES: 002, (DATE RECORDED: Feb 07, 2002)**

Patent Status Files

.. Request for Re-Examination, (OG DATE: Sep 27, 2005)
.. Patent Suit(See LitAlert Entries),
.. Patent Suit(See LitAlert Entries),

Docket Summaries

7 **WORLD FACTORY INC v. BOND MANUFACTURING CO, (N.D.TEX. Jun 13, 2005) (NO. 4:05CV00374), (35 USC 145 PATENT INFRINGEMENT)**
8 **WORLD FACTORY INC v. SOUTHERN SALES AND MARKETING GROUP INC, (N.D.TEX. Jun 13, 2005) (NO. 4:05CV00373), (35 USC 145 PATENT INFRINGEMENT)**

Litigation Alert

9 Derwent LitAlert P2005-42-24 (Jun 13, 2005) Action Taken: A complaint was filed
10 Derwent LitAlert P2005-42-26 (Jun 13, 2005) Action Taken: A complaint was filed

Prior Art (Coverage Begins 1976)

C 11 **AIR COOLED UMBRELLA**, US PAT 5349975 (U.S. PTO Utility 1994)

- C** 12 COMBINATION CANOPY AND FAN, US PAT 5172711 (U.S. PTO Utility 1992)
- C** 13 ILLUMINATED UMBRELLA OR PARASOL, US PAT 5126922 (U.S. PTO Utility 1992)
- C** 14 UMBRELLA, US PAT 5273062 (U.S. PTO Utility 1993)
- C** 15 UMBRELLA WITH A LIGHT SOURCE AND LIGHT REFRACTING MEANS, US PAT 5463536 (U.S. PTO Utility 1995)

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YOT-1003-1326

US District Court Civil Docket

**U.S. District - Texas Northern
(Fort Worth)**

4:05cv373

World Factory Inc v. Southern Sales And Marketing Group Inc

This case was retrieved from the court on Monday, January 01, 2007

Date Filed: 06/13/2005 **Class Code: CLOSED, JURY**
Assigned To: John McBryde **Closed: Yes**
Referred To: **Statute: 35:145**
Nature of suit: Patent (830) **Jury Demand: Plaintiff**
Cause: Patent Infringement **Demand Amount: \$0**
Lead Docket: None **NOS Description: Patent**
Other Docket: None
Jurisdiction: Federal Question

Litigants

Attorneys

World Factory Inc
Plaintiff

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Marshall M Searcy
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817/ 332-2500
Fax: 817/ 878-9280 Fax
Email: Marshall_searcy@khh.com

Southern Sales And Marketing Group Inc Doing Business
as Southern Patio
Defendant

Date # Proceeding Text

YOT-1003-1327

06/13/2005	2	CERTIFICATE OF INTERESTED PERSONS/DISCLOSURE STATEMENT by World Factory Inc. (mjl,) (Entered: 06/14/2005)
06/13/2005	3	Summons Issued as to Southern Sales and Marketing Group Inc. (mjl,) (Entered: 06/14/2005)
06/13/2005	4	Mailing of Patent and Trademark Infringement Notice to Director in Alexandria VA (mjl,) (Entered: 06/14/2005)
06/13/2005	5	CIVIL COVER SHEET filed by World Factory Inc. (mjl,) (Entered: 06/15/2005)
06/14/2005	1	COMPLAINT AND JURY DEMAND against Southern Sales and Marketing Group Inc (Filing fee \$250; Receipt number 53004), filed by World Factory Inc.(mjl,) (Entered: 06/14/2005)
01/04/2006	6	ORDER:...Ordered that on/before 1/18/06 pltf. World Factory Inc file either proof of proper svc. of summons/complaint on deft. or instrument containing satisfactory explanation in affidavit form as to why such proof can't be filed; if pltf. fails to comply court will consider dismissal w/o further notice of pltf's claims... (Signed by Judge John McBryde on 1/4/06) (pdm,) (Entered: 01/04/2006)
01/06/2006	7	Voluntary Dismissal Pursuant to Rule 41(a)(1) by World Factory Inc (pdm,) (Entered: 01/06/2006)
01/09/2006	8	ORDER:...Ordered all claims and causes of action asserted by pltf against deft. dismissed w/o prejudice (Signed by Judge John McBryde on 1/9/06) (pdm,) (Entered: 01/09/2006)
01/09/2006	9	Final JUDGMENT... Ordered all claims and causes of action asserted by pltf against deft. dismissed w/o prejudice (Signed by Judge John McBryde on 1/9/06) (pdm,) (Entered: 01/09/2006)

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YOT-1003-1328

US District Court Civil Docket

**U.S. District - Texas Northern
(Fort Worth)**

4:05cv374

World Factory Inc v. Bond Manufacturing Co

This case was retrieved from the court on Monday, January 01, 2007

Date Filed: 06/13/2005 **Class Code: CLOSED, JURY, PATENT**
Assigned To: John McBryde **Closed: Yes**
Referred To: **Statute: 35:145**
Nature of suit: Patent (830) **Jury Demand: Plaintiff**
Cause: Patent Infringement **Demand Amount: \$0**
Lead Docket: None **NOS Description: Patent**
Other Docket: None
Jurisdiction: Federal Question

Litigants

Attorneys

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Plaintiff

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USA
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Hugh G Connor, II
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Marshall M Searcy
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USA
817/ 332-2500
Fax: 817/ 878-9280 Fax
Email: Marshall_searcy@khh.com

Bond Manufacturing Co
Defendant

Date #

Proceeding Text

YOT-1003-1329

06/13/2005	1	COMPLAINT against Bond Manufacturing Co (Filing fee \$250; Receipt number 53005), filed by World Factory Inc.(jmb,) (Entered: 06/14/2005)
06/13/2005	--	DEMAND for Trial by Jury by World Factory Inc. (jmb,)on face of complaint (Entered: 06/14/2005)
06/13/2005	2	CERTIFICATE OF INTERESTED PERSONS/DISCLOSURE STATEMENT by World Factory Inc. (jmb,) (Entered: 06/14/2005)
06/14/2005	3	Summons Issued as to Bond Manufacturing Co. (jmb,) (Entered: 06/14/2005)
06/14/2005	4	NOTICE of patent filing mailed to US Patent and Trademark Office(jmb,) (Entered: 06/14/2005)
11/14/2005	5	ORDER: that on before Nov 28, 2005, pla file either proof of proper service of summons and complaint on dft, or an instrument containing a satisfactory explanation, in affidavit form, as to why such proof cannot be filed. (Signed by Judge John McBryde on 11/14/05) (mjw,) (Entered: 11/15/2005)
11/21/2005	6	VOLUNTARY DISMISSAL PURSUANT TO RULE 41(a)(1) by World Factory Inc (mjw,) (Entered: 11/21/2005)
11/21/2005	7	FINAL JUDGMENT...dismissed without prejudice. (Signed by Judge John McBryde on 11/21/05) (mjw,) (Entered: 11/22/2005)

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YOT-1003-1330

Source: [Command Searching > Utility, Design and Plant Patents](#)
 Terms: **6612713** ([Edit Search](#) | [Suggest Terms for My Search](#))

Select for FOCUS™ or Delivery

1. [7753546, July 13, 2010, Umbrella apparatus, Kuelbs, Gregory G., Westlake, TEXAS, United States of America\(US\), United States of America\(US\); 255255, October 29, 2008, ASSIGNMENT OF ASSIGNORS INTEREST \(SEE DOCUMENT FOR DETAILS\)., WORLD FACTORY, INC., 306 AIRLINE DRIVE, SUITE 200, COPPELL, TEXAS, UNITED STATES OF AMERICA\(US\), 75019-4670, reel-frame:021752/0802, World Factory, Inc., Coppell, TEXAS, United States of America\(US\), United States company or corporation](#)

CORE TERMS: umbrella, battery, pole, module, rib, lighting, lamp, solar, electrical, pack, charger, rechargeable, installed, coupled, crank, cold cathode tube, closing, power source, switch, wire, bulb, conductively, cell, interior, canopy, cooling, utilized, lens, hollow, wiring

... Ser. No. 10068424, February 7, 2002, GRANTED **6612713** Provisional Application Ser. No. 60267018, February 7, ...

... July 29, 2003, Li, United States of America (US) **6612713**, September 2, 2003, Kuelbs, United States of America (US) ...

2. [7614600, November 10, 2009, Umbrella base with power supply, Smith, James C., Hayward, CALIFORNIA , United States of America\(US\), United States of America\(US\); Taylor, David J., 129 Sugar Creek La., Alamo, CALIFORNIA , United States of America\(US\), 94507, United States of America\(US\); 021487, February 1, 2007, ASSIGNMENT OF ASSIGNORS INTEREST \(SEE DOCUMENT FOR DETAILS\)., TAYLOR, DAVID J., 129 SUGAR CREEK LANE, ALAMO, CALIFORNIA, UNITED STATES OF AMERICA\(US\), 94507, reel-frame:018837/0247, Taylor, David J., Alamo, CALIFORNIA , United States of America\(US\), United States individual, May 11, 2010, ASSIGNMENT OF ASSIGNORS INTEREST \(SEE DOCUMENT FOR DETAILS\)., ROLLING UMBRELLAS, LLC, 484 DIABLO ROAD, DANVILLE, CALIFORNIA, UNITED STATES OF AMERICA\(US\), 94526, reel-frame:024369/0016](#)

CORE TERMS: umbrella, housing, ballast, billboard, screw, cavity, pipe, advertising, user, console, caster, battery, wheel, perimeter, power source, electrical, sleeve, cover plate, foot, container, patio, shaft, locking, nut, suitably, filled, cam, sidewall, cam-screw, latch

... July 29, 2003, Li, United States of America (US) **6612713**, September 2, 2003, Kuelbs, United States of America (US) ...

3. [7604015, October 20, 2009, Umbrella having structural rib configured to receive electrical components and associated wiring, Fraser, Joseph, Woodstock, GEORGIA, United States of America\(US\), United States of America\(US\); 241889, December 10, 2008, ASSIGNMENT OF ASSIGNORS INTEREST \(SEE DOCUMENT FOR DETAILS\)., SOUTHERN SALES & MARKETING GROUP, INC., 4400 COMMERCE CIRCLE, ATLANTA, GEORGIA, UNITED STATES OF AMERICA\(US\),](#)

YOT-1003-1331

30336, reel-frame:021953/0007, Southern Sales & Marketing Group, Inc., Atlanta, GEORGIA, United States of America(US), United States company or corporation, October 22, 2009, NOTICE OF GRANT OF SECURITY INTEREST IN PATENTS, PNC BANK, NATIONAL ASSOCIATION, AS AGENT, SUITE 890, 600 GALLERIA PARKWAY, ATLANTA, GEORGIA, UNITED STATES OF AMERICA(US), 30339, reel-frame:023401/0799

CORE TERMS: umbrella, rib, electrical, channel, web, canopy, configured, conductor, hole, battery, panel, upstanding, convenient, solar, upper side, elongated, lighting, coaxial, wiring, light bulb, outdoor, casing, patio, upper surface, intermediate, energy, weathering, underneath, alignment, insulated

... July 29, 2003, Li, United States of America (US) **6612713**, September 2, 2003, Kuelbs, United States of America (US) ...
... F.R. §1.131 and Exhibits; Reexamination of Pat. No. **6612713**;
submitted Jan. 29, 2007.

4. 7562667, July 21, 2009, Outdoor umbrella with solar power supply, Li, Wanda Ying, 121 E. Alton, Santa Ana, California, 92707, United States(US); 325058,

CORE TERMS: umbrella, solar, lighting, collecting, awning, outdoor, energy, housing, storage battery, arm, electrical, solar power, battery, stem, connecting, switch, user, illuminating, sunlight, mounting, electrically, electricity, illumination, shielding, pivotally, convert, zone, foldable, slidably, slot

... 2002, Pan et al., United States (US), 135#16 **6612713**, September, 2003, Kuelbs, United States (US), 362#102 6666224, ...

5. 7533679, May 19, 2009, Covering with rib lighting arrangement, Harbaugh, Kenneth A., 1000 Overlook Dr., Villa Rica, Georgia, 30180, United States(US); 381070,

CORE TERMS: bulb, holder, rib, globe, light source, covering, hole, elongated, protrusion, umbrella, flange, ridge, intermediate, lighting, gazebo, deformable, installed, resilient, upward, outwardly, arm, longitudinal, configured, channel, accidentally, becoming, detached, outward, groove, light bulb

... 6598990, July, 2003, Li, United States (US), 362#353 **6612713**, September, 2003, Kuelbs, United States (US), 362#353 6666224, ...
... F.R. §1.131 and Exhibits; Reexamination of Patent No. **6612713**;
submitted Jan. 29, 2007. U.S. Appl. No. ...

6. 7431470, October 7, 2008, Trans-membrane solar energy lighting device, Coleiro, Lenard C., 1673 Sharon Drive, London, Ontario, NOL 1R0, Canada(CA); 347571,

CORE TERMS: membrane, electrical, housing, umbrella, radiant energy, fabric, tent, solar, energy, gathering, operatively, constructed, battery, panel, producing, conduit, pin, switch, disc, electricity, oblique, bulb, transmitting, frequency, plastic, cable, layer, conductive, storing, lighting

... States (US) 6598990, July, 2003, Li, United States (US) **6612713**,
September, 2003, Kuelbs, United States (US), 362#102 6659616, ...

7. 7420119, September 2, 2008, Subterranean electrical hub, Janos, Joseph John, Wadsworth, Ohio, United States(US); Ascherl, John Joseph, Medina, Ohio, United

States(US); Briggs, Michael William, Kent, Ohio, United States(US); Fritz, Raymond J., Northfield, Ohio, United States(US); Williams, Richard, Akron, Ohio, United States(US); 564337, The L.D. Kichler Co., Cleveland, Ohio, United States (US), United States company or corporation

CORE TERMS: hub, electrical, depth, exemplary, marker, socket, connector, wiring, fixture, plug, underground, terminal, installed, cable, stem, external, seal, power source, upper surface, buried, additionally, lighting, detector, molded, wire, electrically, periphery, outdoor, safety device, subterranean

6062917, May, 2000, Kingston, United States (US), 439#798 **6612713**, September, 2003, Kuelbs, United States (US), 362#102 6636924, ...

8. 7412984, August 19, 2008, Portable personal shade and cooling device, Spencer, Terrence Michael, 3245 E. Jerome Ave., Mesa, Arizona, 85204, United States (US); Spencer, Nicolle Janine, 3245 E. Jerome Ave., Mesa, Arizona, 85204, United States(US); 194960,

CORE TERMS: reservoir, handle, cooling, canopy, valve, nozzle, user, cartridge, mist, grip, umbrella, portable, misting, shade, conduit, chamber, air pump, communicate, fluid, pump, pressurized, downwardly, filled, seal, pressurization, flexible, evaporative, pressurize, disengaged, threaded

... 5979793, November, 1999, Louis, United States (US), 239#211 **6612713**, September, 2003, Kuelbs, United States (US), 362#102 6682000, ...

9. 7361039, April 22, 2008, Electrical connector within tubular structure, Koehler, Edwin T., Nashville, Tennessee, United States(US); 759581, July 27, 2007, ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., HUNTER FAN COMPANY 2500 FRISCO AVENUE MEMPHIS TENNESSEE 38114, reel-frame:019615/0309, Hunter Fan Company, Memphis, Tennessee, United States(US), United States company or corporation

CORE TERMS: pole, electrical, tubular, connector, coupler, connecting, window, screw, holes, cord, fan, configured, notch, cover plate, elongated, female, neck, male, terminating, mounting, interior, threaded, aligned, wiring, seal, narrowed, ambience, moisture, coupled, connect

... 4914258, April, 1990, Jackson, United States (US), 362#431 **6612713**, September, 2003, Kuelbs, United States (US), 362#102

10. 7331684, February 19, 2008, Sunshade with an illuminating device, Tung, Benson, No. 587, Chiengong Rd., Kaohsiung, Taiwan(TW); 143081,

CORE TERMS: runner, illuminating, conductive, pin, solar, sunshade, energy, wire, rib-mounting, module, electrically, rib, pivotally, electricity, receiver, cell, light units, lighting, stretcher, coupling, seat, compartment, connector, power source, photoelectric, accommodating, unfolded, battery, hole, intermediate

... August, 2002, Pan et al., United States (US) **6612713**, September, 2003, Kuelbs, United States (US), 362#102 6830058, ...

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- 1. AAP Company News, January 30, 2001, Tuesday, 931 words, Second Quarter Activities Report, Sydney

CORE TERMS: PMA, Westgold, Normandy, Saracen, joint venture, PROSPECT, Tonalite, Kintore, Wrixon, mineralisation, drill, holes, MANAGING DIRECTOR, CASTLE HILL, sale agreement, cash flow, JOYNERs, Ridgeback, Roderick, Mineral, Bernard, Mick, Adam, Pty, CHRC447D, AMG, employment, placement, drilling, interval

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- 2. AAP Company News, January 30, 2001, Tuesday, 930 words, Second Quarter Activities Report, Sydney

CORE TERMS: PMA, Westgold, Normandy, Saracen, joint venture, PROSPECT, Tonalite, Kintore, Wrixon, mineralisation, drill, holes, MANAGING DIRECTOR, CASTLE HILL, sale agreement, cash flow, JOYNERs, Ridgeback, Roderick, Mineral, Bernard, Mick, Adam, Pty, CHRC447D, AMG, employment, placement, drilling, interval

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- 3. AAP NEWSFEED, January 30, 2001, Tuesday, Nationwide General News; Finance Wire, 958 words, WGR

CORE TERMS: PMA, Westgold, Normandy, Saracen, joint venture, PROSPECT, Tonalite, Kintore, Wrixon, mineralisation, drill, holes, MANAGING DIRECTOR, CASTLE HILL, sale agreement, cash flow, JOYNERs, Ridgeback, Roderick, Mineral, Bernard, Mick, Adam, Pty, CHRC447D, AMG, employment, placement, drilling, interval

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	Filing Date	2003-09-02
	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret Wambach
	Attorney Docket Number	0664MH-40982-REX

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Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	3129715		1964-04-21	Vincent Militano, et al.	
	2	4540929		1985-09-10	Bruce Binkley, et al.	
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Application Number	95000104
Filing Date	2003-09-02
First Named Inventor	GREGORY G. KUELBS
Art Unit	3992
Examiner Name	Margaret Wambach
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Title of Invention:	UMBRELLA APPARATUS
First Named Inventor/Applicant Name:	6612713
Customer Number:	38441
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In re Reexamination of:

GREGORY G. KUELBS

Control No. **95/000,104**

Patent No. **6,612,713**

Issued: **2 SEPTEMBER 2003**

For: **UMBRELLA APPARATUS**

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Examiner: **MARGARET WAMBACH**

Art Unit: **3992**

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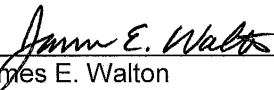
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ATTORNEY FOR PATENT OWNER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 0664MH-40982-REX

In re Reexamination of:

GREGORY G. KUELBS

Control No. **95/000,104**

Patent No. **6,612,713**

Issued: **2 SEPTEMBER 2003**

For: **UMBRELLA APPARATUS**

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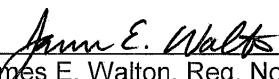
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	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret Wambach
	Attorney Docket Number	0664MH-40982-REX

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	1	2960094		1960-11-15	Small, Samuel N.			
	2	5502624		1996-03-26	Tu, Yeu-Feng			
If you wish to add additional U.S. Patent citation information please click the Add button.								
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	1							<input type="checkbox"/>
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NON-PATENT LITERATURE DOCUMENTS								

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95000104
	Filing Date	2003-09-02
	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret Wambach
	Attorney Docket Number	0664MH-40982-REX

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
	1	Request for Continued Examination and Amendment under 37 CFR 1.114 dated 2010-11-04 from corresponding Application No. 12/240,845	<input type="checkbox"/>
	2	Non-Final Office Action dated 2010-12-15 from corresponding Application No. 12/240,845	<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

EXAMINER SIGNATURE

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**
(Not for submission under 37 CFR 1.99)

Application Number	95000104		
Filing Date	2003-09-02		
First Named Inventor	GREGORY G. KUELBS		
Art Unit	3992		
Examiner Name	Margaret Wambach		
Attorney Docket Number	0664MH-40982-REX		

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

Fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

None

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/jamesewaltonpat/	Date (YYYY-MM-DD)	2011-01-03
Name/Print	James E. Walton	Registration Number	47,245

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Electronic Acknowledgement Receipt	
EFS ID:	9149022
Application Number:	95000104
International Application Number:	
Confirmation Number:	5847
Title of Invention:	UMBRELLA APPARATUS
First Named Inventor/Applicant Name:	6612713
Customer Number:	38441
Filer:	James Edward Walton
Filer Authorized By:	
Attorney Docket Number:	45639-316477
Receipt Date:	03-JAN-2011
Filing Date:	12-AUG-2005
Time Stamp:	11:59:21
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		IDS20110103.pdf	371514 <small>6fe24d8ee77d723644942c132c2a34df6ba984d7</small>	yes	9

YOT-1003-1356

Multipart Description/PDF files in .zip description					
Document Description			Start	End	
Miscellaneous Incoming Letter			1	2	
Transmittal Letter			3	6	
Information Disclosure Statement (IDS) Filed (SB/08)			7	9	
Warnings:					
Information:					
2	NPL Documents	OfficeAction20101215.pdf	646747	no	15
			e8d79aa6742d034fcdb02f62db1293883559ff4d		
Warnings:					
Information:					
3	NPL Documents	RCE20101104.pdf	864663	no	19
			9b9e76a6f69dea9a26811540a4a535a99f03e90cd		
Warnings:					
Information:					
Total Files Size (in bytes):			1882924		
<p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p><u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p>					

YOT-1003-1357

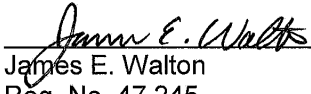
The foregoing documents are being filed via the U.S. Patent and Trademark Office's EFS-Web electronic filing system. No fees are deemed to be necessary; however, the undersigned hereby authorizes the Director to charge any other fees that may be required, or credit any overpayments, to **Deposit Account No. 502806**.

Please link this application to Customer No. 50779 so that its status may be checked via the PAIR System.

Respectfully submitted,

Date

1/3/11


James E. Walton
Reg. No. 47,245
Law Offices of James E. Walton, P.L.L.C.
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Burleson, Texas 76028
(817) 447-9955 (Voice)
(817) 447-9954 (Facsimile)
jim@waltonpllc.com

CUSTOMER NO. 38441

ATTORNEY FOR PATENT OWNER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 0664MH-40982-REX

In re Reexamination of:

GREGORY G. KUELBS

Control No. 95/000,104

Patent No. 6,612,713

Issued: 2 SEPTEMBER 2003

For: **UMBRELLA APPARATUS**

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Examiner: **MARGARET WAMBACH**

Art Unit: **3992**

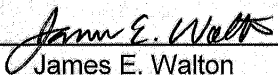
**INFORMATION DISCLOSURE STATEMENT
IN INTER PARTES REEXAMINATION**

Filed via EFS-Web

Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In accordance with 37 C.F.R. § 1.56, the references listed on the attached form PTO/SB/08A are being brought to the attention of the Examiner for consideration in connection with the subject reexamination application.

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8(a)(1)(i)(C)	
Date of Transmission:	<u>1/3/11</u>
I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office (USPTO) via the USPTO electronic filing system (EFS-Web) on the date shown above.	
By:	<u></u> James E. Walton

The filing of this Information Disclosure Statement shall not be construed to be a representation that a search has been conducted, nor shall it be construed as an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 C.F.R. §1.56(b).

Proof of Service:

Pursuant to 37 C.F.R. § 1.903, a true and correct copy of this Information Disclosure Statement has been served on the third-party requester. Pursuant to 37 C.F.R. § 1.248(a)(4), the undersigned hereby certifies that a true and correct copy of this Information Disclosure Statement was served on the third-party requester's attorney of record, John S. Pratt, by First Class Mail with sufficient postage at Kilpatrick Stockton LLP, 1100 Peachtree Street, Suite 2800, Atlanta, Georgia 30309-4530 on **3 January 2011**.



James E. Walton

1/3/11

Date

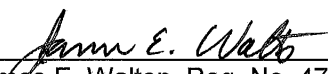
Conclusion:

No fees are deemed to be necessary; however, the undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 502806**.

Please link this application to Customer No. 50779 so that its status may be checked via the PAIR System.

Respectfully submitted,

1/3/11
Date


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CUSTOMER NO. 50779

ATTORNEY FOR PATENT OWNER



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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,104	08/12/2005	6612713	45639-316477	5847
38441	7590	01/12/2011		
LAW OFFICES OF JAMES E. WALTON, PLLC 1169 N. BURLESON BLVD. SUITE 107-328 BURLESON, TX 76028			EXAMINER RUBIN, MARGARET R	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			01/12/2011	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.



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Commissioner for Patents
United States Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Robert E. Richards
Kilpatrick Stockton LLP
1100 Peachtree Street, Suite 2800
Atlanta, GA 30309

MAILED

JAN 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/000,104.

PATENT NUMBER 6612713.

TECHNOLOGY CENTER 3900.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

PTOL-2070 (Rev.07-04)

YOT-1003-1365

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

YOT-1003-1366

Right of Appeal Notice (37 CFR 1.953)	Control No.	Patent Under Reexamination	
	95/000,104	6612713	
	Examiner	Art Unit	
	MARGARET RUBIN	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:
 Patent Owner on 9 March 2010
 Third Party(ies) on _____

Patent owner and/or third party requester(s) may file a notice of appeal with respect to any adverse decision with payment of the fee set forth in 37 CFR 41.20(b)(1) within **one-month or thirty-days (whichever is longer)**. See MPEP 2671. In addition, a party may file a notice of **cross** appeal and pay the 37 CFR 41.20(b)(1) fee **within fourteen days of service** of an opposing party's timely filed notice of appeal. See MPEP 2672.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

If no party timely files a notice of appeal, prosecution on the merits of this reexamination proceeding will be concluded, and the Director of the USPTO will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

The proposed amendment filed 9 March 2010 will be entered will not be entered*

*Reasons for non-entry are given in the body of this notice.

- 1a. Claims 1-14 and 45-74 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims 15-44 have been cancelled.
3. Claims 4,5 and 10-14 are confirmed. [Unamended patent claims].
4. Claims See Continuation Sheet are patentable. [Amended or new claims].
5. Claims 1,6,7,9,45-48,51,54,59,62-64,66-69 and 73 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable. are not acceptable.
8. The drawing correction request filed on _____ is approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d) or (f). The certified copy has:
 been received. not been received. been filed in Application/Control No. _____.
10. Other _____

Attachments

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

Continuation of 4. Claims patentable.[Amended or new claims] are: 2,3,8,49,50,52,53,55-58,60,61,65,70-72 and 74.

INTER PARTES REEXAMINATION RIGHT OF APPEAL NOTICE ("RAN")

This is a reexamination of United States Patent No. 6,612,713 ("the base patent") which issued from United States Patent Application No. 10/068,424 ("the base application"). Claims 1-14 and new claims 45-74 are subject to reexamination. Patent Owner's response to the reissued Action Closing Prosecution ("ACP") of March 2, 2010 was received on March 9, 2010. Patent Owner's March 9, 2010 response ratified Patent Owner's earlier response received on January 18, 2010. A response from the third party requester has not been received.

I. Status of Amendments after ACP

Patent Owner's timely filed amendment under 37 CFR 1.951 on January 18, 2010 which was ratified on March 9, 2010 will not be entered. Such amendments are subject to the criteria of 37 CFR 1.116(b) which is reproduced below:

"After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510,

or an action closing prosecution (§1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

- (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
- (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
- (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented."

Patent Owner has not attempted to make "a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented" as permitted under criterion 3. Criteria 1 and 2 do not permit entry because the proposed amendment would raise new issues. More particularly, despite the fact that prosecution is now closed, the proposal to amend claims 1, 6, 7, 9, 45-48, 51, 65, 67 and 73 would present these claims in a form such that they would not include subject matter that has already been indicated as allowable nor even previously considered nor

did Patent Owner offer an explanation as to how these limitations overcome the prior art except to repeatedly assert without further elaboration that "This combination of features is not disclosed in the cited references." Yet even if it were true that none of the references of record, of which there are many, identically disclose the amendatory features, Patent Owner has not addressed whether references could be obviously combined to meet the amended claims. To enter the amendment would require much more than the " cursory review by the examiner" which is advocated by MPEP 2673.

Further, entry of the amendment would necessitate additional search and a new grounds of rejection for at least claim 6. Claim 6 was rejected in the ACP of March 2, 2010 as being obvious over Phyle and Small. In an attempt to overcome this rejection, Patent Owner added to claim 6 the limitation of "a light subassembly carried by the canopy portion". This limitation does not necessitate that the light assembly is actually coupled to the umbrella apparatus nor does it necessitate that the light subassembly cooperates in any way with either the previously recited rechargeable electrical power system or the previously recited solar energy system. In fact, this limitation could be met by a flashlight that merely rests on the canopy portion.

II.) References Applied or Discussed

- 1.) PCT Patent Document WO 93/00840 (hereafter "WO 93/00840");
- 2.) U.S. Patent No. 5,349,975 to Valdner;
- 3.) U.S. Patent No. 2,960,094 to Small;
- 4.) U.S. Patent No. 6,439,249 to Pan et al (hereafter "Pan");
- 5.) U.S. Patent No. 6,126,293 to Wu;
- 6.) Japanese Patent Document JP 9-168415 (hereafter "JP 9-168415");
- 7.) U.S. Patent No. 6,270,230 to Mai;
- 8.) U.S. Patent No. 6,341,873 to Yang;
- 9.) U.S. Patent No. 5,584,564 to Phyle; and
- 10.) U.S. Patent Application Publication No. 2002/0078985 to Farr.

III.) Information Submissions

The IDS submission of October 6, 2010 and March 15, 2010 have been considered. It is noted that certain of the citations included therein were related to litigation and documents taken from the prosecution history rather than patents and printed publications. Such documents have been lined-through although the documents have been reviewed. Further, it is to be noted that where patents, publications, and other such items of information are submitted by a patent owner in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be limited by the degree to which the patent owner has explained the content and relevance of the information. In instances where no explanation of citations (items of information) is required and none is provided for an information citation, only a cursory review of that information is required. The examiner need only perform a cursory evaluation of each unexplained item of information, to the extent that he/she needs in order to determine whether he/she will evaluate the item further. If the cursory evaluation reveals the item not to be useful, the examiner may simply stop looking at it. This review may often

YOT-1003-1373

Application/Control Number: 95/000,104
Art Unit: 3992

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take the form of considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner, in this proceeding, placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent, without an indication in the record to the contrary in the record, do not signify that the information has been considered by the examiner any further than to the extent noted above. The same degree of consideration was provided for citations on earlier information submissions. See MPEP 609, seventh paragraph, Revision 5, Aug. 2006 [page 600-141].

YOT-1003-1374

IV.) Status of the Previous Rejections

1.) Claims 1, 9, 45-48, 51 and 63 were rejected under 35 U.S.C. 314(a) as enlarging the scope of the claims of the patent being reexamined.

2.) Claims 1, 45, 46, 48, 51, 54, 59, 62, 63, 66 and 73 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

3.) Claim 73 were rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840 and Valdner.

4.) Claim 1 were rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840, Small and Pan or Wu or JP 9-168415 or Mai or Yang.

5.) Claim 63 were rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840, Valdner and Phyle.

6.) Claims 6, 7, 59, 64, 67, 68 and 69 were rejected under 35 U.S.C. 103(a) as being unpatentable over Phyle and Small.

7.) Claim 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Phyle and Farr.

All of the foregoing rejections are maintained for reasons explained in sections V and VI.

V.) Rejections

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.) Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840 and Valdner.

The rejection put forth on pages 22-26 of the ACP of March 2, 2010 is incorporated herein by reference.

2.) Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840, Small and Pan or Wu or JP 9-168415 or Mai or Yang.

The rejection put forth on pages 26-32 of the ACP of March 2, 2010 is incorporated herein by reference.

YOT-1003-1376

3.) Claim 63 were rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840, Valdner and Phyle.

The rejection put forth on pages 32-35 of the ACP of March 2, 2010 is incorporated herein by reference.

4.) Claims 6, 7, 59, 64, 67, 68 and 69 were rejected under 35 U.S.C. 103(a) as being unpatentable over Phyle and Small.

The rejection put forth on pages 35-46 of the ACP of March 2, 2010 is incorporated herein by reference.

5.) Claim 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Phyle and Farr.

The rejection put forth on pages 46-48 of the ACP of March 2, 2010 is incorporated herein by reference.

Claim Rejections - 35 USC § 314(a)

Claims 1, 9, 45-48, 51 and 63 are rejected under 35 U.S.C. 314(a) as enlarging the scope of the claims of the patent being reexamined¹. 35 U.S.C. 314(a) states that "no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted" in an *inter partes* reexamination proceeding. A claim presented in a reexamination "enlarges the scope" of the patent claims where the claim is broader than the claims of the patent. A claim is broadened if it is broader in any one respect, even though it may be narrower in other respects.

The rejection put forth on pages 7-13 of the ACP of March 2, 2010 is incorporated herein by reference.

Claim Rejections - 35 USC § 112

¹ Claim 62 is not rejected as broadening the scope of the base patent claims even though "subassembly" has been substituted for "system" in the claim language because a subassembly is interpreted as a particular type of system when one employs the broadest reasonable interpretation of the terms. In other words, the substitution in question is seen as a narrowing of the claim language rather than a broadening.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 45, 46, 48, 51, 54, 59, 62, 63, 66 and 73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection put forth on pages 14-19 of the ACP of March 2, 2010 is incorporated herein by reference.

VI.) Patent Owner's Arguments

Most of Patent Owner's arguments are directed to assertions that the claims presented in the proposed amendment of March 9, 2010 and (January 18, 2010) are now in patentable form. Insofar

Application/Control Number: 95/000,104

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Art Unit: 3992

as the proposed amendments will not be entered, Patent Owner's arguments in that regard are moot.

On page 43, Patent Owner requested reopening of prosecution pursuant to MPEP 2673.01(I). Insofar as the ACP did not include a new ground of rejection, reopening prosecution is not seen to be appropriate.

YOT-1003-1380

VII.) Reasons for Confirmation/Patentability

The examiner's statement of reasons for patentability and/or confirmation of the claims provided on pages 76-81 of the ACP of March 2, 2010 is incorporated by reference.

VIII.) Conclusion

This is a RIGHT OF APPEAL NOTICE (RAN); see MPEP § 2673.02 and § 2674. The decision in this Office action as to the patentability or unpatentability of any original patent claim, any proposed amended claim and any new claim in this proceeding is a FINAL DECISION.

No amendment can be made in response to the Right of Appeal Notice in an *inter partes* reexamination. 37 CFR 1.953(c). Further, no affidavit or other evidence can be submitted in an *inter partes* reexamination proceeding after the right of appeal notice, except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1). 37 CFR 1.116(f).

Each party has a **thirty-day or one-month time period, whichever is longer**, to file a notice of appeal. The patent owner may appeal to the Board of Patent Appeals and Interferences with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1). The third party requester may appeal to the Board

of Patent Appeals and Interferences with respect to any decision favorable to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1).

In addition, a patent owner who has not filed a notice of appeal may file a notice of cross appeal within **fourteen days of service** of a third party requester's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1). A third party requester who has not filed a notice of appeal may file a **notice of cross appeal within fourteen days of service** of a patent owner's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1).

Any appeal in this proceeding must identify the claim(s) appealed, and must be signed by the patent owner (for a patent owner appeal) or the third party requester (for a third party requester appeal), or their duly authorized attorney or agent.

Any party that does not file a timely notice of appeal or a timely notice of cross appeal will lose the right to appeal from any decision adverse to that party, but will not lose the right to file a respondent brief and fee where it is appropriate for that party to do so. If no party files a timely appeal, the reexamination prosecution will be terminated, and the Director

Art Unit: 3992

will proceed to issue and publish a certificate under 37 CFR

1.997 in accordance with this Office action.

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam

Attn: Central Reexamination Unit

Commissioner for Patents

United States Patent & Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

By FAX to: (571) 273-9900

Central Reexamination Unit

By hand: Customer Service Window

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the

Application/Control Number: 95/000,104
Art Unit: 3992

Page 18

opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/Margaret Rubin/
Primary Examiner, CRU 3992



MARK J. REINHART
CRU SPE-AU 3992

Conferees:

/My-Trang N. Ton/
Primary Examiner, CRU 3992

YOT-1003-1385

Doc code: IDS
 Doc description: Information Disclosure Statement (IDS) Filed

PTO/SB/08a (07-09)
 Approved for use through 07/31/2012. OMB 0651-0031
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
 Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95000104
	Filing Date	2003-09-02
	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret Wambach Rubin
	Attorney Docket Number	0664MH-40982-REX

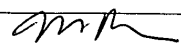
U.S.PATENTS								
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear		
	1	3129715		1964-04-21	Vincent Militano, et al.			
	2	4540929		1985-09-10	Bruce Binkley, et al.			
	3	5141010		1992-08-25	Richard Muller, et al.			
If you wish to add additional U.S. Patent citation information please click the Add button.								
U.S.PATENT APPLICATION PUBLICATIONS								
Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear		
	1							
If you wish to add additional U.S. Published Application citation information please click the Add button.								
FOREIGN PATENT DOCUMENTS								
Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ² j	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1							<input type="checkbox"/>

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95000104
	Filing Date	2003-09-02
	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret Wendrich Rubin
Attorney Docket Number	0664MH-40982-REX	

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NON-PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
	1	Interview Summary dated 2010-04-05 from corresponding Application No. 12/240,845	<input type="checkbox"/>
	2	Amendment dated 2010-04-09 from corresponding Application No. 12/240,845	<input type="checkbox"/>
	3	Final Office Action dated 2010-07-06 from corresponding Application No. 12/240,845	<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

EXAMINER SIGNATURE			
Examiner Signature		Date Considered	1/6/11

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

PTO/SB/08a (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95000104
	Filing Date	2003-09-02
	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret Wambach Rubin
	Attorney Docket Number	0664MH-40982-REX

U.S.PATENTS								
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear		
	1							
If you wish to add additional U.S. Patent citation information please click the Add button.								
U.S.PATENT APPLICATION PUBLICATIONS								
Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear		
	1							
If you wish to add additional U.S. Published Application citation information please click the Add button.								
FOREIGN PATENT DOCUMENTS								
Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ²	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1							<input type="checkbox"/>
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NON-PATENT LITERATURE DOCUMENTS								
Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.						T ⁵

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95000104
	Filing Date	2003-09-02
	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret W. [unclear] Ruby
Attorney Docket Number	0664MH-40982-REX	

1	Office Action dated 2010-01-13 from 12/240,845	<input type="checkbox"/>
2	Examiner's Answer Dated 2009-12-09 from 10/650,537	<input type="checkbox"/>
3	Reply Brief dated 2010-02-09 from 10/650,537	<input type="checkbox"/>
4	Notice of Allowance dated 2010-03-09 from 12/255,255	<input type="checkbox"/>


If you wish to add additional non-patent literature document citation information please click the Add button

EXAMINER SIGNATURE

Examiner Signature		Date Considered	1/6/11
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

Reexamination 	Application/Control No. 95/000,104	Applicant(s)/Patent Under Reexamination 6612713
	Certificate Date	Certificate Number

Requester Correspondence Address: <input type="checkbox"/> Patent Owner <input checked="" type="checkbox"/> Third Party
Robert E. Richards Kilpatrick Stockton LLP 1100 Peachtree Street, Suite 2800 Atlanta, GA 30309

LITIGATION REVIEW <input checked="" type="checkbox"/>	MR <small>(examiner initials)</small>	1/6/11 <small>(date)</small>
Case Name	Director Initials	
World Factory Inc v. Southern Sales and Marketing Group Inc U.S. District Court - Texas Northern (Fort Worth) 4:05cv373	<i>MR for IY</i>	
World Factory Inc v. Bond Manufacturing Co U.S. District Court - Texas Northern (Fort Worth) 4:05cv374	↓	

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TYPE OF PROCEEDING	NUMBER
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Robert E. Richards
Kilpatrick Stockton LLP
1100 Peachtree Street, Suite 2800
Atlanta, GA 30309

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/000,104.

PATENT NUMBER 6612713.

TECHNOLOGY CENTER 3900.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,104	08/12/2005	6612713	45639-316477	5847
38441	7590	01/12/2011		
LAW OFFICES OF JAMES E. WALTON, PLLC 1169 N. BURLESON BLVD. SUITE 107-328 BURLESON, TX 76028			EXAMINER RUBIN, MARGARET R	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			01/12/2011	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.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Robert E. Richards

Kilpatrick Stockton LLP

1100 Peachtree Street, Suite 2800

Atlanta, GA 30309

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester *Inter Partes* Reexamination

REEXAMINATION CONTROL NUMBER 95/000,104.

PATENT NUMBER 6612713.

TECHNOLOGY CENTER 3900.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

PTOL-2070 (Rev.07-04)

YOT-1003-1395

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

YOT-1003-1396

Right of Appeal Notice (37 CFR 1.953)	Control No.	Patent Under Reexamination	
	95/000,104	6612713	
	Examiner	Art Unit	
	MARGARET RUBIN	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:
Patent Owner on 9 March 2010
Third Party(ies) on _____

Patent owner and/or third party requester(s) may file a notice of appeal with respect to any adverse decision with payment of the fee set forth in 37 CFR 41.20(b)(1) within **one-month or thirty-days (whichever is longer)**. See MPEP 2671. In addition, a party may file a notice of **cross** appeal and pay the 37 CFR 41.20(b)(1) fee **within fourteen days of service** of an opposing party's timely filed notice of appeal. See MPEP 2672.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

If no party timely files a notice of appeal, prosecution on the merits of this reexamination proceeding will be concluded, and the Director of the USPTO will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

The proposed amendment filed 9 March 2010 will be entered will not be entered*

*Reasons for non-entry are given in the body of this notice.

- 1a. Claims 1-14 and 45-74 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims 15-44 have been cancelled.
3. Claims 4,5 and 10-14 are confirmed. [Unamended patent claims].
4. Claims See Continuation Sheet are patentable. [Amended or new claims].
5. Claims 1,6,7,9,45-48,51,54,59,62-64,66-69 and 73 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable. are not acceptable.
8. The drawing correction request filed on _____ is approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d) or (f). The certified copy has:
 been received. not been received. been filed in Application/Control No. _____.
10. Other _____

Attachments

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

Continuation of 4. Claims patentable. [Amended or new claims] are: 2,3,8,49,50,52,53,55-58,60,61,65,70-72 and 74.

INTER PARTES REEXAMINATION RIGHT OF APPEAL NOTICE ("RAN")

This is a reexamination of United States Patent No. 6,612,713 ("the base patent") which issued from United States Patent Application No. 10/068,424 ("the base application"). Claims 1-14 and new claims 45-74 are subject to reexamination. Patent Owner's response to the reissued Action Closing Prosecution ("ACP") of March 2, 2010 was received on March 9, 2010. Patent Owner's March 9, 2010 response ratified Patent Owner's earlier response received on January 18, 2010. A response from the third party requester has not been received.

I. Status of Amendments after ACP

Patent Owner's timely filed amendment under 37 CFR 1.951 on January 18, 2010 which was ratified on March 9, 2010 will not be entered. Such amendments are subject to the criteria of 37 CFR 1.116(b) which is reproduced below:

"After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510,

Art Unit: 3992

or an action closing prosecution (§1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented."

Patent Owner has not attempted to make "a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented" as permitted under criterion 3. Criteria 1 and 2 do not permit entry because the proposed amendment would raise new issues. More particularly, despite the fact that prosecution is now closed, the proposal to amend claims 1, 6, 7, 9, 45-48, 51, 65, 67 and 73 would present these claims in a form such that they would not include subject matter that has already been indicated as allowable nor even previously considered nor

YOT-1003-1400

did Patent Owner offer an explanation as to how these limitations overcome the prior art except to repeatedly assert without further elaboration that "This combination of features is not disclosed in the cited references." Yet even if it were true that none of the references of record, of which there are many, identically disclose the amendatory features, Patent Owner has not addressed whether references could be obviously combined to meet the amended claims. To enter the amendment would require much more than the "cursory review by the examiner" which is advocated by MPEP 2673.

Further, entry of the amendment would necessitate additional search and a new grounds of rejection for at least claim 6. Claim 6 was rejected in the ACP of March 2, 2010 as being obvious over Phyle and Small. In an attempt to overcome this rejection, Patent Owner added to claim 6 the limitation of "a light subassembly carried by the canopy portion". This limitation does not necessitate that the light assembly is actually coupled to the umbrella apparatus nor does it necessitate that the light subassembly cooperates in any way with either the previously recited rechargeable electrical power system or the previously recited solar energy system. In fact, this limitation could be met by a flashlight that merely rests on the canopy portion.

II.) References Applied or Discussed

- 1.) PCT Patent Document WO 93/00840 (hereafter "WO 93/00840");
- 2.) U.S. Patent No. 5,349,975 to Valdner;
- 3.) U.S. Patent No. 2,960,094 to Small;
- 4.) U.S. Patent No. 6,439,249 to Pan et al (hereafter "Pan");
- 5.) U.S. Patent No. 6,126,293 to Wu;
- 6.) Japanese Patent Document JP 9-168415 (hereafter "JP 9-168415");
- 7.) U.S. Patent No. 6,270,230 to Mai;
- 8.) U.S. Patent No. 6,341,873 to Yang;
- 9.) U.S. Patent No. 5,584,564 to Phyle; and
- 10.) U.S. Patent Application Publication No. 2002/0078985 to Farr.

III.) Information Submissions

The IDS submission of October 6, 2010 and March 15, 2010 have been considered. It is noted that certain of the citations included therein were related to litigation and documents taken from the prosecution history rather than patents and printed publications. Such documents have been lined-through although the documents have been reviewed. Further, it is to be noted that where patents, publications, and other such items of information are submitted by a patent owner in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be limited by the degree to which the patent owner has explained the content and relevance of the information. In instances where no explanation of citations (items of information) is required and none is provided for an information citation, only a cursory review of that information is required. The examiner need only perform a cursory evaluation of each unexplained item of information, to the extent that he/she needs in order to determine whether he/she will evaluate the item further. If the cursory evaluation reveals the item not to be useful, the examiner may simply stop looking at it. This review may often

YOT-1003-1403

Application/Control Number: 95/000,104
Art Unit: 3992

Page 7

take the form of considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner, in this proceeding, placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent, without an indication in the record to the contrary in the record, do not signify that the information has been considered by the examiner any further than to the extent noted above. The same degree of consideration was provided for citations on earlier information submissions. See MPEP 609, seventh paragraph, Revision 5, Aug. 2006 [page 600-141].

YOT-1003-1404

V.) Rejections

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.) Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840 and Valdner.

The rejection put forth on pages 22-26 of the ACP of March 2, 2010 is incorporated herein by reference.

2.) Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840, Small and Pan or Wu or JP 9-168415 or Mai or Yang.

The rejection put forth on pages 26-32 of the ACP of March 2, 2010 is incorporated herein by reference.

3.) Claim 63 were rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/00840, Valdner and Phyle.

The rejection put forth on pages 32-35 of the ACP of March 2, 2010 is incorporated herein by reference.

4.) Claims 6, 7, 59, 64, 67, 68 and 69 were rejected under 35 U.S.C. 103(a) as being unpatentable over Phyle and Small.

The rejection put forth on pages 35-46 of the ACP of March 2, 2010 is incorporated herein by reference.

5.) Claim 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Phyle and Farr.

The rejection put forth on pages 46-48 of the ACP of March 2, 2010 is incorporated herein by reference.

Claim Rejections - 35 USC § 314(a)

Claims 1, 9, 45-48, 51 and 63 are rejected under 35 U.S.C. 314(a) as enlarging the scope of the claims of the patent being reexamined¹. 35 U.S.C. 314(a) states that "no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted" in an *inter partes* reexamination proceeding. A claim presented in a reexamination "enlarges the scope" of the patent claims where the claim is broader than the claims of the patent. A claim is broadened if it is broader in any one respect, even though it may be narrower in other respects.

The rejection put forth on pages 7-13 of the ACP of March 2, 2010 is incorporated herein by reference.

Claim Rejections - 35 USC § 112

¹ Claim 62 is not rejected as broadening the scope of the base patent claims even though "subassembly" has been substituted for "system" in the claim language because a subassembly is interpreted as a particular type of system when one employs the broadest reasonable interpretation of the terms. In other words, the substitution in question is seen as a narrowing of the claim language rather than a broadening.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 45, 46, 48, 51, 54, 59, 62, 63, 66 and 73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection put forth on pages 14-19 of the ACP of March 2, 2010 is incorporated herein by reference.

VI.) Patent Owner's Arguments

Most of Patent Owner's arguments are directed to assertions that the claims presented in the proposed amendment of March 9, 2010 and (January 18, 2010) are now in patentable form. Insofar

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Page 13

Art Unit: 3992

as the proposed amendments will not be entered, Patent Owner's arguments in that regard are moot.

On page 43, Patent Owner requested reopening of prosecution pursuant to MPEP 2673.01(I). Insofar as the ACP did not include a new ground of rejection, reopening prosecution is not seen to be appropriate.

YOT-1003-1409

VII.) Reasons for Confirmation/Patentability

The examiner's statement of reasons for patentability and/or confirmation of the claims provided on pages 76-81 of the ACP of March 2, 2010 is incorporated by reference.

VIII.) Conclusion

This is a RIGHT OF APPEAL NOTICE (RAN); see MPEP § 2673.02 and § 2674. The decision in this Office action as to the patentability or unpatentability of any original patent claim, any proposed amended claim and any new claim in this proceeding is a FINAL DECISION.

No amendment can be made in response to the Right of Appeal Notice in an *inter partes* reexamination. 37 CFR 1.953(c). Further, no affidavit or other evidence can be submitted in an *inter partes* reexamination proceeding after the right of appeal notice, except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1). 37 CFR 1.116(f).

Each party has a **thirty-day or one-month time period, whichever is longer**, to file a notice of appeal. The patent owner may appeal to the Board of Patent Appeals and Interferences with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1). The third party requester may appeal to the Board

of Patent Appeals and Interferences with respect to any decision favorable to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1).

In addition, a patent owner who has not filed a notice of appeal may file a notice of cross appeal within **fourteen days of service** of a third party requester's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1). A third party requester who has not filed a notice of appeal may file a **notice of cross appeal within fourteen days of service** of a patent owner's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1).

Any appeal in this proceeding must identify the claim(s) appealed, and must be signed by the patent owner (for a patent owner appeal) or the third party requester (for a third party requester appeal), or their duly authorized attorney or agent.

Any party that does not file a timely notice of appeal or a timely notice of cross appeal will lose the right to appeal from any decision adverse to that party, but will not lose the right to file a respondent brief and fee where it is appropriate for that party to do so. If no party files a timely appeal, the reexamination prosecution will be terminated, and the Director

Art Unit: 3992

will proceed to issue and publish a certificate under 37 CFR
1.997 in accordance with this Office action.

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam

Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900

Central Reexamination Unit

By hand: Customer Service Window

Randolph Building
401 Dulany Street
Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the

Application/Control Number: 95/000,104
Art Unit: 3992

Page 18

opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/Margaret Rubin/
Primary Examiner, CRU 3992



MARK J. REINHART
CRU SPE-AU 3992

Conferees:

/My-Trang N. Ton/
Primary Examiner, CRU 3992

YOT-1003-1414

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

PTO/SB/08a (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95000104
	Filing Date	2003-09-02
	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret Wambach <i>Rubin</i>
	Attorney Docket Number	0664MH-40982-REX

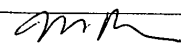
U.S.PATENTS								
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear		
	1	3129715		1964-04-21	Vincent Militano, et al.			
	2	4540929		1985-09-10	Bruce Binkley, et al.			
	3	5141010		1992-08-25	Richard Muller, et al.			
If you wish to add additional U.S. Patent citation information please click the Add button.								
U.S.PATENT APPLICATION PUBLICATIONS								
Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear		
	1							
If you wish to add additional U.S. Published Application citation information please click the Add button.								
FOREIGN PATENT DOCUMENTS								
Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ² j	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1							<input type="checkbox"/>

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95000104
	Filing Date	2003-09-02
	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret W... Rubin
	Attorney Docket Number	0664MH-40982-REX

If you wish to add additional Foreign Patent Document citation information please click the Add button

NON-PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
	1	Interview Summary dated 2010-04-05 from corresponding Application No. 12/240,845	<input type="checkbox"/>
	2	Amendment dated 2010-04-09 from corresponding Application No. 12/240,845	<input type="checkbox"/>
	3	Final Office Action dated 2010-07-06 from corresponding Application No. 12/240,845	<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

EXAMINER SIGNATURE			
Examiner Signature		Date Considered	1/6/11

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

PTO/SB/08a (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	95000104
	Filing Date	2003-09-02
	First Named Inventor	GREGORY G. KUELBS
	Art Unit	3992
	Examiner Name	Margaret Winkler Rubin
	Attorney Docket Number	0664MH-40982-REX

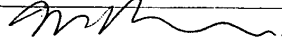
U.S. PATENTS								
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear		
	1							
If you wish to add additional U.S. Patent citation information please click the Add button.								
U.S. PATENT APPLICATION PUBLICATIONS								
Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear		
	1							
If you wish to add additional U.S. Published Application citation information please click the Add button.								
FOREIGN PATENT DOCUMENTS								
Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ²	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1							<input type="checkbox"/>
If you wish to add additional Foreign Patent Document citation information please click the Add button								
NON-PATENT LITERATURE DOCUMENTS								
Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.						T ⁵

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		95000104
	Filing Date		2003-09-02
	First Named Inventor	GREGORY G. KUELBS	
	Art Unit	3992	
	Examiner Name	Margaret W. Rubin Rubin	
Attorney Docket Number		0664MH-40982-REX	

1	Office Action dated 2010-01-13 from 12/240,845	<input type="checkbox"/>
2	Examiner's Answer dated 2009-12-09 from 10/650,537	<input type="checkbox"/>
3	Reply Brief dated 2010-02-09 from 10/650,537	<input type="checkbox"/>
4	Notice of Allowance dated 2010-03-09 from 12/255,255	<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

EXAMINER SIGNATURE

Examiner Signature		Date Considered	1/6/11
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Reexamination of:)
Gregory G. Kuelbs)
Control No. **95/000,104**) Examiner: **Margaret Rubin**
Patent No.: **6,612,713**) Art Unit: **3992**
Issued: **September 2, 2003**) Confirmation No: **5847**
Assignee: **WORLD FACTORY, INC.**)


NOTICE OF APPEAL OF THIRD-PARTY REQUESTER UNDER 37 CFR 41.61(a)(2)

Pursuant to the Notice of Right to Appeal issued by the examiner on January 12, 2011, SOUTHERN SALES & MARKETING, INC., the third-party requestor/appellant, files this Notice of Appeal of the examiner's determination favorable to patentability of Claims 2-5, 8, 10-14, 49, 50, 52, 53, 55-58, 60, 61, 65, 70-72, and 74.

The Notice of Right to Appeal sets a date of one month or thirty days (whichever is longer) from the date of the Notice of Right to Appeal within which to file this Notice of Appeal. This Notice of Appeal is filed prior to the deadline, February 12, 2011.

The appellant is a small entity. The fee for a small entity as set forth in 37 CFR § 41.20(b)(1) is \$270.00 and is being paid herewith. The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 11-0855.

This Notice of Appeal is signed by a duly authorized attorney of the appellant.



Larry A. Roberts
Reg. No. 31,871

Kilpatrick Townsend & Stockton, LLP
1100 Peachtree Street | Suite 2800
Atlanta, GA 30309-4530
(404) 745-2409

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Reexamination of:)
Gregory G. Kuelbs)
Control No. **95/000,104**) Examiner: **Margaret Rubin**
Patent No.: **6,612,713**) Art Unit: **3992**
Issued: **September 2, 2003**)
Assignee: **WORLD FACTORY, INC.**)

CERTIFICATE OF SERVICE

I have this day served a true and correct copies of the foregoing "Notice of Appeal of Requester under 37 CFR 41.61(a)(2)" by depositing same in the United States mail, properly addressed with sufficient first class postage affixed thereto to ensure delivery to:

James E. Walton, Esq.
1169 N. Burleson Boulevard
Suite 107-328
Burleson, Texas 76028

This 10th day of February, 2011.


Larry A. Roberts

Electronic Patent Application Fee Transmittal				
Application Number:	95000104			
Filing Date:	12-Aug-2005			
Title of Invention:	UMBRELLA APPARATUS			
First Named Inventor/Applicant Name:	6612713			
Filer:	Larry A. Roberts./Andrea Cummings			
Attorney Docket Number:	45639-316477			
Filed as Small Entity				
inter partes reexam Filing Fees				
Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Notice of appeal	2401	1	270	270
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:	YOT-1003-1421			

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Total in USD (\$)				270

Electronic Acknowledgement Receipt	
EFS ID:	9418027
Application Number:	95000104
International Application Number:	
Confirmation Number:	5847
Title of Invention:	UMBRELLA APPARATUS
First Named Inventor/Applicant Name:	6612713
Customer Number:	38441
Filer:	Larry A. Roberts./Andrea Cummings
Filer Authorized By:	Larry A. Roberts.
Attorney Docket Number:	45639-316477
Receipt Date:	10-FEB-2011
Filing Date:	12-AUG-2005
Time Stamp:	14:33:44
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	yes
Payment Type	Credit Card
Payment was successfully received in RAM	\$ 270
RAM confirmation Number	813
Deposit Account	
Authorized User	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part / .zip YOT-1003-1423	Pages (if appl.)

1		316477_notice.pdf	125586 1b88bb77b86b08784501c4fdb157f47381733c90	yes	2
Multipart Description/PDF files in .zip description					
		Document Description	Start	End	
		Notice of Cross Appeal - Third Party Requester	1	1	
		Reexam Certificate of Service	2	2	
Warnings:					
Information:					
2	Fee Worksheet (PTO-875)	fee-info.pdf	29684 d09ba459d040bbf8aee2727787888f959a67d3bd	no	2
Warnings:					
Information:					
Total Files Size (in bytes):			155270		
<p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p><u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p>					

YOT-1003-1424

Litigation Search Report CRU 3999

Reexam Control No. 95/000,104

To: Margaret Rubin
Art Unit: 3992
Date: 03/11/11

Case Serial Number: 95/000,104

From: Karen L. Ward
Location: CRU 3999
MDW 7C76
Phone: (571) 272-7932

Karen.Ward@uspto.gov

Search Notes

Litigation was found involving U.S. Patent No. 6,612,713.

4:05CV373 – YES

4:05CV374 – YES

- 1) I performed a KeyCite Search in Westlaw, which retrieves all history on the patent including any litigation.
- 2) I performed a search on the patent in Lexis CourtLink for any open dockets or closed cases.
- 3) I performed a search in Lexis in the Federal Courts and Administrative Materials databases for any cases found.
- 4) I performed a search in Lexis in the IP Journal and Periodicals database for any articles on the patent.
- 5) I performed a search in Lexis in the news databases for any articles about the patent or any articles about litigation on this patent.

YOT-1003-1425



Date of Printing: Mar 11, 2011

KEYCITE

C US PAT 6612713 UMBRELLA APPARATUS, Assignee: World Factory, Inc. (Sep 02, 2003)

History

Direct History

=> 1 UMBRELLA APPARATUS, US PAT 6612713, 2003 WL 22044809 (U.S. PTO Utility Sep 02, 2003) (NO. 10/068424)

Patent Family

2 UMBRELLA APPARATUS FOR LAWNS, HAS SOLAR ENERGY SYSTEM CONDUCTIVELY COUPLED TO RECHARGEABLE ELECTRICAL POWER SYSTEM FOR CONVERTING SOLAR ENERGY INTO ELECTRICAL ENERGY AND CHARGER FOR RECHARGING POWER SYSTEM, Derwent World Patents Legal 2003-895364

Assignments

3 ACTION: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS). NUMBER OF PAGES: 002, (DATE RECORDED: Feb 07, 2002)

Patent Status Files

.. Request for Re-Examination, (OG DATE: Sep 27, 2005)
.. Patent Suit(See LitAlert Entries),
.. Patent Suit(See LitAlert Entries),

Docket Summaries

7 WORLD FACTORY INC v. BOND MANUFACTURING CO, (N.D.TEX. Jun 13, 2005) (NO. 4:05CV00374), (35 USC 145 PATENT INFRINGEMENT)
8 WORLD FACTORY INC v. SOUTHERN SALES AND MARKETING GROUP INC, (N.D.TEX. Jun 13, 2005) (NO. 4:05CV00373), (35 USC 145 PATENT INFRINGEMENT)

Litigation Alert

9 Derwent LitAlert P2005-42-24 (Jun 13, 2005) Action Taken: A complaint was filed
10 Derwent LitAlert P2005-42-26 (Jun 13, 2005) Action Taken: A complaint was filed

Prior Art (Coverage Begins 1976)

C 11 AIR COOLED UMBRELLA, US PAT 5349975 (U.S. PTO Utility 1994)

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YOT-1003-1426

<http://web2.westlaw.com/print/printstream.aspx?prft=HTMLE&pbcb=BC6E23F9&vr=2.0&...> 3/11/2011

- C 12 COMBINATION CANOPY AND FAN, US PAT 5172711 (U.S. PTO Utility 1992)
- C 13 ILLUMINATED UMBRELLA OR PARASOL, US PAT 5126922 (U.S. PTO Utility 1992)
- C 14 UMBRELLA, US PAT 5273062 (U.S. PTO Utility 1993)
- C 15 UMBRELLA WITH A LIGHT SOURCE AND LIGHT REFRACTING MEANS, US PAT 5463536 (U.S. PTO Utility 1995)

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YOT-1003-1427

<http://web2.westlaw.com/print/printstream.aspx?prft=HTML&pb=BC6E23F9&vr=2.0&...> 3/11/2011

US District Court Civil Docket

**U.S. District - Texas Northern
(Fort Worth)**

4:05cv373

World Factory Inc v. Southern Sales And Marketing Group Inc

This case was retrieved from the court on Friday, July 30, 2010

Date Filed: 06/13/2005 **Class Code: CLOSED**
Assigned To: Judge John McBryde **Closed: Yes**
Referred To: **Statute: 35:145**
Nature of suit: Patent (830) **Jury Demand: Plaintiff**
Cause: Patent Infringement **Demand Amount: \$0**
Lead Docket: None **NOS Description: Patent**
Other Docket: None
Jurisdiction: Federal Question

Litigants

Attorneys

World Factory Inc
Plaintiff

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Suite 2500
Fort Worth , TX 76102-3194
USA
817/ 332-2500
Fax: 817/ 878-9280 Fax
Email: Marshall_searcy@khh.com

Southern Sales And Marketing Group Inc Doing Business
as Southern Patio
Defendant

Date #

Proceeding Text

YOT-1003-1428

<https://w3.courtlink.lexisnexis.com/ControlSupport/UserControls/ShowDocket.aspx?Key=...> 3/11/2011

06/13/2005	2	CERTIFICATE OF INTERESTED PERSONS/DISCLOSURE STATEMENT by World Factory Inc. (mjw,) (Entered: 06/14/2005)
06/13/2005	3	Summons Issued as to Southern Sales and Marketing Group Inc. (mjw,) (Entered: 06/14/2005)
06/13/2005	4	Mailing of Patent and Trademark Infringement Notice to Director in Alexandria VA (mjw,) (Entered: 06/14/2005)
06/13/2005	5	CIVIL COVER SHEET filed by World Factory Inc. (mjw,) (Entered: 06/15/2005)
06/14/2005	1	COMPLAINT AND JURY DEMAND against Southern Sales and Marketing Group Inc (Filing fee \$250; Receipt number 53004), filed by World Factory Inc.(mjw,) (Entered: 06/14/2005)
01/04/2006	6	ORDER:...Ordered that on/before 1/18/06 pltf. World Factory Inc file either proof of proper svc. of summons/complaint on deft. or instrument containing satisfactory explanation in affidavit form as to why such proof can't be filed; if pltf. fails to comply court will consider dismissal w/o further notice of pltf's claims... (Signed by Judge John McBryde on 1/4/06) (pdm,) (Entered: 01/04/2006)
01/06/2006	7	Voluntary Dismissal Pursuant to Rule 41(a)(1) by World Factory Inc (pdm,) (Entered: 01/06/2006)
01/09/2006	8	ORDER:...Ordered all claims and causes of action asserted by pltf against deft. dismissed w/o prejudice (Signed by Judge John McBryde on 1/9/06) (pdm,) (Entered: 01/09/2006)
01/09/2006	9	Final JUDGMENT... Ordered all claims and causes of action asserted by pltf against deft. dismissed w/o prejudice (Signed by Judge John McBryde on 1/9/06) (pdm,) (Entered: 01/09/2006)

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YOT-1003-1429

<https://w3.courtlink.lexisnexis.com/ControlSupport/UserControls/ShowDocket.aspx?Key=...> 3/11/2011

US District Court Civil Docket

**U.S. District - Texas Northern
(Fort Worth)**

4:05cv374

World Factory Inc v. Bond Manufacturing Co

This case was retrieved from the court on Friday, July 30, 2010

Date Filed: 06/13/2005 **Class Code: CLOSED**
Assigned To: Judge John McBryde **Closed: Yes**
Referred To: **Statute: 35:145**
Nature of suit: Patent (830) **Jury Demand: Plaintiff**
Cause: Patent Infringement **Demand Amount: \$0**
Lead Docket: None **NOS Description: Patent**
Other Docket: None
Jurisdiction: Federal Question

Litigants

Attorneys

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Plaintiff

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Marshall M Searcy
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Fax: 817/ 878-9280 Fax
Email: Marshall_searcy@khh.com

Bond Manufacturing Co
Defendant

Date #

Proceeding Text

YOT-1003-1430

<https://w3.courtlink.lexisnexis.com/ControlSupport/UserControls/ShowDocket.aspx?Key=...> 3/11/2011

06/13/2005	1	COMPLAINT against Bond Manufacturing Co (Filing fee \$250; Receipt number 53005), filed by World Factory Inc.(jmb,) (Entered: 06/14/2005)
06/13/2005	--	DEMAND for Trial by Jury by World Factory Inc. (jmb,)on face of complaint (Entered: 06/14/2005)
06/13/2005	2	CERTIFICATE OF INTERESTED PERSONS/DISCLOSURE STATEMENT by World Factory Inc. (jmb,) (Entered: 06/14/2005)
06/14/2005	3	Summons Issued as to Bond Manufacturing Co. (jmb,) (Entered: 06/14/2005)
06/14/2005	4	NOTICE of patent filing mailed to US Patent and Trademark Office(jmb,) (Entered: 06/14/2005)
11/14/2005	5	ORDER: that on before Nov 28, 2005, pla file either proof of proper service of summons and complaint on dft, or an instrument containing a satisfactory explanation, in affidavit form, as to why such proof cannot be filed. (Signed by Judge John McBryde on 11/14/05) (mjw,) (Entered: 11/15/2005)
11/21/2005	6	VOLUNTARY DISMISSAL PURSUANT TO RULE 41(a)(1) by World Factory Inc (mjw,) (Entered: 11/21/2005)
11/21/2005	7	FINAL JUDGMENT...dismissed without prejudice. (Signed by Judge John McBryde on 11/21/05) (mjw,) (Entered: 11/22/2005)

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YOT-1003-1431

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Terms: **6612713** (Edit Search | Suggest Terms for My Search)

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- 1. 7824061, November 2, 2010, Rechargeable battery powered cordless lamps, Riedfort, Robert A., 19720 N. 83rd Dr., Peoria, ARIZONA , United States of America (US), 85382, United States of America(US); Riedfort, Karen A., 19720 N. 83rd Dr., Phoenix, ARIZONA , United States of America(US), 95382, United States of America (US); 082391, RIEDFORT ROBERT A; RIEDFORT KAREN A

CORE TERMS: lamp, battery, timer, electrical, pack, pole, variant, cordless, outlet, user, electrical communication, light bulbs, controller, sensor, cord, rechargeable, recharger, remote, optionally, furniture, powered, display, numeral, actuate, outdoor, dimmer, switch, button, floor, bulb

... September 3, 2002, Rudenberg, United States of America (US) **6612713**, September 2, 2003, Kuelbs, United States of America (US) ...

- 2. 7789459, September 7, 2010, Octagonal patio picnic table with accessories, Rodriguez, Adriana, 3897 State Road 64 E., Wauchula, FLORIDA, United States of America(US), 33873, United States of America(US); Rodriguez, Victor, 3897 State Road 64 E., Wauchula, FLORIDA, United States of America(US), 33873, United States of America(US); 074743, RODRIGUEZ ADRIANA; RODRIGUEZ VICTOR

CORE TERMS: roof, umbrella, picnic, cup, octagonal, storage, holder, patio, seat, electrical, glass, duplex, outlet, lighting, accessory, shelf, hanger, integral, wiring, tabletop, envisioned, fastener, rack, plug, invention described, seating, wooden, male, convenient, feet

... 2002, Isensee et al., United States of America (US) **6612713**, September 2, 2003, Kuelbs, United States of America (US) ...

- 3. 7753546, July 13, 2010, Umbrella apparatus, Kuelbs, Gregory G., Westlake, TEXAS, United States of America(US), United States of America(US); 255255, October 29, 2008, ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., WORLD FACTORY, INC., 306 AIRLINE DRIVE, SUITE 200, COPPELL, TEXAS, UNITED STATES OF AMERICA(US), 75019-4670, reel-frame:021752/0802, World Factory, Inc., Coppel, TEXAS, United States of America(US), United States company or corporation

CORE TERMS: umbrella, battery, pole, module, rib, lighting, lamp, solar, electrical, pack, charger, rechargeable, installed, coupled, crank, cold cathode tube, closing, power source, switch, wire, bulb, conductively, cell, interior, canopy, cooling, utilized, lens, hollow, wiring

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http://www.lexis.com/research/retrieve?_m=61cd191102f42bd8a6d70f4054d86d82&csvc=... 3/11/2011

... Ser. No. 10068424, February 7, 2002, GRANTED **6612713** Provisional Application Ser. No. 60267018, February 7, ...
 ... July 29, 2003, Li, United States of America (US) **6612713**, September 2, 2003, Kuelbs, United States of America (US) ...

4. 7614600, November 10, 2009, Umbrella base with power supply, Smith, James C., Hayward, CALIFORNIA , United States of America(US), United States of America (US); Taylor, David J., 129 Sugar Creek La., Alamo, CALIFORNIA , United States of America(US), 94507, United States of America(US); 021487, February 1, 2007, ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., TAYLOR, DAVID J., 129 SUGAR CREEK LANE, ALAMO, CALIFORNIA, UNITED STATES OF AMERICA(US), 94507, reel-frame:018837/0247, Taylor, David J., Alamo, CALIFORNIA , United States of America(US), United States individual, May 11, 2010, ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., ROLLING UMBRELLAS, LLC, 484 DIABLO ROAD, DANVILLE, CALIFORNIA, UNITED STATES OF AMERICA(US), 94526, reel-frame:024369/0016

CORE TERMS: umbrella, housing, ballast, billboard, screw, cavity, pipe, advertising, user, console, caster, battery, wheel, perimeter, power source, electrical, sleeve, cover plate, foot, container, patio, shaft, locking, nut, suitably, filled, cam, sidewall, cam-screw, latch

... July 29, 2003, Li, United States of America (US) **6612713**, September 2, 2003, Kuelbs, United States of America (US) ...

5. 7604015, October 20, 2009, Umbrella having structural rib configured to receive electrical components and associated wiring, Fraser, Joseph, Woodstock, GEORGIA, United States of America(US), United States of America(US); 241889, December 10, 2008, ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., SOUTHERN SALES & MARKETING GROUP, INC., 4400 COMMERCE CIRCLE, ATLANTA, GEORGIA, UNITED STATES OF AMERICA(US), 30336, reel-frame:021953/0007, Southern Sales & Marketing Group, Inc., Atlanta, GEORGIA, United States of America(US), United States company or corporation, October 22, 2009, NOTICE OF GRANT OF SECURITY INTEREST IN PATENTS, PNC BANK, NATIONAL ASSOCIATION, AS AGENT, SUITE 890, 600 GALLERIA PARKWAY, ATLANTA, GEORGIA, UNITED STATES OF AMERICA(US), 30339, reel-frame:023401/0799

CORE TERMS: umbrella, rib, electrical, channel, web, canopy, configured, conductor, hole, battery, panel, upstanding, convenient, solar, upper side, elongated, lighting, coaxial, wiring, light bulb, outdoor, casing, patio, upper surface, intermediate, energy, weathering, underneath, alignment, insulated

... July 29, 2003, Li, United States of America (US) **6612713**, September 2, 2003, Kuelbs, United States of America (US) ...

... F.R. §1.131 and Exhibits; Reexamination of Pat. No. **6612713**; submitted Jan. 29, 2007.

6. 7562667, July 21, 2009, Outdoor umbrella with solar power supply, Li, Wanda Ying, 121 E. Alton, Santa Ana, California, 92707, United States(US); 325058,

CORE TERMS: umbrella, solar, lighting, collecting, awning, outdoor, energy, housing, storage battery, arm, electrical, solar power, battery, stem, connecting, switch, user, illuminating, sunlight, mounting, electrically, electricity, illumination, shielding, pivotally, convert, zone, foldable, slidably, slot

... 2002, Pan et al., United States (US), 135#16 **6612713**, September, 2003,

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http://www.lexis.com/research/retrieve?_m=61cd191102f42bd8a6d70f4054d86d82&csvc=... 3/11/2011

Kuelbs, United States (US), 362#102 6666224, ...

7. 7533679, May 19, 2009, Covering with rib lighting arrangement, Harbaugh, Kenneth A., 1000 Overlook Dr., Villa Rica, Georgia, 30180, United States(US); 381070,

CORE TERMS: bulb, holder, rib, globe, light source, covering, hole, elongated, protrusion, umbrella, flange, ridge, intermediate, lighting, gazebo, deformable, installed, resilient, upward, outwardly, arm, longitudinal, configured, channel, accidentally, becoming, detached, outward, groove, light bulb

... 6598990, July, 2003, Li, United States (US), 362#353 **6612713**, September, 2003, Kuelbs, United States (US), 362#353 6666224, ...

... F.R. §1.131 and Exhibits; Reexamination of Patent No. **6612713**; submitted Jan. 29, 2007. U.S. Appl. No. ...

8. 7431470, October 7, 2008, Trans-membrane solar energy lighting device, Coleiro, Lenard C., 1673 Sharon Drive, London, Ontario, N0L 1R0, Canada(CA); 347571,

CORE TERMS: membrane, electrical, housing, umbrella, radiant energy, fabric, tent, solar, energy, gathering, operatively, constructed, battery, panel, producing, conduit, pin, switch, disc, electricity, oblique, bulb, transmitting, frequency, plastic, cable, layer, conductive, storing, lighting

... States (US) 6598990, July, 2003, Li, United States (US) **6612713**, September, 2003, Kuelbs, United States (US), 362#102 6659616, ...

9. 7420119, September 2, 2008, Subterranean electrical hub, Janos, Joseph John, Wadsworth, Ohio, United States(US); Ascherl, John Joseph, Medina, Ohio, United States(US); Briggs, Michael William, Kent, Ohio, United States(US); Fritz, Raymond J., Northfield, Ohio, United States(US); Williams, Richard, Akron, Ohio, United States(US); 564337, The L.D. Kichler Co., Cleveland, Ohio, United States(US), United States company or corporation

CORE TERMS: hub, electrical, depth, exemplary, marker, socket, connector, wiring, fixture, plug, underground, terminal, installed, cable, stem, external, seal, power source, upper surface, buried, additionally, lighting, detector, molded, wire, electrically, periphery, outdoor, safety device, subterranean

6062917, May, 2000, Kingston, United States (US), 439#798 **6612713**, September, 2003, Kuelbs, United States (US), 362#102 6636924, ...

10. 7412984, August 19, 2008, Portable personal shade and cooling device, Spencer, Terrence Michael, 3245 E. Jerome Ave., Mesa, Arizona, 85204, United States(US); Spencer, Nicolle Janine, 3245 E. Jerome Ave., Mesa, Arizona, 85204, United States (US); 194960,

CORE TERMS: reservoir, handle, cooling, canopy, valve, nozzle, user, cartridge, mist, grip, umbrella, portable, misting, shade, conduit, chamber, air pump, communicate, fluid, pump, pressurized, downwardly, filled, seal, pressurization, flexible, evaporative, pressurize, disengaged, threaded

... 5979793, November, 1999, Louis, United States (US), 239#211 **6612713**, September, 2003, Kuelbs, United States (US), 362#102 6682000, ...

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In

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Reexamination of:)
Gregory G. Kuelbs)
Control No. 95/000,104) Examiner: Margaret Rubin
Patent No.: 6,612,713) Art Unit: 3992
Issued: September 2, 2003)
Assignee: WORLD FACTORY, INC.)

APPEAL BRIEF OF APPELLANT THIRD-PARTY REQUESTOR

The Examiner overstepped her bounds in requiring the Appellant/Third Party Requestor to remove, rather than correct, non-complying material in the Comments dated September 14, 2009. The Examiner also failed to provide the Appellant with an opportunity to correct Comments that exceeded the 50 page limit. Further, Appellant did, in fact, meet the 50-page limit, and to the extent it didn't, it was a matter of formality. Having expunged the September 14, 2009, Comments of the Appellant without considering them, the Examiner has allowed claims that are clearly unpatentable. Appellant therefore requests that the Examiner's decision not to consider the Appellant's Comments of the TPR be reversed and that the case be remanded to the Examiner for further prosecution.

Real party in interest. The Appellant real party in interest is Southern Sales & Marketing Group, Inc.

Related appeals and interferences. Other than those disclosed by the Patent Owner, of which the Appellant has no personal knowledge, the Appellant is not aware of any related appeals or interferences.

Status of claims. Claims 4, 5, and 10-14 have been confirmed without amendment. New or amended claims 2, 3, 8, 49, 50, 52, 53, 55-58, 60, 61, 65, 70-72 have been determined to be patentable. Claims 15-44 have been canceled. Claims 1, 6, 7, 9, 45-48, 51, 54, 59, 62-64, 66-69, and 73 are rejected. Appellant appeals the examiner's determination favorable to patentability of Claims 2, 49, 50, 52, 53, 55-58, 60, 61, 65, 70-72, and 74.

Status of amendments. Respondent submitted amendments to Claims 1, 6, 7, 9, 45-48, 51, 65, 67, and 73 after the Action Closing Prosecution, but the examiner did not enter the amendments.

Summary of claimed subject matter. Appellant appeals the examiner's determination of patentability of independent claims 2, 3, 8, 10, 49, 52, 56, 57, 60, 61, 70, 72, 74. A brief summary of each of the appealed independent claims is now set forth.

Limitations common to all appealed claims

All of the claims under appeal relate generally to an umbrella apparatus (11, 111, 211) having a base support portion (stand portion 118, 218). The umbrella apparatus further comprises a

pole portion (15, 115, 215) coupled to the base support portion, and a canopy portion (17, 117, 217) hingedly coupled to the pole portion (3:23–26; 5:26–31; 7:40–45; 12:40, 41).

All of the claims under appeal further recite a rechargeable electrical power system (*e.g.*, a rechargeable battery) (50, 150, 250, 725, 825, 955) conductively coupled to a solar energy system (35, 135, 235, 727, 827, 957) to recharge the electrical power system when the sun is shining (4:49–57).

In addition to the features described above as common to all claims, Claim 2 recites a power module (725) that is carried by the pole above the canopy (12:35–40), the solar energy system being located in the upper portion of the power module (12:32–34), and the rechargeable electrical power system being located in the lower portion of the power module. There is no support for the rechargeable electrical power system in the apparatus of FIGS. 6–9; only a “battery compartment” (707, 807, 907) is recited with no mention of batteries (12:34, 35).

Claim 8 includes an electro-mechanical system (40) for opening and closing the canopy (17) (3:61–64), the electro-mechanical system being powered by the battery and including an electric motor (49), a control system, gears, cables, and pulleys (43) operatively connected to the electric motor for raising and lowering the canopy.

In Claim 49 there are lighting elements and electrical conductors recessed within the ribs (FIGS. 4A–C; 9:42–44).

Claim 50 depends from Claim 49 and adds the additional limitation that the lighting system includes multiple discrete lighting elements along each rib member (*see* FIGS. 4A–C).

Claim 52 recites multiple discrete lighting elements fully recessed within a corresponding rib (*see* FIGS. 4A–C).

Claim 56 recites that the solar energy system and the rechargeable electrical power system each form a separate part of a power module (12:31, 32; 12:34, 35).

Claim 57 recites that the rechargeable electrical power system (55) is disposed below the canopy (4:24–27).

Claim 58 depends from Claim 57 and recites a switch (47) carried by the crank housing (44) for controlling the system for opening and closing the canopy portion (4:13–15).

In Claim 60 each light (307) is recessed within a rib member (301) and covered by a translucent cover (305) (*see* FIGS. 4A–C).

Claim 61 recites a power unit (725) carried by the pole portion (719) above the canopy (717), wherein the rechargeable electrical power system (12:34, 35; recites a “battery compartment” (707, 807, 907) but no mention of the batteries) and the solar energy system (727) are component parts of the power unit. Further, the conductors (709) carrying power from the rechargeable electrical power system are carried by the corresponding rib member (717).

In Claim 70 each rib member has a recessed channel, and the lighting elements are disposed within the channel (*see* FIGS. 4A–C).

Claim 72 is similar to Claim 70, but in addition to the lighting elements being recessed within the channels, the electrical conductors are also recessed within the channels. Again, *see* FIGS. 4A–C.

In Claim 74 the power module (725) has upper and lower portions, with the solar panel (727) located in the upper portion of the power module and the battery located in the lower portion. There is no disclosure of a battery, only of the compartment within which the batteries are to reside.

ISSUES TO BE REVIEWED ON APPEAL

The issues to be reviewed on appeal are:

Did the Examiner err in concluding that Appellant's submission of September 14, 2009, contained material outside the scope of permitted content pursuant to 37 CFR § 1.948, where the new prior art was submitted in response to arguments raised by the Respondent?

Did the Examiner exceed her authority by demanding that the appellant remove allegedly improper proposed arguments rather than correct alleged defects, where MPEP § 2666.05 specifically provides for replacement comments and contains no requirement that alleged defects be removed?

Did the Examiner err in refusing to consider Appellant's comments of September 14, 2009, for violating the 50-page limit on submissions, where:

removal of drawings from prior art references would have brought the page count below 50; a simple reformatting of the document to reduce font size and margins would have brought the page count below 50; and the Examiner failed to afford Appellant the notice and opportunity to correct specifically required by MPEP § 2667 I.B.2?

Did the Examiner err by failing to reject Claims 51 and 56 for failure to comply with the written description requirement of § 112(1)?

Did the Examiner err by failing to find Claims 51 and 56 unpatentable for failure to comply with the written description requirement of 35 U.S.C. § 112(1)?

ARGUMENT

This case involves not only issues of patentability of the claims but also procedural errors made by the Examiner that prevented Appellant from introducing new prior art and having comments considered before the Action Closing Prosecution issued. Accordingly, a brief summary of the prosecution history will now be presented.

I. PROCEDURAL ERRORS IN THE REEXAMINATION PROSECUTION

Relevant Prosecution History

The Examiner issued the First Office Action on September 28, 2005. The Respondent filed a response to the Office Action on November 21, 2005, but the Examiner issued a Notification of

Informal or Nonresponsive Amendment on December 5, 2005, declining to enter that response. The Respondent filed a corrected Amendment on December 12, 2005.

The Respondent filed an amendment on December 12, 2005, adding new Claims 45–74, a total of thirty new claims (there were only thirteen claims in the patent as issued). Of the new claims, twenty-two of the thirty were independent claims. For the first time Respondent attempted to claim a feature in which the rechargeable electrical power system and the solar energy system were contained in a common housing (Claims 45–48, 56, 59, 61, 64–66, 69–71).

The Examiner issued a Notice of Defective Paper on February 7, 2006, declining to enter the Respondent's amendment of December 12, 2005, and requiring correction. The Respondent filed a substitute amendment on February 7, 2006. In the subsequent Office Action of December 5, 2006, the Examiner noted that this submission was still noncompliant, but the legal staff of the CRU *sua sponte* made the necessary changes, and the submission was accepted by the Examiner.

Thus it was only *after* the Office Action of December 5, 2006, that the newly added claims 45–74 were compliant.

In response to the Office Action of December 5, 2006, the Respondent submitted an amendment on February 7, 2007, and the Appellant submitted responsive comments on March 9, 2007. But on July 27, 2008, the Examiner determined that the Respondent's submission of February 7, 2007, was defective and required correction. Respondent filed a corrected submission on August 27, 2008.

On March 20, 2009, the Examiner issued a Notice of Defective Paper that Respondent's corrected submission of August 27, 2008, was still defective. On April 21, 2009, the Respondent submitted a substitute amendment. In response, the Appellant submitted comments on May 18, 2009, which included new grounds for rejection.

On August 28, 2009, the Examiner issued a Notice of Defective Paper. On page 2 of the Notice, the Examiner rejected the Appellant's submission of May 18, 2009, because the proposed new rejections did not adequately discuss the pertinency of the new references. The Examiner stated that "in order for the examiner to properly evaluate the new proposed rejections, the third party requester's comments must present the newly proposed rejections in compliance with the guidelines set forth in MPEP § 2617." On p. 9 the Notice contended that the Appellant's submission of 14 September 2009 contains material outside the permitted content pursuant to 37 CFR § 1.948. The Examiner then stated: "The third party requester is given fifteen days to rectify and refile comments removing the improper proposed rejections." (Emphasis in original).

Requester filed corrected comments on September 14, 2009. Requester did not remove the proposed rejections but instead presented the newly proposed rejections in compliance with MPEP § 2617. Requester added more text to the original comments such that the 50 page limit set by 37 CFR § 1.943 was unintentionally exceeded. On October 22, 2009, the Examiner *sua sponte* returned the Appellant's comments of May 18, 2009, and had them expunged from the record. Appellant's

comments of May 18, 2009, were not considered by the Examiner in the subsequent Action Closing Prosecution and are not part of the file history.

Because Appellant's comments of September 14, 2009, have been expunged from the record, a copy is attached as Exhibit B.

On November 16, 2009, Appellant filed five petitions seeking relief from the Examiner's determination of non-compliance on the basis of having exceeded the 50-page limit for the comments submitted September 14, 2009. All five petitions were either denied or dismissed by decisions dated March 1, 2010.

A. The Patent Office Erred in Expunging Appellant's Comments for Failing to Comply with MPEP § 2666.05.

1. The Appellant's submission of September 14, 2009, does not contain material outside the scope of permitted content pursuant to 37 CFR § 1.948.

The Examiner refused to enter Appellant's comments on the further basis that the submission included additional prior art, which the Examiner contends violates 37 CFR § 1.948. The examiner is in error, because the additional prior art rebuts a response of the patent owner. 37 CFR § 1.948(a)(2).

During prosecution the Respondent added a claim limitation not found in the claims of the original patent, *i.e.*, that the solar energy system and the rechargeable electrical power system both be contained within a common housing. Because this feature had not been claimed in the original patent, Appellant had not cited prior art in the Request for Reexamination that showed this feature. To rebut Respondent's new claims, Appellant cited the following new prior art, copies of which are attached:

Patent No./App. No.	Inventor	Exhibit No.
5,055,984	Hung et al.	C
5,758,948	Hale	D
6,406,163	T. Yang	E
6,729,742	Wismeth	F

Each of these references relates to a feature covered by new claims that were not in the original patent. It was improper for the Examiner to refuse consideration of these references under 37 CFR § 1.948, and the case should be sent back to the Examiner for further prosecution.

2. The Examiner Exceeded Her Authority by Demanding that the Appellant Remove Allegedly Improper Proposed Arguments.

In the Office Action dated August 28, 2009, the examiner identified a number of allegedly improper new arguments in Requester's Comments of May 18, 2009. The examiner did not afford the Requester an opportunity to correct the alleged defects but instead, citing MPEP § 2666.05, limited Requester's remedies to removing the allegedly improper remarks, stating "The third party

requester is given fifteen days to rectify and refile comments removing the improper proposed rejections.”¹ (emphasis in original).

MPEP § 2666.05 does not require removing an improper proposed rejection. Rather, that section requires only that

[a]ny replacement comments submitted in response to the notification must be strictly limited to (*i.e.*, must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

Appellant’s comments were strictly limited to the comments in the original. No new arguments or prior art were added, and no new basis for rejection was proposed. The only text added was to bring the existing comments into compliance with the guidelines set forth in MPEP § 2617.

If MPEP § 2666.05 were meant to require a party always to remove allegedly improper proposed rejections, it would have said so. Instead, it gives the party the latitude to add new text so long as the comments are strictly limited to the comments in the original. The Examiner’s refusal to consider Appellant’s remarks of May 18, 2009, because Appellant did not yield to the Examiner’s improper requirement to delete the remarks is improper and should be reversed.

B. The Patent Office Erred in Expunging Appellant’s Comments for Exceeding 50 Pages, Because the Submission Was in Actual Compliance with the 50-Page Limit.

The examiner’s objections in the notice of deficiency of October 22, 2009, found the requester’s Second Comments defective on the basis that they exceeded the 50-page limit, and the Second Comments were expunged from the record. However, the Third Party Requestor’s Comments of September 14, 2009, were in full compliance with 37 C.F.R. § 1.943(b), and it was error for the examiner to expunge the comments from the record.

C.F.R. § 1.943(b) provides that “... written comments by the third party requester shall not exceed 50 pages in length, excluding ... reference materials such as prior art references.” (Emphasis added.) Pages 16–27 of the Requester’s Second Comments were devoted to a recap of the prior art in view of amendments made to the claims by the Patent Owner. To facilitate discussion of the prior art references, relevant drawing figures of the prior art were inserted into the text. These figures from prior art references constitute “reference materials such as prior art references” and do not count toward the 50-page limit. When these reference materials from prior art references are removed, the Third Party Requester’s Second Comments fall well below the 50-page limit.

Attached as Exhibit G is a copy of Requester’s Second Comments filed September 14, 2009. The document has been changed only in that the drawings from prior art references have been removed. Wording, spacing, fonts, and margins are unchanged from the original document. With the

¹ Notice Re Defective Paper dated August 28, 2009, p. 2.

prior art reference drawing figures removed and no other changes made, the document is only 45 pages in length, well below the 50-page limit.

Because a majority of the drawings included within the body of the Comments constitute reference materials such as prior art references, they do not count toward the 50-page limit. Requester's Second Comments filed September 14, 2009, are in full compliance with the page limitations set by C.F.R. § 1.943(b). It was error for the examiner to expunge the comments from the record, and the examiner's confirmation of the claims should be reversed.

C. It Was Error for the General Counsel Not to Waive the Rules Regarding the 50-Page Limit

37 C.F.R. § 104.3 provides that, in extraordinary situations, when the interest of justice requires, the General Counsel may waive or suspend the rules of this part, *sua sponte* or on petition of an interested party to the Director, subject to such requirements as the General Counsel may impose.

The examiner's objections on October 22, 2009 (Second Objections), found the requester's Second Comments defective on the basis that they exceeded the 50-page limit, and the Second Comments were expunged from the record. Requester requested that the 50-page limit be waived, as the submission was in substantial compliance.

Requester's Second Comments filed September 14, 2009, contained 55 pages. Notwithstanding the comments being 5 pages over the limit imposed by 37 C.F.R. § 1.943(b), the document was in substantial compliance with the regulation.

This is a classic case of form over substance. The 50-page limit of 37 C.F.R. § 1.943(b) is not imposed for the purpose of restricting the amount of paper that can be filed, but for restricting the number and length of arguments that can be submitted to the examiner.

37 C.F.R. § 1.52 states that documents filed with the USPTO, including reexamination, must be on either A4 size (21 cm x 29.7 cm) or 8-1/2 x 11 inch (letter size) paper. The top, right, and bottom margins must be at least 3/4 inch (2 cm), and the left margin must be at least 1 inch (2.5 cm). In addition, documents submitted to the PTO must be printed in type that is at least 12 point, non-script type and at least one-and-one-half spaced.

Requester filed the comments in question on letter-sized paper having margins of 1.5 inches top and 1 inch left, right, and bottom. Further, Requester's comments were filed in a larger typeface, 12.5 pts., and double spaced. Typeface selection changes not only the height of each line but also the amount of space between lines and the number of characters per line.

Attached as Exhibit H is a copy of Requester's Second Comments filed September 14, 2009. The document has been changed only in the following respects:

- the margins have been decreased to 1 inch on the left and 3/4 inch on the top, right, and bottom, as permitted by 37 C.F.R. § 1.52;

- the typeface is a smaller, non-script font, as permitted by 37 C.F.R. § 1.52, specifically Times New Roman 12 pt. font; and
- the spacing between lines has been decreased from double spaced to 1-1/2 spaced, as permitted by 37 C.F.R. § 1.52.

Not one word of the document has been changed, and all of the drawings remain in their original sizes. Simply by changing font and margins alone, the document has decreased from 57 to 43 pages, well under the 50-page limit.

By providing larger margins and a larger typeface, the requester's original submission did not contain any arguments that could not have been submitted, *verbatim*, in 43 pages. The 50-page limit has therefore been substantially met. The interest of justice requires a waiver or suspension of the rules.

As further evidence that this was an extraordinary situation in when the interest of justice requires a waiver or suspension of the rules, the disparity between the Examiner's treatments of the Respondent and Appellant should be noted. On not one but TWO occasions, the Examiner made concessions on behalf of Respondent as to matters of form.

1. On November 21, 2005, Respondent filed an amendment in response to the office action of September 28, 2005. The examiner deemed the amendment defective by notice dated December 5, 2005. Respondent then filed a substitute amendment on December 19, 2005. In the subsequent Office Action of December 5, 2006, the examiner concluded that the substitute amendment was still defective as to a matter of form, but the legal staff of the CRU *sua sponte* made the necessary changes, and the submission was accepted by the Examiner.

2. On July 25, 2008, the Examiner imposed a Notice of Defective Paper relating to Respondent's amendment of February 7, 2007. On August 28, 2008, Respondent filed a substitute amendment. On March 20, 2009, the Examiner issued a SECOND Notice of Defective Paper, this time finding Respondent's substitute amendment of August 28, 2008, deficient. Respondent thus had a second opportunity to comply with the Notice of Defective paper, and did so in a substitute response dated April 21, 2009.

Appellant does not begrudge the leniency and common-sense approach afforded Respondent in making these corrections. It should be the goal of the patent office to be helpful and to address the substantive issues to determine whether a reexamined patent should be confirmed, rather than placing form over substance. But in the interest of equity and fairness, Appellant should have been afforded the same opportunities given to Respondent. In view of the fact that Appellant's 55-page brief could have been reformatted to less than 50 pages without changing a single word, it was error—a classic case of “form over substance”—not to waive the 50-page limit for the Replacement Comments filed September 14, 2009.

Because the Examiner has expunged Appellant's comments filed September 14, 2009 from the record and refused to consider the prior art or arguments contained therein, claims have been

affirmed that are clearly invalid. This does injustice not only to Appellant but also to the public at large, in whose best interest it is to get invalid claims and patents removed from the books.

D. The Examiner Failed To Comply With the Requirements of M.P.E.P. § 2667 I.B.2

M.P.E.P. § 2667 I.B.2 provides that, where the length of the third party requester submission exceeds that permitted by 37 CFR 1.943, a Notice will be issued by the examiner and mailed to the third party requester permitting the third party requester to exercise one of the following two options:

- Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or
- File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement. (Emphasis added.)

The objections to requester's comments as exceeding the 50-page limit were raised for the first time in the Decision of October 22, 2009. The comments should not have immediately been expunged. Rather, the Examiner should have issued a notice to the Appellant under M.P.E.P. § 2667 to correct the submission to bring the submission below the 50-page limit. In this case the requester was never given notice under M.P.E.P. § 2667 that a submission exceeded the 50-page limit and was never afforded an opportunity to correct the submission, either by filing a re-drafted response or by redacting pages.

The examiner may argue that M.P.E.P. § 2666.05 "trumps" the notice provisions of M.P.E.P. § 2667, in that M.P.E.P. § 2666.05 provides for only a single opportunity by a requester to cure defective comments. But there is no suggestion anywhere in the M.P.E.P. or the C.F.R. that the notice requirement and opportunity to correct of M.P.E.P. § 2667 is in any way overruled by or of less import and effect than M.P.E.P. § 2666.05. There is nothing in M.P.E.P. § 2667 that makes the notice provision for exceeding the 50-page limit optional, nor is there anything suggesting that this provision does not apply when M.P.E.P. § 2666.05 is involved. The provision simply states that a notice WILL BE ISSUED to give a third party requestor an opportunity to revise a submission from a length of more than 50 pages to a length of 50 pages or less. The Examiner's position that MPEP § 2666.05 supersedes the notice provision of MPEP § 2667 lacks any authority in support. The Examiner's decision to simply ignore the notice provisions of M.P.E.P. § 2667 denied the Third Party Requester due process and are a grounds for reversal.

II. REJECTIONS UNDER 35 U.S.C. § 112(1)

A. Claims 56 and 61 Fail to Satisfy the Written Description Requirement of § 112(1).

The Examiner has already rejected Claim 1 under 35 U.S.C. § 112(1) for failure to satisfy the "written description" requirement. Claims 56 and 61 contain the same limitations as Claim 1 that the

Examiner determined there was no “written description,” and so Claims 56 and 61 are similarly unpatentable for failure to comply with the written description requirement of § 112(1).

In the action closing prosecution dated March 2, 2010, at p. 14-15 the Examiner pointed out in her rejection of Claim 1 under § 112(1)²,

With regard to claim 1, the base patent does not support an arrangement. where a solar energy system is carried by a module (power unit 725) on the same umbrella apparatus having “multiple discrete lighting elements positioned along at least one of the rib members” because only one light subassembly 721 is disclosed as being placed on an individual rib (Figure 6).

Claim 56 recites a rechargeable electrical power system and solar energy system each forming a separate component part of a power module. Claim 56 further recites a “lighting system comprising a plurality of lighting elements...” Claim 61 recites a “power unit” of which the rechargeable electrical system and the solar energy system are both component parts. Claim 61 further recites a “lighting system ... having a plurality of lighting elements...”

Claims 56 and 61 suffer the same defect. The base patent does not show a “power module” or “power unit” on the same umbrella apparatus having “a plurality of lighting elements,” as required by Claims 56 and 61. The examiner should have applied the same criteria to Claims 56 and 61 as he applied to Claim 1 and found Claims 56 and 61 unpatentable for failure to satisfy the written description requirement of § 112(1).

Claim 49 also fails to satisfy the written description requirement. Claim 49 does not limit in any way the location of the rechargeable electrical system. This is far broader in scope than what is contained in the written description. This language would literally permit the battery to be located on or in a rib of the umbrella, on the outside of the pole, or 100 feet away connected by a long wire. However, there is no written description of any of these embodiments. The specification discloses the battery as being located (a) within the post, (b) in the base (Fig. 3A), or in a housing above the canopy. A patentee cannot make a minor contribution to the art by disclosing only a few embodiments and then claim every possible way of accomplishing that result. Claim 49 is invalid under 35 U.S.C. § 112(1) for failing to comply with the written description requirement.

Claim 50 depends from Claim 49 and does not add any limitations regarding the location of the battery. Claim 50 thus also fails to satisfy the written description requirement.

Claim 52 suffers the same defect as Claim 49, in that the specification provides no support for the location of the rechargeable electrical power system except for the three identified with respect to Claim 49. Claims 53 and 54 depend from Claim 52 and add no additional limitations with regard to the location of the rechargeable electrical power system. Claims 53 and 55 are therefore unpatentable for failure to comply with the written description requirement.

² Cite to ACP

Claim 57 fails to satisfy the written description requirement for the same reasons set forth above with respect to Claim 49, *i.e.*, there is no written support for the batteries to be located in any position other than the three named above.

Claim 58 depends from Claim 57 and does not further limit the location of the rechargeable electrical system. Claim 58 is therefore unpatentable for failure to satisfy the written description requirement for the same reasons as Claim 57.

Claims 2, 56, 61, 62, 65, and 74 are unpatentable for failure to satisfy the written description requirement of § 112(1). These claims relate to the embodiment of Figs. 6–9, in that they all recite the rechargeable electrical power system and solar power system contained in a common housing. However, the specification does not disclose a rechargeable electrical power system with respect to Figs. 6–9. Instead, the specification recites only an interior battery compartment. (“A bottom portion 705 of power unit 725 defines an interior battery compartment 707.” 12:34-35. “A bottom portion 805 of power unit 825 defines an interior battery compartment 807.” 13:12-13. “A bottom portion 905 of power unit 955 defines an interior battery compartment 907. 13:41-42. “A bottom portion 1005 of power unit 1055 defines an interior battery compartment 1007.” 14:9–11.). The battery compartment is not even disclosed as being in conductive contact with the solar cell. The battery compartment is not a “rechargeable electrical power system.” Claims 2, 56, 61, 62, 65, and 74 are thus all unpatentable for failure to comply with the written description requirement of § 112(1).

B. Claim 65 is obvious over Phyle and Small

Claim 65 depends from Claim 64, which stands rejected as being obvious under § 103(a) over Phyle and Small, for the reasons set forth by the Examiner in the ACP at pp. 40–42. The only feature of Claim 65 that is arguably not shown by the combination of Phyle and Small is the feature that the module is “releasably coupled” to the pole.

Making an element separable is generally not a grounds for patentability. The Examiner stated so at p. 28 of the ACP with respect to Claim 1:

“What WO 93/00840 fails to show is a module carrying the solar energy system that is releasably coupled to the pole portion.... These differences are obvious in light of the teachings of Small and Pan or Wu or JP 9-168415 or Yang or Mai.”

...

[M]aking a structure portable or movable is not sufficient to patentably distinguish over an otherwise old device. Likewise, making an old device separable has not been found to be an obvious modification.

See also M.P.E.P. 2144.04(V)(C)).

Further, the motivation for making a module removable is clear—to permit replacement of the module without having to replace the entire umbrella.

For the same reasons set forth by the Examiner with respect to Claim 1 at p. 28 in the ACP, merely making a module releasably coupled to the pole does not patentably distinguish over the

prior art. Claim 65 is therefore obvious under 35 U.S.C. § 103(a), and hence unpatentable, for the same reasons set forth by the Examiner in rejecting Claim 64, and further in view of the fact that making an element separable is not a patentable distinction.

C. Discussion of the prior art references submitted by Appellant in comments that the Examiner has refused to consider and has expunged from the record.

U.S. Patent No. 5,055,984 to Hung, identified in the submission that has been expunged from the record, discloses a solar-powered light (10) in which a rechargeable battery (26) charged by a solar panel (32) both reside within a common housing comprised of an upper housing (34) and base (16). The housing is supported atop a post (*see* Fig. 1).

U.S. Patent No. 6,406,163 to Yang discloses a solar-powered light comprising a solar cell panel (1) that charges a battery (30). The solar cell panel (1) is mounted atop a post (4), and the battery (30) is mounted beneath the solar panel inside the post (*see, e.g.*, Fig. 11).

U.S. Patent No. 6,729,742 to Wismuth discloses a solar powered light having a housing (2) sitting on the upper end of a pole (3). Solar cells (5) are located in the top part of the housing (2), and a module containing a battery and circuitry is also contained in the housing (2).

U.S. Patent No. 5,758,948 to Hale discloses a seasonal decoration in the general shape of a Christmas tree. Light supporting strips (12) that are C-shaped in cross-section (3:4-8) are mounted to a central supporting shaft (14). The lighting strips are movable from an extended position (Fig. 1) to a position in which they are collapsed against the pole for storage (Fig. 6). A housing (70) is located at the top of the shaft (14). Light sockets (30) are mounted in the C-shaped channel of the light supporting strips so that a bulb (15) extends outwardly. Conductors (36) extend at least partially within the C-shaped channel (*see* Fig. 9).

D. Claims under appeal that are unpatentable over prior art references submitted by Appellant that the Examiner has refused to consider and expunged from the record.

Claim 2—was allowable because of the limitation that the rechargeable electrical power system and the solar energy system be contained within a common housing. None of the prior art of record shows this feature. However, Hung and Yang, identified in the submission that has been expunged from the record, disclose a solar-powered light in which a solar energy system and a rechargeable electrical power system are contained within a common housing sitting atop a post. Because of the advantages inherent in combining solar cell and battery within a common housing, and in view of the teaching of supporting the housing atop a post, it would have been obvious to modify the combination of WO 93/00840 and Phyle by placing the solar cell and battery within a common housing atop the pole, thus rendering Claim 2 unpatentable.

(viii) *Claims appendix*. An appendix containing a copy of the claims to be reviewed on appeal is attached as Exhibit A.

(ix) *Evidence appendix*. None.

(x) ***Related proceedings appendix.*** Appellant has no knowledge of any related proceedings.

EXHIBIT A
LISTING OF CLAIMS UNDER APPEAL

US2000 12107218.1

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2. (Amended) An umbrella apparatus comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion hingedly coupled to the pole portion;
a power module carried by the pole portion above the canopy portion, the power module having an upper portion and a lower portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus, the rechargeable electrical power system being disposed in the lower portion of the power module;
a solar energy system carried by the [pole portion above the canopy portion] upper portion of the power module, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system.

3. (Amended - Confirmed) [The] An umbrella apparatus [according to claim 2,] comprising:

a base support portion;
a pole portion coupled to the base support portion;
a canopy portion hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;

wherein the lighting system comprises:

a plurality of rib members coupled to the canopy portion; and
a plurality of cold cathode tube elements carried by the rib members, each cold cathode tube element being conductively coupled to and powered by the rechargeable electrical power source.

4. (Original) The umbrella apparatus according to claim 2, wherein the lighting system comprises:

a plurality of rib members coupled to the canopy portion; and
a plurality of light emitting diode elements carried by the rib members, each light emitting diode element being conductively coupled to and powered by the rechargeable electrical power source.

5. (Original) The umbrella apparatus according to claim 2, wherein the lighting

system comprises:

a plurality of rib members coupled to the canopy portion; and

a plurality of fluorescent light elements carried by the rib members, each fluorescent light element being conductively coupled to and powered by the rechargeable electrical power source.

8. (Amended - Confirmed) [The] An umbrella apparatus [according to claim 7,] comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and
an electromechanical opening and closing system for opening and closing the canopy portion, the electromechanical opening and closing system being conductively coupled to and powered by the rechargeable electrical power system;

wherein the electromechanical opening and closing system comprises:

an electric motor carried by the pole portion;

a control system for controlling the electric motor;

a gear system coupled to the electric motor; and

a cable and pulley system coupled to the gear system and the canopy portion;

wherein the opening and closing of the canopy portion is achieved by the electric motor in response to selective operation of the control system;

and

wherein the control system comprises:

a receiver conductively coupled to the electric motor;

a remote transmitter for transmitting an encoded signal to the receiver; and

a decoder conductively coupled to the receiver for decoding the encoded signal from the transmitter.

10. (Confirmed) An umbrella apparatus comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and

a combination of two or more of the following modular systems:

a lighting system carried by the canopy portion;

an electromechanical opening and closing system for opening and closing the canopy portion; or

a cooling system;

wherein each modular system is configured to be interchanged with each other, each modular system being conductively coupled to and powered by the rechargeable electrical power system.

11. (Confirmed) The umbrella apparatus according to claim 10, wherein the lighting system comprises:

- a plurality of rib members coupled to the canopy portion; and
- a plurality of cold cathode tube elements carried by the rib members, each cold cathode tube element being conductively coupled to and powered by the rechargeable electrical power source.

12. (Confirmed) The umbrella apparatus according to claim 10, wherein the lighting system comprises:

- a plurality of rib members coupled to the canopy portion; and
- a plurality of light emitting diode elements carried by the rib members, each light emitting diode element being conductively coupled to and powered by the rechargeable electrical power source.

13. (Confirmed) The umbrella apparatus according to claim 10, wherein the cooling system comprises:

- a fluid reservoir operably associated with the umbrella apparatus;
- at least one mist nozzle coupled to the canopy portion, each mist nozzle being in fluid communication with the fluid;
- a conduit creating fluid communication between the fluid reservoir and each mist nozzle; and
- a pump for pumping the fluid from the reservoir through each mist nozzle.

14. (Confirmed) The umbrella apparatus according to claim 10, wherein the electromechanical opening and closing system comprises:

an electric motor carried by the pole portion; a control system for controlling the electric motor;
a gear system coupled to the electric motor; and
a cable and pulley system coupled to the gear system and the canopy portion;
wherein the opening and closing of the canopy portion is achieved by the electric motor in response to selective operation of the control system.

49. (New) An umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;

wherein the lighting system includes multiple discrete lighting elements positioned along a rib member, each lighting element being recessed within the rib member and being conductively coupled to the

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rechargeable electrical power system by an electrical conductor, the electrical conductor also being recessed within the rib member.

50. (New) The umbrella apparatus according to claim 49, wherein the lighting system includes multiple discrete lighting elements along each rib member.

52. (New) An umbrella apparatus comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;
wherein the lighting system includes multiple discrete lighting elements positioned along a rib member; and
wherein each lighting element is fully recessed within the corresponding rib member.

53. (New) The umbrella apparatus according to claim 52, further comprising:

a translucent cover over the lighting elements.

55. (New) The umbrella apparatus according to claim 52, further comprising:

wires for conductively coupling the lighting elements to the rechargeable electrical power source, the wires being fully recessed within the rib members.

56. (New) An umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system, the lighting system comprising a plurality of lighting elements carried by the rib members, each lighting element being conductively coupled to and powered by the rechargeable electrical power system;

wherein the rechargeable electrical power system and the solar energy system each form a separate component part of a power module that is carried by the pole portion above the canopy portion.

57. (New) A patio umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion hingedly coupled to the pole portion, the canopy portion having a plurality of rib members;

a crank housing coupled to the pole portion, the crank housing being adapted to partially house a system for opening and closing the canopy portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus, the rechargeable electrical power system being disposed below the canopy portion;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system, the lighting system comprising a plurality of lighting elements carried by the rib members, each lighting element being conductively coupled to and powered by the rechargeable electrical

power system via conductors, the conductors being recessed within the rib members.

58. (New) The patio umbrella apparatus according to claim 57, further comprising:

a switch carried by the crank housing for controlling the system for opening and closing the canopy portion.

60. (New) An umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;

wherein the lighting system includes a plurality of lighting elements, each lighting element being recessed within a corresponding rib member and being covered by a translucent cover carried by the corresponding rib member.

61. (New) An umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;

a power unit carried by the pole portion above the canopy portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus, the rechargeable electrical power system forming a component part of the power unit; a solar energy system for collecting solar energy and converting the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system, the solar energy system also forming a component part of the power unit; and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system and having a plurality of lighting elements, each lighting element being carried by a rib member and being conductively coupled to the rechargeable electrical power system via a conductor carried by the corresponding rib member.

65. (New) The patio umbrella apparatus according to claim 64, wherein the discuss-shaped module is releasably coupled to the pole portion.

70. (New) An umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion being hingedly coupled to the pole portion, the canopy portion having a plurality of rib members, each rib member having a recessed longitudinal channel;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system, the lighting system comprising a plurality of lighting elements carried by the rib members, each lighting element being disposed within the channel and being conductively coupled to and powered by the rechargeable electrical power source.

71. (New) The umbrella apparatus according to claim 70, further comprising:

a transparent cover disposed over each channel.

72. (New) An umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion being hingedly coupled to the pole portion, the canopy portion having a plurality of rib members;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system.

wherein the lighting system comprises:

a plurality of discrete lighting elements carried by each rib member;

wherein each discrete lighting element is conductively coupled to and powered by the rechargeable electrical power source and is recessed within a corresponding rib member, the discrete lighting elements being conductively coupled to the rechargeable electrical power system by electrical conductors, the electrical conductors also being recessed within the rib members.

74. (New) An umbrella apparatus comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion hingedly coupled to the pole portion;

a power module carried by the pole portion above the canopy portion, the power module having an upper portion and a lower portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus, the rechargeable electrical power system being disposed in the lower portion of the power module;
a solar energy system disposed in the upper portion of the power module, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system.

YOT-1003-1468

EXHIBIT B
REQUESTER'S COMMENTS OF SEPTEMBER 14, 2009
(expunged from prosecution record)

US2000 12107219.1

YOT-1003-1469

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Reexamination of:)
Gregory G. Kuelbs)
)
Control No. **95/000,104**) Examiner: **Margaret Rubin**
)
Patent No.: **6,612,713**) Art Unit: **3992**
)
Issued: **September 2, 2003**)
)
Assignee: **WORLD FACTORY, INC.**)

**REPLACEMENT COMMENTS OF THIRD PARTY REQUESTER TO PATENT
OWNER'S RESPONSE IN *INTER PARTES* REEXAMINATION AND TO OFFICE
ACTION**

Mail Stop Ex Parte Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madame:

In response to the Inter Partes Reexamination Communication dated August 28, 2009, third party requester, Southern Sales & Marketing Group, Inc. ("Southern Sales"), pursuant to 37 CFR §§ 1.947 and 1.948, hereby submits its replacement comments to the "Response to Office Action in *Inter Partes* Reexamination" by the patent owner, World Factory, Inc. ("World Factory"), filed April 17, 2009.

**CLAIMS 1, 47, 48, 51, AND 63 ARE UNPATENTABLE BECAUSE
THEY BROADEN THE SCOPE OF THE PATENT**

The Federal Circuit standard for determining whether a claim has been broadened is as follows: "A claim of a reissue application is broader in scope than the original claims if it

US2000 11503020.1

YOT-1003-1470

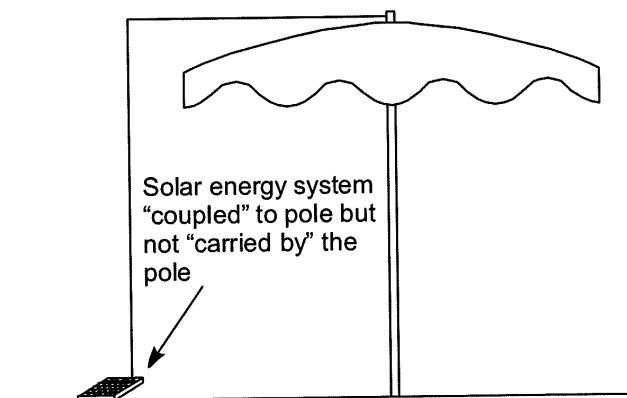
contains within its scope any conceivable apparatus or process which would not have infringed the original patent....” *Tillotson, Ltd. v. Walbro Corp.*, 831 F2d at 1037, 4 USPQ2d at 1453 n.2. The same broadening test is applied to claims in reexamination. *Anderson v. International Eng’g & Mfg.*, 160 F.3d at 1349, 48 USPQ2d at 1634.

For the purposes of the following analysis, the “conceivable apparatus” will be an apparatus that consists of the elements of the amended or new claim. If a device consisting of the elements of the amended or new claim does not infringe the patent claim, the amended or new claim impermissibly broadens the patent.

Amended Claim 1

Patent Claim 1—A device of amended Claim 1 does not infringe patent Claim 1. The device of amended Claim 1 lacks “an electrical charging system for recharging the rechargeable electrical power system, the electrical charging system being adapted to receive power from an AC power outlet.” Thus a device according to amended Claim 1 does not infringe patent Claim 1.

Patent Claims 2–5—A device of amended Claim 1 does not infringe patent Claims 2–5. The device of patent Claims 2–5 requires “a solar energy system carried by the pole portion.” “Carried” means “to sustain the weight or burden of.” Thus patent Claims 2–5 require that the weight of the solar energy system be borne by the pole portion above the canopy portion. In contrast, amended Claim 1 requires only that the solar energy system be “carried by a module coupled to the pole.” Thus a hypothetical device according to amended



Claim 1 could include a module sitting on the ground beside the umbrella, coupled to the pole portion above the canopy portion but without the weight of the module being borne by the pole portion (see diagram). Thus a hypothetical device could infringe amended Claim 1 without infringing patent Claims 2–5.

Patent Claims 6–8—A device according to amended Claim 1 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6–8. Thus a device according to amended Claim 1 does not infringe patent Claims 6–8.

Patent Claim 9—A device according to amended Claim 1 lacks a cooling system as required by patent Claim 9. Thus a device according to amended Claim 1 does not infringe patent Claim 9.

Patent Claims 10–14—A device according to amended Claim 1 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10–14. Thus a device according to amended Claim 1 does not infringe patent Claims 10–14.

CONCLUSION: Because a hypothetical device consisting of the limitations of amended Claim 1 would not infringe any of the claims of the original patent, Claim 1 as amended impermissibly broadens the scope of the patent and is not allowable.

New Claim 47

Patent Claim 1—A device according to new Claim 47 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 47 does not infringe patent Claim 1.

Patent Claims 2–5—A device according to new Claim 47 lacks a lighting system carried by the canopy portion, as required by patent Claims 2–5. Thus a device according to new Claim 47 does not infringe patent Claims 2–5.

Patent Claims 6–8—A device according to new Claim 47 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6–8. Thus a device according to new Claim 47 does not infringe patent Claims 6–8.

Patent Claim 9—A device according to new Claim 47 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 47 does not infringe patent Claim 9.

Patent Claims 10–14—A device according to new Claim 47 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10–14. Thus a device according to new Claim 47 does not infringe patent Claims 10–14.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 47 would not infringe any of the claims of the original patent, Claim 47 impermissibly broadens the scope of the patent and is not allowable.

New Claim 48

Patent Claim 1—A device according to new Claim 48 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 48 does not infringe patent Claim 1.

Patent Claims 2–5—A device according to new Claim 48 lacks a lighting system “being conductively coupled to and powered by the rechargeable electrical power system,” as required by patent Claims 2–5. Thus a device according to new Claim 48 does not infringe patent Claims 2–5.

Patent Claims 6–8—A device according to new Claim 48 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6–8. Thus a device according to new Claim 48 does not infringe patent Claims 6–8.

Patent Claim 9—A device according to new Claim 48 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 48 does not infringe patent Claim 9.

Patent Claims 10–14—A device according to new Claim 48 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10–14. Thus a device according to new Claim 48 does not infringe patent Claims 10–14.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 48 would not infringe any of the claims of the original patent, Claim 48 impermissibly broadens the scope of the patent and is not allowable.

New Claim 51

Patent Claim 1—A device according to new Claim 51 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 51 does not infringe patent Claim 1.

Patent Claims 2–5—Patent Claims 2–5 recite “a solar energy system carried by the pole portion above the canopy portion.” For the reasons set forth above with respect to amended Claim 1, a hypothetical device could infringe new Claim 51 without infringing patent Claims 2–5.

Patent Claims 6–8—A device according to new Claim 51 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6–8. Thus a device according to new Claim 51 does not infringe patent Claims 6–8.

Patent Claim 9—A device according to new Claim 51 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 51 does not infringe patent Claim 9.

Patent Claims 10–14—A device according to new Claim 51 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10–14. Thus a device according to new Claim 51 does not infringe patent Claim 9.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 51 would not infringe any of the claims of the original patent, Claim 51 impermissibly broadens the scope of the patent and is not allowable.

New Claim 63

Patent Claim 1—A device according to new Claim 63 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 63 does not infringe patent Claim 1.

Patent Claims 2-5—Patent Claims 2-5 recite “a solar energy system carried by the pole portion above the canopy portion.” “Carried” means “to sustain the weight or burden of.” Thus patent Claims 2-5 require that the weight of the solar energy system be borne by the pole portion above the canopy portion. In contrast, new Claim 63 requires only that the solar energy system be “coupled” to the pole. Thus a hypothetical device according to new Claim 63 could include a solar energy system sitting on the ground beside the umbrella, coupled to the pole portion above the canopy portion but without the weight of the solar energy system being borne by the pole portion. Thus a hypothetical device could infringe new Claim 63 without infringing patent Claims 2-5.

Patent Claims 6-8—A device according to new Claim 63 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6-8. Thus a device according to new Claim 63 does not infringe patent Claims 6-8.

Patent Claim 9—A device according to new Claim 63 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 63 does not infringe patent Claim 9.

Patent Claims 10-14—A device according to new Claim 63 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10-14. Thus a device according to new Claim 63 does not infringe patent Claims 10-14.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 63 would not infringe any of the claims of the original patent, Claim 63 impermissibly broadens the scope of the patent and is not allowable.

CLAIM 52 IS UNPATENTABLE FOR DOUBLE PATENTING

Claim 52 as added by patentee in the present reexamination is unpatentable over Claim 49 as added by patentee in the present reexamination under the judicially-created doctrine of double patenting.

49. (New) An umbrella apparatus, comprising:
a base support portion;
a pole portion coupled to the base support portion;

a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;
wherein the lighting system includes multiple discrete lighting elements positioned along a rib member, each lighting element being recessed within the rib member and being conductively coupled to the rechargeable electrical power system by an electrical conductor, the electrical conductor also being recessed within the rib member.

52. (New) An umbrella apparatus comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;
wherein the lighting system includes multiple discrete lighting elements positioned along a rib member; and
wherein each lighting element is fully recessed within the corresponding rib member.

The preamble and first six body paragraphs of each claim are identical. The only difference between the two claims is that Claim 49 recites that each lighting element is recessed within the corresponding rib member, whereas Claim 52 recites that each lighting element is fully recessed within the corresponding rib member.

The only way in which the terms “fully recessed” and “recessed” can differ is if Claim 49 covers a situation in which a lighting element is only partially recessed. However, there is no support in the specification of the '713 patent of a lighting element that is only partially recessed. All of the disclosed embodiments describe only lighting elements that are fully recessed. The term “recessed” in Claim 49 can only be interpreted to cover a lighting element that is “fully” recessed.

Because the '713 patent lacks support for any recess other than “fully” recessed, the terms “recessed” and “fully recessed” must be construed identically. Claim 49 is identical to Claim 52 and therefore constitutes double-patenting.

**THE PROVISIONAL PATENT APPLICATIONS OF FEBRUARY 7,
2001, FAIL TO SUPPORT CLAIMS 1, 2, 4-7, 45-48, 51, 56, 61, 64-66,
AND 74 OF THE PATENT**

Patentee is not entitled to the filing dates of the provisional patent application of February 7, 2001 with respect to Claims 1, 2, 4-7, 45-48, 51, 56, 61, 64-66, and 74, because the 2/7/01 provisional application fails to disclose elements of these claims.

The 2/7/01 provisional does not disclose a “module” or “power unit” as required by Claims 1, 2, 4-7, 45-48, 51, 56, 61, 64-66, and 74. Rather, the solar cell is carried directly atop the pole. Similarly, the 2/7/01 provisional does not disclose a “rechargeable electrical power system” located above the canopy, as required by Claims 1, 2, 4-7, 45-48, 51, 56, 61, 64-66, and 74. Accordingly, these claims are not entitled to the February 7, 2001, filing date of this provisional.

**THE DECLARATIONS UNDER RULE 131 ARE INSUFFICIENT TO
SWEAR BEHIND THE REFERENCES**

It is the patentee's responsibility to establish conception and, where necessary, diligence in reduction to practice from a time prior to the effective date of the cited references until the date of reduction to practice. Kuelbs' second Declaration, even when taken in combination with Kuelbs' first Declaration and the Quillen Declaration, fail to

establish diligence. Large blocks of unexplained inactivity remain, and the patentee has therefore failed to establish diligence.

Declarant's statements in Paragraph 2 of the Declaration are conclusory, self-serving, and uncorroborated.

Declarant's statements in Paragraph 3 of the Declaration are uncorroborated.

Declarant's statements in Paragraph 4 of the Declaration are uncorroborated.

The copy of the passport pages (Exhibit A) referenced in Paragraph 5 of the Declaration establish, at best, that Declarant visited China in July and October 1999. The passport pages do not contain any information about a solar-powered umbrella. Declarant's statements about the purpose of the trip are uncorroborated.

The notes (Exhibit B) referenced in Paragraph 6 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 6 of the Declaration are uncorroborated.

The notes (Exhibit C) referenced in Paragraph 7 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 7 of the Declaration are uncorroborated.

The notes (Exhibit D) referenced in Paragraph 8 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 8 of the Declaration are uncorroborated.

Paragraph 9 misstates the law. Exhibits B, C, and D are only drawings and, while possibly relevant to the issue of conception, do not constitute a reduction to practice, as they do not constitute making and using the invention and proving it useful for its intended purpose. Declarant's statements in Paragraph 9 of the Declaration are uncorroborated.

The notes (Exhibit E) referenced in Paragraph 10 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any

independent party. Declarant's statements in Paragraph 10 of the Declaration are uncorroborated.

The notes (Exhibit F) referenced in Paragraph 11 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 11 of the Declaration are uncorroborated.

The notes (Exhibit G) referenced in Paragraph 12 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 12 of the Declaration are uncorroborated.

The notes (Exhibit H) referenced in Paragraph 13 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. The notes are undated. While they bear the notation "Proposed Discussion Notes China Trip - July-Aug 99," the notes could have been prepared contemporaneously with the trip or months earlier. Declarant's statements in Paragraph 13 of the Declaration are uncorroborated.

The notes (Exhibit I) referenced in Paragraph 14 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 14 of the Declaration are uncorroborated.

The proposed itinerary (Exhibit J) referenced in Paragraph 15 of the Declaration is uncorroborated. Its existence prior to the critical date has not been attested to by any independent party. A proposed itinerary is not proof that a trip was ever made. The proposed itinerary contains no information about the alleged invention or any efforts to reduce it to practice. Declarant's statements in Paragraph 15 of the Declaration are uncorroborated.

The receipt for currency exchange (Exhibit K) referenced in Paragraph 16 of the Declaration establishes, at best, that Declarant was in the Hong Kong airport on October 20, 1999. Declarant's presence in the Hong Kong airport is no indicator of the purpose of

Declarant's trip and most certainly does not establish any element of the claimed invention. Declarant's statements in Paragraph 16 of the Declaration are uncorroborated.

The e-mail (Exhibit L) referenced in Paragraph 17 of the Declaration establishes, at best, that Declarant received an e-mail from an Eric Li on October 11, 1999. The e-mail does not establish any element of the claimed invention and does not even reference a stated purpose for a proposed visit. Declarant's statements in Paragraph 17 of the Declaration beyond his assertion that he received an e-mail are uncorroborated.

The e-mail (Exhibit M) referenced in Paragraph 18 of the Declaration establishes, at best, that Declarant received an e-mail from an Eric Li on October 14, 1999. The e-mail does not establish any element of the claimed invention and does not even reference a stated purpose for a proposed visit. Declarant's statements in Paragraph 18 of the Declaration beyond his assertion that he received an e-mail are uncorroborated.

The e-mail (Exhibit N) referenced in Paragraph 19 of the Declaration establishes, at best, that Declarant received an e-mail from an Eric Li on October 16, 1999. The e-mail does not establish any element of the claimed invention and does not even reference a stated purpose for a proposed visit. Declarant's statements in Paragraph 19 of the Declaration beyond his assertion that he received an e-mail are uncorroborated.

The drawings (Exhibits O, P, and Q) referenced in Paragraph 20 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. The drawings are undated. Declarant's statements in Paragraph 20 of the Declaration are uncorroborated.

The screen shot (Exhibit R) referenced in Paragraph 22 of the Declaration at best establishes that there are files on a computer bearing modified dates as shown. There is no corroboration that the screen shot has not been altered or modified. There is no corroboration that the files identified in Paragraph 22 of the Declaration relate in any way to the claimed invention.

Patentee's statements in Paragraphs 25 and 26 of the Declaration that he worked diligently on the invention from a date prior to 30 April, 1999, through the filing date of U.S.

Provisional Application No. 60/267,018, *i.e.*, 7 February 2001, are uncorroborated and conclusory.

Patentee's statements in Paragraphs 27, 28, and 30 of the Declaration that he worked diligently on the invention from a date prior to 30 April, 1999, through the filing date of U.S. Provisional Application No. 60/335,933, *i.e.*, 2 November 2001, are uncorroborated and conclusory.

Exhibit V was prepared on 26 April 2006, seven years after the events described therein. No contemporaneous notes are produced. No reason for the statement is given, leading to the inescapable conclusion that the document was produced solely for the purpose of this reexamination and, most likely, that the patentee instructed the author what to say. No specific dates are given except for July 1999, and it is unclear from the document when work on the project was discontinued. Thus the document fails to explain any period of inactivity during the critical period. Declarant's statements in Paragraph 20 of the Declaration are uncorroborated.

**EVEN IF ALL OF DECLARANT'S STATEMENTS ARE *ARGUENDO*
PRESUMED ACCURATE, THEY FAIL TO ESTABLISH DILIGENCE**

An inventor's date of invention is his date of conception, IF he is thereafter diligent in reducing the invention to practice. The Patentee in this case seems to be alleging acts directed toward both an actual reduction to practice (making and using the invention) and a constructive reduction to practice (the filing of a patent application). To establish a valid date of invention, the Patentee must establish diligence in reducing the invention to practice from a time just prior to the effective date of a prior art reference until the filing date of the patent application. However, even if all of the facts alleged in the Patentee's § 1.131 Declaration are assumed to be correct for the sake of argument, there are large unexplained gaps of inactivity in his alleged efforts to reduce the invention to practice that preclude a date of invention any earlier than the filing date of the application.

A time line of the Patentee's activities shows the following:¹

Date	Activity	Delay Since Previous Activity (days)
4/30/1999	Earliest possible date of conception (4, 6-8)	—
6/30/1999	Preparation of sketches of an umbrella (10)	61
7/30/1999	Trip to China (5)	30
7/31/1999	Notes in preparation for trip to China (11, 12, 13)	1
9/30/1999	Notes and sketches of umbrella (14)	61
10/11/1999	E-mail from Eric Li re Real Faith factory in China (17)	11
10/14/1999	E-mail from Eric Li re Jiangsu Metal & Minerals Import and Export (18)	3
10/16/1999	Memo from Eric Li re Mr. Bakula (19)	2
10/20/1999	Trip to China (5, 16)	4
10/23/2000	Quillen works on drawings (20, 22)	369
11/9/2000	Correspondence to patent attorney re preparation of patent application (21)	17
2/7/2001	Provisional patent application filed (23)	90

Patentee has unexplained periods of inactivity of 61, 30, 61, 369, and 90 days. Thus even if the Patentee's declaration did not suffer fatal flaws of lack of corroboration, any one of these unexplained prolonged periods of inactivity preclude a finding of diligence in reduction to practice.

For the reasons set forth above, the declarations submitted by patentee are insufficient to swear behind the references.

**CLAIMS 1, 2, 4-7, 9, 47-57, 59-62, 64-66, AND 70-74 ARE
 UNPATENTABLE OVER THE PRIOR ART**

Additional Prior Art Submitted Under 37 CFR § 1.948

For the Examiner's benefit, new prior art applicable to World Factory's amendments has been found. Pursuant to 37 CFR § 1.948, Southern Sales files herewith the following

¹ Where Patentee's Declaration does not specify a day but specifies only a month and year (e.g., "6-99" in ¶ 10, "7-99" in ¶ 11), it is assumed that the event occurred on the last day of the month.

additional prior art references that address features of the amended Claims 1-5, 47-56, 59-62, 64-66, 70-72, and 74 not present in the original claims:

Patent No./App. No.	Inventor	Effective Date	Exhibit No.
5,055,984	Hung et al.	Aug. 11, 1989	13
5,758,948	Hale	July 10, 1996	14
6,406,163	T. Yang	Nov. 27, 2000	15
6,729,742	Wismeth	May 10, 2002	16

These submissions are made in response to the new amendments submitted by World Factory. Southern Sales believes that an overview of the newly submitted prior art would benefit the reexamination process.

World Factory has submitted a Second Declaration Under 37 C.F.R. § 1.131 in which the inventor swears behind the effective dates of the Cathel, Lee '856, Mai, Pan, Lee '224, Yang, Molnar, Vivian, Farr, and Lai references. The reference date alleged in the Second Declaration is April of 1999. The effective date of the newly submitted Hung and Hale prior art references predates April 1999. Thus even if the Examiner finds the Second Declaration effective in establishing a date of invention of April 1999, the new Hung and Hale prior art submissions would still constitute prior art.

U.S. Patent No. 5,055,984 to Hung et al. (hereafter "Hung") discloses a solar rechargeable lamp for outdoor use. The device contains a solar energy system (hereafter "SES") (32) that collects and converts solar energy into electrical energy, which the SES (32) stores in a rechargeable electrical system (hereafter "RES") (26, a battery) to which it is connected (Col. 3, 26-39). The two power systems are found in one housing (FIG. 5), the SES (32) found above the RES (26), which is releasably coupled to a pole (80) (See FIG. 2). The RES powers a lighting system (18)(FIG. 5).

U.S. Patent No. 5,758,948 to Hale (hereafter "Hale") discloses a seasonal light display device. The device contains an apparatus comprising a pole portion (3) and has a plurality of ribs (12) hingedly coupled to the pole portion, and a lighting system, wherein the lighting system includes multiple discrete lighting elements (15) positioned along a rib member (12), each lighting element being recessed (12, 22 and 24) within the rib member

and being conductively coupled to a electrical power system by an electrical conductor (36), the electrical conductor also being recessed within the rib member(12, 22 and 24).

If World Factory is successful in establishing a date of invention of April 1999, the newly submitted Yang and Wismeth prior art references may not constitute prior art. However, in the likely event that the Examiner finds the Second Declaration lacking, the following new prior art submissions would be highly useful in the reexamination.

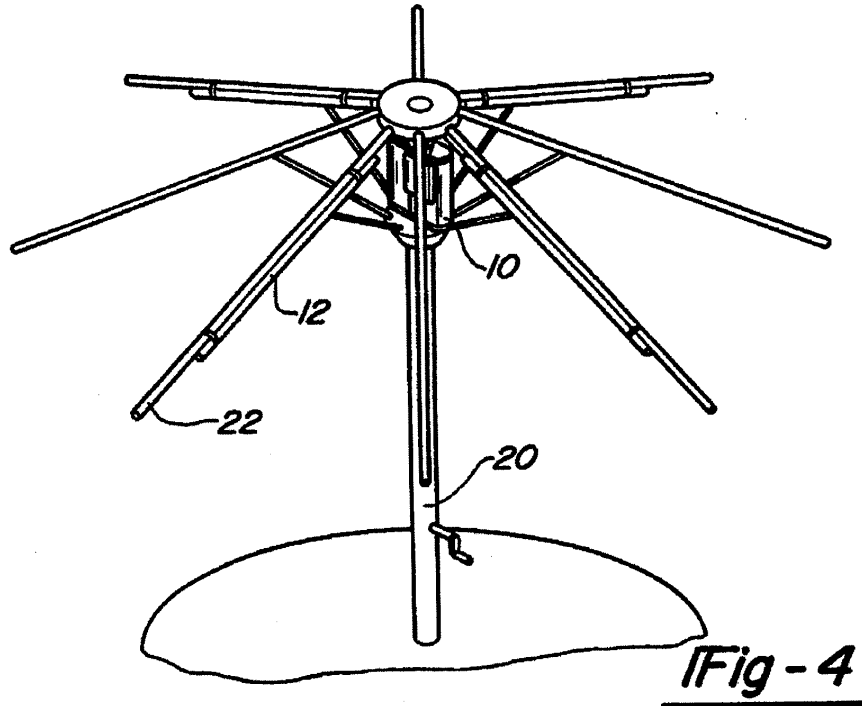
U.S. Patent No. 6,406,143 to Yang (hereafter "Yang '163") (Exhibit 13) discloses a solar cell lighting fixture. The device contains a SES that collects and converts solar energy into electrical energy, which it stores in the RES to which the SES is connected (Col. 2, 62 – Col. 3, 18, FIG. 2). These two power systems are found in one module which is releasably coupled to a pole portion of the device (Col. 5, 11-18, FIG. 15). The SES is found in the upper portion of the module while the RES is found in the lower portion of the module. The RES powers a lighting system carried by the device (Col. 3, 4-10, FIG. 2).

U.S. Patent No. 6,729,742 to Wismeth et al. (hereafter "Wismeth") discloses a solar lamp for outdoor use. The device contains a solar energy system that collects and converts solar energy into electrical energy, which the SES stores in a RES to which it is connected (Col. 1, 53-59, Col. 2, 47-64). The two power systems are found in the cubic housing, the SES found above the RES (Col. 2, 38-58). The housing is coupled to a pole (Col. 2, 38-42, FIG. 1). The RES powers a lighting system (Col. 1, 53-57, Col. 2, 58-59).

Summary of Previously Presented Prior Art in View of Patentee's Amendments

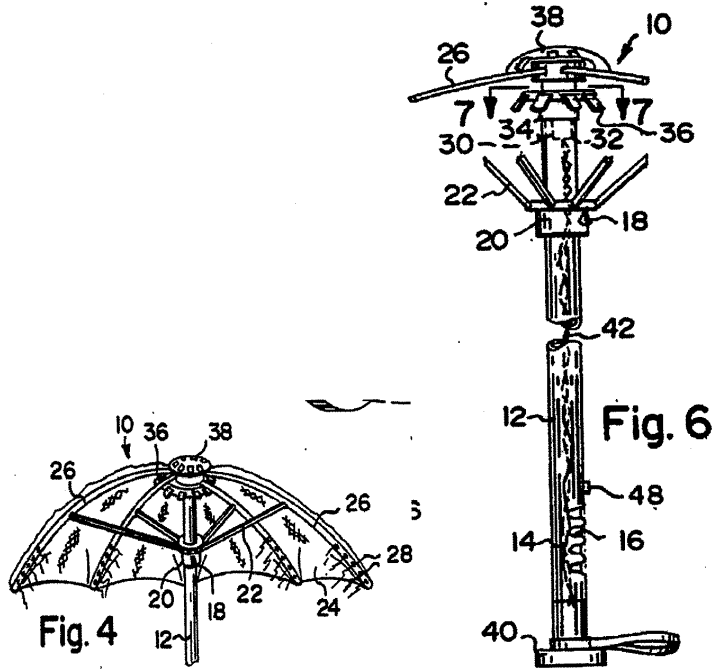
While the following patents have previously been presented, a recap of their relevance is appropriate in view of the amendments made and new claims submitted by the patentee.

Phyle - U.S. Patent No. 5,584,564



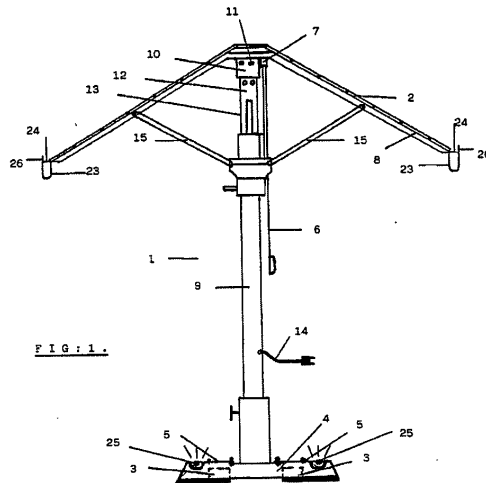
Phyle discloses an apparatus that has an illumination device 12 carried by the canopy ribs. Battery (10) is rechargeable and is carried by the pole at an upper portion 20.

Valdner – US Patent No. 5,349,975



Valdner includes a solar power electrical system 38 found above the canopy 24, and carried by the rod (pole) 12. The solar power electrical system 38 has a disc-shape. The apparatus has a rechargeable battery pack that can be connected at the bottom 40 of the rod 12.

WO 93/00840



Includes a solar collector 2 carried by the canopy that charges batteries 3 in the base 4. The batteries 3 can power a light 12.

Benton - U.S. Patent No. 6,017,188

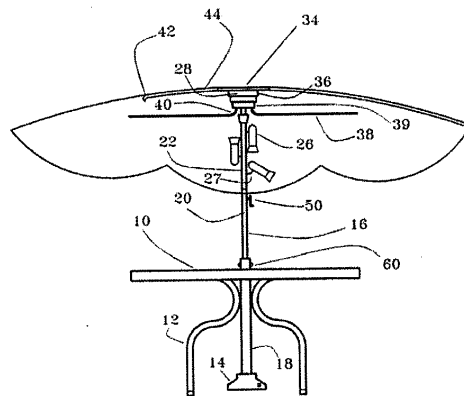
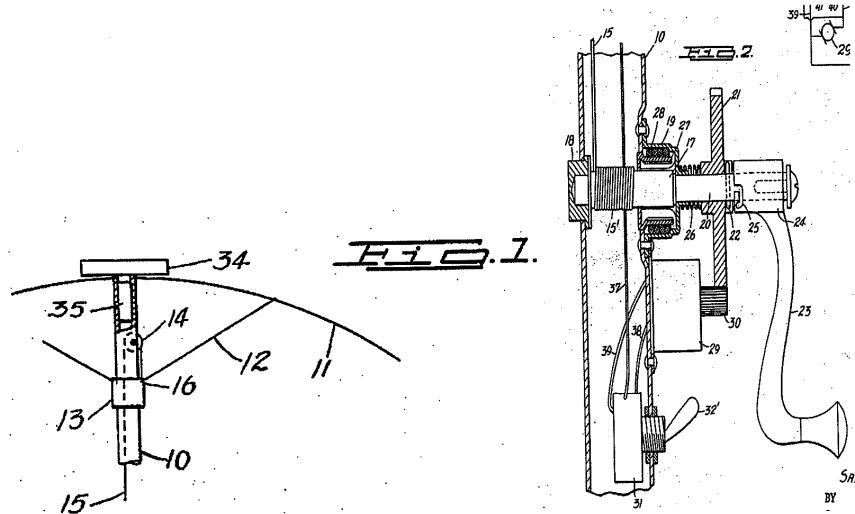


FIG. 1

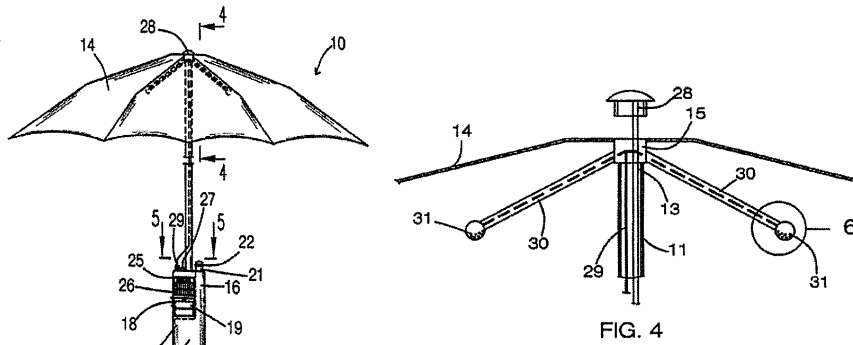
Benton describes an umbrella supported by an upper portion 22 of a pole. The pole 22 supports lights 26. A solar panel 34 positioned on top of the canopy of the umbrella can

Small – US Patent No. 6,126,293



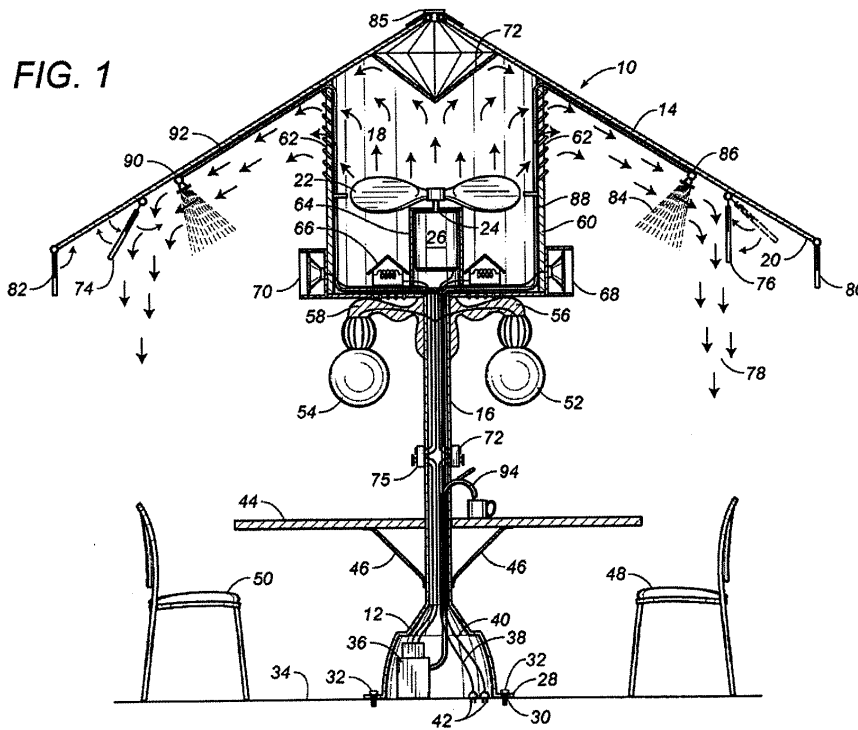
Small discloses an umbrella supported by a post 10. The umbrella employs a motor 29 to open and close the canopy. The motor may be powered by a solar battery 34 and a storage battery 35. The solar battery 34 charges the storage battery 35. The storage battery 35 may be found in other positions along the post 10. However, as shown in FIG. 1, the storage battery 35 is located below the solar battery 34 and is carried by the upper portion of the post 10.

Farr – US Patent App. Pub. No. 2002/0078985



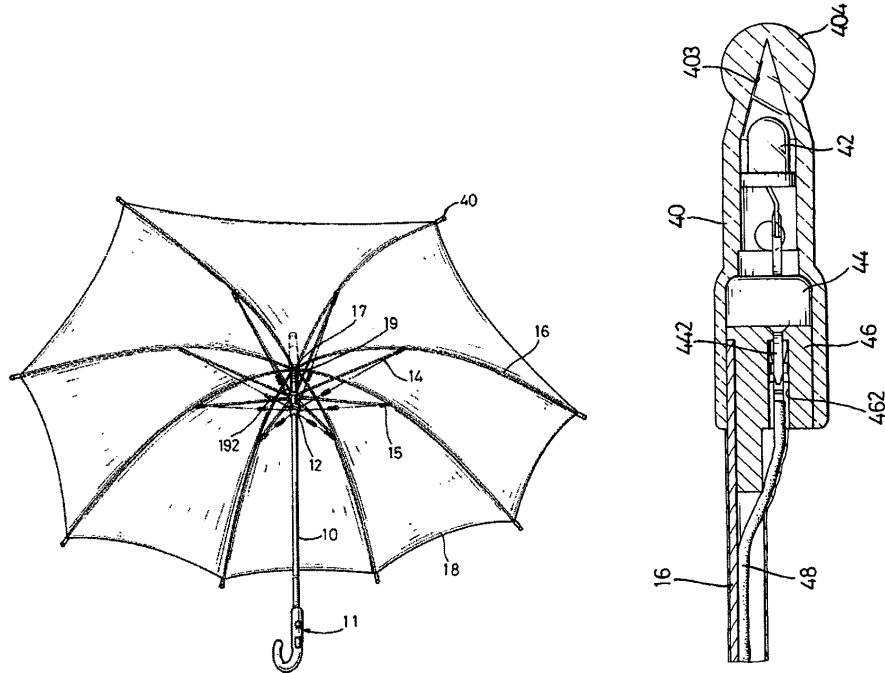
Farr discloses an umbrella 10 with a cooling device. A tube supports the canopy 14 of the umbrella. The cooling device 16 is carried by the tube and may be detached from the tube. A battery 19 is contained within the cooling device 16, and is connected to a solar collector 28. The solar collector 28 is detachably connected to the tube, as shown in FIG. 4.

Molnar – US Patent No. 6,298,866



Molnar discloses an umbrella 10 that includes a fan 18 and lights 54. A battery 36 that powers the fan and lights may be housed in the base 12 of the umbrella 10.

Yang – US Patent No. 6,341,873



Yang discloses an umbrella that has illumination devices mounted above the canopy 18 and in the tips 40 of each rib 16. The illumination device 40 includes a transparent tip 40 and an LED 42, so arguably, the LED 42 is within the rib 16.

Lee - US Patent No. 6,666,224 and 6,499,856

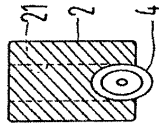


FIG. 4

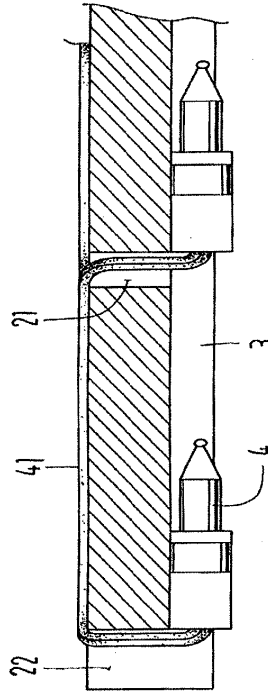
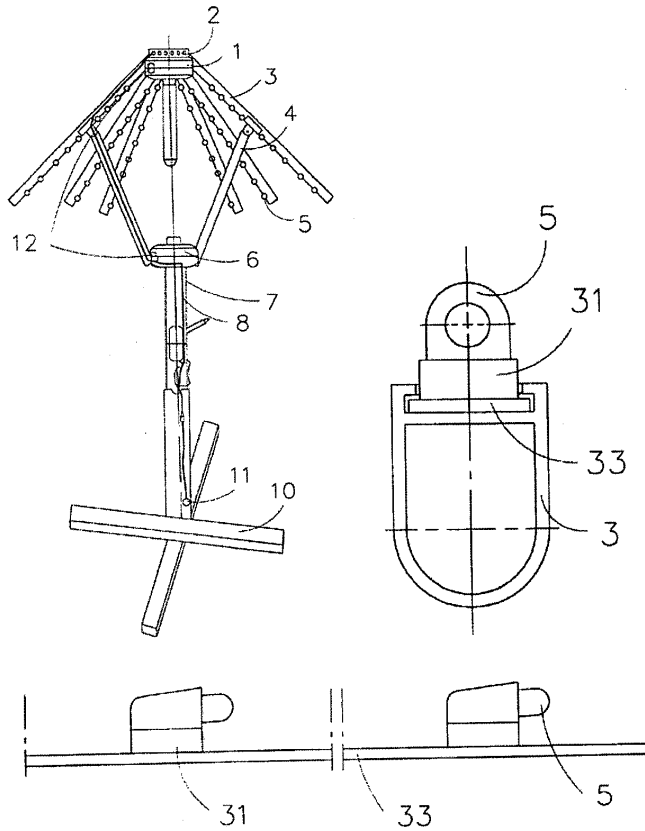


FIG. 3

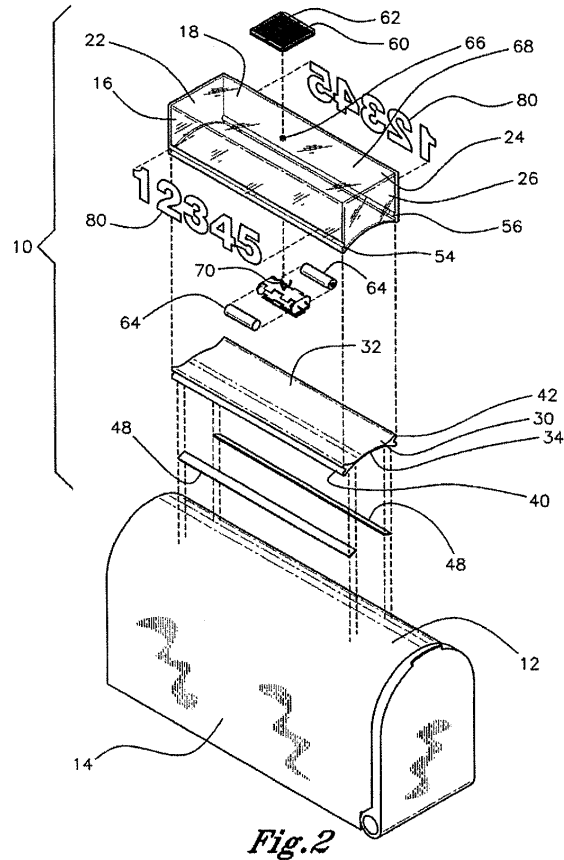
Lee discloses an umbrella that has a plurality of ribs 2 with trenches 3 throughout the bottoms of the ribs 2. Lamps 4 are partially retained within the trenches 3 of the ribs 2.

Pan et al. – US Patent No. 6,439,249



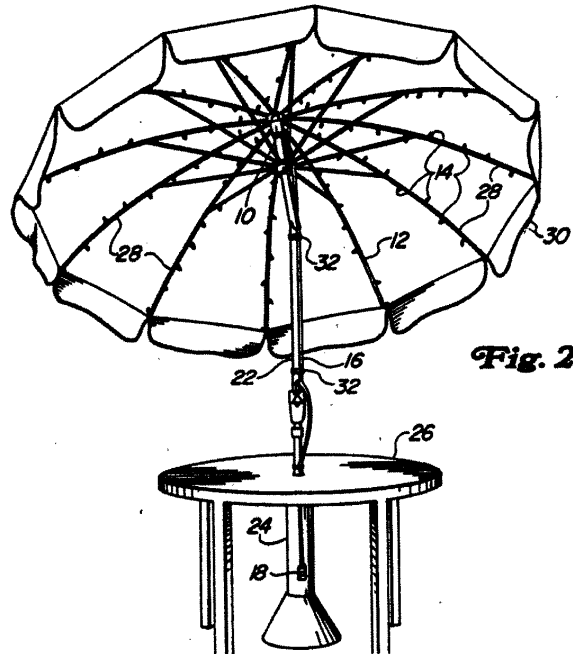
Pan et al discloses an umbrella that includes a plurality of hollow ribs 3. Along each rib is a trench (32, not shown in these figures) that retain light sources 5. The light sources may be connected with an illuminating connector 31.

Cathel – US Patent No. 6,299,325



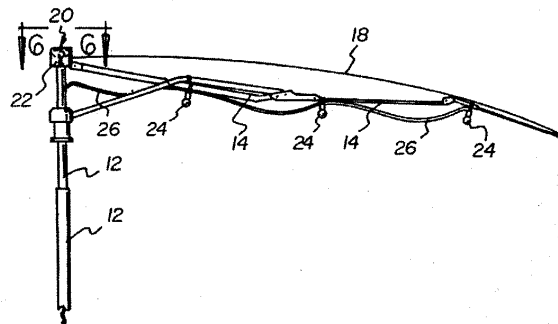
Cathel discloses an illuminated mailbox address device 10. The device 10 is powered by a solar cell 60 that recharges a battery 64. LEDs (not shown) may be used to illuminate the device.

Rushing – US Patent No. 5,053,931



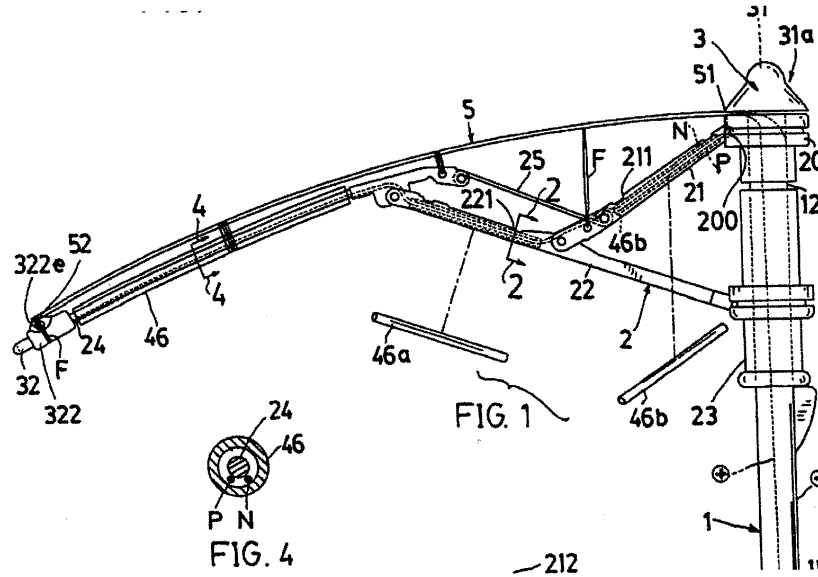
Rushing discloses an umbrella having a central support pole 22 that supports a plurality of ribs 28 that support a canopy 30. Light strings 12 with miniature lights 14 are attached to the ribs 28.

Morgan - US Patent No. 5,611,614



Morgan discloses an umbrella 20 with a plurality of ribs 14 that support a canopy 18 and electrical bulbs 24 and electrical connectors 26.

Wu – US Patent No. 6,126,293



Wu discloses an umbrella that has rib members 24 that have tip illuminators 32. The tip illuminators 23 may be LEDs.

REJECTIONS UNDER 35 U.S.C. §§ 102 AND/OR 103

The Rejection of Claim 1 under Combination I

The Office Action rejected Claim 1 as being obvious and unpatentable over WO 93/00840 and Valdner which was designated Combination I. In response, World Factory amended Claim 1 by adding these limitations: 1) a canopy portion has a plurality of rib members; 2) the SES is carried by a module coupled to the pole portion above the canopy portion; 3) the module is releasably coupled to the pole portion; and 4) the lighting system is carried by the canopy portion and coupled to and powered by the RES. Additionally, World

Factory deleted the requirement that the RES be adapted to receive power from an AC power outlet.

The introduction of these limitations fails to overcome the § 103(a) rejections over Combination I. WO 93/00840 and Valdner both disclose a canopy having a plurality of ribs. WO 93/00840 discloses an umbrella having a base 4, a pole 9, a canopy carried by the pole, and a solar collector 2 carried by the canopy that charges batteries 3 in the base 4. The batteries 3 can power a light 12. WO 93/00840 fails to show a lighting system carried by the canopy portion. In Valdner, the ribs carry the ventilation shafts. It would be obvious to a person of ordinary skill in the art at the time of the invention of the '713 patent to have the lighting system of WO 93/00840 carried by ribs such as those of Valdner, which carries the ventilation shafts along its ribs. Additionally, Valdner's solar cell is connected to the rechargeable system, so that the absence of the electrical system being able to receive power from an AC outlet would be a trivial change on their devices. Logically, the solar power system must be located at a position in which it may receive solar power. If the solar power system is located on the umbrella device, the solar panel may only be located on top of the umbrella, which can be either on the canopy itself or the pole portion of an umbrella, which would be obvious to a person skilled in the art. Finally, the solar portion being releasably coupled to the pole portion is not a novel concept. A component being releasably coupled to any device is ubiquitous.

The Rejection of Claim 1 under Combination I in view of Hung

Claim 1 is further unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination I in view of Hung. The teachings of Combination I are discussed in the preceding paragraph. Hung discloses a SES that is releasably coupled to a pole portion. Hung discloses a solar panel (32) on the upper portion of the housing for the light (10) which is removable from the pole portion (80). Thus, to the extent that Combination I does not expressly disclose a solar panel removably mounted to the upper portion of a pole, Hung provides this missing teaching. Claim 1 is therefore unpatentable under 35 U.S.C. § 103(a) as being obvious over Combination I in view of Hung.

The Rejection of Claims 2, 5 and 74 under Combination II

The Office Action rejected Claims 2 and 5 as being obvious and unpatentable over WO 93/00840 and Phyle, which was deemed Combination II. In response, World Factory amended Claim 2 by adding these limitations: 1) a power module is carried by the pole portion above the canopy portion; 2) the power module has an upper portion and a lower portion; 3) the SES is carried by the upper portion of the module; and 4) the RES is disposed in the lower portion of the power module. No amendments were made to Claim 5, which is dependent on claim 2. The only additional limitation of Claim 5 is the canopy has a plurality of rib members and that each rib member carries a fluorescent light.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections based on WO 93/00840 and Phyle. In addition, Claim 74 claims the same elements and has identical amendments, so it too should be found rejected based upon Combination II as well. The changes to the claims mean that the SES and the RES naturally reside in one singular component, with the SES found over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must have access to light. Accordingly, the SES must be above the canopy portion, either on the canopy itself or on the pole portion supporting the canopy. Additionally, placing the RES below the SES would be obvious as well; placing the RES above the SES would block sunlight from reaching the SES, preventing the SES from operating. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems. For Claim 5, both references disclose a canopy with multiple rib members. One skilled in the art would find it obvious to have the lighting system carried by the rib members, especially the use of fluorescent lights. Phyle itself carries fluorescent lights.

The Rejection of Claims 2, 5 and 74 under Combination II in view of Hung

Alternately, Claims 2, 5 and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination II and further view of Hung. Combination II discloses all the elements of Claim 2 and 74 except for the amendments above, but Hung discloses a SES and a RES in a power module that is carried by a pole, the SES found in the upper portion and the RES found in the lower portion of the module. Accordingly, a person skilled in the art would find it obvious to modify Combination II by adding the power module carried by a pole, as taught by Hung. Additionally, claims 2 and 74 are identical. As such, one or the other should be cancelled even if the claims are allowed.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination II in view of Hung.

The Rejection of Claims 2, 5 and 74 under Combination II in view of Yang '163 or Wismeth

If the Examiner finds World Factory's § 131 Declaration lacking, Claims 2, 5, and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination II in further view of Yang '163 or Wismeth. Both Yang '163 and Wismeth disclose a SES and a RES in a power module that is carried by a pole, the SES found in the upper portion and the RES found in the lower portion of the module. Because an SES, if mounted to the umbrella, must be mounted above the canopy if it is to be exposed to sunlight, it would have been obvious to one of ordinary skill in the art to have mounted a SES and a RES in a power module carried by the pole, as taught by Yang '163 or Wismeth, and to affix it to a portion of the pole above the canopy so it will be exposed to sunlight. Claims 2, 5, and 74 are therefore obvious, and therefore unpatentable, over Combination II in view of Yang '163 or Wismeth.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination II in further view of Yang '163 or Wismeth.

The Rejection of Claims 2, 5 and 74 under Combination III

The Office Action rejected Claims 2, 5, and 74 as being unpatentable over Phyle and Valdner which was deemed Combination III. In response, World Factory amended Claims 2 and 74 by adding these limitations: 1) a power module carried by the pole portion above the canopy portion; 2) the power module has an upper portion and a lower portion; 3) the SES is carried by the upper portion of the module; and 4) the RES is disposed in the lower portion of the power module. No amendments were made to Claim 5, which is dependent on claim 2. The only additional limitation of Claim 5 is that the canopy has a plurality of rib members and that each rib member carries a fluorescent light. For Claim 5, both references disclose a canopy with multiple rib members. Phyle discloses fluorescent lights (12) attached to its rib members.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Phyle and Valdner. The changes to the claims mean that the SES and the RES reside in one singular component, with the SES found over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must be exposed to light. As such, the SES must be above the canopy portion, either on the canopy itself or on the pole portion supporting the canopy. Additionally, having the RES below the SES would be obvious as well, as having the RES above the SES would prevent the SES from receiving sunlight and thereby prevent its operation. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems.

The Rejection of Claims 2, 5 and 74 under Combination III in view of Hung

Alternately, Claim 2, 5, and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination III in view of Hung. Combination III discloses all the elements of former Claims 2 and 74. As to the features added by amendment, Hung discloses a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to modify Combination III by placing the SES and RES in a single module carried by a pole, as taught by Hung. When combined with Combination III, accordingly, a person skilled in the art would see this combination as obvious.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination III in view of Hung.

Claims 2, 5 and 74 are unpatentable under Combination III in view of Yang '163 or Wismeth

If the Examiner finds World Factory's § 131 Declaration lacking, Claim 2, 5 and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination III in view of either Yang '163 or Wismeth. Combination III discloses all the elements of Claim 2 and 74 and Yang '163 and Wismeth disclose a SES and a RES in a singular module that is carried by a pole. When combined with Combination III, accordingly, a person skilled in the art would see this combination as obvious.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination III in view of either Yang '163 or Wismeth.

Claims 2 and 4 are unpatentable under Combination IV

The Office Action rejected Claims 2 and 4 as being unpatentable over WO 93/00840 and Pan or Wu or JP 9-168415 or Mai or Yang which was deemed Combination IV. In response, World Factory amended Claim 2 by adding these limitations: 1) a power module carried by the pole portion above the canopy portion; 2) the power module has an upper portion and a lower portion; 3) the SES is carried by the upper portion of the module; and 4) the electrical power system is disposed in the lower portion of the power module. Lastly, World Factory submitted a Declaration in which the inventor attempts to swear behind Mai, Pan, and Yang.

World Factory has failed to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over WO 93/00840 and Wu or JP-9-168415. The changes to the claims mean that the SES and the RES reside in one singular component, with the SES found over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must have access to light. As such, the SES must be above the canopy portion, either on the canopy itself or on the pole portion supporting the canopy. Additionally, having the RES below the SES would be obvious as well; having the RES above the SES would prevent the SES from receiving light and thereby preventing its operation. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems.

No amendments were made to Claim 4, which is dependent on Claim 2. The only additional limitation of Claim 4 is that the canopy has a plurality of rib members which carries the lighting system and that the rib members carry a plurality of light emitting diodes coupled to the RES. For Claim 4, the references disclose a canopy with multiple rib members and the use of lighting devices. All but WO 93/00480 disclose using light emitting diodes in various positions, some specifically on the ribs. As such, the arguments above that apply to Claim 2 apply to Claim 4.

Claims 2 and 4 are unpatentable under Combination IV in view of Hung

Alternately, Claim 2 and 4 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination IV in view of Hung. Combination IV discloses all the elements of former Claims 2 and 4, and Hung discloses the new elements added by the amendments: a SES and a RES in a singular module that is carried by a pole, the SES found in the upper portion and the RES found in a lower portion. It would have been obvious to a person skilled in the art to modify Combination IV by substituting a SES and a RES in a singular module that is carried by a pole, as taught by Hung, and thereby construct the invention of Claims 2 and 4.

The Rejection of Claims 2 and 4 under Combination IV in view of Yang '163 or Wismeth

If the Examiner finds the Declaration lacking, Claims 2 and 4 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Combination IV in view of either Yang '163 or Wismeth. Combination IV discloses all the elements of former Claims 2 and 4, and Yang '163 and Wismeth disclose the limitations added by the recent amendments: a SES and a RES in a singular module that is carried by a pole. A person of ordinary skill in the art would have found it obvious to modify Combination IV by adding a SES and a RES in a singular module that is carried by a pole, as taught by Yang '163 or Wismeth, and thereby construct the claimed invention. Claims 2 and 4 are therefore unpatentable.

The Rejection of Claim 4 under Combination V

The Office Action rejected Claim 4 as being unpatentable over Phyle and Valdner and Wu or Pan or JP-9-168415 or Mai or Yang, which was deemed Combination V. Claim 4 was not amended; however, Claim 4 remained dependent upon Claim 2, which was amended as stated above. As such, it includes the limitations of Claim 2. For Claim 4, the limitations disclose a canopy with multiple rib members and the lighting elements being LEDs. Also, World Factory submitted a Declaration in which the inventor attempts to swear behind Mai, Pan, and Yang.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Combination V. The changes to the claims mean that the SES and the RES reside in one singular component, with the SES located over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must have access to light. As such, the SES must be above the canopy portion, either on the canopy itself or on the pole portion supporting the canopy. Additionally, having the RES below the SES would be obvious as well; having the RES above the SES would prevent the SES from receiving light and thereby preventing its operation. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems.

Claim 4 is unpatentable over Combination V in view of Hung

Alternately, Claim 4 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination V in view of Hung. Combination V discloses all the elements of previous Claim 4. Hung discloses a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified Combination V by providing a SES and a RES in a single module that is carried by a pole, as taught by Hung. Locating the module on the pole above the canopy is an obvious step, because a module located beneath the canopy would not be exposed to sunlight and could not collect energy. Claim 4 is therefore unpatentable as obvious over Combination V in view of Hung.

Claim 4 is unpatentable over Combination V in view of either Yang '163 or Wismeth

If the Examiner finds the Declaration lacking, Claim 4 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination V in view of either Yang '163 or Wismeth. Combination V discloses all the elements of former Claim 4. Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified Combination V by providing a SES and a RES in a single module that is carried by a pole, as taught by either

Yang '163 or Wismeth. Locating the module on the pole above the canopy is an obvious step, because a module located beneath the canopy would not be exposed to sunlight and could not collect energy. Claim 4 is therefore unpatentable as obvious over Combination V in view of either Yang '163 or Wismeth.

The Rejection of Claims 49, 50 and 72 under Combination VIII (A)

The Office Action rejected Claims 49, 50 and 72 as being unpatentable over WO 93/00840 and Morgan or Rushing or Pan or JP 9-168415 or Mai which was deemed Combination VIII (A). World Factory responded by amending claims 49 and 72 by adding this limitation: each lighting element is recessed within the rib member and is conductively coupled to the rechargeable electrical power system by an electrical conductor that is also recessed within the rib member. Claim 50 was not amended, but is dependent on Claim 49, therefore taking in the limitation. In addition, World Factory submitted a Declaration in which the inventor attempted to swear behind Mai and Pan.

This amendment fails to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Combination VIII(A). The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. Such an element would be obvious to a person skilled in the art in light of Combination VIII (A). The lighting elements and connecting wires must be carried by a reinforced structure of a canopy, which would be the rib members. Safety issues would make it obvious not to have wires protruding from the rib members. As such, the logical solution would be to recess the wires and lighting elements within the rib members.

Claims 49, 50 and 72 are obvious over Combination VIII (A) in view of Hale or Wu or Walker

Alternatively, Claims 49, 50 and 72 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII (A) in view of Hale or Wu or Walker. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). Walker discloses lighting elements and wires

(32) that are recessed into channels (30) along the underside of the rib (16). It would have been obvious, and hence unpatentable, for a person skilled in the art to have modified Combination VIII(A) by recessing the wires and lighting elements into the rib members, as taught by either Hale or Wu or Walker. Claims 49, 50, and 72 are therefore unpatentable.

Claims 49, 50 and 72 are obvious over Combination VIII (A) in view of Lee '224 or Lee '856

If the Examiner finds the Rule 1.131 Declaration lacking, Claims 49, 50 and 72 are unpatentable under U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII (A) in view of Lee '224 or Lee '856. Former Claims 49, 50, and 72 have already been rejected as obvious over Combination VIII(A). Claims 49, 50, and 72 have now been amended to add the limitations that each lighting element is recessed within the rib member and is conductively coupled to the rechargeable electrical power system by an electrical conductor that is also recessed within the rib member. Lee '224 and Lee '856 disclose an umbrella that has a plurality of ribs 2 with trenches 3 throughout the bottoms of the ribs 2. Lamps 4 are partially retained within the trenches 3 of the ribs 2. Both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into the rib members with the wires connected to a rechargeable power source. It would have been obvious to a person skilled in the art to have modified Combinaton VIII(A) by providing trenches in the bottoms of the ribs, with lighting elements and associated wiring recessed into the trenches as taught by Lee '224 and Lee '856 and thereby construct the claimed invention. Claims 49, 50, and 72 are therefore unpatentable under § 103(a).

The Rejection of Claims 51 and 55 under Combination VIII (B) in view of Wu or Hale

The Office Action rejected Claims 51 and 55 as being unpatentable over WO 93/00840 and Lee '856 which was deemed Combination VIII (B). Claim 51 was originally dependent on Claim 49, but World Factory amended Claim 51 to become independent, and incorporated the limitations of Claim 49, except that a single lighting element has replaced a plurality of lighting elements along a rib member. These additional limitations were added as well: 1) a translucent cover for covering the lighting elements; 2) the SES carried by a power

unit coupled to the pole portion above the canopy portion; and 3) a portion of each lighting element extends beyond the corresponding rib member. Claim 55 was amended to depend from Claim 52, which is identical to Claim 51 except that it claims the lighting elements are fully recessed within the rib member. Claim 55 further claims that each wire is fully recessed within the rib member. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Lee '856.

Claims 51 and 55 as amended are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII(B) in view of Wu or Hale. The amendments made disclose the solar power system coupled to the pole portion in a removable manner. Hung has the same configuration. Alternatively, having an item coupled to another item is ubiquitous. Wu and Hale both disclose lighting elements that extend beyond the ribs. Additionally, whether a lighting element is fully recessed or extended from a rib does not have an inventive value. Wu has a translucent cover (322) that covers the lighting element (32). The wire elements for Wu and Hale are recessed within the rib members.

It would have been obvious to a person skilled in the art to modify Combination VIII(B) by coupling one item to another, to have lighting elements that extend beyond the ribs as taught by Wu or Hale, to recess wires within the rib members as taught by Wu or Hale, and to provide a translucent cover that covers a lighting element, as taught by Wu. Claims 51 and 55 are therefore unpatentable as obvious over § 103(a).

The Rejection of Claim 54 under Combination VIII(C)

The Office Action rejected Claim 54 as being unpatentable over WO 93/00840 and Pan or JP 9-168415 or Mai, which was deemed Combination VIII(C). World Factory did not amend Claim 54, but did amend Claim 49, from which Claim 54 depends. Claim 49 was amended by adding these limitations: 1) each lighting element is recessed within the rib member; and 2) is conductively coupled to the rechargeable electrical power system by an electrical conductor that is also recessed within the rib member. Claim 54 adds the limitation

that the lighting elements are each an LED. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Pan and Mai.

Even if Pan and Mai are removed as references, these amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over WO 93/00840 and JP 9-168415. The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. The lighting elements and connecting wires must be carried by a reinforced structure of a canopy, which would be the rib members. Safety issues would make it obvious not to have protruding wires from the rib members. As such, the logical solution would be to recess the wires and lighting elements within the rib members. Such an element would be obvious to a person skilled in the art in light of WO 93/00840 and JP 9-168415.

Claim 54 is unpatentable over WO 93/00840 and JP 9-168415 in view of either Hale or Wu

Alternatively, Claim 54 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over WO 93/00840 and JP 9-168415 in view of either Hale or Wu. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). JP 9-168415 discloses using LEDs. A person skilled in the art would find it obvious to modify WO 93/00840 and JP 9-168415, which show all of the features of former Claim 54, by providing a recessed channel with the ribs into which the lighting elements and wires are recessed, as taught by Hale or Wu. Claim 54 is therefore unpatentable as obvious over WO 93/00840 and JP 9-168415 in view of either Hale or Wu.

If the Examiner finds World Factory's § 1.131 Declaration lacking, Claim 54 is unpatentable under U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII(C) in view of Lee '224 or Lee '856. Lee '224 and Lee '856 each disclose lighting elements and wires that are recessed into umbrella rib members. Combination VIII(C) discloses all of the elements of former Claim 54. The new limitations added to Claim 54 are shown in Lee '224 and Lee '856. It would be obvious to a person skilled in the art to modify

Combination VIII(C) by recessing the lighting elements and wires into umbrella rib members, as taught by Lee '224 and Lee '856. Claim 54 is therefore unpatentably obvious over Combination VIII(C) in view of Lee '224 or Lee '856.

Claims 49, 50, and 72 are unpatentable under Phyle and Valdner, and Morgan or Rushing or JP 9-168415

The Office Action rejected claims 49, 50 and 72 as being unpatentable over Phyle and Valdner, and Morgan or Rushing or Pan or JP 9-168415 or Mai which was deemed Combination IX (A). World Factory amended Claims 49 and 72 (50 was not amended, but dependent on 49), by adding these limitations: 1) each lighting element is recessed within the rib member and being conductively coupled to the rechargeable electrical power system by an electrical conductor; and 2) the electrical conductor also is recessed within the rib member. Claim 72 further states the lighting element is recessed within the corresponding rib member. Additionally, World Factory submitted a Declaration that attempts to swear behind Pan and Mai.

Even if Pan and Mai are removed as prior art references, the amendments to Claims 49, 50 and 72 fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Phyle and Valdner, and Morgan or Rushing or JP 9-168415. The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. The lighting elements and connecting wires must be carried by a reinforced structure of a canopy, which would be the rib members. Safety issues would make it obvious not to have protruding wires from the rib members. As such, the logical solution would be to recess the wires and lighting elements within the rib members, which would be obvious to a person skilled in the art in light of the combination of Phyle and Valdner, and Morgan or Rushing or JP 9-168415.

Claims 49, 50, and 72 are unpatentable under Phyle and Valdner, and Morgan or Rushing or JP 9-168415 and further in view of Hale or Wu or Walker

Alternatively, Claims 49, 50 and 72 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Phyle and Valdner, and Morgan or Rushing or JP 9-

168415 in view of Hale or Wu or Walker. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). Walker discloses lighting elements and wires (32) that are recessed into channels (30) along the underside of the rib (16). It would have been obvious to a person skilled in the art to have modified the combination of Phyle and Valdner, and Morgan or Rushing or JP 9-168415 by providing recesses in the ribs to receive the wires and lighting elements, as taught by Hale or Wu or Walker, and thereby construct the claimed invention.

Claims 49, 50, and 72 are unpatentable over Combination IX(A) in view of Lee '224 or Lee '856

If the Examiner finds World Factory's Rule 1.131 Declaration inadequate to establish a date of invention earlier than its filing date, Claims 49, 50 and 72 are unpatentable under U.S.C. § 103(a) as being obvious over Combination IX (A) in view of Lee '224 or Lee '856. Both Lee '224 and Lee '856 disclose an umbrella that has a plurality of ribs 2 with trenches 3 throughout the bottoms of the ribs 2. Lamps 4 are partially retained within the trenches 3 of the ribs 2. Both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into the rib members with the wires connected to a power source. It would have been obvious to a person skilled in the art to modify Combination IX(A) by providing recesses in the bottom of the rib members with the lighting elements and wires received within the recesses, as taught by Lee '224 and Lee '856, and thereby construct the claimed invention.

Claims 51 and 55 are unpatentable under Combination IX (B)

The Office Action rejected Claims 51 and 55 as being unpatentable over Phyle, Valdner, and Lee '856, which was deemed Combination IX (B). Claim 51 was originally dependent on Claim 49, but World Factory amended Claim 51 to become independent, and incorporated the limitations of Claim 49, except that a single lighting element has replaced a plurality of lighting elements along a rib member. The additional limitations were added: 1) a translucent cover for covering the lighting elements; 2) the SES carried by a power unit

coupled to the pole portion above the canopy portion; and 3) that a portion of each lighting element extends beyond the corresponding rib member. Claim 55 was amended to depend from Claim 52, which is identical to Claim 51 except that it claims that the lighting elements are fully recessed within the rib member. Claim 55 further claims that each wire is fully recessed within the rib member. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Lee '856.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Phyle and Valdner. The amendments have made the SES part of a power module, which Valdner discloses. The SES is attached to the pole portion of World Factory's invention. Valdner's SES is attached to the apex of the canopy portion, which would be the equivalent of the pole portion of World Factory's invention. Having a removable SES is not a novel concept either. The venting component (28) of Valdner is recessed in the rib members (26) of the canopy portion. It would have been obvious to a person skilled in the art to position the lights and wiring of Phyle within the venting component of Valdner and thereby construct the claimed invention.

Claims 51 and 55 are unpatentable under Combination IX (B)

Alternatively, Claims 51 and 55 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Phyle and Valdner, and Hung in view of Wu or Hale. The amendments made to Claims 51 and 55 disclose the solar power system coupled to the pole portion in a removable manner. Hung has the same configuration. Wu and Hale both disclose lighting elements that extend beyond the ribs. Additionally, the extent to the amount a lighting element is fully recessed or extended from a rib does not have an inventive value. Wu has a translucent cover (322) that covers the lighting element (32). The wire elements for Wu and Hale are fully recessed within the rib members. It would have been obvious to a person skilled in the art to have modified Combination IX(B) by providing a solar power system coupled to the pole portion in a removable manner, as taught by Hung, to provide lighting elements that extend beyond the ribs, as taught by Wu and Hale, and to provide a translucent cover, as taught by Wu, and thereby construct the claimed invention.

Claims 51 and 55 are unpatentable over Combination IX (B)

If the Examiner finds the Declaration lacking, Claims 51 and 55 are unpatentable under U.S.C. § 103(a) as being obvious over Combination IX (B) and Wu in view of Lee '224 or Lee '856. As previously discussed, both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into the rib members. It would have been obvious to a person skilled in the art to have modified Combination IX(B) by providing lighting elements and wires recessed into rib members, as taught by Lee '224 and Lee '856, and thereby construct the claimed invention.

Claim 54 is unpatentable over Combination IX (C)

The Office Action rejected Claim 54 as unpatentable over Phyle and Valdner, and Pan or JP 9-168415 or Mai which was deemed Combination IX (C). World Factory did not amend Claim 54, but did amend Claim 49, from which Claim 54 depends. Claim 49 was amended by adding these limitations: 1) each lighting element is recessed within the rib member; and 2) each lighting element is conductively coupled to the rechargeable electrical power system by an electrical conductor that is also recessed within the rib member. Claim 54 adds the limitation that the lighting elements are each an LED. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Pan and Mai.

Even if Pan and Mai were removed as prior art references, World Factory has failed to overcome the 35 U.S.C. § 103(a) rejections over Phyle and Valdner and JP 9-168415. The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. Phyle discloses the lighting elements (12) being carried by the rib portions (22). Valdner discloses its venting element (28) being recessed in the rib members (26). Using an LED as the lighting element would be obvious to one skilled in the art, and JP 9-168415 discloses the use of LEDs. The combination of recessing an LED and its wiring components within a rib member would be obvious to a person skilled in the art in light of Combination IX (C).

Claim 54 is unpatentable over Combination IX (C) in view of Hale or Wu

Alternatively, Claim 54 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination IX (C) in view of either Hale or Wu. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). It would have been obvious to a person skilled in the art to have modified Combination IX(C) by providing a recess in each rib into which lighting elements and wires are recessed, as taught by either Hale or Wu, and thereby construct the claimed invention.

Claim 54 is unpatentable over Combination IX (C) in view of Lee '224 or Lee '856.

If the Examiner finds the Rule 1.131 Declaration lacking, Claim 54 is unpatentable under U.S.C. § 103(a) as being obvious and unpatentable over Combination IX (C) in view of Lee '224 or Lee '856. As previously discussed, both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to have modified Combination IX(C) by providing lighting elements and wires recessed into rib members, as taught by either Lee '224 or Lee '856, and thereby construct the claimed invention.

ADDITIONAL PROPOSED REJECTIONS

Claim 1—Claim 1 is not patentable under 35 U.S.C. § 103(a) over Mueller and Rushing in view of Hung. Mueller discloses an umbrella apparatus (80), a base portion (28), a pole portion (16) coupled to the pole portion (28), a canopy portion hingedly coupled to the pole portion, the canopy portion having a plurality of rib members, a rechargeable electrical power system for providing power to the umbrella apparatus, and a SES (82) carried by a module coupled to the pole portion above the canopy portion, the SES being connected to the RES (26). Rushing discloses a lighting system having multiple discrete lighting elements (28) positioned along at least one of the rib members (12), and being conductively coupled to an electrical power system. Hung discloses a SES (32) carried by a module (10), the module being releaseably coupled to the pole portion (80). It would have been obvious to a person skilled in the art to have modified the umbrella of Mueller by providing a lighting system

having multiple discrete lighting elements positioned along a rib member and being conductively coupled to an electrical power system, as taught by Rushing, and to substitute a SES carried by a module that is releasably coupled to the pole portion, as taught by Hung, and thereby construct the invention of Claim 1.

Claim 2, 4, 5, 56, and 74—Claims 2, 4, 5, 56, and 74 are not patentable under 35 U.S.C. § 103(a) over Mueller and Phyle in light of Hung. Claim 2 recites a base, a pole, a canopy hingedly mounted to the pole, a power module attached to the pole above the canopy, and a lighting system carried by the canopy. Claim 4 depends from Claim 2 and adds the additional limitations that the canopy comprises a plurality of ribs and the lighting system comprises LEDs. Claim 5 depends from Claim 2 and adds the limitations that the canopy comprises a plurality of ribs and the lighting elements are fluorescent. Claim 56 recites a base, a pole, a canopy comprising a plurality of ribs, and a power module carried by the pole above the canopy. Claim 74 recites a base, a pole, a canopy, a lighting system carried by the canopy, and a power module carried by the pole above the canopy. It should also be noted that Claims 2 and 74 are identical as amended.

Mueller discloses an umbrella apparatus (80), a base portion (28), a pole portion (16) coupled to the pole portion (28), a canopy portion hingedly coupled to the pole portion, a rechargeable electrical power system for providing power to the umbrella apparatus, and a SES (82) carried by a module coupled to the pole portion above the canopy portion, the SES being connected to the RES (26). It does not disclose a power module carried by the pole portion having an upper and lower portion, nor does it disclose the canopy carrying a lighting system that is coupled to the RES. Phyle does disclose a lighting system that is carried by the canopy that is coupled to the RES. Hung discloses a power module (10) carried by the pole portion (80), with the SES (32) in the upper portion and the RES (26) in the lower portion.

It would have been obvious to a person of ordinary skill in the art to have modified the umbrella apparatus of Mueller by providing a lighting system carried by the canopy that is coupled to the power module, as taught by Phyle, and to have the power module carried by the pole portion with the SES in the upper portion of the module and the RES in the lower portion. Claim 2 would therefore be obvious and unpatentable. The only element of Claim 4

not disclosed by this combination is that the lighting elements are LEDs. The type of lighting element used is trivial and cannot form the basis for patentability. In any event, JP 9-168415 discloses the use of LED lighting elements. The only element of Claim 5 not disclosed by this combination is that the lighting elements are fluorescent. The type of lighting element used is trivial and cannot form the basis for patentability. All of the elements of Claims 56 and 74 are shown in this combination.

Alternatively, if the Examiner finds the Declaration lacking, the combination of Mueller and Phyle in light of Yang '613 or Wismeth would make Claims 2, 46, and 74 obvious in the same manner. As previously discussed, Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified the previously discussed combination of Mueller and Phyle by providing a SES and a RES in a single module that is carried by a pole, as taught by either Yang '163 or Wismeth. Locating the module on the pole above the canopy is an obvious step, because a module located beneath the canopy would not be exposed to sunlight and could not collect energy.

Claim 47—Claim 47 is unpatentable under 35 U.S.C. 103(a) as being unpatentable over Phyle and Hung. Phyle discloses a patio umbrella apparatus (1), a base portion, a pole portion (20) coupled to the base portion, a canopy portion hingedly coupled to the pole portion, and a RES for providing power to the umbrella apparatus. It does not disclose a power module carried by the pole portion having an upper and lower portion. Hung discloses a power unit (10) that has a SES (32) in the upper portion and a RES (26) in the lower portion, the unit coupled to the top portion of a pole (80). It would have been obvious to a person skilled in the art to modify the umbrella apparatus of Phyle by providing a power unit that has a SES in the upper portion and a RES in the lower portion, the unit coupled to the top portion of a pole as taught by Hung. Claim 47 would therefore have been obvious to a person skilled in the art.

Alternatively, if the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle and Yang '613 or Wismeth would make Claim 47 obvious in the same manner as Phyle and Hung. Yang '163 and Wismeth disclose a SES and a RES in a single

module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified Phyle by providing a SES and a RES in a single module that is carried by a pole, as taught by either Yang '163 or Wismeth.

Claim 48—Claim 48 is unpatentable under 35 U.S.C. 103(a) over Phyle, Valdner, and Hung in view of Hale. Valdner discloses all elements of Claim 48 except a plurality of lighting elements carried by the rib member, the lighting elements being recessed within the rib members and the RES and SES each forming a component part disposed in a power unit carried by the pole portion above the canopy. Phyle discloses most of the same, but further includes carrying lighting elements. Phyle does not have a SES. However, Valdner does disclose its venting mechanisms (28) being recessed within the rib members (26). Hale discloses its lighting elements (15) being recessed within its rib members (12). Hung discloses the power unit (10) coupled on top of the pole portion (80), with the SES being in the top portion and the RES being in the bottom portion. It would have been obvious to one skilled in the art to have modified the apparatus of Phyle or Valdner by providing the lighting elements recessed within the canopy rib members, as taught by Hale, and providing the power unit coupled on top of the pole portion, with the SES being in the top portion and the RES being in the bottom portion. Claim 48 is therefore unpatentable as obvious.

Additionally, if the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle, Valdner or Mueller and Yang '613 or Wismeth in view of Lee '224 or Lee '856 would make Claim 48 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified the previously discussed combination of Phyle and Valdner or Mueller by providing lighting elements and wires recessed into rib members, as taught by Lee '224 or Lee '856, and to combine a SES and a RES in a single module that is carried by a pole, as taught by Yang '163 and Wismeth, and thereby construct the claimed invention.

Claim 49, 50 and 54—Claim 49 is unpatentable under 35 U.S.C. § 103(a) over Mueller and Rushing in view of Hale. Mueller discloses all elements of Claim 49 except

those dealing with the lighting system. Rushing discloses all of the lighting elements of Claim 49 except each lighting element being recessed within the rib member as well as the electrical conductor being recessed. Hale discloses each lighting element and electrical conductor being recessed within the rib member (see FIG. 1 and 9). It would have been obvious to a person skilled in the art to have modified the apparatus of Mueller to provide the lighting elements as taught by Rushing, recessing the lighting elements and wires as taught by Hale, and thereby construct the claimed invention.

Alternatively, if the Examiner finds the Declaration lacking, the combination of Mueller and Rushing in view of Lee '224 and Lee '856 would make Claims 49, 50 and 54 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to have modified the apparatus of Mueller to provide the lighting elements as taught by Rushing, recessing the lighting elements and wires as taught by Lee '224 and Lee '856, and thereby construct the claimed invention.

Additionally, Claim 50 is dependent on Claim 49, with the additional limitation that the lighting system includes multiple discrete lighting elements along each rib member. Rushing discloses this feature, so Claim 50 would be obvious based on the same combination that renders Claim 49 unpatentable.

Claim 54 is also dependent on Claim 49, with the additional limitation that the multiple discrete lighting elements are each an LED. Having the lighting elements being an LED would be obvious to anyone skilled in the art. It is common practice to use LEDs in such applications which World Factory states in its Response to the Office Action. Alternatively, with the addition of JP 9-168415, which clearly discloses LEDs, Claim 54 would be obvious to one skilled in the art.

Claim 51—Claim 51 is unpatentable under 35 U.S.C. 103(a) over Phyle and Hung in view of Wu. Phyle discloses every element of Claim 51 except the power unit being releasably coupled to the pole, translucent covers for the lighting elements, and the lighting elements extending beyond the corresponding rib member. Hung discloses a power unit that comprises a SES that is releasably coupled to the pole portion. Wu discloses translucent

covers (322) where the lighting elements extend beyond the rib member. It would have been obvious to a person skilled in the art to have modified the device of Phyle by providing a power unit that comprises a SES that is releasably coupled to the pole portion, as taught by Hung, and translucent covers where the lighting elements extend beyond the rib member, as taught by Wu.

Alternatively, if the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle and Yang '613 in view of Wu would make Claim 51 obvious in the same manner. Yang '163 discloses a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to modify the apparatus of Phyle to provide a SES and a RES in a single module that is carried by a pole, as taught by Yang '613, and translucent covers where the lighting elements extend beyond the rib member, as taught by Wu, thereby constructing the claimed invention.

Claim 52, 53, and 55—Claim 52 is unpatentable under 35 U.S.C. 103(a) over Mueller, Rushing, and Hale or Wu. Mueller contains all of the elements of Claim 52 except the canopy carrying a lighting system which includes multiple discrete lighting elements positioned along a rib member, wherein each lighting element is fully recessed within the corresponding rib member. Rushing discloses the canopy portion carrying the lighting system, with multiple discrete lighting elements positioned along the rib members. Hale and Wu disclose the lighting elements being recessed within the corresponding rib member. However, being fully recessed in the rib member would be obvious to one skilled in the art. It would have been obvious to a person skilled in the art to have modified the apparatus of Mueller by providing that the canopy portion carry the lighting system, with multiple discrete lighting elements positioned along the rib members, as taught by Rushing, with the lighting elements being recessed within the corresponding rib member, as taught by Hale or Wu, thereby constructing the claimed invention.

Alternatively, if the Examiner finds the rule 1.131 Declaration lacking, the combination of Mueller, Rushing, and Lee '224 or Lee '856 would make Claim 52 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to

modify the device of Mueller by providing that the canopy portion carry the lighting system, with multiple discrete lighting elements positioned along the rib members, as taught by Rushing, with lighting elements and wires that are recessed into rib members, as taught by Lee '224 and Lee '856, thereby constructing the claimed invention.

Claims 53 and 55 are dependent on Claim 52. Claim 55 has the further limitation that the wires for the lighting elements be fully recessed within the rib members. Hale, Wu, Lee '224, and Lee '856 disclose this limitation as well. Claim 53 adds the limitation that the lighting elements are covered by a translucent cover. Wu discloses this limitation. As such, the combination of Mueller, Rushing, and Lee '224 or Lee '856 would make Claims 53 and 55 obvious.

Claim 60—Claim 60 is unpatentable under 35 U.S.C. § 103(a) over Mueller and Wu. Mueller discloses every element of Claim 60 except for a lighting system that is carried by the canopy portion that is conductively coupled to and powered by the RES, wherein the lighting system includes a plurality of lighting elements, each lighting element being recessed within a corresponding rib member and being covered by a translucent cover carried by the corresponding rib member. Wu discloses these limitations. It would have been obvious to a person skilled in the art to have modified the device of Mueller by providing a lighting system that is carried by the canopy portion that is conductively coupled to and powered by the RES, wherein the lighting system includes a plurality of lighting elements, each lighting element being recessed within a corresponding rib member and being covered by a translucent cover carried by the corresponding rib member, as taught by Wu, thereby constructing the claimed invention.

If the Examiner finds the Rule 1.131 Declaration lacking, the combination of Mueller and Wu in view of Lee '224 or Lee '856 would make Claim 60 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to have modified the device of Mueller by providing a lighting system that is carried by the canopy portion that is conductively coupled to and powered by the RES, wherein the lighting system includes a plurality of lighting elements, each lighting element being recessed within a corresponding

rib member and being covered by a translucent cover carried by the corresponding rib member, as taught by Wu, with the lighting elements and wires recessed into rib members, as taught by Lee '224 and Lee '856, thereby constructing the claimed invention.

Alternatively, Claim 60 is unpatentable based on this combination and Hale. Hale discloses the lighting elements being recessed within a rib portion. As such, one skilled in the art would find Claim 60 obvious after observing this combination.

Claim 61—Claim 61 is unpatentable under 35 U.S.C. § 103(a) over Phyle, Mueller, and Hung. Phyle discloses a patio umbrella apparatus, a base portion, a pole portion coupled to the base portion, a canopy portion hingedly coupled to the pole portion, a RES for providing power to the umbrella apparatus, and the canopy carrying a lighting system, each lighting element carried by a rib member, as well as the wiring system. It does not disclose a power unit carried by the pole portion having an upper and lower portion. Mueller discloses a SES carried by the pole portion that recharges the RES. Hung discloses a power unit (10) that has a SES (32) in the upper portion and a RES (26) in the lower portion, the unit coupled to the top portion of a pole (80). It would have been obvious to a person skilled in the art to have modified the device of Phyle by providing a SES carried by the pole portion that recharges the RES, as taught by Mueller, and a power unit that has a SES in the upper portion and a RES in the lower portion, the unit coupled to the top portion of a pole, as taught by Hung, thereby constructing the claimed invention.

If the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle, Mueller and Yang '613 or Wismeth would make Claim 61 obvious in the same manner. Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified the device of Phyle by providing a SES carried by the pole portion that recharges the RES, as taught by Mueller, and a power unit that has a SES in the upper portion and a RES in the lower portion, the unit coupled to the pole, as taught by Yang '163 and Wismeth, thereby constructing the claimed invention.

Claim 62—Claim 62 is unpatentable under 35 U.S.C. § 103(a) over Mueller and JP 9-168415. Mueller discloses all of the elements of Claim 62 except all limitations dealing

with the lighting subassembly, its location and components. JP 9-168415 discloses a lighting subassembly (7) that is carried by the canopy portion, the lighting subassembly being conductively coupled (9) to the RES, wherein the lighting subassembly includes a plurality of LEDs (7), each LED being recessed relative to a corresponding rib member (3) and each LED being conductively coupled by a conductor (9) recessed relative to the corresponding rib member. It would have been obvious to a person skilled in the art to have modified the device of Mueller by providing a lighting subassembly that is carried by the canopy portion, the lighting subassembly being conductively coupled to the RES, wherein the lighting subassembly includes a plurality of LEDs, each LED being recessed relative to a corresponding rib member, and each LED being conductively coupled by a conductor recessed relative to the corresponding rib member, as taught by JP 9-168415, thereby constructing the claimed device.

Alternatively, this combination in view of Hale would make Claim 62 obvious to a person skilled in the art as well. Hale has a lighting subassembly (15) and conductor (36) that are recessed relative to the corresponding rib member (12). If the Examiner finds the Declaration lacking, the combination above in view of Lee '224 or Lee '856 would make Claim 62 obvious in the same manner.

Claim 64 and 65—Claim 64 is unpatentable under 35 U.S.C. § 103(a) over Mueller or Valdner and Phyle or Rushing. Mueller and Valdner disclose all of the elements of Claim 64 except the lighting system portions. Valdner and Mueller both have discus-shaped modules that hold the SES. Phyle and Rushing disclose a lighting system being carried by the canopy portion. It would have been obvious to a person skilled in the art to have modified Mueller or Valdner by providing a lighting system being carried by the canopy portion, as taught by Phyle or Rushing, and thereby construct the claimed invention.

Alternatively, Claim 64 is unpatentable over the combination above in further view of Hung. The SES is contained in a discus-shaped module that is carried by a pole portion. As such, these combinations make Claim 64 obvious in the eyes of a person skilled in the art. If the Examiner finds the Declaration lacking, the combination above in light of Yang '613 would make Claim 64 obvious in the same manner.

Claim 65 has been amended to be dependent on Claim 64, with the only additional limitation that the discuss-shaped module is releasably coupled to the pole portion. To the extent the term “discuss-shaped module” can be understood, Hung’s module is releasably coupled to the pole portion, as is module in Yang ’613. As such, this combination makes Claim 65 obvious.

Claim 66—Claim 66 is unpatentable under 35 U.S.C. § 103(a) over Phyle and Hung in view of Hale. Phyle discloses all of the elements of Claim 66 except for elements dealing with the SES and the RES forming a power unit fixed relative to the pole portion, with the SES forming the upper portion and the RES forming the lower portion. Additionally, Phyle does not disclose conductors recessed within the rib members. Hung discloses a power unit fixed relative to the pole portion that has the SES forming the upper portion and the RES forming the lower portion. Hale discloses conductors that are recessed within the rib members. As such, Claim 66 would be seen as obvious by one who was skilled in the art after referring to the above combination. If the Examiner finds the Declaration lacking, the combination of Phyle and Yang ’613 or Wismeth in view of Lee ’224 or Lee ’ 856 would make Claims 2, 46, and 74 obvious in the same manner.

Alternatively, Claim 66 is unpatentable in further view of the combination above and Mueller and Wu. Mueller discloses a SES carried by the pole portion of the umbrella, whereas Wu discloses the electrical conductors being recessed within the rib members.

Claims 70 and 71—Claims 70 and 71 are unpatentable under 35 U.S.C. § 103(a) over Mueller or Valdner and Wu. Mueller and Valdner disclose all of the elements of Claim 70 except each rib member having a recessed longitudinal channel and having a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the RES, the lighting system comprising a plurality of lighting elements carried by the rib members, each lighting element being disposed within the channel. Wu discloses a recessed longitudinal channel in each rib member (21 - See FIGS. 5, 7- 8). The lighting elements (32) are recessed within the rib member. As such, a person skilled in the art would view this combination and find Claim 70 obvious. Claim 71 is dependent on Claim 70, with the only additional element being that a transparent cover is disposed over each channel. Wu

discloses a translucent cover being placed over the channel. As such, 71 is unpatentable as well for obviousness. If the Examiner finds the Declaration lacking, the combination of Mueller or Valdner in view of Lee '224 or Lee '856 would make Claim 70 obvious in the same manner, with the addition of Wu for Claim 71.

Alternatively, Claims 70 and 71 are unpatentable with Mueller or Valdner and Wu in further view of Hale. Hale has a recessed longitudinal channel (See FIGS. 3, 8, and 9) within which the lighting elements are disposed. Additionally, having a translucent cover over the lighting elements would be obvious in the view of a person skilled in the art.

Claim 72—Claim 72 is unpatentable under 35 U.S.C. § 103(a) over Mueller or Valdner and Rushing or Phyle in view of Wu or Hale. Mueller and Valdner disclose all of the elements of Claim 72 except a lighting system carried by the canopy portion, a plurality of discrete lighting elements carried by each rib member that is recessed within a corresponding rib member, and the electrical conductors also being recessed within the rib members. Rushing and Phyle disclose a lighting system carried by the canopy portion and a plurality of discrete lighting elements carried by each rib member. Hale and Wu disclose the lighting elements and the electrical conductors being recessed within the rib members as well. As such, Claim 72 would be obvious to one skilled in the art in view of the above combination. If the Examiner finds the Declaration lacking, the combination Mueller or Valdner and Rushing or Phyle in light of Lee '224 or Lee '856 would make Claim 72 obvious in the same manner.

Compliance with 37 C.F.R. §§ 1.52 and 1.943

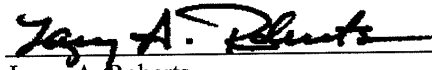
The foregoing Comments are submitted in 12 point nonscript type, 1-1/2 spaced, and do not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

CONCLUSION

In view of the foregoing, Southern Sales respectfully requests that the rejection of Claims 1, 2, 4, 5, 6, 7, 9, 49, 50, 51, 54, 55, 57, 72, 73 and 74 be maintained, and that Claims 1, 2, 4, 5, 47-56, 59-62, 64-66, 70-72, and 74 be rejected under 35 U.S.C. § 103(a) based

upon the various combinations discussed above and any other various combinations that may be developed in further combination with the new prior art references cited herein and the other bases as set forth above.

Respectfully submitted:



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EXHIBIT C
U.S. PATENT NO. 5,055,984 TO HUNG *ET AL.*

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YOT-1003-1525

United States Patent [19]
Hung et al.

[11] **Patent Number:** **5,055,984**
 [45] **Date of Patent:** **Oct. 8, 1991**

- [54] **SOLAR RECHARGEABLE LIGHT**
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- [22] **Filed:** **Aug. 11, 1989**
- [51] **Int. Cl.:** **F21L 7/00**
- [52] **U.S. Cl.:** **362/183; 362/431; 362/145; D26/67**
- [58] **Field of Search:** **362/183, 145, 153, 285, 362/287, 372, 431; 136/291; D26/67-71**

4,486,820	12/1984	Baba et al.	362/183
4,751,622	6/1988	Williams	362/183
4,835,664	5/1989	Wen	362/183
4,841,416	6/1989	Doss	362/183

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[57] **ABSTRACT**

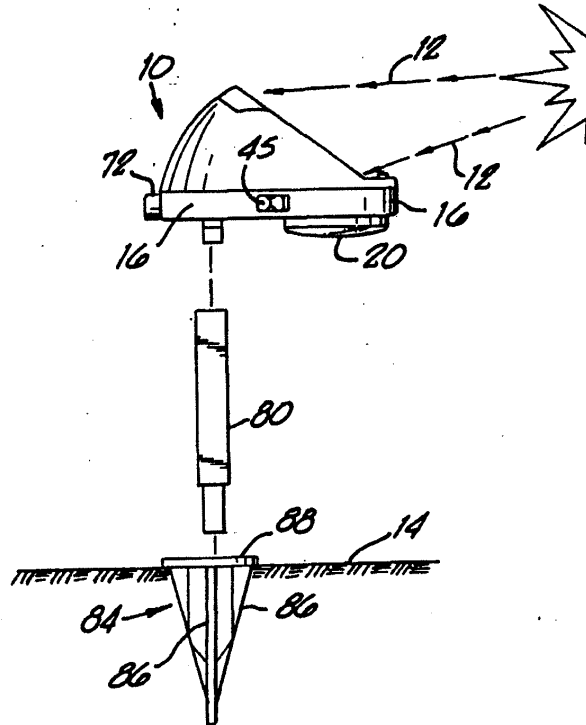
A solar rechargeable light has a lamp for illuminating a selected area such as the ground or a wall. A base is adapted to support the lamp in a fixed position to illuminate the selected area. An electrical storage device and power supply is electrically coupled to the lamp. A solar panel is electrically coupled to the electrical storage device for charging the storage device when the solar panel is exposed to light, wherein current from the storage device energizes the lamp, and wherein the solar panel is moveable relative to the base so that the orientation of the solar panel is substantially independent of an orientation of the lamp relative to the selected area.

[56] **References Cited**

U.S. PATENT DOCUMENTS

D207,273	3/1967	Muller et al.	D48/31
D291,926	9/1987	Schlepp	D26/67
2,919,353	12/1959	Paradise	250/239
3,869,604	3/1975	Prochnow	362/285
4,281,369	7/1981	Batte	362/183
4,450,507	5/1984	Gordin	362/431
4,481,562	11/1984	Hickson	362/183

1 Claim, 2 Drawing Sheets



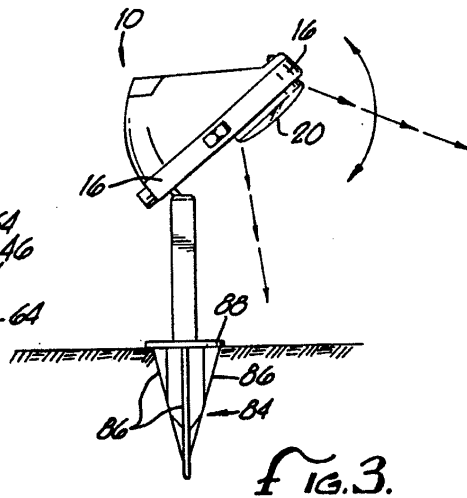
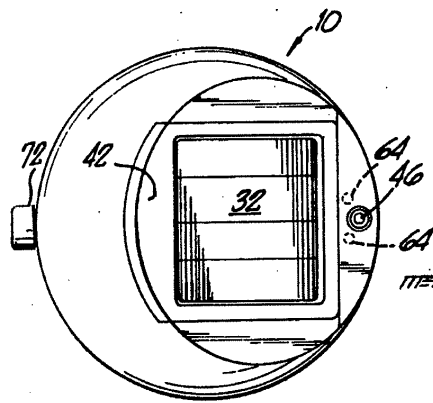
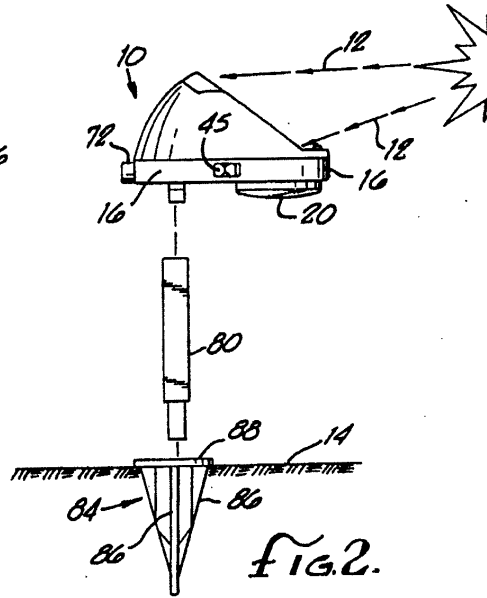
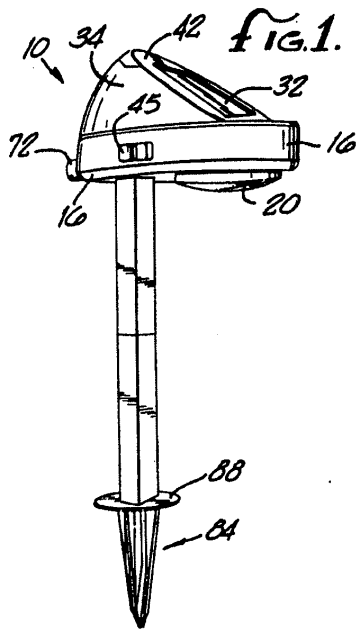
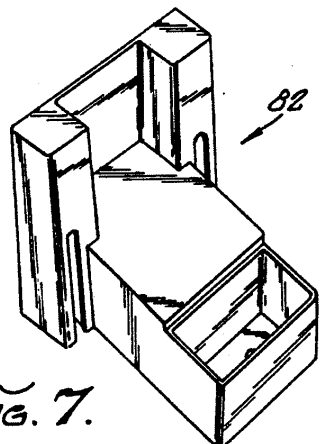
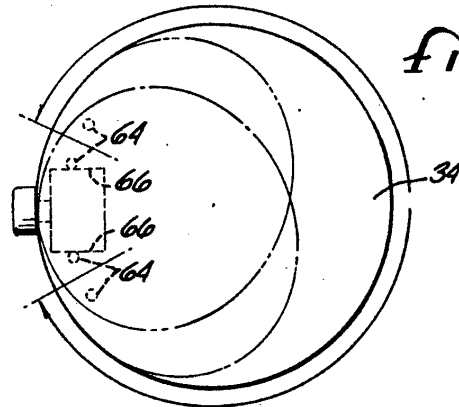
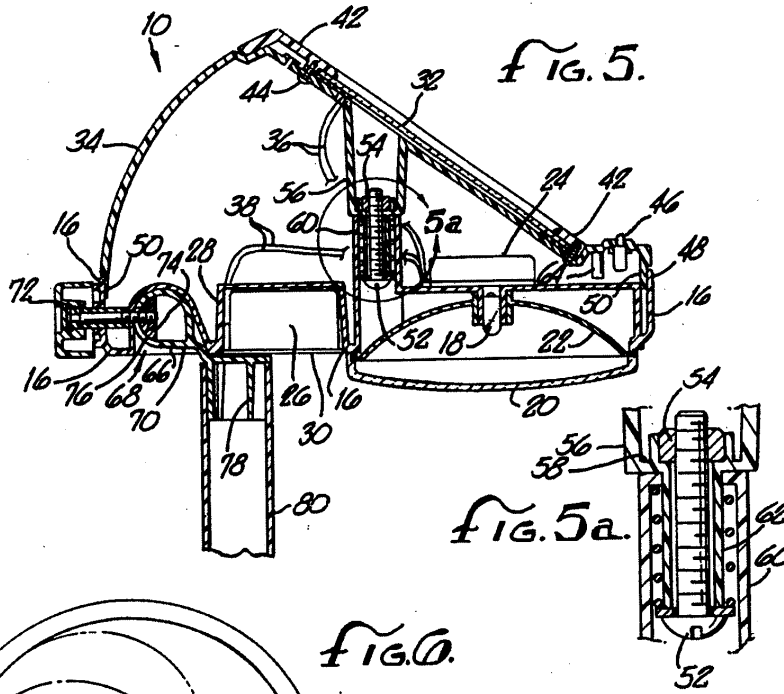


FIG. 4.

FIG. 3.



SOLAR RECHARGEABLE LIGHT**BACKGROUND OF THE INVENTION****1. Field Of The Invention**

The present invention relates to solar rechargeable lights.

2. Related Art

Yard and walkway lights are well known for providing illumination of sidewalks, driveways, yards, and so forth. These lights typically are powered through underground wiring or gas supply. To eliminate the need for such underground power supply, solar powered lights have been used which can be selectively placed irrespective of underground power supplies, as long as there is sufficient illumination of the solar panel to charge a battery sufficiently to power the light when darkness sets in.

Such solar powered lights typically have been mounted on posts stuck in the ground and have had the light bulb placed on the bottom of the housing of the solar light. The solar panel for the light sloped downward on a side of the housing from the top of the housing to the bottom. With this arrangement, however, placement of the light in the desired location for optimum illumination of a selected area necessarily determined the orientation of the sloped solar panel. On the other hand, if the light was positioned so as to optimize collection of solar rays in the solar panel, the selected area for illumination was not always properly lighted. There has been a need, therefore, for a solar powered light wherein the orientation of the light is independent of the orientation of the solar panel.

Prior solar powered lights were rigidly fixed to the standard or post on which the light housing was mounted. As a result, the light source always pointed down to illuminate the ground underneath the light. The light would illuminate a circular area centered around the solar powered light. The rigid structure of the light did not allow reorientation of the light to illuminate a different area. There also has been, therefore, a need for a solar powered light which can be adjusted for illuminating any number of selected areas from the same location.

Prior solar lights were placed in the ground merely by sticking the support stake in the ground. Whenever the surrounding area was to be mowed or cleaned, the light would be left in place, in which case it could be hit or bumped and possibly damaged or the area next to the stake could not be adequately maintained, or the stake could be removed from the ground. If the stake were removed from the ground, the hole is often widened through the action of withdrawing and replacing the stake, making the repositioning of the light unstable. Therefore, there has been a further need for a solar powered light which can be placed in the ground and repeatedly removed to allow mowing or cleaning in the surrounding area without loosening the surrounding soil with repeated removal of the stake.

SUMMARY OF THE INVENTION

Briefly, and in general terms, the present invention resides in a solar rechargeable light which the orientation of the light source is independent of the orientation of the solar panel, movement of the light source is allowed to change the area of illumination, and the light

can be quickly and easily removed from the ground and replaced after mowing, trimming and so forth.

In accordance with the present invention, a solar rechargeable light has a lamp for illuminating a selected area such as the ground or a wall. A base is adapted to support the lamp in a fixed position to illuminate the selected area. An electrical storage device and power supply is electrically coupled to the lamp. A solar panel is electrically coupled to the electrical storage device for charging the storage device when the solar panel is exposed to light, wherein current from the storage device energizes the lamp, and wherein the solar panel is moveable relative to the base so that the orientation of the solar panel is substantially independent of an orientation of the lamp relative to the selected area. With this invention, the lamp and the solar panel can be oriented independently of one another to optimize the collection of solar rays and still provide the desired illumination at the same time.

In a preferred embodiment, the solar panel is rotatable about an axis relative to the base through an angle of only less than 360°. This minimizes the possibility of entanglement of any wires or conductors which may be used in the solar rechargeable light. Additionally, the base may include a mount which is releasably fixed to the base so that the base and lamp can be adjusted in position relative to the support. This would allow, for example, the light to be tilted for illuminating a different area or for adjusting the solar panel angle to present the best panel angle at the particular latitude.

In a further preferred embodiment, the solar rechargeable light can be mounted on a light stand having an end which can be placed in a ground stake embedded in the ground. The light stand can be easily removed from the ground stake to allow mowing or trimming. The light stand can then be easily reinserted into the ground stake without disturbing the surrounding soil so that the light is in the same stable position and orientation as previously.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is a perspective view of a solar rechargeable light supported by a light stand and ground stake.

FIG. 2 is a side elevation exploded view of the solar rechargeable light shown in FIG. 1.

FIG. 3 is a side elevation view of the solar rechargeable light of FIG. 1 showing the light tilted.

FIG. 4 is a top plan and sectional view of the light of FIG. 1.

FIG. 5 is a vertical cross-sectional view of the light of FIG. 1.

FIG. 5a is a detailed vertical cross-sectional view of a portion of the light of FIG. 5 showing concentric pivot cylinders.

FIG. 6 is a plan view of the light of FIG. 1 depicting the full extent of rotation of a solar panel.

FIG. 7 is a perspective view of a wall mounting bracket for use with the light of FIG. 1.

DESCRIPTION OF THE PREFERRED EMBODIMENTS

In accordance with the invention, a solar rechargeable light is described which provides orientation of the light source independent of the orientation of the solar collector for the light so that the light can be positioned as desired while still allowing orientation of the solar panel for optimum efficiency. Considering FIGS. 1, 2 and 3, a solar rechargeable light 10 receives light rays

12 (FIG. 2) from the sun or other suitable light source and converts the light rays to electrical energy for storage and subsequent use to energize the light source for illuminating a selected area, such as the ground 14. A base 16 forms the lower part of a housing for the rechargeable light. A lamp or lamp bulb 18 is mounted in the base for producing light to shine below the base through a lens 20 for illuminating a selected area such as the ground or a wall. The lamp bulb may be an incandescent light source, or a gas-filled, fluorescent or other suitable light source. The lens 20 transmits the light, part of which light is reflected from a reflector 22 also mounted in the base 16. The lens holds the reflector in an opening in the bottom of the base through a bayonet lock mount or other suitable means for removeably retaining the lens.

The bulb is electrically coupled through an appropriate circuit 24, to be described more fully below, to an electrical storage device and power supply or battery 26 so that current from the power supply can energize the lamp bulb. The battery may be, for example a gelled electrolyte lead acid battery or NiCad battery, for example. The battery 26 is retained in a battery compartment 28 formed in the bottom of the base using a cover 30 fastened to the bottom of the base.

A solar panel 32 is mounted on an upper housing or cover 34 relative to the base 16 so as to be slanted or sloped for receiving light rays and converting the energy of the light rays to electrical energy. The solar panel may also be used as light/darkness indicator for determining when it is dark enough to turn the lamp bulb on. The solar panel is preferably a semi-crystalline solar panel well known in the art for receiving and converting light rays to electrical energy, such as may be used for charging a storage battery. The solar panel is electrically coupled to the battery 26 through the electrical circuit 24 by means of suitable conductors 36 and 38 for charging the storage device when the solar panel is exposed to light.

The solar panel is placed on a sloped surface on the cover 34 and sandwiches a water seal cover or gasket 40 against the outer top surface of the solar panel to keep water out of the housing under normal conditions. The solar panel and gasket are held in place by a panel cover 42 having lugs or clips 44 passing through slots in the gasket around the edges of the gasket and through respective slots in the cover 38 to clip the underside of the cover and thereby retain the gasket and solar panel in place. A suitable opening is formed in the panel cover to allow light rays to reach the solar panel.

A switch 45 is mounted on the outside of the base for selecting between an "Automatic" configuration for circuit 24 and an "Off" configuration. In the "Off" configuration, the light will be off at all times while still allowing charging of the battery by the solar panel. In the "Automatic" configuration, the solar panel charges the battery during the day while the light is off, and the light comes on at night using current stored in the battery. Alternatively, the "Off" configuration can disconnect the battery from both the solar panel and the lamp bulb.

The electrical circuit 24 is any suitable circuit well known to those skilled in the art for accomplishing the functions described herein. The circuit passes current from the solar panel to the battery for charging the battery during the day while light is absorbed by the solar panel. The electrical circuit includes a circuit for determining when darkness has set in. In one embodi-

ment, the darkness sensor circuit is coupled to the solar panel and a diode is provided in the circuit between the solar panel and battery to prevent current from passing in the opposite direction from the battery to the solar panel during darkness, resulting in a gradual low level drain. The electrical circuit also includes a further circuit for testing the charge level of the battery. When the charge level on the battery approaches 30% of maximum, due to continuous energization of the lamp bulb, the electrical circuit opens the circuit between the battery and the lamp bulb to prevent further draining of the battery. The battery can then be recharged. A further circuit is included for keeping an open circuit between the battery and the lamp bulb when there is sufficient ambient light, for example from the sun, to illuminate the solar panel. The electronic circuit is preferably moisture resistant.

In the disclosed embodiment, a low battery indicator 46 is mounted in the cover 38 centered and in front of the solar panel (FIG. 4). The indicator 46 may be an LED coupled to the electrical circuit 24 and is illuminated when the battery charge level approaches 30% of maximum. Alternatively, the battery indicator may be omitted.

In the disclosed embodiment, the base 16 and the cover 38 are circular in plan view and engage at their circumferential edges in an overlapping junction around the circumferences thereof. The inside diameter of the rim 48 of the base is approximately the same as the outside diameter of the circular rim 50 of the cover which slidingly contacts the inside surface of the rim of the base. The rim of the base abuts against a ledge extending outwardly from the rim of the cover so that the ledge rests on the rim of the base. This engagement between the base and the cover allows the rim of the base to support the outer edge of the cover which allows rotation of the cover relative to the base. Moreover, the sliding joint between the cover and the base around the entire circumference thereof provides centering, interlocking stability and mutual alignment of the cover and the base. The rims take some of the centering pressure off the pivot cylinders and distributes it around the edges of the base and cover.

The cover and base are placed in mutual engagement and allowed to rotate relative to one another about a central axis defined by a bolt 52 threaded into a captivated nut 54. The nut 54 rests at the bottom 58 of a first pivot or depending cylinder 56 extending downward from the flat sloping surface on which the solar panel is retained. A hole is formed in the bottom of the depending cylinder to allow a portion of the bolt 52 to pass into the cylinder and thread with the nut.

A second pivot or base cylinder 60, having an outside diameter less than the outside diameter of the first cylinder 56 and having an inside diameter slightly less than the inside diameter of the first cylinder, extends upwardly from the base to contact the bottom 58 of the depending cylinder. The length of the first and second pivot cylinders are such as to provide support for the cover in addition to the support provided by the engagement of the rims of the cover and base. An annular cap 61 closes off part of the second pivot cylinder to act as a bearing surface for a spring, described below.

Concentric with the first and second pivot cylinders is a third pivot or stop cylinder 62 fixed to the bottom 58 of the first cylinder and extending downward within the interior of the second cylinder 60. A compression spring 64 extends from a washer at the head of the bolt 52 to

the annular cap on the base cylinder between the inside of the base cylinder and the outside of the stop cylinder. The combination of the first, second and third pivot cylinders, the bolt and captivated nut and the compression spring provide centering for the cover and base and allow the cover to rotate relative to the base. The lengths of the base cylinder and the stop cylinder from the bottom 58 are such as to provide a uniform tension in the compression spring 64 when the bolt is threaded until the washer stops against the stop cylinder. This provides the desired amount of frictional engagement between the base and cover while still allowing manual rotation of the cover.

The conductors 36 and 38 are sufficiently long to allow rotation of the cover relative to the base about 360°. A pair of posts 64 (FIG. 5; shown in phantom in FIG. 4) extend downwardly on each side of the low battery indicator 46. The posts extend downwardly a distance sufficient to come into contact with walls 66 in the base defining a cavity 68 for accommodating a hinge 70, to be described more fully below. The cover can rotate relative to the base in one direction until the first post contacts the wall of the cavity 68 (FIG. 6). The contact between the post and the wall prevents wrapping of the conductors around the pivot cylinders. The cover can be rotated in the other direction until the second post contacts the opposite wall of the cavity 68. This prevents the conductors from wrapping around the pivot cylinders in the other direction. The full extent of rotation of the cover, however, approaches 360° and allows for almost any desired orientation of the solar panel regardless of the position, in a horizontal plane, of the lamp bulb. This allows for optimum exposure of the solar panel to light rays while still allowing the best possible positioning of the light source for illuminating the selected area of the ground, wall or the like.

The base and cover are made of a suitable plastic. The first, second and third pivot cylinders are dimensioned along with the spring and bolt in such a way as to allow easy manual rotation of the cover while still providing sufficient frictional engagement between the rims and cylinders of the cover and base to keep the cover from rotating when no force is applied to the cover.

The cavity 68 accepts a cylindrical hinge element 70 in a manner which allows the hinge to rotate about a horizontal axis extending from the left to the right side of the base. The cavity defines an inverted round-bottomed trough enclosed at each end by straight sides. The cylindrical hinge element rests and rotates in the trough and is held in place by each side of the trough. The hinge element is rotatably cradled in cusps in the sides of the trough by protrusions on each end of the hinge element. The hinge element is releasably fastened in place in the trough by a bolt 72 and friction nut 74 so that the base and cover can be rotated about the hinge element to change the orientation of the light and solar panel. A slot 76 in the hinge element allows rotation of the hinge element relative to the bolt.

A mounting post 78 is coupled to the hinge element 70 to allow the rechargeable light to be mounted to a light stand 80 which can then be anchored in the ground or to a wall mounting bracket 82 (FIG. 7) for mounting to another suitable support surface.

As shown in FIG. 2, the light stand can be inserted on the mounting post 78 and then used in conjunction with

a ground stake 84 so that the rechargeable light can illuminate the ground or walkway, etc. The ground stake preferably includes a plurality of flanges 86 to maintain a stable anchor for the light. The ground stake also has a flat, horizontally extending rim 88 to be placed flush against the ground to provide a low profile for the ground stake and to provide a bearing surface for pushing the ground stake into the ground. After installing the light, the light stand and light can be removed from the ground stake so that the surrounding area can be mowed, trimmed or otherwise maintained.

As shown in FIG. 3, the bolt 72 can be loosened to allow the hinge element to rotate within the cavity 68 to change the planar orientation of the base and cover of the light. This changes the selected area of illumination for the light. It can also be used to change the slant angle of the solar panel as a function of geographic latitude. The bolt can be retightened as desired to fix the orientation of the light.

FIG. 4 shows the slanted solar panel retained in the cover by the panel cover 42. The low battery indicator is centered in front of the solar panel and the posts 64 are shown in phantom on each side.

The wall mount bracket 82 (FIG. 7) includes a rectangular cavity for accepting the mounting post 78 and a pair of slots for accepting the heads of suitable fasteners mounted in a wall or fence for mounting the wall mount bracket to the wall or fence.

The base may include one or more louvers or vents for preventing build-up of humid air inside the cover and base. There may also be provided a labyrinthine path from inside the cover, through a small gap in the gasket 40 and out the top of the cover underneath the upper portion of the panel cover 42. This allows for convective circulation of air through the unit and prevents accumulation of humid air inside the housing.

Although the present invention has been described in detail with reference only to the presently preferred embodiments, it will be appreciated by those of ordinary skill in the art that various modifications can be made without departing from the invention. Accordingly, the invention is limited only by the following claims.

We claim:

1. A solar rechargeable light assembly comprising:
 - a substantially planar base;
 - a lamp mounted in the planar base in a fixed position for illuminating a selected area such as the ground or a wall in a direction away from the base;
 - a mount releasably fixed on the base for mounting the light assembly to a support such as the ground or a wall;
 - an electrical storage device and power supply for supplying electric current to the lamp;
 - a cover mounted to a side of the base opposite the lamp and rotatable relative to the base through an angle less than 360°; and
 - a solar panel fixed to the cover at an angle slanted relative to the planar base to face away from the base and electrically coupled to the electrical storage device for charging the storage device when the solar panel is exposed to light, and wherein current from the storage device illuminates the lamp.

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EXHIBIT D
U.S. PATENT NO. 5,758,948 TO HALE

US2000 12107221.1

YOT-1003-1532



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United States Patent [19]
Hale

[11] **Patent Number:** 5,758,948
[45] **Date of Patent:** Jun. 2, 1998

[54] **SEASONAL LIGHT DISPLAY DEVICE**

5,488,549 1/1996 Miller et al. 362/123
5,609,412 3/1997 Contigiani 362/123

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Attorney, Agent, or Firm—Ryan, Maki, Mann & Hohenfeldt

[21] **Appl. No.:** 677,832

[57] **ABSTRACT**

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[51] **Int. Cl.⁶** F21P 1/00; F21P 1/02;
A47G 33/06

[52] **U.S. Cl.** 362/123; 362/123; 362/249;
428/8; 428/9

[58] **Field of Search** 362/102, 123,
362/109, 249; 428/8, 9

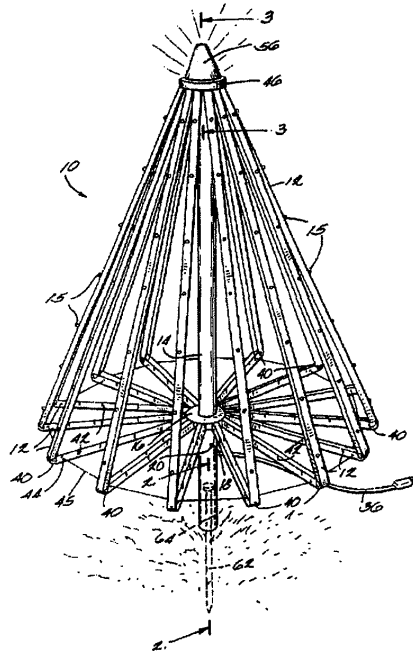
A lighting display device simulates a decorated, lighted tree, when illuminated. A plurality, preferably 15 elongated support members are attached at each end to a central shaft. The upper end is hingedly attached to a stationary collar while the lower end is attached to a collar which is axially moveable along the shaft. A hinge is formed in each of the support members at a point spaced away from the ends of the support members. Each of the support members has a generally C-shaped configuration with an open side facing the shaft and a plurality of spaced openings through a surface of each of the support members faces away from the shaft. Each of the openings is adapted to receive a light bulb from a string of lights, and the channel is adapted to receive a plurality of light sockets supporting the lights. When the collar is moved axially along the shaft, each of the support members is moved, from a substantially straight position suitable for storage of the device, to an erect position wherein each of the support members is folded outwardly from the shaft at the hinge point. The axially moveable ends of the support members are secured to the shaft thus forming a conical tree-like structure.

[56] **References Cited**

U.S. PATENT DOCUMENTS

2,087,537	7/1937	Finkel	362/102
2,414,866	1/1947	Glaser	362/123
2,708,324	5/1955	Wedden	362/123
3,313,929	4/1967	Schiavone	362/102
3,704,366	11/1972	Korb et al.	362/123
3,819,459	6/1974	Wren	362/123
4,404,621	9/1983	Mauro	362/123
4,620,270	10/1986	Laakso	362/123
4,734,301	3/1988	McKinney	428/8
4,806,392	2/1989	Dixon	362/123
4,847,123	7/1989	Armstead et al.	428/9
5,053,931	10/1991	Rushing	362/102
5,359,502	10/1994	Cantin	362/249

10 Claims, 5 Drawing Sheets



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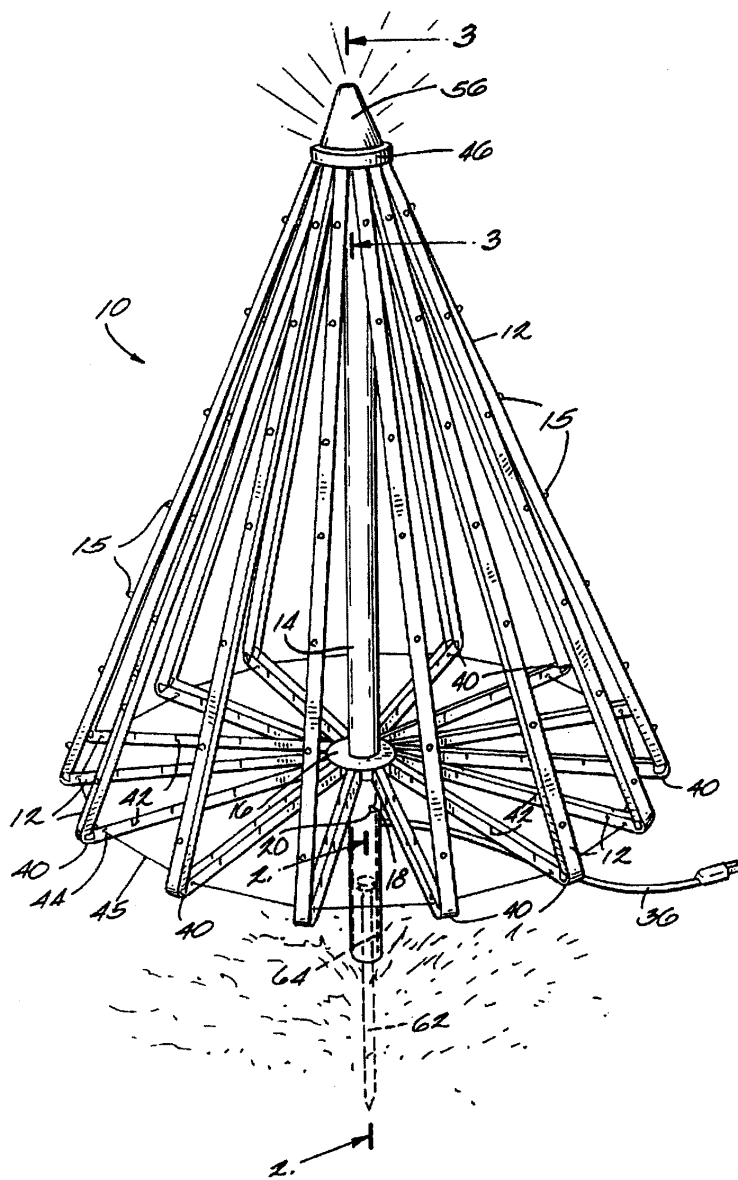
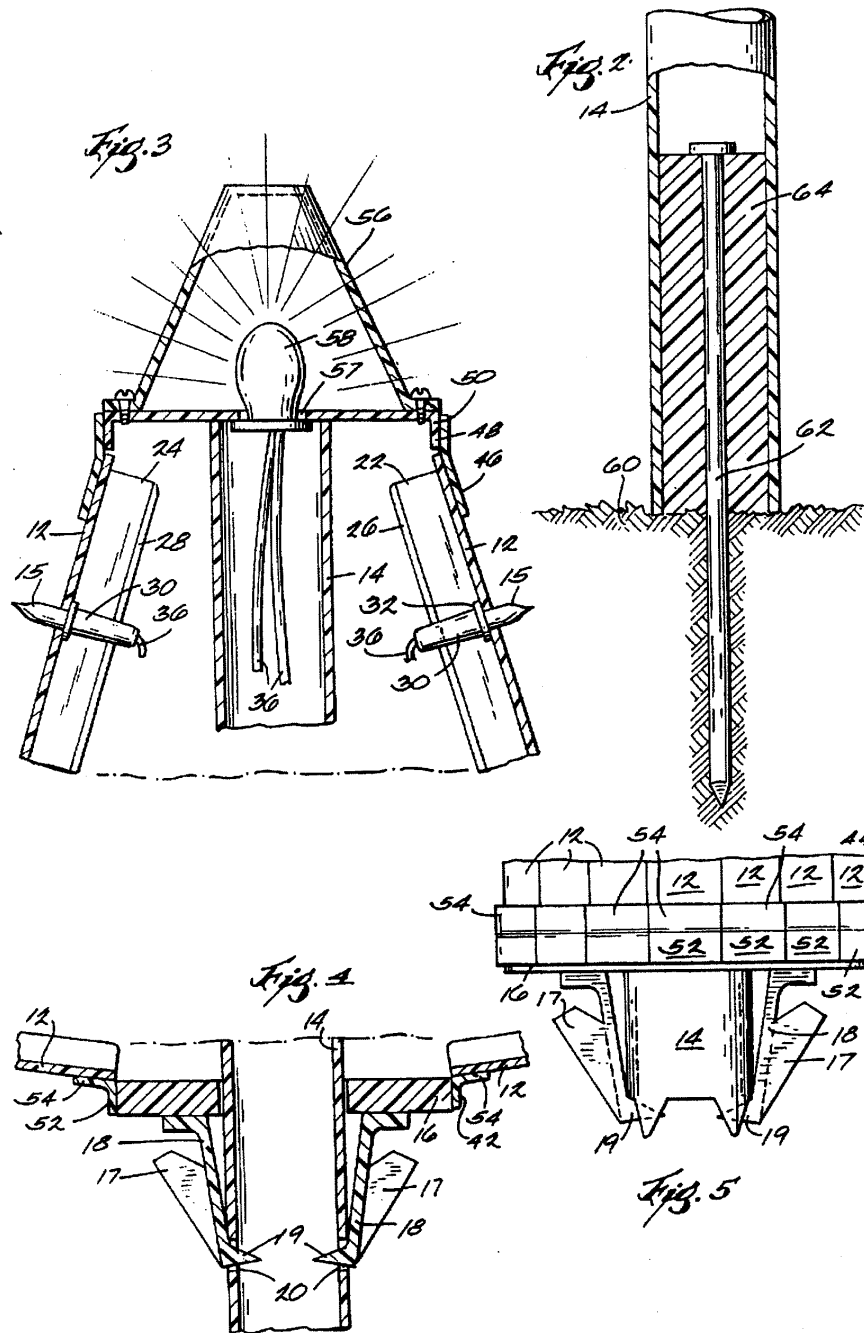
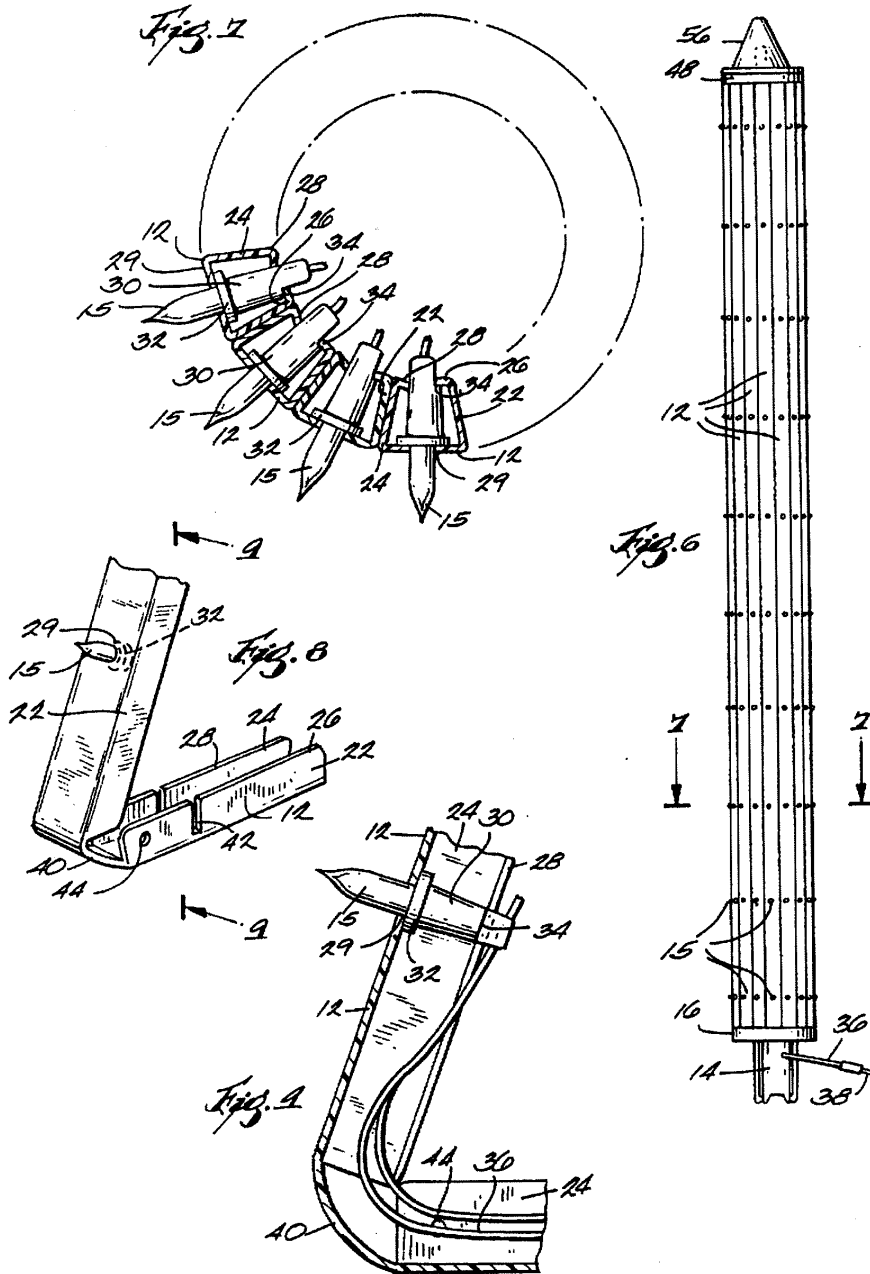


Fig. 1

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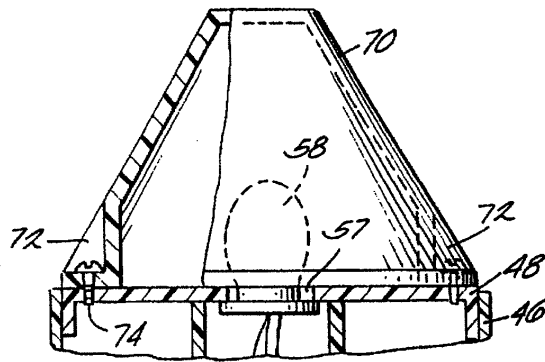


Fig. 10

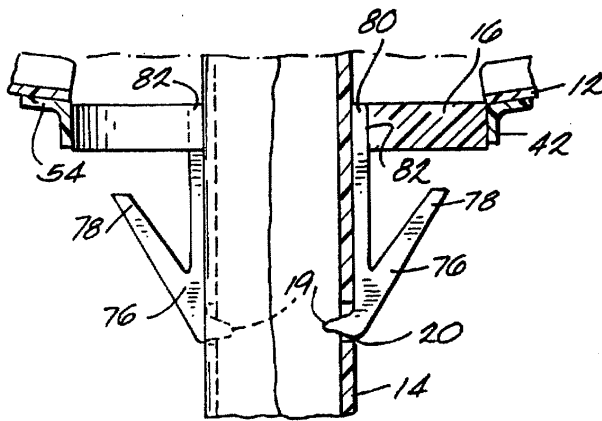
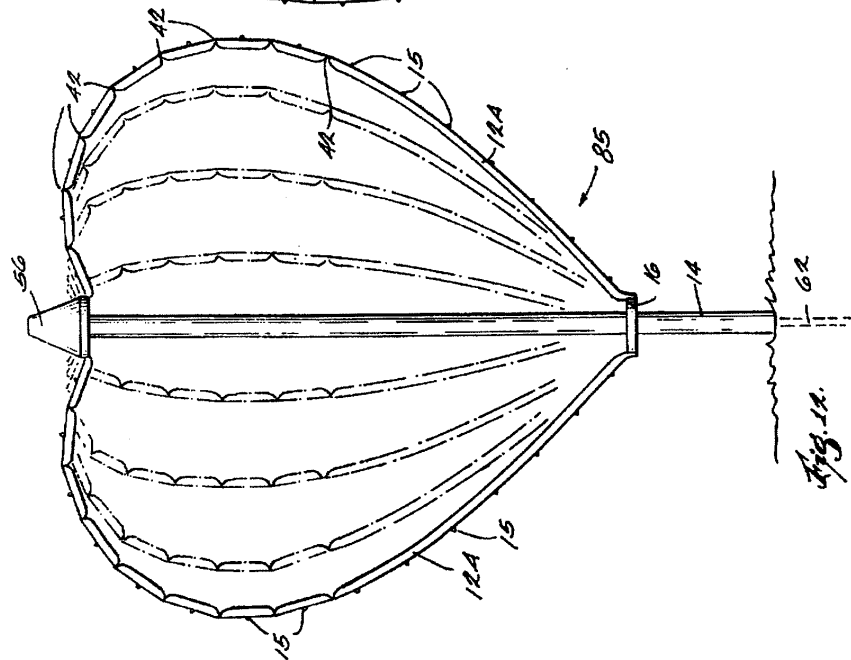
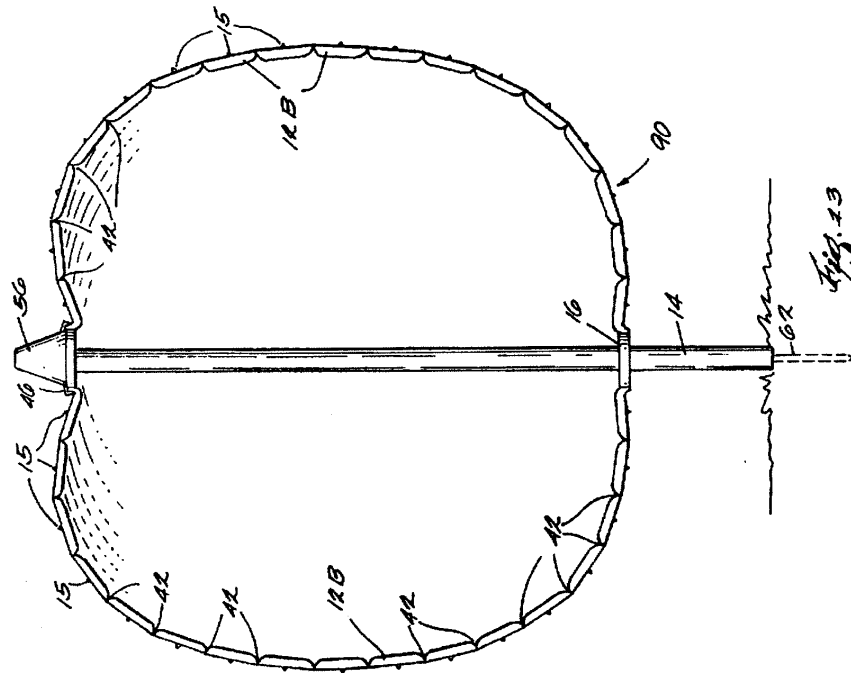


Fig. 11



YOT-1003-1538

SEASONAL LIGHT DISPLAY DEVICE

FIELD OF THE INVENTION

The present invention relates to lighted display devices such as simulated Christmas tree. More specifically the invention relates to a collapsible light-supporting device that, when illuminated, at night resembles a lighted outdoor tree or similar lighted object.

BACKGROUND OF THE INVENTION

Various types of artificial Christmas trees have been utilized for indoor and outdoor usage. Often, to provide an outdoor lighted tree, either a living tree or some type of framework that can support the Christmas lights in a shape resembling a tree, when lighted at night, have been utilized.

SUMMARY OF THE INVENTION

The present invention provides a collapsible and erectable structure adapted to hold one or more strings of conventional Christmas tree lights, and which, when erected, assumes a conical shape resembling a lighted Christmas tree when illuminated and viewed in darkness.

In accordance with one of its aspects, the invention provides a collapsible light supporting device adapted to hold one or more strings of conventional Christmas lights in a shape simulating a tree when erected and illuminated.

In accordance with a related aspect of the invention, a framework is provided which includes a plurality of channels for holding a string of lights. In accordance with a further aspect of the invention the channels for receiving the lights are configured to receive a string of commercially available lights installed in plurality of sockets generally wired together to form a string of lights. Preferably the channels are provided with openings for receiving and supporting the individual lights. In accordance with a further aspect of the invention a conical, treelike structure can be collapsed, much in the manner of an umbrella, for off-season storage.

In accordance with a further aspect of the invention the conical structure is provided with a supporting base which preferably is provided at its lower end with a projecting spike which can be inserted into the ground, by hammering, even if the ground is frozen.

In accordance with yet further aspects of the invention, the structure is preferably formed of plastic channel-shaped strips connected to the upper end of a central shaft which resembles a tree trunk and which are adapted to be pivoted away therefrom into a conically shaped superstructure for use.

In accordance with still further aspects of the invention, the lower ends of each strip are connected to a collar, which forms an interconnecting structure for the lower end of the conical superstructure, which is slidable axially along the central shaft. In accordance with still further aspects of the invention, each rib is provided with a pivoting joint nearer the base of the treelike structure than its top so that, when the collar is moved upwardly on the central shaft, the strips will each pivot outwardly to provide a uniform conically-shaped structure.

In accordance with still further aspects of the invention, other shapes of lighted displays of varying colors are provided for different holidays or special days such as Valentine's Day or Halloween.

Briefly, a lighting display device of the invention simulates a decorated, lighted tree, when illuminated. A plurality,

preferably 15, elongated support members are attached at each end to a central shaft. The upper end is hingedly attached to a stationary collar while the lower end is attached to a collar which is axially moveable along the shaft. A hinge is formed in each of the support members at a point spaced away from the ends of the support members. Each of the support members has a generally C-shaped configuration with an open side facing the shaft and a plurality of spaced openings through a surface of each of the support members faces away from the shaft. Each of the openings is adapted to receive a light bulb from a string of lights, and the channel is adapted to receive a plurality of light sockets supporting the lights. When the collar is moved axially along the shaft, each of the support members is moved, from a substantially straight position suitable for storage of the device, to an erect position wherein each of the support members is folded outwardly from the shaft at the hinge point. The axially moveable ends of the support members are secured to the shaft thus forming a conical tree-like structure.

Further objects and advantages of the invention will be apparent from the following detailed description, the claims and the accompanying drawings.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is a perspective view showing a lighting device of this invention in the assembled, erect position;

FIG. 2 is a fragmentary cross sectional view taken along line 2-2 of FIG. 1;

FIG. 3 is a fragmentary sectional view taken along line 3-3 of FIG. 1;

FIG. 4 is a fragmentary central sectional view showing in expanded detail the relationship between the central shaft and the elongated light supporting members;

FIG. 5 is fragmentary view showing the lower strip connecting assembly in the storage position;

FIG. 6 is a side elevational view showing the device of the invention in the collapsed storage position;

FIG. 7 is a fragmentary sectional view taken along line 7-7 in FIG. 6;

FIG. 8 is a fragmentary perspective view of a pivoting joint formed in the elongated supporting strips used in connection with the structure of the invention; and,

FIG. 9 is a sectional view taken along line 9-9 of FIG. 8;

FIG. 10 is a fragmentary cross-sectional view showing an alternate form of an upper end cap for device of this invention;

FIG. 11 is a fragmentary view with parts in section showing an alternative embodiment of a slidable collar and central supporting shaft assembled together;

FIG. 12 is a side elevational view with some of the light supporting strips removed for clarity showing a lighting device of this invention suitable for use at Valentine's Day; and,

FIG. 13 is a view showing schematically a lighting device suitable for use at Halloween.

DETAILED DESCRIPTION

Referring more particularly to the drawings, a lighting device 10 of this invention is shown in the assembled and erect position in FIG. 1. Device 10 is adapted to support at least one string of conventional Christmas tree lights and to resemble, when illuminated, a lighted Christmas tree, when viewed at night or in darkness. As will be further explained, such a device can be provided either for indoor or outdoor display.

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Device 10 includes a plurality, around its circumference, of elongated light supporting strips 12. Strips 12 are all mounted concentrically around a central supporting shaft 14. Each strip 12 is preferably in the form of a generally C-shaped channel and is adapted to support a plurality of small miniature or small light bulbs 15 provided in a conventional string of lights. Each of the strips 12 is connected at its lower end to a sleeve 16 which is concentrically slidably mounted around a central supporting shaft 14. As best seen in FIG. 4 the lower end of supporting sleeve 16 is provided with a plurality, preferably a pair, of clips 18 which have inwardly extending tips or ends 19, which are adapted to be received in openings or slats 20 provided in shaft 14 at an elevation which supports the strips 12 in a generally conical shape as shown in FIG. 1.

As best seen in FIG. 7, each of strips 12 is provided with an outwardly exposed side having circular openings through each of which a light bulb 15 extends. Strips 12 have opposed lateral edges 22 and 24 which are sloped inwardly at an angle which enables all of the strips, when placed in the storage position shown in FIG. 6, to form an encircling assembly around central shaft 14. In the illustrated embodiment there are 15 strips 12 positioned around central shaft 14. This number of strips has been convenient, and preferred, in that a single string of miniature type Christmas tree lights will conveniently fit within and be supported by the channels of strips 12. However, it will be understood that a different number of strips 12 can be utilized and that the side surfaces 22 and 24 can be positioned at a slightly different angle appropriate for the number of strips 12 employed to fit together.

As further seen in FIG. 7, the sides 22 and 24 of strips 12 also have inwardly turned edges 26 and 28 which form a partial inner wall for strips 12 through which light bulbs 15 can be introduced or removed as needed.

It will be noted that the sockets 30 into which miniature style light bulbs 15 are conveniently each provided with a flange or ledge 32 which abuts against the inner side of strips 12 thereby enabling the light bulbs 15 only, to extend through openings 29 in strips 12. Light sockets 30 also, conveniently, usually have ledges 34 formed thereon, which are of a size adapted to snap under and to be retained by an edge 26 or 28, to thus securely hold the lights in place. In conventional fashion the light sockets are all connected electrically in by means of wires or cords 36 which are provided at their ends with a conventional electrical plug 38 for installation in the socket of an electrical outlet or extension cord.

Each of the strips 12 is provided with a section 40 which is the devoid of sidewalls 22 and 24. Sections 40 thus provide a point for folding of the strips 12 outwardly when sleeve 16 is raised along the length supporting shaft 14. The pivoting points defined by sections 40 are preferably located closer to the lower end of the assembly than to the top so that a conical shape is achieved as shown in FIG. 1 when sleeve 16 is moved to an elevation wherein ends 19 of clips 18 can be lodged in slots 20. Note also in FIGS. 4 and 5 that clips 18 have projecting flanges 17 which are provided to enable removal of ends 19 from slots 20 by pivoted caused by inward finger pressure against the projecting flanges 17.

As also best seen in FIGS. 1 and 8, the lower ends of strips 12 are preferably provided with a plurality of slots or notches 42 which impart a degree of flexibility and curvature to the lower ends of strips 12 while the upper ends are relatively more rigid. Also provided in the strips 12 at a location just below pivot sections 40 are openings 44 which

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are adapted to receive an encircling restraining cord 45. Cord 45 is of benefit in assisting the assembly 10 in holding its shape even when adverse weather conditions, such as wind or blowing snow are encountered. Cord 45 is preferably attached to each strip 12 by means of glue, a clip or similar fastening means. An L-shaped tab 52 can be adhered to sleeve 16 corresponding to each strip 12. The ends 54 of tabs 52 provide surfaces for attachment of strips 12.

An upper plate 50 is also provided at the upper end of shaft 14 as best seen in FIG. 3. Connecting strips 46 are also connected to upper ends of strips 12 and to a downwardly depending flange 48 on plate 50. This arrangement will be observed to enable repeating pivoting of the upper ends of strips 12 toward and away from shaft 14 without failure on account of material fatigue.

Also located at the upper end of the device 10 is a translucent conical cap 56 which houses a bulb 58 which is adapted to extend through a central opening 57 in plate 50. This enables lighting of the conical cap 56 at the upper end of the device. Instead of a single bulb 58, a short string, for example, one with 10 miniature lights can be inserted within cap 56 to provide a somewhat modified visual effect.

Device 10 can be mounted outdoors and secured to the ground 60 by means of a spike 62 which is centrally located through a hole in a short cylindrical shaft 64 preferably formed of plastic material. Shaft 64 has an outer dimension to fit snugly within the inside diameter of central supporting shaft 14. Thus the device can be easily installed by hammering the top of spike 62 to install shaft 64 above the ground surface and the central shaft 14 is installed thereover with the strips 12 in the conically expanded position. The device is then ready for illumination by installation of plug 38 into an electrically energized socket. Spike 62 can be provided with laterally extending fins to improve anchoring of the device in temperate climates or when soft ground is encountered, for example, for non-wintertime use.

It is preferred to construct the device 10 entirely out of plastic material such as polyvinyl chloride, high density polyethylene or other commercially available plastics. An exception, of course is spike 62 which would generally be formed of metal. It will also be appreciated that instead of a spike 62, shaft 64 can be attached to a suitable supporting base having laterally extending feet, so that device 10 can be placed in an indoor location. It will thus be appreciated that while during daylight only a conical structure as shown in FIG. 1 will be noted, that, in the darkness, when illuminated, the device will resemble a lighted Christmas tree. The device also can be provided with accessories for storage such as a suitable containing sleeve or a band, such as a Velcro strip, to retain the strips 12 in the elongated storage position of FIG. 6 for off season storage. The device of this invention can also be displayed in the collapsed position to form a "pillar of light."

While it is convenient to use a string of lights to provide illumination, other arrangements could be substituted. For example, a separate string of lights could be provided for each of strips 12.

Also, the device can be provided in alternate forms for use in seasons other than Christmas. For example, as depicted in FIG. 12, a lighting display appropriate for Valentine's Day or Halloween can be provided by altering the placement of the strips 12 and notches 42 formed therein.

Referring to FIG. 10, there is seen an alternative form of a cap 70 suitable for attachment to upper end plate flange 48. For that purpose, indentations are formed on two or more sides of the conically-shaped cap 70 and indentations 72 are

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formed on two or more sides of the conically-shaped cap 70. The bottoms of indentations 72 are provided with openings to facilitate placement of screws 74 for attachment of cap 70 to end plate flange 48.

An alternative form of clip 76 is illustrated in FIG. 11. Two or more clips 76 are provided in place of clips 18 to engage an opening 20 and central shaft 14. Extensions 78 are provided to enable flexing of the ends 19 of clip 76 out of openings 20 to permit sliding of the assembly along shaft 14. The upper ends 80 of clips 76 are adapted to be adhered within channels 82 cut into the interior edge of sleeve 16.

FIGS. 12 and 13 illustrate alternative embodiments of the invention provided for differing seasons of the year. It will be noted that by appropriate placement of notches 42 and light supporting strips 12A, in the embodiment shown on FIG. 12, a generally heart-shaped lighting display 85 can be formed. In keeping with a Valentine's display, the lights 15 could be fitted with red or pink bulbs.

A still further form of display device 90 is shown in FIG. 13. Device 90 is suitable for use as a Halloween display. In this case, the notches 42 in strips 12B are formed so as to provide a pumpkin-shaped outline. Light bulbs 15 can be orange-colored bulbs. Upper conical cap 56 in such event could be fitted with a green bulb. Additionally, it will be apparent to those skilled in the art that lighting displays suitable for other seasons or occasions can be provided.

While preferred embodiments of the invention have been shown for the purposes of illustration, it will be understood various substitutes and changes may be made by those skilled in the art without departing from the concepts of the invention.

What is claimed is:

1. A lighting display device for simulating a selected lighted object, when illuminated, comprising

a central shaft,

a plurality of elongated support members each attached at one end to said shaft adjacent a first end of said shaft, at least one hinge formed in each of said support members and spaced away from said first end of said shaft,

each of said support members having a generally C-shaped configuration with an open side facing said shaft and a closed side facing away from said shaft, a plurality of spaced openings through said closed side of each of said support members, each of said openings being adapted to receive a light bulb which is provided with means for illumination thereof, said bulbs extendable through said openings in a direction away from said shaft, said C-shaped configuration being adapted to receive and contain therein a plurality of light sockets supporting said light bulbs, the end of each said support members opposite said first end being moveable axially along said shaft, whereby each of said support members can be moved, from a substantially straight position suitable for storage of said device, to an erected position wherein each of said support members is folded outwardly from said shaft at said hinge, and,

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means to retain said axially moveable ends at a selected position relative to said shaft.

2. A device according to claim 1 wherein said support members have inwardly angled sidewalls on each side thereof which are each complementary with the side walls of an adjacent support member, whereby said support members, collectively, when in the elongated storage position, circumscribe said shaft.

3. A device according to claim 1 wherein a cylindrical collar is provided for supporting each end of said elongated support members on said shaft.

4. A device according to claim 2 wherein fifteen of said elongated support members are employed.

5. A display device according to claim 1 wherein said open sides of said C-shaped channels are bordered by inwardly extending edges and said sockets are adapted to snap fit under and to be retained by said edges.

6. A lighting display device which simulates a decorated, lighted tree, when illuminated, comprising a plurality of elongated support members attached at each end to a central shaft, the upper end of each member being hingedly attached to a stationary collar and the lower end being attached to a collar which is axially moveable along the shaft, a hinge being provided in each of the support members at a point spaced away from the ends thereof, each of the elongated support members having a plurality of spaced openings therethrough, said openings passing through a surface of each of the support members which faces outwardly away from the shaft, each of the openings being adapted to receive a light bulb attached to a string of lights with each bulb extendable through one of said openings in a direction away from said central shaft, the elongated support members each having a C-shaped channel having an open side facing toward said shaft and a closed side having said surface facing away from said shaft which channel is adapted to receive and contain a plurality of light sockets supporting the light bulbs, each of the support members being movable, from a substantially straight position suitable for storage of the device, to an erect position wherein each of the support members is folded outwardly from the shaft at the hinge, thus forming a conical tree-like structure, when said moveable collar is moved axially upward along the shaft.

7. A device according to claim 6 wherein said support members comprise generally C-shaped channels with an open side facing the shaft.

8. A device according to claim 6 wherein a hollow conical housing is provided at the upper end of said shaft, said housing being adapted to contain at least one light bulb for illumination thereof.

9. A device according to claim 7 wherein said hinge on each support member is formed by a section which is devoid of side walls.

10. A device according to claim 7 wherein each end of each of said elongated members is hingedly attached to one of said collars.

* * * * *

EXHIBIT E
U.S. PATENT NO. 6,406,163 TO T. YANG

US2000 12107248.1

YOT-1003-1542



US006406163B1

(12) **United States Patent**
Yang

(10) **Patent No.:** **US 6,406,163 B1**
(45) **Date of Patent:** **Jun. 18, 2002**

(54) **SOLAR CELL LIGHTING FIXTURE
INTEGRATED WITH HEAT SINK**

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Assistant Examiner—Bao Truong
(74) *Attorney, Agent, or Firm*—Bacon & Thomas

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(57) **ABSTRACT**

(*) **Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

A solar cell lighting fixture is integrated with a heat sink adapted to a lantern, a garden light, a wall fitting, a portable lighting fixture or other lighting fixtures, or on a mobile vehicle including an automobile, a sea vessel, an aircraft, a bicycle, or a motorcycle. A support structure with a predetermined configuration is provided between an upper lid with a solar cell panel, and a bulb is provided below the upper lid. A bulb housing contains battery components, such as a secondary cell or a battery capacitor, a charging circuit or a component to convert electrical energy into optical energy, and operation and control circuits. The support structure defines a space for the heat sink, thus allowing heat dissipation for the area between the upper lid and the bulb, thus protecting the charging circuit and battery components contained inside the bulb housing from being damaged or having their performance negatively affected by heat built up due to prolonged exposure to the direct sun.

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(52) **U.S. Cl.** **362/183; 362/374; 362/276**

(58) **Field of Search** **362/183, 218, 362/191, 249, 276, 363, 306, 360, 361, 353, 354, 294, 373**

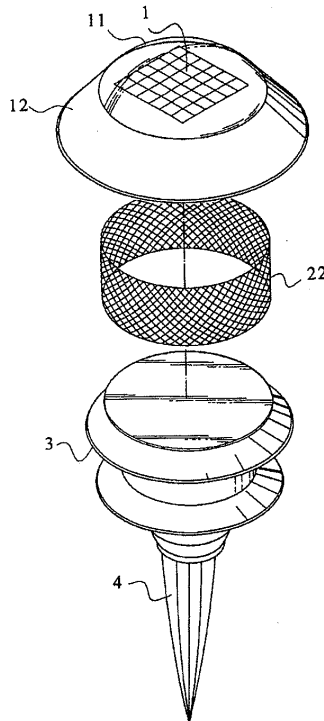
(56) **References Cited**

U.S. PATENT DOCUMENTS

5,103,384 A	*	4/1992	Drohan	362/191
5,249,112 A	*	9/1993	Bray	362/306
5,297,013 A	*	3/1994	Hall et al.	362/363
6,120,165 A	*	9/2000	Shalvi	362/276

* cited by examiner

13 Claims, 15 Drawing Sheets



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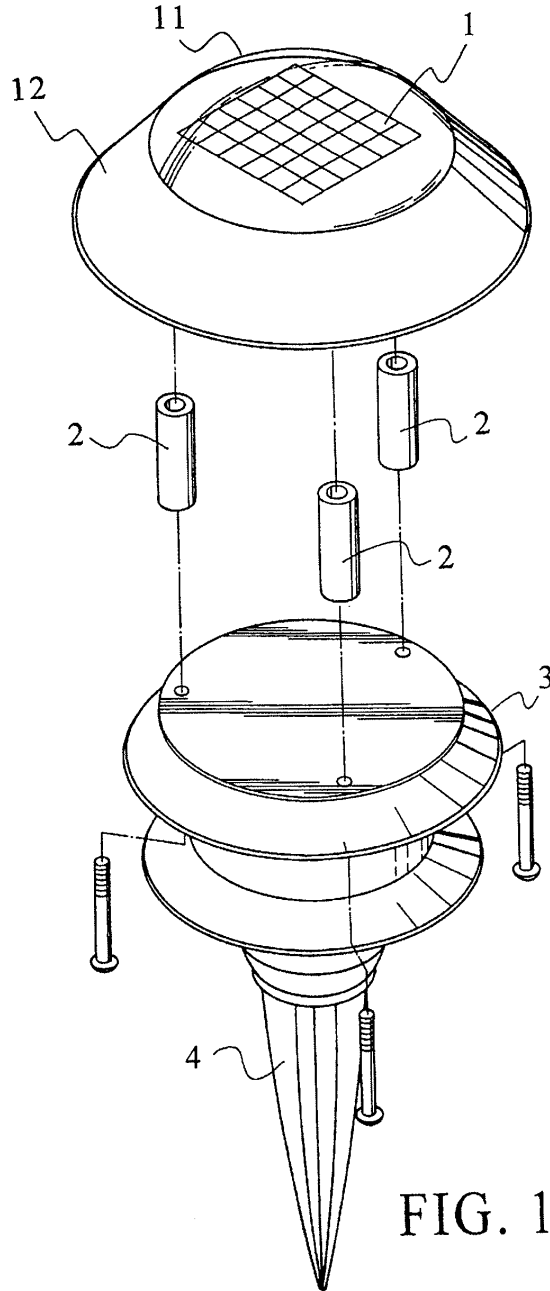


FIG. 1

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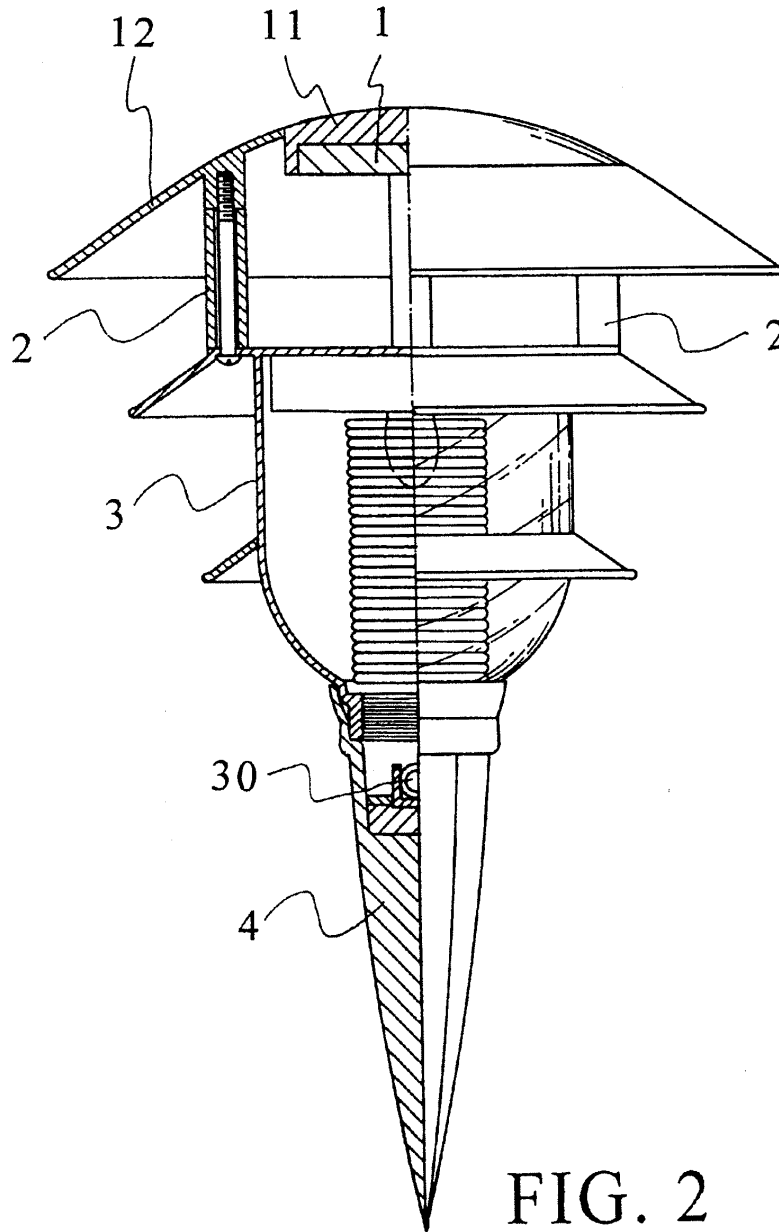


FIG. 2

YOT-1003-1545

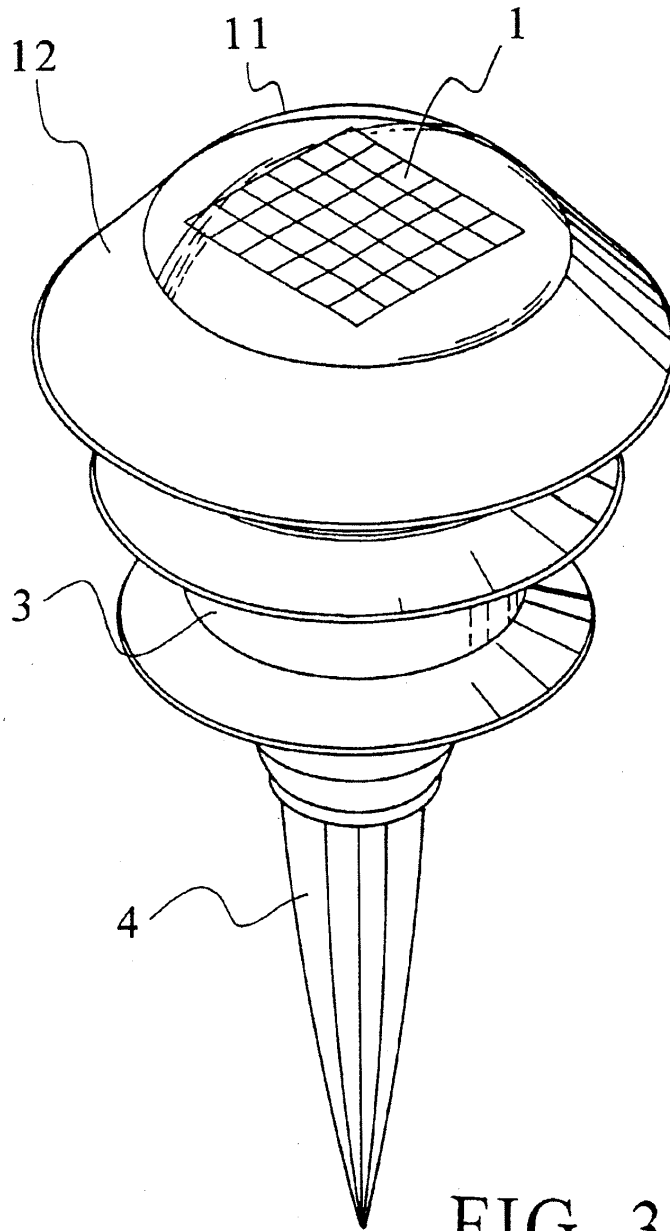


FIG. 3

YOT-1003-1546

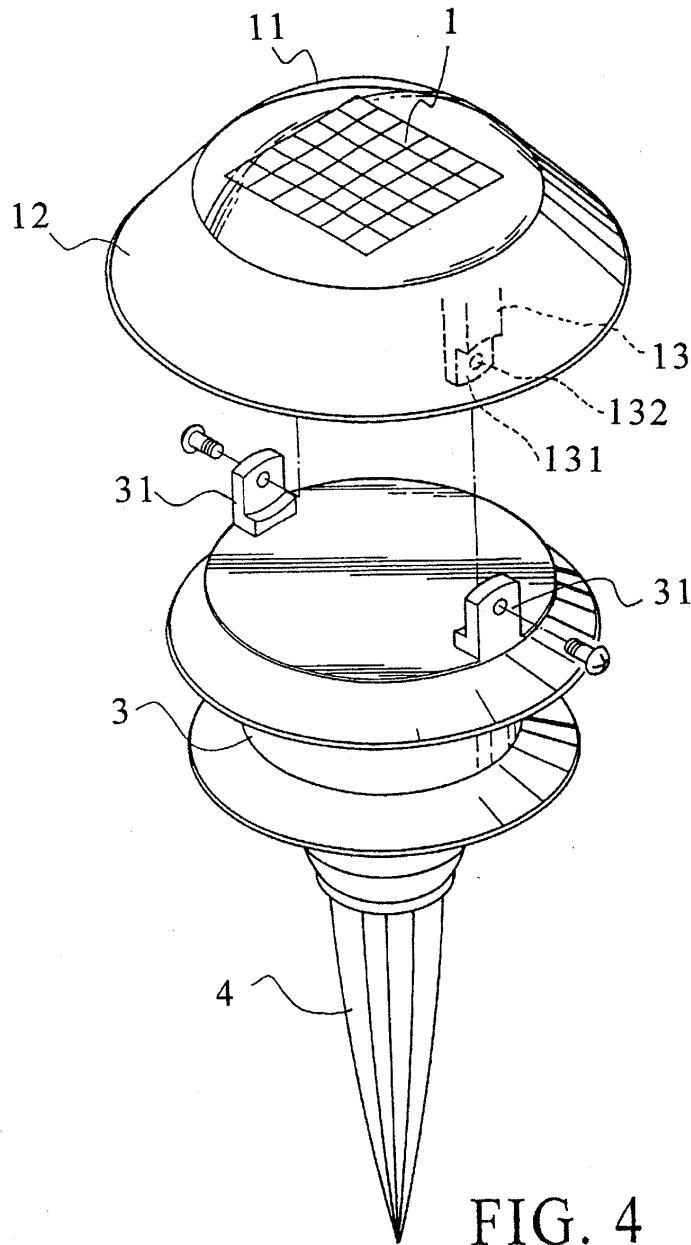
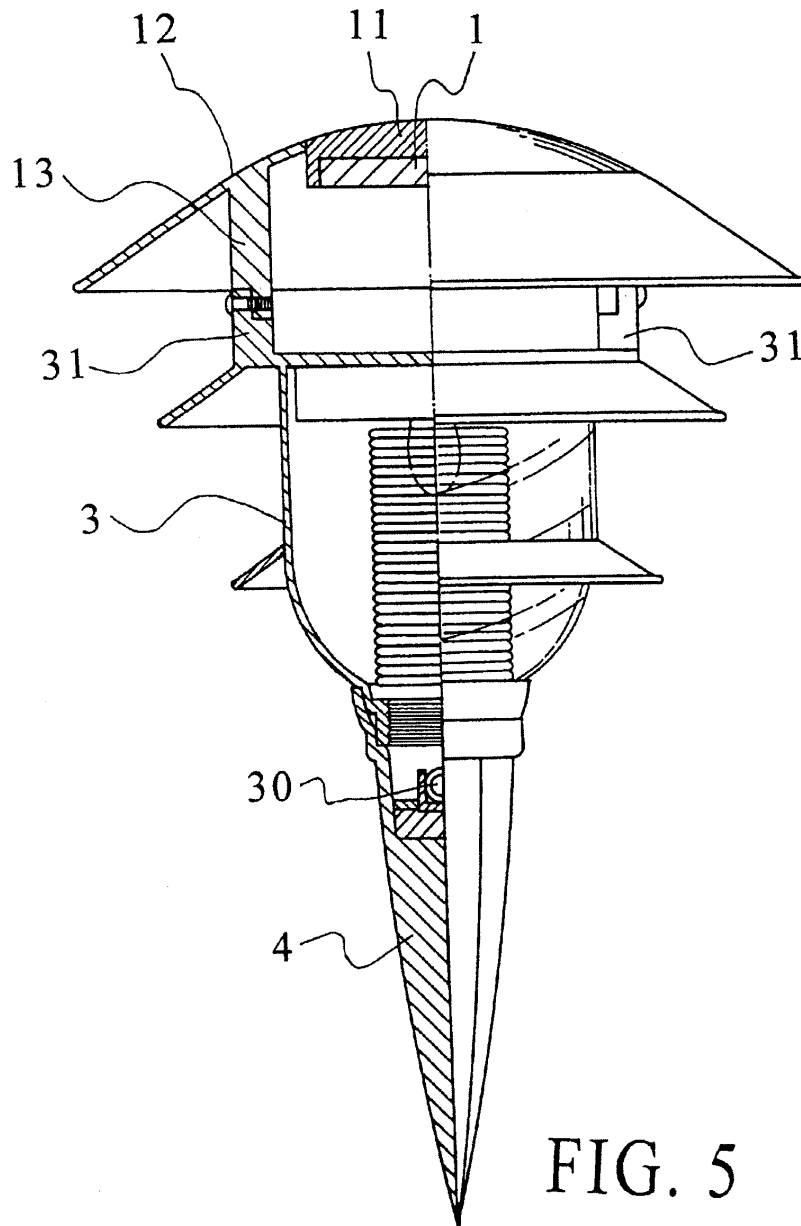


FIG. 4

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YOT-1003-1548

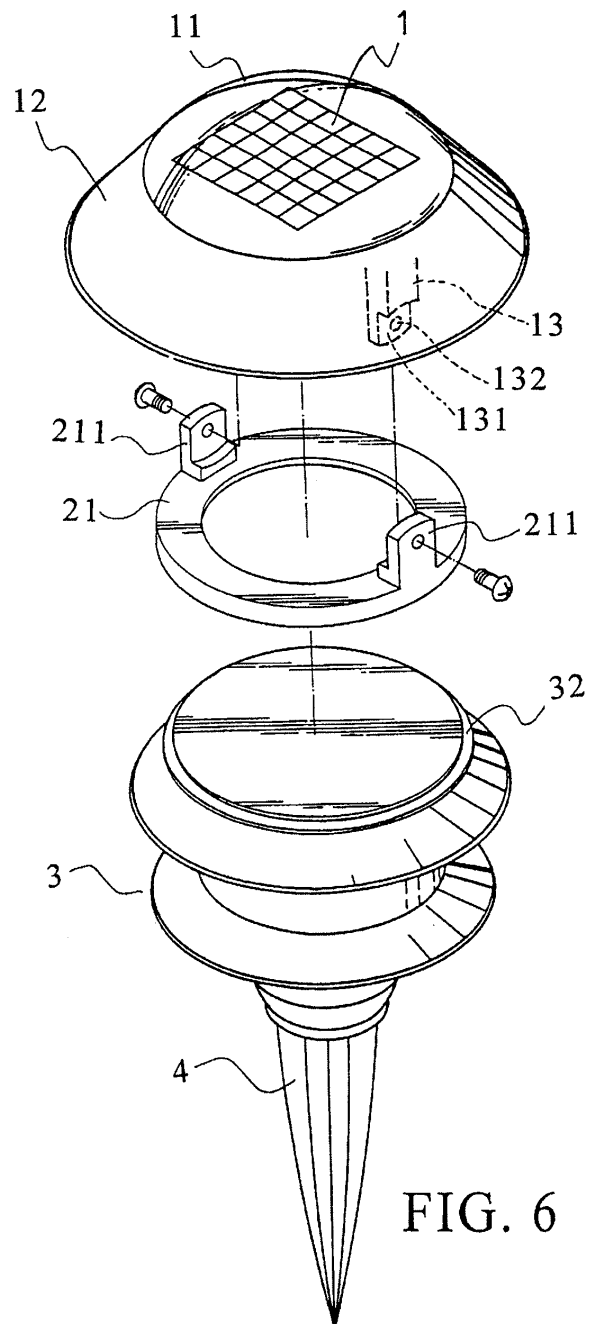
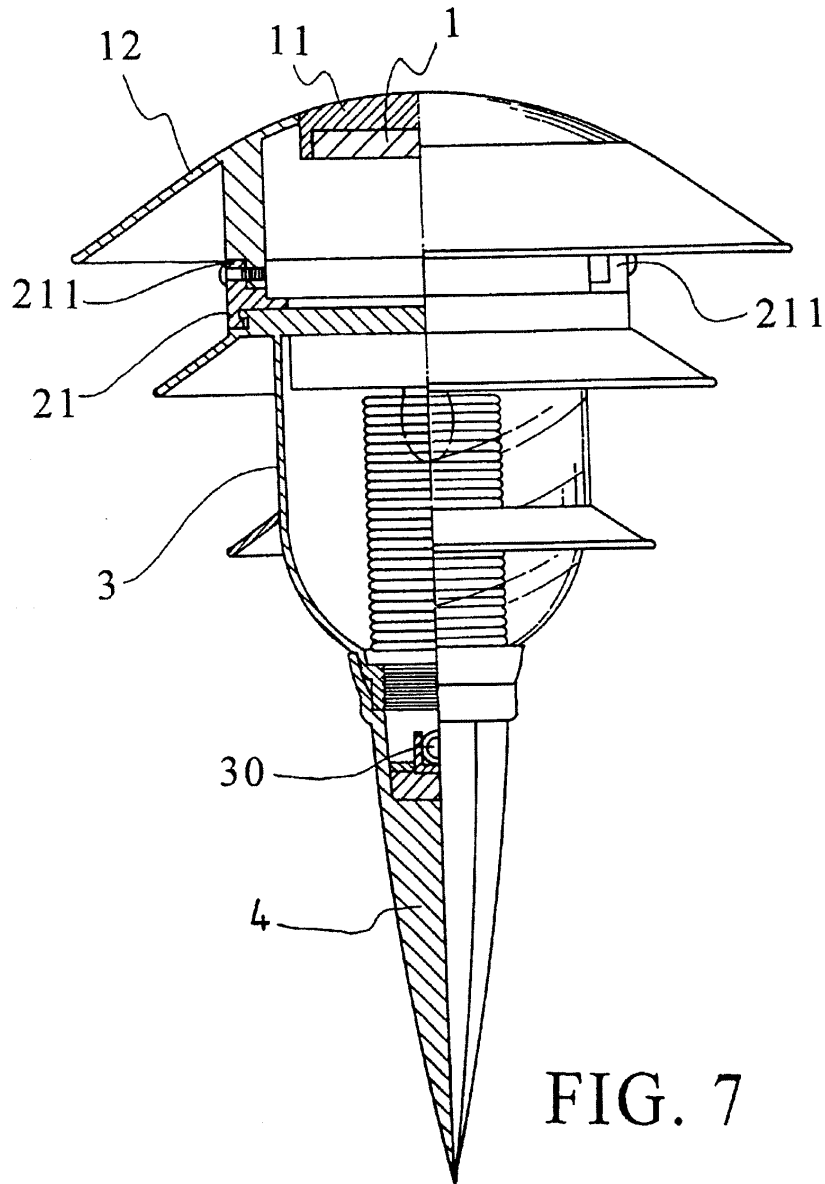


FIG. 6

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YOT-1003-1550

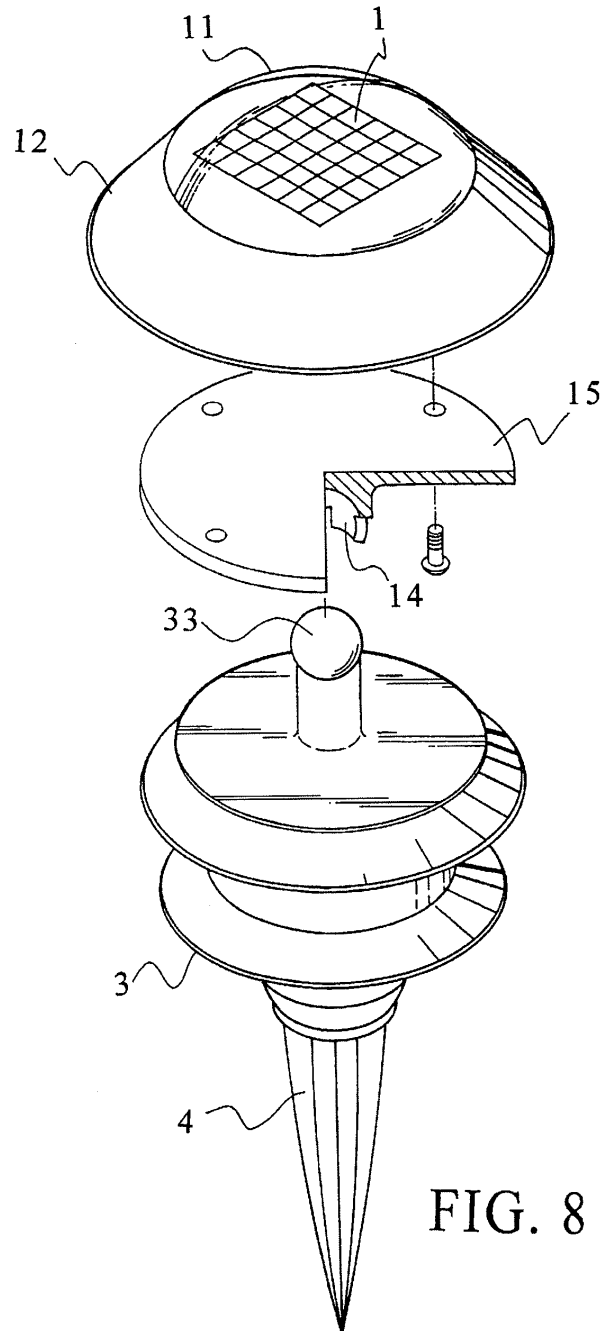


FIG. 8

YOT-1003-1551

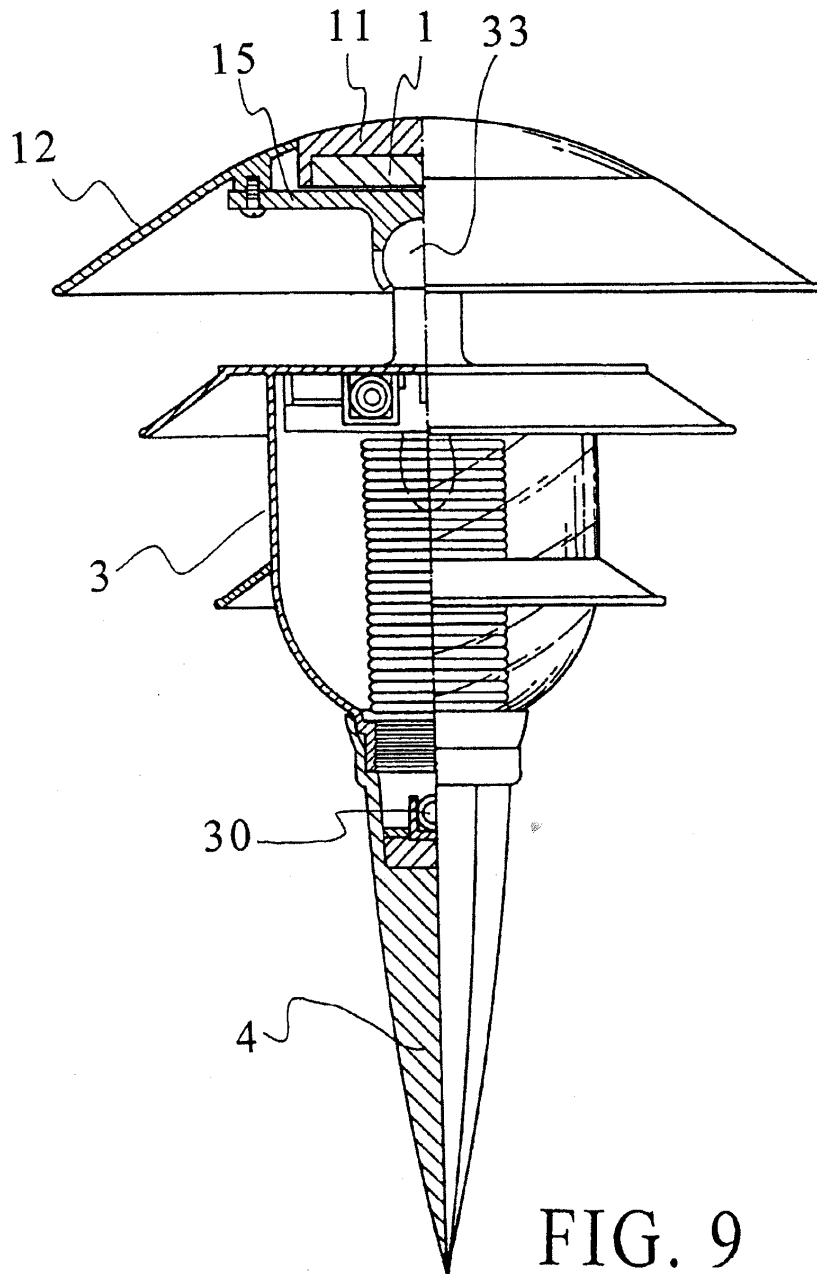


FIG. 9

YOT-1003-1552

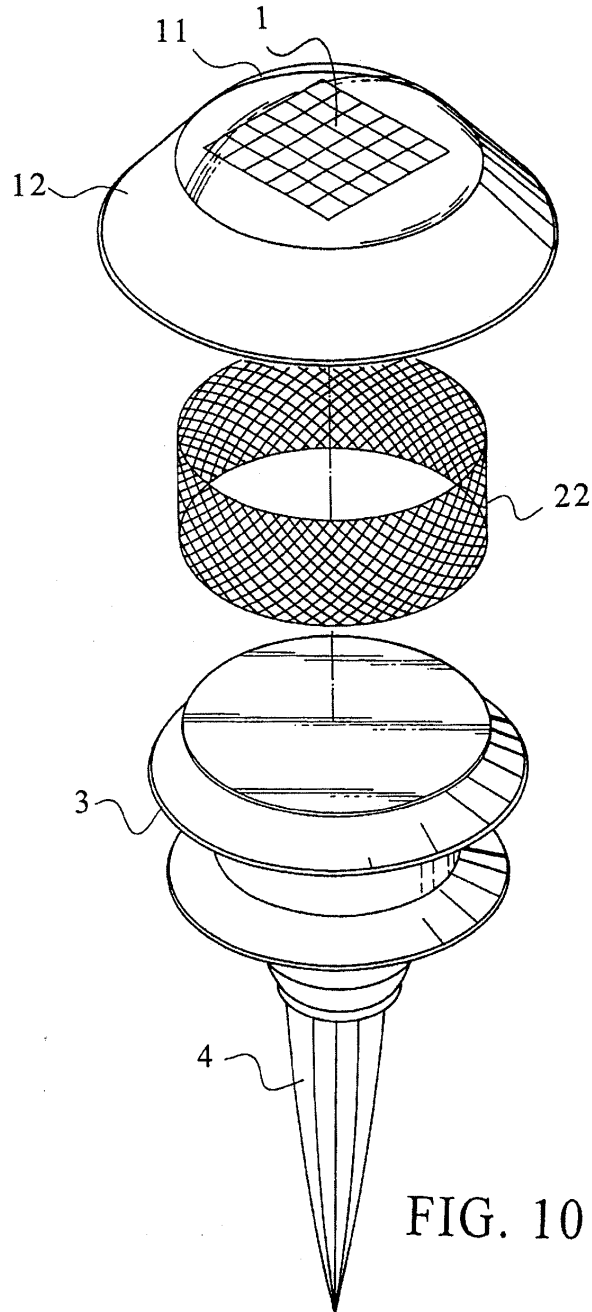


FIG. 10

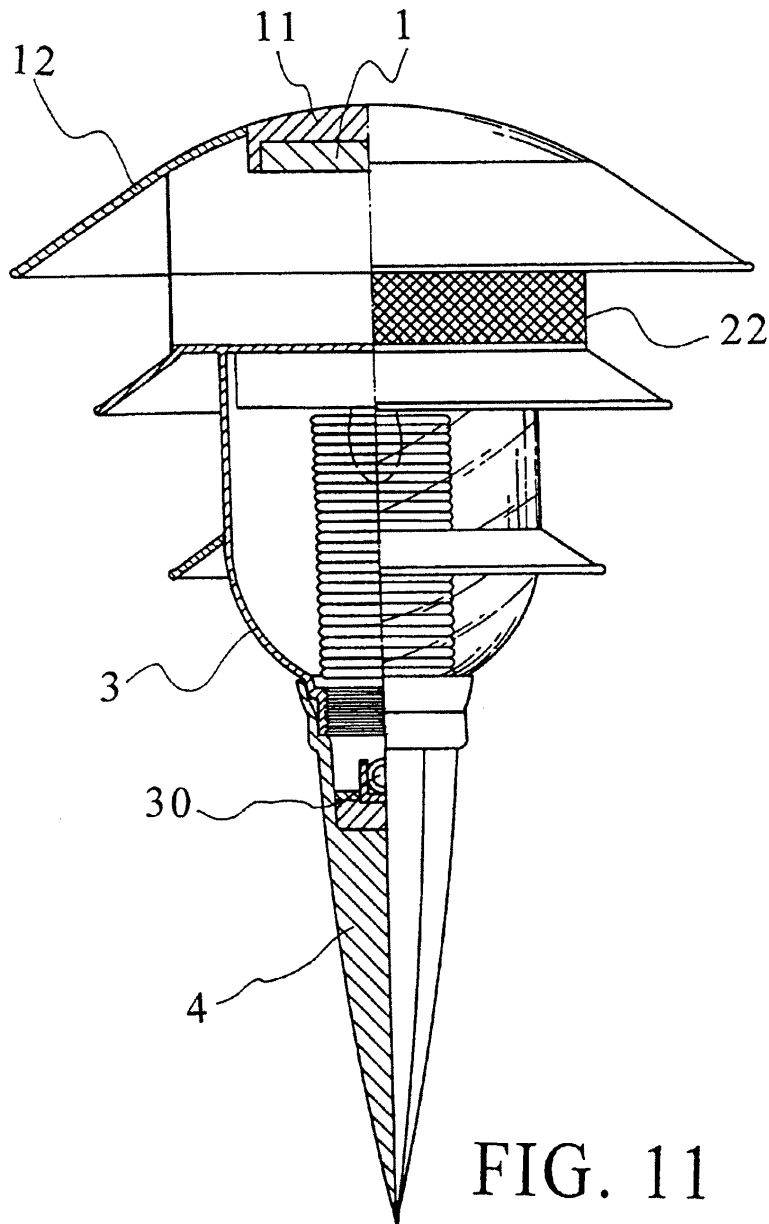


FIG. 11

YOT-1003-1554

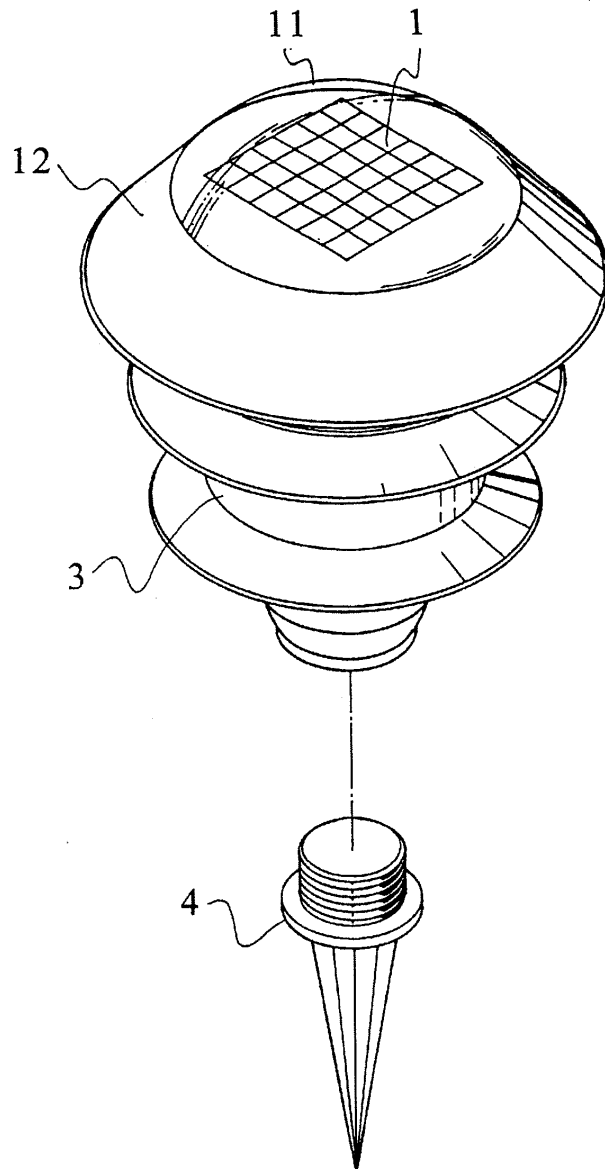


FIG. 12

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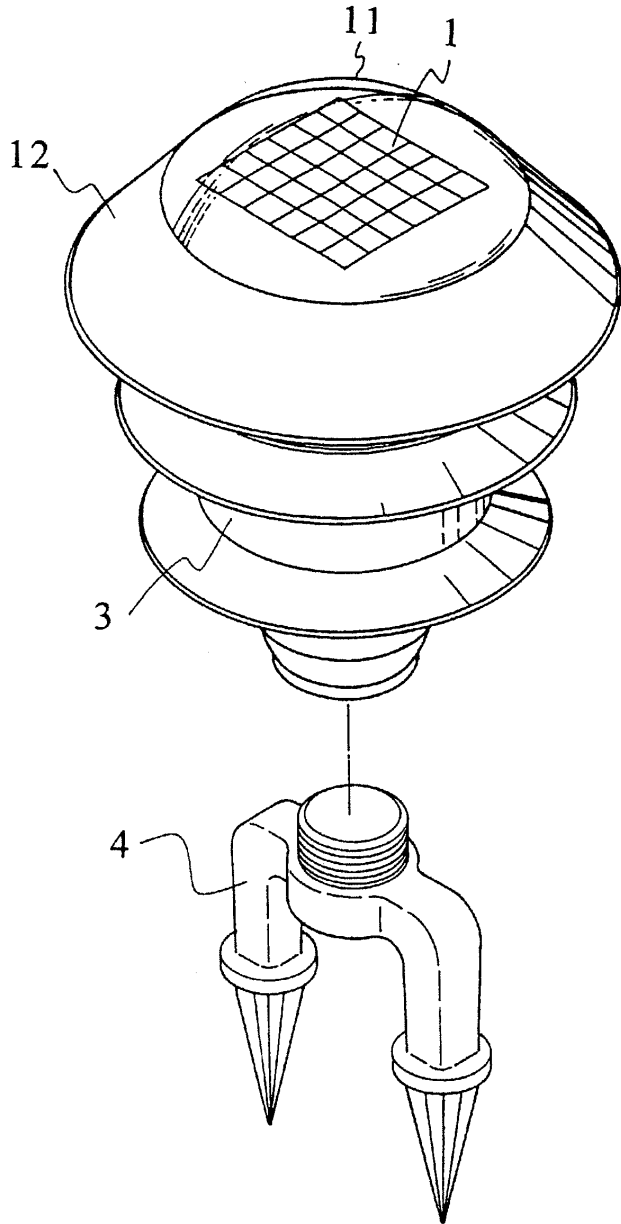


FIG. 13

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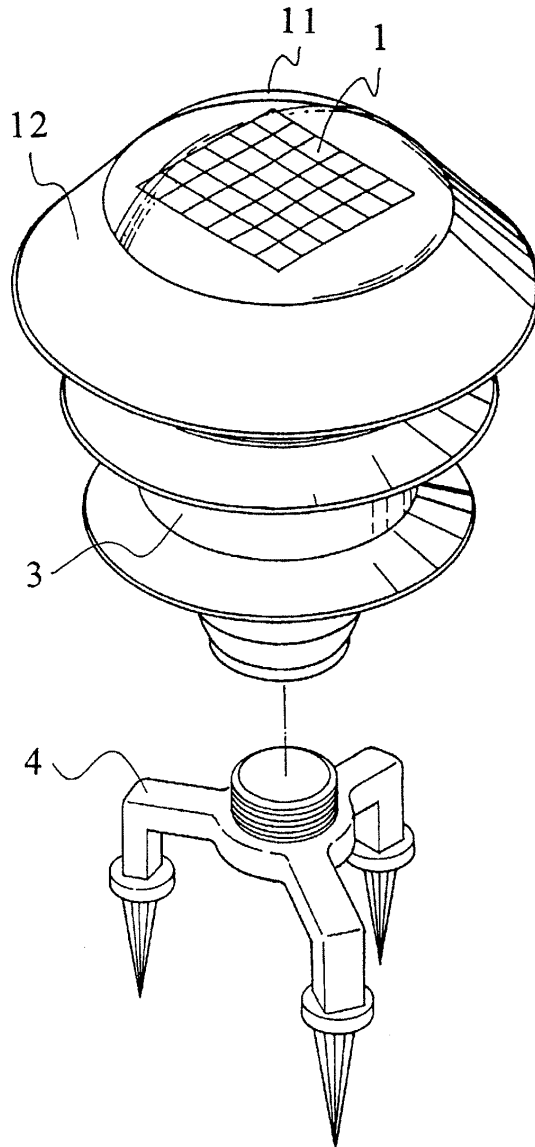


FIG. 14

YOT-1003-1557

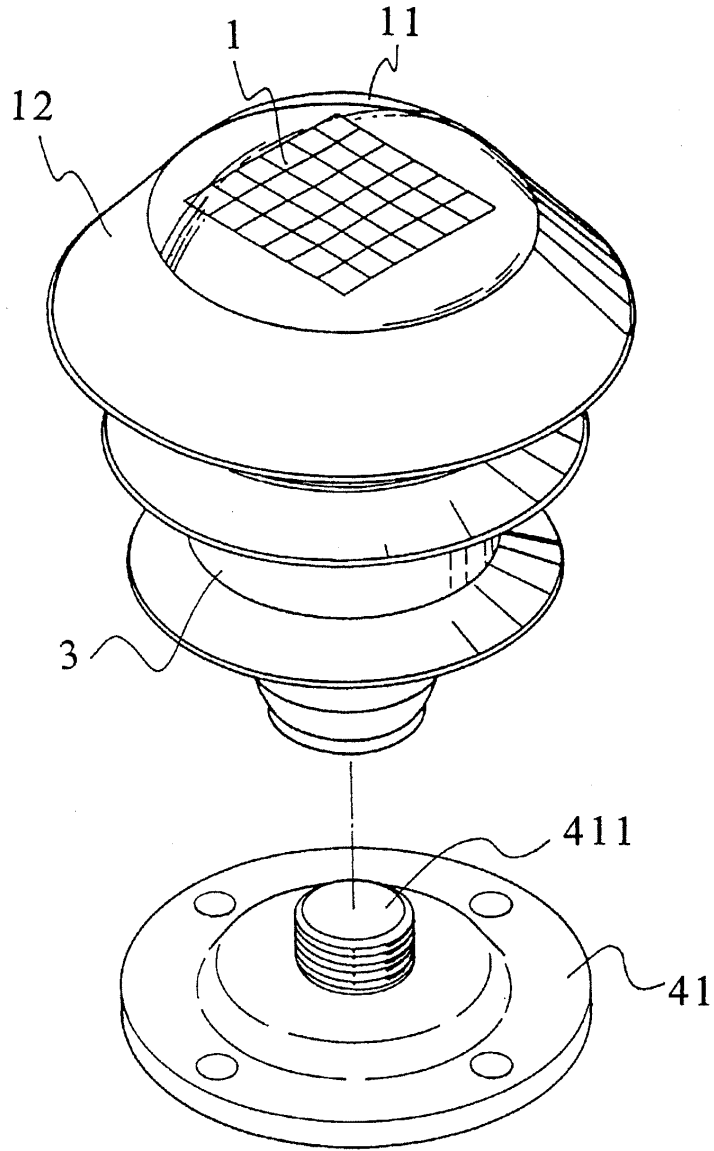


FIG. 15

YOT-1003-1558

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**SOLAR CELL LIGHTING FIXTURE
INTEGRATED WITH HEAT SINK**

BACKGROUND OF THE INVENTION

(a) Field of the Invention

The present invention relates to a solar cell lighting fixture integrated with a heat sink, and more particularly, to one to be adapted to a wall fitting or a garden light. Between its utmost top where an upper lid of a solar cell panel is provide, and below the top where a bulb containing battery components and other circuit devices, a ventilation space and a support structure of a predetermined configuration in said space are provided. An isolated heat sink between the upper lid and the bulb is created for protecting the charging circuits and its battery components from being damaged or their performance from been negatively affected by excessively high interior temperature due to prolonged direct sunshine.

(b) Description of the Prior Art

The prior art of solar lighting fixture, such as a traditional solar cell post lantern, garden light or wall fitting is essentially comprised of a solar cell panel light shade, bulb, battery components within the bulb (containing charging circuit and battery and a mounting member. The purpose of said mounting member is for the fixture to be either directly buried in the ground, or provided at the top of a post, in a mechanical equipment, or to a vehicle including a automobile, a sea vessel or an aircraft. Said member may be also provided in a form of an underground post or ground tapered support. However, in the traditional solar cell lighting fixture, the light shade of the solar cell panel and the bulb are integrated that encourages heat to build up inside the bulb due to hyperthermal effect when the solar cell panel absorbs solar energy. Since the heat can not be effectively dissipated, the performance of the charging circuit and cell components is vulnerable to damage or failure.

SUMMARY OF THE INVENTION

The primary purpose of the present invention is to provide a solar cell lighting fixture integrated with a heat sink. The present invention is for adaptation to a post lantern, a garden light, a wall fitting, or a vehicle including an automobile, a sea vessel or a aircraft, or a bicycle, a motorcycle, a portable light or other types of lighting fixtures. A ventilation space is provided between utmost top and bulb of the lighting fixture of the present invention. The utmost top of the lighting fixture accommodates an upper lid of a solar cell panel. Battery components such as a secondary cell or a battery capacitor, and a charging circuit or device to convert electric energy into optical energy such as a bulb or an illuminating diode and its operation and control circuits are provided below the upper lid. Within the ventilation space separating a support structure of the solar cell panel from the bulb, the support structure in a predetermined configuration is provided to protect charging circuit and its batter components from being damaged or having their performance negatively affected by excessively high interior temperature in the bulb.

Another purpose of the present invention is to provide a solar cell lighting fixture integrated with a heat sink. Said heat sink is comprised of one or more than one support pillar provided between the support structure of the solar cell panel and the bulb. Said pillars may be made mobile and mutually interlocked between the support structure of the solar cell panel and the bulb to adjust the angle of the support structure as desired. Said pillar may be individually provided onto a ring that is inserted to the bulb so that the pillar

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can be adjusted as desired by rotation. A universal ball joint may be provided at the bottom of the support casing of the solar cell panel and inserted into the joint pillar corresponding to the bulb for adjustment as desired by rotation. The heat sink may be also provided in net or porous structure.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is a blowout of a first preferred embodiment of the present invention.

FIG. 2 is a sectional view of the first preferred embodiment of the present invention as assembled.

FIG. 3 is a view showing the appearance of the first preferred embodiment as assembled.

FIG. 4 is a blowout of a second preferred embodiment of the present invention.

FIG. 5 is a sectional view of the second preferred embodiment of the present invention as assembled.

FIG. 6 is a blowout of a third preferred embodiment of the present invention.

FIG. 7 is a sectional view of the third preferred embodiment of the present invention as assembled.

FIG. 8 is a blowout of a fourth preferred embodiment of the present invention.

FIG. 9 is a sectional view of the fourth preferred embodiment of the present invention as assembled.

FIG. 10 is a blowout of a fifth preferred embodiment of the present invention.

FIG. 11 is a sectional view of the fifth preferred embodiment of the present invention as assembled.

FIG. 12 is a view showing a preferred embodiment of the present invention with one tapered pillar provided at the bottom of a bulb.

FIG. 13 is a view showing a preferred embodiment of the present invention with two tapered pillars provided at the bottom of the bulb.

FIG. 14 is a view showing a preferred embodiment of the present invention with three tapered pillars provided at the bottom of the bulb.

FIG. 15 is a view showing a preferred embodiment of the present invention with a fixed base provided at the bottom of the bulb.

**DETAILED DESCRIPTION OF THE
PREFERRED EMBODIMENTS**

The present invention, as illustrated by multiple preferred embodiments of the accompanying drawings, is for adaptation to a post lantern, a garden light, a wall fitting or other types of lighting fixtures. It is essentially comprised of an upper lid at the utmost top to accommodate a solar cell panel, and a support structure with a predetermined configuration provided between the upper lid for accommodation of the solar cell panel and the bulb underneath said upper lid. Said support structure thus creates an isolated space for heat sink. Both of the support structure and the heat sink protect batter components inside the bulb from being damaged or having their performance negatively affected by heat build up due to prolonged exposure to direct sun. As illustrated in FIGS. 1, 2 and 3, a first preferred embodiment of the present invention of a solar lighting fixture integrated with a heat sink is essentially comprised of a solar cell panel 1, a support structure and bulb 3. Wherein, said solar cell panel 1 is provided at the tip of the utmost top of the lighting fixture and a light transmission plate 11 coupled to the solar cell panel 1 and incorporated to the upper lid 12. A support

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structure is fixed by incorporation or assembly between the solar cell panel 1 and a bulb 3 with one or more than one hollow or solid pillar 2 to permit an isolated heat sink between the solar cell panel 1 and the bulb 3. The bulb 3 is essentially provided to accommodate a battery component, such as a secondary cell or a battery capacitor 30. It may be further placed with a charging circuit or device that converts electrical energy into optical energy, such as an electric bulb or an illuminating diode, and light operation and control circuits as applicable. The bulb 3 may be made with a tapered footing structure 4 extending downward for the lighting fixture to be directly planted into the ground. The tapered footing structure 4 provides an interior space closer to the ground for accommodating the battery component, such as the secondary cell or the battery capacitor 30, and the charging circuit or device that converts electrical energy into optical energy, such as an electric bulb or an illuminating diode. Or, a tapered footing member may be separately provided at bottom of the bulb 3.

By assembling those members disclosed above, a heat sink is formed among the support structure of the solar cell panel, the bulb and the operation and control circuits. By taking advantage of said isolated heat sink, the charging circuit and its battery component 30 inside the bulb 3 are protected from being damaged or having their performance negatively affected by excessively heat built up due to the prolonged direct sunshine.

As illustrated in FIGS. 4 and 5, a second preferred embodiment of the present invention of a solar cell lighting fixture integrated with a heat sink is essentially comprised of a solar cell panel 1, a support structure and a bulb 3. Wherein, said solar cell panel 1 is provided at the utmost top of the lighting fixture. A light transmission 11 is coupled to the peripheral of the solar cell panel 1 and incorporated to the upper lid 12. An insertion post 13 is each provided at where appropriately on both sides of at the bottom of the upper lid 12, and a graded arc 131 and a pivot hole 132 are provided at the terminal of each insertion post 13. In the support structure, one locking post 31 is each provided at the where appropriately on both sides of the upper end of the bulb 3. The upper end of said locking post 31 indicates an arc so to pivot to the insertion post 13. Both of the insertion post 13 and the locking 31 when pivoted define for the solar cell panel 1 an isolated heat sink between said support structure and the bulb 3. The solar cell panel 1 on the upper lid 12 can also be adjusted for the optimal area to contact the sunlight as desired. The bulb 3 is essentially provided for accommodation battery component 30, such as a secondary cell or battery capacitor. If required, a charging circuit or a component to convert electrical energy into optical energy, such as an electric bulb or an illuminating diode and light operation and control circuits. The bulb 3 may further include a tapered footing structure 4 extending downward from the bulb 3 for the lighting fixture to be directly planted into the ground. The footing structure 4 also provides an interior space closer to the ground to accommodate the battery component, such as a secondary cell or a battery capacitor 30. Furthermore, as required, a charging circuit or a component to convert electrical energy into optical energy such as an electric bulb or an illuminating diode may also be included in the interior space. Alternatively, the tapered footing member to plant the lighting fixture may be separately provided at the bottom of the bulb 3.

Those members disclosed above for the second preferred embodiment of the present invention when assembled create a space between the support structure for the solar cell panel support structure and the operation and control circuits for

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heat sink. The angle facing the sunlight for the solar cell panel 1 can be adjusted as desired. By taking advantage of the heat sink, the charging circuit and its battery component 30 in the bulb 3 are protected from being damaged or having their performance negatively affected by the heat built up due to prolonged exposure to the direct sunshine.

Referring to those preferred embodiments disclosed above and FIGS. 6 and 7, in a third preferred embodiment of the present invention of a solar cell lighting fixture integrated with a heat sink, the locking post of the support structure is separately provided to a ring component 21. A groove 32 in relation to the locking post is provided at the upper edge of the bulb 3. A locking post 211 provided on the ring component 21 is pivoted to the insertion post 13 provided under the solar cell panel 1. Accordingly, the solar cell panel is able to freely rotate by means of said ring component 21 to adjust elevation of the isolated heat sink, and an adjusting effect by radius oriented rotation. The bulb 3 may further include a tapered footing structure 4 extending downward from the bulb 3 for the lighting fixture to be directly planted into the ground. The footing structure 4 also provides an interior space closer to the ground to accommodate the battery component, such as a secondary cell or a battery capacitor 30. Furthermore, as required, a charging circuit or a component to convert electrical energy into optical energy such as an electric bulb or an illuminating diode may also be included in the interior space. Alternatively, the tapered footing member to plant the lighting fixture may be separately provided at the bottom of the bulb 3.

In relation to the support structure disclosed in the preferred embodiments above, a structure of universal ball point 14 is provided at a lower casing 15 of the solar cell panel 1 in a fourth preferred embodiment of the present invention as illustrated in FIGS. 8 and 9. Said ball joint 14 is given with a proper packing structure to rotate a corresponding ball pillar 33 freely inserted into the upper end of the bulb 3. The bulb 3 may further include a tapered footing structure 4 extending downward from the bulb 3 for the lighting fixture to be directly planted into the ground. The footing structure 4 also provides an interior space closer to the ground to accommodate the battery component, such as a secondary cell or a battery capacitor 30. Furthermore, as required, a charging circuit or a component to convert electrical energy into optical energy such as an electric bulb or an illuminating diode may also be included in the interior space. Alternatively, the tapered footing member to plant the lighting fixture may be separately provided at the bottom of the bulb 3.

In relation to the support structure disclosed in the preferred embodiments above, a net or porous support structure 22 is provided between the solar cell panel 1 and the bulb 3 to create a heat sink in a fifth preferred embodiment of the present invention as illustrated in FIGS. 10 and 11. Said ball joint 14 is given with a proper packing structure to rotate a corresponding ball pillar 33 freely inserted into the upper end of the bulb 3. The bulb 3 may further include a tapered footing structure 4 extending downward from the bulb 3 for the lighting fixture to be directly planted into the ground. The footing structure 4 also provides an interior space closer to the ground to accommodate the battery component, such as a secondary cell or a battery capacitor 30. Furthermore, as required, a charging circuit or a component to convert electrical energy into optical energy such as an electric bulb or an illuminating diode may also be included in the interior space. Alternatively, the tapered footing member to plant the lighting fixture may be separately provided at the bottom of the bulb 3.

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Those additional preferred embodiments of the present invention as illustrated in FIGS. 12, 13 and 14 are adapted to various types of garden light. Wherein, the tapered footing member 4 separately provided at the bottom of the bulb 3 for planting the lighting fixture of the present invention into the ground as disclosed in those preferred embodiments disclosed above is incorporated to the bottom of the bulb 3. Said member 4 may be provided in the form of having one, two or three, or more than three sharp pedestals, which will be directly buried in the ground or simply erected on the ground. As the title of the present invention, a solar cell lighting fixture integrated with heat sink, suggests, a fixed base 41 in disk shape may be incorporated to the bottom of the bulb 3 with a locking pillar 411 at the center of the fixed base 41. Furthermore, the fixed base 41 may be fixed to any place, a body of mechanical equipment, a building, a mechanical equipment, or vehicles including automobile, sea vessel or aircraft.

To sum up, as a complete assembly, the solar cell lighting fixture integrated with heat sink is innovative either in its means, manipulation or spatial, configuration, and is significantly different from the structure of the prior art of integrated solar cell lighting fixtures. It can effectively protect circuits and battery devices contained within the light fixture from being damaged due to prolonged direct sunshine.

I claim:

1. A solar cell lighting fixture integrated with a heat sink comprising an upper lid having a solar cell panel at the top of the upper lid; a bulb; and a bulb housing that encloses said bulb, said heat sink comprising a support structure below said upper lid and above said bulb, and said support structure defining a space for the heat sink between said solar cell panel and said bulb;

wherein a charging circuit and a battery component are contained inside said bulb housing; and

whereby said heat sink protects said charging circuit and battery component from being damaged or having their performance negatively affected by heat built up due to prolonged direct sunshine.

2. A solar cell lighting fixture integrated with a heat sink as claimed in claim 1, wherein said upper lid comprises a light transmission plate coupled to the solar cell panel; and said support structure includes at least one pillar and a fixing or locking means to secure said at least one pillar to the lighting fixture.

3. A solar cell lighting fixture integrated with a heat sink as claimed in claim 1, wherein said upper lid comprises a light transmission plate coupled to the solar cell panel; said support structure includes an insertion post provided on both sides of the bottom of the upper lid, a graded arc and a pivot hole provided at the terminal of each said insertion post and, a locking post provided on both sides of the upper end of the bulb, wherein the upper end of said locking post defines an arc to pivot the insertion post into said locking post so that the solar cell panel on the upper lid can be adjusted for an optimal area to face the sunlight; the insertion post and the locking post defining said space between said support structure and the bulb.

4. A solar cell lighting fixture integrated with a heat sink as claimed in claim 3, wherein the support structure further

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comprises a ring component and a groove provided at the upper edge of the bulb, and said locking post attaches to the ring component so that the solar cell panel can freely rotate by means of said ring component.

5. A solar cell lighting fixture integrated with a heat sink as claimed in claim 4, wherein said bulb housing further includes a tapered footing structure extending downward from the bulb, said tapered footing structure allowing the lighting fixture to be directly planted into the ground and providing an interior space to accommodate said battery component and said charging circuit.

6. A solar cell lighting fixture integrated with a heat sink as claimed in claim 1, wherein said support structure further comprises a universal ball joint and a corresponding ball pillar, said ball joint is provided at a lower casing of the solar cell panel and said ball pillar is inserted into the upper end of the bulb, wherein the ball joint rotates freely around the ball pillar.

7. A solar cell lighting fixture integrated with a heat sink as claimed in claim 6, wherein said bulb housing further includes a tapered footing structure extending downward from the bulb, said tapered footing allowing the lighting fixture to be directly planted into the ground, and providing an interior space to accommodate said battery component and said charging circuit.

8. A solar cell lighting fixture integrated with a heat sink as claimed in claim 1, wherein said support structure further comprises a net or porous support structure between the solar cell panel and the bulb to create said heat sink.

9. A solar cell lighting fixture integrated with a heat sink as claimed in claim 8, wherein said bulb housing further includes a footing structure extending downward from the bulb, said footing structure allowing the lighting fixture to be directly planted into the ground and providing an interior space to accommodate said battery component.

10. A solar cell lighting fixture integrated with a heat sink as claimed in claim 1, wherein said bulb housing further includes a tapered footing member having one, two, three, or more sharp pedestals separately provided at the bottom of the bulb housing, wherein said pedestals are planted, buried, or erected on the ground.

11. A solar cell lighting fixture integrated with a heat sink as claimed in claim 1, wherein, said bulb housing further comprises a fixed base with a locking pillar, said base being movably fixed.

12. A solar cell lighting fixture integrated with a heat sink as claimed in claim 1, wherein said bulb housing further includes a tapered footing structure extending downward from the bulb, said tapered footing allowing the lighting fixture to be directly planted into the ground, and providing an interior space to accommodate said battery component and said charging circuit.

13. A solar cell lighting fixture integrated with a heat sink as claimed in claim 2, wherein said bulb housing further includes a tapered footing structure extending downward from the bulb, said tapered footing allowing the lighting fixture to be directly planted into the ground, and providing an interior space to accommodate said battery component and said charging circuit.

* * * * *

EXHIBIT F
U.S. PATENT NO. 6,729,742 TO WISMETH

US2000 12107249.1

YOT-1003-1562



US006729742B2

(12) **United States Patent**
Wismeth et al.

(10) **Patent No.: US 6,729,742 B2**
(45) **Date of Patent: May 4, 2004**

(54) **SOLAR LAMP FOR OUTDOOR USE** 5,984,570 A * 11/1999 Parashar 40/565

(76) **Inventors:** **Wofgang Wismeth**, Hans-Vogel-Strasse 22, Fürth (DE), 90765; **Gerhard Lutz**, Hermann-Kolb-Strasse 51, Nürnberg (DE), 90473; **Werner Kohlmann**, Am Kriegerdenkmal 13, Nürnberg (DE), 90427

FOREIGN PATENT DOCUMENTS

DE	8521579.1	*	9/1985
DE	85 21 579.1		10/1985
DE	39 38 251.6		5/1991
DE	91 04 219.4		8/1991
DE	93 04 947.1		7/1993
DE	298 08 876 U1		10/1998
DE	298 12 152 U1		10/1998

(*) **Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

* cited by examiner

(21) **Appl. No.:** 10/142,464

(22) **Filed:** May 10, 2002

(65) **Prior Publication Data**

US 2002/0176248 A1 Nov. 28, 2002

Primary Examiner—Alan Cariaso
Assistant Examiner—Ali Alavi

(57) **ABSTRACT**

Related U.S. Application Data

(63) Continuation of application No. PCT/DE00/03948, filed on Nov. 10, 2000.

(30) **Foreign Application Priority Data**

Nov. 12, 1999 (DE) 299 19 948 U

(51) **Int. Cl.⁷** **F21L 13/00**

(52) **U.S. Cl.** **362/183; 362/153.1; 362/431; 136/206**

(58) **Field of Search** **362/153.1, 431, 362/183, 414, 367, 800; 323/906; 136/206**

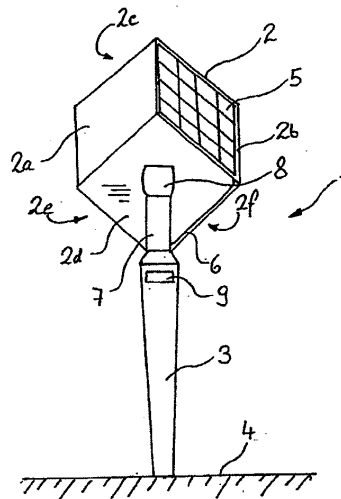
Solar lamp for outdoor use, in particular a garden lamp, road or street lamp or such, consisting of one or more solar module, and a housing with a storage means for electric energy (battery), which is electrically connected to the solar module, and one or more luminous body, whereby between the battery and the luminous body a circuit is provided, which reacts to signals from a light sensor attached to the solar lamp, and which enables or disables the electrical connection between the battery and the luminous body depending on the degree of brightness/darkness, whereby the housing is provided with two or more walls of different orientation which do not converge parallel to each other, and whereby one or more solar modules are arranged on each wall, or that the walls are formed by solar modules.

(56) **References Cited**

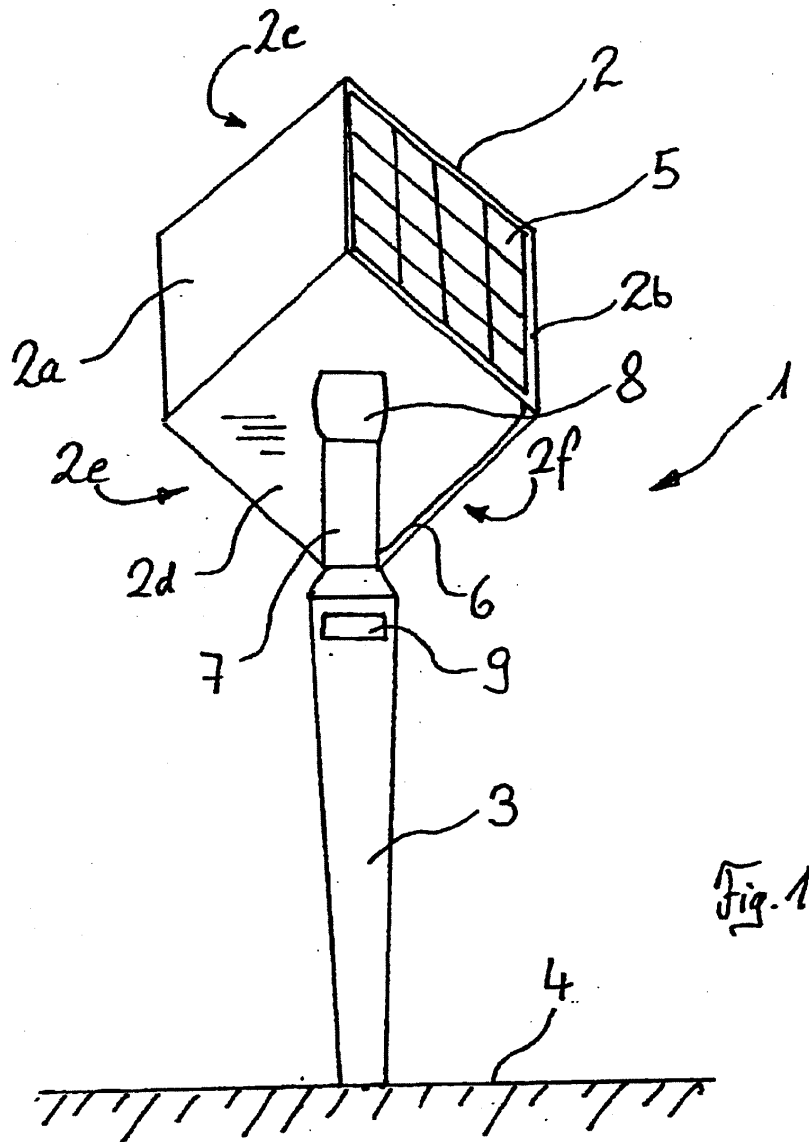
U.S. PATENT DOCUMENTS

4,816,970 A * 3/1989 Garcia, Jr. 362/183

4 Claims, 1 Drawing Sheet



YOT-1003-1563



SOLAR LAMP FOR OUTDOOR USE

CROSS-REFERENCE TO RELATED APPLICATIONS

This application is a continuation of PCT/DE00/03948, filed Nov. 10, 2000, which claims priority from German Application No. 299 19 948.7, filed Nov. 12, 1999.

BACKGROUND OF THE INVENTION

1. Field of the Invention

The invention relates to a solar lamp for outdoor use which is in the shape of a cube, which has solar modules in or on two or more top wall surfaces and which is attached to a fastening structure for being supported.

2. Description of the Related Art

Known in prior art are solar lamps for outdoor use, in particular garden lamps, consisting of one or more solar module, and a housing with a storage means for electric energy (battery), which is electrically connected to the solar module, and one or more luminous bodies, whereby between the battery and the luminous body a circuit is provided which reacts to signals from a light sensor attached to the solar lamp and enables or disables the electrical connection between the battery and the luminous body, depending on the degree of brightness/darkness. One version, which is marketed under the name of "Pagoda" ["Pagode"], consists of a post to be inserted into the ground, which on the top is provided with a cylindrical housing into which the luminous body, battery, circuit and sensors are integrated and which is covered by a disc-shaped horizontal solar module. Another version called "Solite" is also provided with a disc-shaped upper end with a solar module, but is covered by a transparent dome. It is also known in prior art to design street lamps as solar lamps, whereby in one version, a plate-shaped elongated solar module itself serves as the largest component of the post. Other solutions have lines of lamps leading to external solar modules, since the power of the modules arranged on the plate-shaped ends of the garden lamps is inadequate since—for design reasons and practical considerations—the use of small modules is preferred.

BRIEF SUMMARY OF THE INVENTION

It is the object of the present invention to create a solar lamp, in which energy generation is optimized and which still allows for an aesthetically pleasing design.

This object is achieved with of a cube, which has two or more solar modules in or on two or more top wall surfaces and which is attached to a fastening structure for being supported.

According to the invention is a solar lamp for outdoor use, in particular a garden lamp, road or street lamp or such, consisting of one or more solar modules, and a housing with a storage means for electric energy (battery), which is electrically connected to the solar module, and one or more luminous bodies, whereby between the battery and the luminous body a circuit is provided, which reacts to signals from a light sensor attached to the solar lamp, and which enables or disables the electrical connection between the battery and the luminous body, depending on the degree of brightness/darkness, characterized in that the housing is provided with at least two walls of different orientation and which do not converge parallel to each other, and that one or more solar modules are arranged on each wall, or that the walls are formed by solar modules.

This basic idea deviates from the "conventional wisdom" about the orientation of solar modules, according to which a southern exposure is suggested to allow a maximum incidence of solar light. Instead, two modules with different orientations are suggested, whereby it is found, however, that the sum of the energy obtained is increased to such an extent that it is possible to achieve a satisfactory illumination with a relatively small lamp design.

Preferably, the housing is a regular body (n-hedron) with at least four wall surfaces. According to a preferred embodiment of the invention, it is a cube arranged so that it stands on an apex on a fastening, whereby the solar modules are arranged on two or more of its upper surfaces or form these surfaces. Preferably, the fastening is arranged in the region of the lower apex of the cube, and it may form either a vertical post or a horizontal arm.

According to a special embodiment of the invention, there is also a motion sensor connected with electrical control means, whereby the luminous body is provided with two or more controllable brightness levels, and the higher brightness level is turned on in reaction to a signal of the motion sensor, whereby a timer is provided which limits this on period.

According to an advantageous embodiment of the invention, the luminous body consists of a plurality of light emitting diodes (LEDs).

The invention is described in detail below, using an example, and with reference to the accompanying drawing figure.

BRIEF DESCRIPTION OF THE VIEW OF THE DRAWING

FIG. 1 is an elevational view of the solar lamp of the present invention.

DETAILED DESCRIPTION OF THE INVENTION

FIG. 1 shows a solar lamp 1, consisting of a cubic housing 2 and a pole 3. A lower apex of cubic housing 2 sits on the upper end of pole 3 where it is fastened to same. Pole 3 is inserted in conventional fashion in the ground 4, for example in the earth. This renders the configuration of cubic housing 2 such that three wall surfaces 2a, 2b, 2c are slanted toward the top, while the other three wall surfaces 2a, 2b, 2c are slanted toward the bottom. The upper surfaces 2a, 2b, 2c are formed by solar modules 5, of which only that of module 5 is indicated here. The solar modules are glass plates with series-connected solar cells and a frame, whereby the modules are connected to their frames in such a way that they produce a cubic shape. The lower wall surfaces 2d, 2e, 2f are transparent and can be formed, for example, by equal glass plates which have no solar cells and are provided with frames, by which they are connected to each other and to the solar modules. The solar modules are provided with connections from which cables 6 lead to a module 7 in the interior of housing 2, which is provided with the above described circuits and the battery. A luminous body 8 is arranged on module 7. A sensor 9 for light and motion is arranged in pole 3, from which the corresponding line runs to module 7. When all the upper surfaces 2a, 2b, 2c are formed by solar modules, or when they carry solar modules, the cubic shape of housing 2 ensures that an optimal use of solar energy is always guaranteed without the owner having to worry about the orientation of the solar modules.

What is claimed is:

1. Solar lamp for outdoor use, in particular a garden lamp, road or street lamp, comprising one or more solar modules,

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and a housing with a battery, which is electrically connected to the at least one solar module, and one or more luminous bodies, a circuit being provided between the battery and the luminous body which reacts to signals from a light sensor attached to the solar lamp and which enables or disables the electrical connection between the battery and the at least one luminous body, depending on the degree of brightness/darkness,

characterized in that

the housing is a cube with six wall surfaces, that one or more solar modules (5) are arranged on at least two wall surfaces of the cube, or that at least two wall surfaces of the cube are formed by solar modules themselves,

that the cube stands on its apex the cube is attached to a fastening structure for supporting the cube above the floor or ground and the fastening structure is attached to the cube in the area of the lower apex of the cube, and

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that the solar modules (5) are arranged on two or more top surfaces (2a, 2b, 2c) of the cube or the solar modules (5) and form the at least two wall surfaces of the cube.

2. Solar lamp according to claim 1, characterized in that the fastening structure for the cube comprises one of a vertical pole (3) or a horizontal arm.

3. Solar lamp according to claim 1, characterized by comprising:

a motion sensor which is connected to electrical control means, the luminous body having two or more controllable brightness levels, and the higher brightness level is turned on in reaction to a signal from the motion sensor, and a timer is provided which limits the period that the higher brightness level is turned on.

4. Solar lamp according to claim 1, characterized in that the luminous body comprises a plurality of light emitting diodes (LED's).

* * * * *

EXHIBIT G

**COPY OF APPELLANT'S COMMENTS OF SEPTEMBER 14, 2009,
REFORMATTED TO REMOVE PRIOR ART IMAGES**

**(This exhibit is provided for the sole purpose of showing that the comments
comply with the 50-page limit once prior art images are removed.)**

Reexamination No. 95/000,104

**EXHIBIT 1 TO
APPEAL BRIEF OF THIRD PARTY REQUESTOR**

Applicant's submission of 9/14/2009 reproduced with same margins and font sizes as original submission, but with prior art drawings removed

TOTAL: 44 PAGES

For purposes only of illustrating effects of elimination of embedded images on total page length. NOT submitted for substantive content as it relates to patentability of claims.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Reexamination of:)
Gregory G. Kuelbs)
)
Control No. **95/000,104**) Examiner: **Margaret Rubin**
)
Patent No.: **6,612,713**) Art Unit: **3992**
)
Issued: **September 2, 2003**)
)
Assignee: **WORLD FACTORY, INC.**)

**REPLACEMENT COMMENTS OF THIRD PARTY REQUESTER TO PATENT
OWNER'S RESPONSE IN *INTER PARTES* REEXAMINATION AND TO OFFICE
ACTION**

Mail Stop Ex Parte Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madame:

In response to the Inter Partes Reexamination Communication dated August 28, 2009, third party requester, Southern Sales & Marketing Group, Inc. ("Southern Sales"), pursuant to 37 CFR §§ 1.947 and 1.948, hereby submits its replacement comments to the "Response to Office Action in *Inter Partes* Reexamination" by the patent owner, World Factory, Inc. ("World Factory"), filed April 17, 2009.

**CLAIMS 1, 47, 48, 51, AND 63 ARE UNPATENTABLE BECAUSE
THEY BROADEN THE SCOPE OF THE PATENT**

The Federal Circuit standard for determining whether a claim has been broadened is as follows: "A claim of a reissue application 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....” *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d at 1037, 4 USPQ2d at 1453 n.2. The same broadening test is applied to claims in reexamination. *Anderson v. International Eng’g & Mfg.*, 160 F.3d at 1349, 48 USPQ2d at 1634.

For the purposes of the following analysis, the “conceivable apparatus” will be an apparatus that consists of the elements of the amended or new claim. If a device consisting of the elements of the amended or new claim does not infringe the patent claim, the amended or new claim impermissibly broadens the patent.

Amended Claim 1

Patent Claim 1—A device of amended Claim 1 does not infringe patent Claim 1. The device of amended Claim 1 lacks “an electrical charging system for recharging the rechargeable electrical power system, the electrical charging system being adapted to receive power from an AC power outlet.” Thus a device according to amended Claim 1 does not infringe patent Claim 1.

Patent Claims 2–5—A device of amended Claim 1 does not infringe patent Claims 2–5. The device of patent Claims 2–5 requires “a solar energy system carried by the pole portion.” “Carried” means “to sustain the weight or burden of.” Thus patent Claims 2–5 require that the weight of the solar energy system be borne by the pole portion above the canopy portion. In contrast, amended Claim 1 requires only that the solar energy system be “carried by a module coupled to the pole.” Thus a hypothetical device according to amended Claim 1 could include a module sitting on the ground beside the umbrella, coupled to the pole portion above the canopy portion but without the weight of the module being borne by the pole portion (see diagram). Thus a hypothetical device could infringe amended Claim 1 without infringing patent Claims 2–5.

Patent Claims 6–8—A device according to amended Claim 1 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6–8. Thus a device according to amended Claim 1 does not infringe patent Claims 6–8.

Patent Claim 9—A device according to amended Claim 1 lacks a cooling system as required by patent Claim 9. Thus a device according to amended Claim 1 does not infringe patent Claim 9.

Patent Claims 10–14—A device according to amended Claim 1 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10–14. Thus a device according to amended Claim 1 does not infringe patent Claims 10–14.

CONCLUSION: Because a hypothetical device consisting of the limitations of amended Claim 1 would not infringe any of the claims of the original patent, Claim 1 as amended impermissibly broadens the scope of the patent and is not allowable.

New Claim 47

Patent Claim 1—A device according to new Claim 47 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 47 does not infringe patent Claim 1.

Patent Claims 2–5—A device according to new Claim 47 lacks a lighting system carried by the canopy portion, as required by patent Claims 2–5. Thus a device according to new Claim 47 does not infringe patent Claims 2–5.

Patent Claims 6–8—A device according to new Claim 47 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6–8. Thus a device according to new Claim 47 does not infringe patent Claims 6–8.

Patent Claim 9—A device according to new Claim 47 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 47 does not infringe patent Claim 9.

Patent Claims 10–14—A device according to new Claim 47 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10–14. Thus a device according to new Claim 47 does not infringe patent Claims 10–14.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 47 would not infringe any of the claims of the original patent, Claim 47 impermissibly broadens the scope of the patent and is not allowable.

New Claim 48

Patent Claim 1—A device according to new Claim 48 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 48 does not infringe patent Claim 1.

Patent Claims 2-5—A device according to new Claim 48 lacks a lighting system “being conductively coupled to and powered by the rechargeable electrical power system,” as required by patent Claims 2-5. Thus a device according to new Claim 48 does not infringe patent Claims 2-5.

Patent Claims 6-8—A device according to new Claim 48 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6-8. Thus a device according to new Claim 48 does not infringe patent Claims 6-8.

Patent Claim 9—A device according to new Claim 48 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 48 does not infringe patent Claim 9.

Patent Claims 10-14—A device according to new Claim 48 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10-14. Thus a device according to new Claim 48 does not infringe patent Claims 10-14.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 48 would not infringe any of the claims of the original patent, Claim 48 impermissibly broadens the scope of the patent and is not allowable.

New Claim 51

Patent Claim 1—A device according to new Claim 51 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 51 does not infringe patent Claim 1.

Patent Claims 2-5—Patent Claims 2-5 recite “a solar energy system carried by the pole portion above the canopy portion.” For the reasons set forth above with respect to amended Claim 1, a hypothetical device could infringe new Claim 51 without infringing patent Claims 2-5.

Patent Claims 6-8—A device according to new Claim 51 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6-8. Thus a device according to new Claim 51 does not infringe patent Claims 6-8.

Patent Claim 9—A device according to new Claim 51 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 51 does not infringe patent Claim 9.

Patent Claims 10-14—A device according to new Claim 51 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10-14. Thus a device according to new Claim 51 does not infringe patent Claim 9.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 51 would not infringe any of the claims of the original patent, Claim 51 impermissibly broadens the scope of the patent and is not allowable.

New Claim 63

Patent Claim 1—A device according to new Claim 63 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 63 does not infringe patent Claim 1.

Patent Claims 2-5—Patent Claims 2-5 recite “a solar energy system carried by the pole portion above the canopy portion.” “Carried” means “to sustain the weight or burden of.” Thus patent Claims 2-5 require that the weight of the solar energy system be borne by the pole portion above the canopy portion. In contrast, new Claim 63 requires only that the solar energy system be “coupled” to the pole. Thus a hypothetical device according to new Claim 63 could include a solar energy system sitting on the ground beside the umbrella, coupled to the pole portion above the canopy portion but without the weight of the solar

energy system being borne by the pole portion. Thus a hypothetical device could infringe new Claim 63 without infringing patent Claims 2–5.

Patent Claims 6–8—A device according to new Claim 63 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6–8. Thus a device according to new Claim 63 does not infringe patent Claims 6–8.

Patent Claim 9—A device according to new Claim 63 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 63 does not infringe patent Claim 9.

Patent Claims 10–14—A device according to new Claim 63 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10–14. Thus a device according to new Claim 63 does not infringe patent Claims 10–14.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 63 would not infringe any of the claims of the original patent, Claim 63 impermissibly broadens the scope of the patent and is not allowable.

CLAIM 52 IS UNPATENTABLE FOR DOUBLE PATENTING

Claim 52 as added by patentee in the present reexamination is unpatentable over Claim 49 as added by patentee in the present reexamination under the judicially-created doctrine of double patenting.

49. (New) An umbrella apparatus, comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;
wherein the lighting system includes multiple discrete lighting elements positioned along a rib member, each lighting element being recessed within the rib member and being conductively coupled to the rechargeable electrical power system by an electrical conductor, the electrical conductor also being recessed within the rib member.

52. (New) An umbrella apparatus comprising:
a base support portion;
a pole portion coupled to the base support portion;
a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system;
and
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;
wherein the lighting system includes multiple discrete lighting elements positioned along a rib member; and
wherein each lighting element is fully recessed within the corresponding rib member.

The preamble and first six body paragraphs of each claim are identical. The only difference between the two claims is that Claim 49 recites that each lighting element is recessed within the corresponding rib member, whereas Claim 52 recites that each lighting element is fully recessed within the corresponding rib member.

The only way in which the terms “fully recessed” and “recessed” can differ is if Claim 49 covers a situation in which a lighting element is only partially recessed. However, there is no support in the specification of the '713 patent of a lighting element that is only partially recessed. All of the disclosed embodiments describe only lighting elements that are fully recessed. The term “recessed” in Claim 49 can only be interpreted to cover a lighting element that is “fully” recessed.

Because the '713 patent lacks support for any recess other than "fully" recessed, the terms "recessed" and "fully recessed" must be construed identically. Claim 49 is identical to Claim 52 and therefore constitutes double-patenting.

**THE PROVISIONAL PATENT APPLICATIONS OF FEBRUARY 7,
2001, FAIL TO SUPPORT CLAIMS 1, 2, 4-7, 45-48, 51, 56, 61, 64-66,
AND 74 OF THE PATENT**

Patentee is not entitled to the filing dates of the provisional patent application of February 7, 2001 with respect to Claims 1, 2, 4-7, 45-48, 51, 56, 61, 64-66, and 74, because the 2/7/01 provisional application fails to disclose elements of these claims.

The 2/7/01 provisional does not disclose a "module" or "power unit" as required by Claims 1, 2, 4-7, 45-48, 51, 56, 61, 64-66, and 74. Rather, the solar cell is carried directly atop the pole. Similarly, the 2/7/01 provisional does not disclose a "rechargeable electrical power system" located above the canopy, as required by Claims 1, 2, 4-7, 45-48, 51, 56, 61, 64-66, and 74. Accordingly, these claims are not entitled to the February 7, 2001, filing date of this provisional.

**THE DECLARATIONS UNDER RULE 131 ARE INSUFFICIENT TO
SWEAR BEHIND THE REFERENCES**

It is the patentee's responsibility to establish conception and, where necessary, diligence in reduction to practice from a time prior to the effective date of the cited references until the date of reduction to practice. Kuelbs' second Declaration, even when taken in combination with Kuelbs' first Declaration and the Quillen Declaration, fail to establish diligence. Large blocks of unexplained inactivity remain, and the patentee has therefore failed to establish diligence.

Declarant's statements in Paragraph 2 of the Declaration are conclusory, self-serving, and uncorroborated.

Declarant's statements in Paragraph 3 of the Declaration are uncorroborated.

Declarant's statements in Paragraph 4 of the Declaration are uncorroborated.

The copy of the passport pages (Exhibit A) referenced in Paragraph 5 of the Declaration establish, at best, that Declarant visited China in July and October 1999. The passport pages do not contain any information about a solar-powered umbrella. Declarant's statements about the purpose of the trip are uncorroborated.

The notes (Exhibit B) referenced in Paragraph 6 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 6 of the Declaration are uncorroborated.

The notes (Exhibit C) referenced in Paragraph 7 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 7 of the Declaration are uncorroborated.

The notes (Exhibit D) referenced in Paragraph 8 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 8 of the Declaration are uncorroborated.

Paragraph 9 misstates the law. Exhibits B, C, and D are only drawings and, while possibly relevant to the issue of conception, do not constitute a reduction to practice, as they do not constitute making and using the invention and proving it useful for its intended purpose. Declarant's statements in Paragraph 9 of the Declaration are uncorroborated.

The notes (Exhibit E) referenced in Paragraph 10 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 10 of the Declaration are uncorroborated.

The notes (Exhibit F) referenced in Paragraph 11 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 11 of the Declaration are uncorroborated.

The notes (Exhibit G) referenced in Paragraph 12 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 12 of the Declaration are uncorroborated.

The notes (Exhibit H) referenced in Paragraph 13 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. The notes are undated. While they bear the notation "Proposed Discussion Notes China Trip - July-Aug 99," the notes could have been prepared contemporaneously with the trip or months earlier. Declarant's statements in Paragraph 13 of the Declaration are uncorroborated.

The notes (Exhibit I) referenced in Paragraph 14 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 14 of the Declaration are uncorroborated.

The proposed itinerary (Exhibit J) referenced in Paragraph 15 of the Declaration is uncorroborated. Its existence prior to the critical date has not been attested to by any independent party. A proposed itinerary is not proof that a trip was ever made. The proposed itinerary contains no information about the alleged invention or any efforts to reduce it to practice. Declarant's statements in Paragraph 15 of the Declaration are uncorroborated.

The receipt for currency exchange (Exhibit K) referenced in Paragraph 16 of the Declaration establishes, at best, that Declarant was in the Hong Kong airport on October 20, 1999. Declarant's presence in the Hong Kong airport is no indicator of the purpose of Declarant's trip and most certainly does not establish any element of the claimed invention. Declarant's statements in Paragraph 16 of the Declaration are uncorroborated.

The e-mail (Exhibit L) referenced in Paragraph 17 of the Declaration establishes, at best, that Declarant received an e-mail from an Eric Li on October 11, 1999. The e-mail does not establish any element of the claimed invention and does not even reference a stated purpose for a proposed visit. Declarant's statements in Paragraph 17 of the Declaration beyond his assertion that he received an e-mail are uncorroborated.

The e-mail (Exhibit M) referenced in Paragraph 18 of the Declaration establishes, at best, that Declarant received an e-mail from an Eric Li on October 14, 1999. The e-mail does not establish any element of the claimed invention and does not even reference a stated purpose for a proposed visit. Declarant's statements in Paragraph 18 of the Declaration beyond his assertion that he received an e-mail are uncorroborated.

The e-mail (Exhibit N) referenced in Paragraph 19 of the Declaration establishes, at best, that Declarant received an e-mail from an Eric Li on October 16, 1999. The e-mail does not establish any element of the claimed invention and does not even reference a stated purpose for a proposed visit. Declarant's statements in Paragraph 19 of the Declaration beyond his assertion that he received an e-mail are uncorroborated.

The drawings (Exhibits O, P, and Q) referenced in Paragraph 20 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. The drawings are undated. Declarant's statements in Paragraph 20 of the Declaration are uncorroborated.

The screen shot (Exhibit R) referenced in Paragraph 22 of the Declaration at best establishes that there are files on a computer bearing modified dates as shown. There is no corroboration that the screen shot has not been altered or modified. There is no corroboration that the files identified in Paragraph 22 of the Declaration relate in any way to the claimed invention.

Patentee's statements in Paragraphs 25 and 26 of the Declaration that he worked diligently on the invention from a date prior to 30 April, 1999, through the filing date of U.S. Provisional Application No. 60/267,018, *i.e.*, 7 February 2001, are uncorroborated and conclusory.

Patentee's statements in Paragraphs 27, 28, and 30 of the Declaration that he worked diligently on the invention from a date prior to 30 April, 1999, through the filing date of U.S. Provisional Application No. 60/335,933, *i.e.*, 2 November 2001, are uncorroborated and conclusory.

Exhibit V was prepared on 26 April 2006, seven years after the events described therein. No contemporaneous notes are produced. No reason for the statement is given,

leading to the inescapable conclusion that the document was produced solely for the purpose of this reexamination and, most likely, that the patentee instructed the author what to say. No specific dates are given except for July 1999, and it is unclear from the document when work on the project was discontinued. Thus the document fails to explain any period of inactivity during the critical period. Declarant's statements in Paragraph 20 of the Declaration are uncorroborated.

**EVEN IF ALL OF DECLARANT'S STATEMENTS ARE ARGUENDO
PRESUMED ACCURATE, THEY FAIL TO ESTABLISH DILIGENCE**

An inventor's date of invention is his date of conception, IF he is thereafter diligent in reducing the invention to practice. The Patentee in this case seems to be alleging acts directed toward both an actual reduction to practice (making and using the invention) and a constructive reduction to practice (the filing of a patent application). To establish a valid date of invention, the Patentee must establish diligence in reducing the invention to practice from a time just prior to the effective date of a prior art reference until the filing date of the patent application. However, even if all of the facts alleged in the Patentee's § 1.131 Declaration are assumed to be correct for the sake of argument, there are large unexplained gaps of inactivity in his alleged efforts to reduce the invention to practice that preclude a date of invention any earlier than the filing date of the application.

A time line of the Patentee's activities shows the following:¹

Date	Activity	Delay Since Previous Activity (days)
4/30/1999	Earliest possible date of conception (4, 6-8)	—
6/30/1999	Preparation of sketches of an umbrella (10)	61
7/30/1999	Trip to China (5)	30
7/31/1999	Notes in preparation for trip to China (11, 12, 13)	1
9/30/1999	Notes and sketches of umbrella (14)	61
10/11/1999	E-mail from Eric Li re Real Faith factory in China (17)	11

¹ Where Patentee's Declaration does not specify a day but specifies only a month and year (e.g., "6-99" in ¶ 10, "7-99" in ¶ 11), it is assumed that the event occurred on the last day of the month.

10/14/1999	E-mail from Eric Li re Jiangsu Metal & Minerals Import and Export (18)	3
10/16/1999	Memo from Eric Li re Mr. Bakula (19)	2
10/20/1999	Trip to China (5, 16)	4
10/23/2000	Quillen works on drawings (20, 22)	369
11/9/2000	Correspondence to patent attorney re preparation of patent application (21)	17
2/7/2001	Provisional patent application filed (23)	90

Patentee has unexplained periods of inactivity of 61, 30, 61, 369, and 90 days. Thus even if the Patentee's declaration did not suffer fatal flaws of lack of corroboration, any one of these unexplained prolonged periods of inactivity preclude a finding of diligence in reduction to practice.

For the reasons set forth above, the declarations submitted by patentee are insufficient to swear behind the references.

**CLAIMS 1, 2, 4-7, 9, 47-57, 59-62, 64-66, AND 70-74 ARE
UNPATENTABLE OVER THE PRIOR ART**

Additional Prior Art Submitted Under 37 CFR § 1.948

For the Examiner's benefit, new prior art applicable to World Factory's amendments has been found. Pursuant to 37 CFR § 1.948, Southern Sales files herewith the following additional prior art references that address features of the amended Claims 1-5, 47-56, 59-62, 64-66, 70-72, and 74 not present in the original claims:

Patent No./App. No.	Inventor	Effective Date	Exhibit No.
5,055,984	Hung et al.	Aug. 11, 1989	13
5,758,948	Hale	July 10, 1996	14
6,406,163	T. Yang	Nov. 27, 2000	15
6,729,742	Wismeth	May 10, 2002	16

These submissions are made in response to the new amendments submitted by World Factory. Southern Sales believes that an overview of the newly submitted prior art would benefit the reexamination process.

World Factory has submitted a Second Declaration Under 37 C.F.R. § 1.131 in which the inventor swears behind the effective dates of the Cathel, Lee '856, Mai, Pan, Lee '224, Yang, Molnar, Vivian, Farr, and Lai references. The reference date alleged in the Second Declaration is April of 1999. The effective date of the newly submitted Hung and Hale prior art references predates April 1999. Thus even if the Examiner finds the Second Declaration effective in establishing a date of invention of April 1999, the new Hung and Hale prior art submissions would still constitute prior art.

U.S. Patent No. 5,055,984 to Hung et al. (hereafter "Hung") discloses a solar rechargeable lamp for outdoor use. The device contains a solar energy system (hereafter "SES") (32) that collects and converts solar energy into electrical energy, which the SES (32) stores in a rechargeable electrical system (hereafter "RES") (26, a battery) to which it is connected (Col. 3, 26-39). The two power systems are found in one housing (FIG. 5), the SES (32) found above the RES (26), which is releasably coupled to a pole (80) (See FIG. 2). The RES powers a lighting system (18)(FIG. 5).

U.S. Patent No. 5,758,948 to Hale (hereafter "Hale") discloses a seasonal light display device. The device contains an apparatus comprising a pole portion (3) and has a plurality of ribs (12) hingedly coupled to the pole portion, and a lighting system, wherein the lighting system includes multiple discrete lighting elements (15) positioned along a rib member (12), each lighting element being recessed (12, 22 and 24) within the rib member and being conductively coupled to a electrical power system by an electrical conductor (36), the electrical conductor also being recessed within the rib member(12, 22 and 24).

If World Factory is successful in establishing a date of invention of April 1999, the newly submitted Yang and Wismeth prior art references may not constitute prior art. However, in the likely event that the Examiner finds the Second Declaration lacking, the following new prior art submissions would be highly useful in the reexamination.

U.S. Patent No. 6,406,143 to Yang (hereafter "Yang '163") (Exhibit 13) discloses a solar cell lighting fixture. The device contains a SES that collects and converts solar energy into electrical energy, which it stores in the RES to which the SES is connected (Col. 2, 62 – Col. 3, 18, FIG. 2). These two power systems are found in one module which is releasably

coupled to a pole portion of the device (Col. 5, 11-18, FIG. 15). The SES is found in the upper portion of the module while the RES is found in the lower portion of the module. The RES powers a lighting system carried by the device (Col. 3, 4-10, FIG. 2).

U.S. Patent No. 6,729,742 to Wismeth et al. (hereafter "Wismeth") discloses a solar lamp for outdoor use. The device contains a solar energy system that collects and converts solar energy into electrical energy, which the SES stores in a RES to which it is connected (Col. 1, 53-59, Col. 2, 47-64). The two power systems are found in the cubic housing, the SES found above the RES (Col. 2, 38-58). The housing is coupled to a pole (Col. 2, 38-42, FIG. 1). The RES powers a lighting system (Col. 1, 53-57, Col. 2, 58-59).

Summary of Previously Presented Prior Art in View of Patentee's Amendments

While the following patents have previously been presented, a recap of their relevance is appropriate in view of the amendments made and new claims submitted by the patentee.

Phyle - U.S. Patent No. 5,584,564

Phyle discloses an apparatus that has an illumination device 12 carried by the canopy ribs. Battery (10) is rechargeable and is carried by the pole at an upper portion 20.

Valdner includes a solar power electrical system 38 found above the canopy 24, and carried by the rod (pole) 12. The solar power electrical system 38 has a discus-shape. The apparatus has a rechargeable battery pack that can be connected at the bottom 40 of the rod 12.

Includes a solar collector 2 carried by the canopy that charges batteries 3 in the base 4. The batteries 3 can power a light 12.

Benton describes an umbrella supported by an upper portion 22 of a pole. The pole 22 supports lights 26. A solar panel 34 positioned on top of the canopy of the umbrella can power a motor 36 of a fan 28. The motor and lights may be powered through an AC connection 27.

Walker discloses an umbrella 10 that includes hollow tubes 30 that carry light ropes 32 carried by the ribs 16 of the umbrella 10.

Small discloses an umbrella supported by a post 10. The umbrella employs a motor 29 to open and close the canopy. The motor may be powered by a solar battery 34 and a storage battery 35. The solar battery 34 charges the storage battery 35. The storage battery 35 may be found in other positions along the post 10. However, as shown in FIG. 1, the storage battery 35 is located below the solar battery 34 and is carried by the upper portion of the post 10.

Farr discloses an umbrella 10 with a cooling device. A tube supports the canopy 14 of the umbrella. The cooling device 16 is carried by the tube and may be detached from the tube. A battery 19 is contained within the cooling device 16, and is connected to a solar collector 28. The solar collector 28 is detachably connected to the tube, as shown in FIG. 4.

Molnar discloses an umbrella 10 that includes a fan 18 and lights 54. A battery 36 that powers the fan and lights may be housed in the base 12 of the umbrella 10.

Yang discloses an umbrella that has illumination devices mounted above the canopy 18 and in the tips 40 of each rib 16. The illumination device 40 includes a transparent tip 40 and an LED 42, so arguably, the LED 42 is within the rib 16.

Lee discloses an umbrella that has a plurality of ribs 2 with trenches 3 throughout the bottoms of the ribs 2. Lamps 4 are partially retained within the trenches 3 of the ribs 2.

Pan et al discloses an umbrella that includes a plurality of hollow ribs 3. Along each rib is a trench (32, not shown in these figures) that retain light sources 5. The light sources may be connected with an illuminating connector 31.

Cathel discloses an illuminated mailbox address device 10. The device 10 is powered by a solar cell 60 that recharges a battery 64. LEDs (not shown) may be used to illuminate the device.

Rushing discloses an umbrella having a central support pole 22 that supports a plurality of ribs 28 that support a canopy 30. Light strings 12 with miniature lights 14 are attached to the ribs 28.

Morgan discloses an umbrella 20 with a plurality of ribs 14 that support a canopy 18 and electrical bulbs 24 and electrical connectors 26.

Wu discloses an umbrella that has rib members 24 that have tip illuminators 32. The tip illuminators 23 may be LEDs.

REJECTIONS UNDER 35 U.S.C. §§ 102 AND/OR 103

The Rejection of Claim 1 under Combination I

The Office Action rejected Claim 1 as being obvious and unpatentable over WO 93/00840 and Valdner which was designated Combination I. In response, World Factory amended Claim 1 by adding these limitations: 1) a canopy portion has a plurality of rib members; 2) the SES is carried by a module coupled to the pole portion above the canopy portion; 3) the module is releasably coupled to the pole portion; and 4) the lighting system is carried by the canopy portion and coupled to and powered by the RES. Additionally, World Factory deleted the requirement that the RES be adapted to receive power from an AC power outlet.

The introduction of these limitations fails to overcome the § 103(a) rejections over Combination I. WO 93/00840 and Valdner both disclose a canopy having a plurality of ribs. WO 93/00840 discloses an umbrella having a base 4, a pole 9, a canopy carried by the pole, and a solar collector 2 carried by the canopy that charges batteries 3 in the base 4. The batteries 3 can power a light 12. WO 93/00840 fails to show a lighting system carried by the canopy portion. In Valdner, the ribs carry the ventilation shafts. It would be obvious to a person of ordinary skill in the art at the time of the invention of the '713 patent to have the lighting system of WO 93/00840 carried by ribs such as those of Valdner, which carries the ventilation shafts along its ribs. Additionally, Valdner's solar cell is connected to the rechargeable system, so that the absence of the electrical system being able to receive power

from an AC outlet would be a trivial change on their devices. Logically, the solar power system must be located at a position in which it may receive solar power. If the solar power system is located on the umbrella device, the solar panel may only be located on top of the umbrella, which can be either on the canopy itself or the pole portion of an umbrella, which would be obvious to a person skilled in the art. Finally, the solar portion being releasably coupled to the pole portion is not a novel concept. A component being releasably coupled to any device is ubiquitous.

The Rejection of Claim 1 under Combination I in view of Hung

Claim 1 is further unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination I in view of Hung. The teachings of Combination I are discussed in the preceding paragraph. Hung discloses a SES that is releasably coupled to a pole portion. Hung discloses a solar panel (32) on the upper portion of the housing for the light (10) which is removable from the pole portion (80). Thus, to the extent that Combination I does not expressly disclose a solar panel removably mounted to the upper portion of a pole, Hung provides this missing teaching. Claim 1 is therefore unpatentable under 35 U.S.C. § 103(a) as being obvious over Combination I in view of Hung.

The Rejection of Claims 2, 5 and 74 under Combination II

The Office Action rejected Claims 2 and 5 as being obvious and unpatentable over WO 93/00840 and Phyle, which was deemed Combination II. In response, World Factory amended Claim 2 by adding these limitations: 1) a power module is carried by the pole portion above the canopy portion; 2) the power module has an upper portion and a lower portion; 3) the SES is carried by the upper portion of the module; and 4) the RES is disposed in the lower portion of the power module. No amendments were made to Claim 5, which is dependent on claim 2. The only additional limitation of Claim 5 is the canopy has a plurality of rib members and that each rib member carries a fluorescent light.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections based on WO 93/00840 and Phyle. In addition, Claim 74 claims the same elements and has identical amendments, so it too should be found rejected based upon Combination II as well. The

changes to the claims mean that the SES and the RES naturally reside in one singular component, with the SES found over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must have access to light. Accordingly, the SES must be above the canopy portion, either on the canopy itself or on the pole portion supporting the canopy. Additionally, placing the RES below the SES would be obvious as well; placing the RES above the SES would block sunlight from reaching the SES, preventing the SES from operating. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems. For Claim 5, both references disclose a canopy with multiple rib members. One skilled in the art would find it obvious to have the lighting system carried by the rib members, especially the use of fluorescent lights. Phyle itself carries fluorescent lights.

The Rejection of Claims 2, 5 and 74 under Combination II in view of Hung

Alternately, Claims 2, 5 and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination II and further view of Hung. Combination II discloses all the elements of Claim 2 and 74 except for the amendments above, but Hung discloses a SES and a RES in a power module that is carried by a pole, the SES found in the upper portion and the RES found in the lower portion of the module. Accordingly, a person skilled in the art would find it obvious to modify Combination II by adding the power module carried by a pole, as taught by Hung. Additionally, claims 2 and 74 are identical. As such, one or the other should be cancelled even if the claims are allowed.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination II in view of Hung.

The Rejection of Claims 2, 5 and 74 under Combination II in view of Yang '163 or Wismeth

If the Examiner finds World Factory's § 131 Declaration lacking, Claims 2, 5, and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination II in further view of Yang '163 or Wismeth. Both Yang '163 and Wismeth disclose a SES and a RES in a power module that is carried by a pole, the SES found in the upper portion and the RES found in the lower portion of the module. Because an SES, if mounted to the umbrella, must be mounted above the canopy if it is to be exposed to sunlight, it would have been obvious to one of ordinary skill in the art to have mounted a SES and a RES in a power module carried by the pole, as taught by Yang '163 or Wismeth, and to affix it to a portion of the pole above the canopy so it will be exposed to sunlight. Claims 2, 5, and 74 are therefore obvious, and therefore unpatentable, over Combination II in view of Yang '163 or Wismeth.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination II in further view of Yang '163 or Wismeth.

The Rejection of Claims 2, 5 and 74 under Combination III

The Office Action rejected Claims 2, 5, and 74 as being unpatentable over Phyle and Valdner which was deemed Combination III. In response, World Factory amended Claims 2 and 74 by adding these limitations: 1) a power module carried by the pole portion above the canopy portion; 2) the power module has an upper portion and a lower portion; 3) the SES is carried by the upper portion of the module; and 4) the RES is disposed in the lower portion of the power module. No amendments were made to Claim 5, which is dependent on claim 2. The only additional limitation of Claim 5 is that the canopy has a plurality of rib members and that each rib member carries a fluorescent light. For Claim 5, both references disclose a

canopy with multiple rib members. Phyle discloses fluorescent lights (12) attached to its rib members.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Phyle and Valdner. The changes to the claims mean that the SES and the RES reside in one singular component, with the SES found over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must be exposed to light. As such, the SES must be above the canopy portion, either on the canopy itself or on the pole portion supporting the canopy. Additionally, having the RES below the SES would be obvious as well, as having the RES above the SES would prevent the SES from receiving sunlight and thereby prevent its operation. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems.

The Rejection of Claims 2, 5 and 74 under Combination III in view of Hung

Alternately, Claim 2, 5, and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination III in view of Hung. Combination III discloses all the elements of former Claims 2 and 74. As to the features added by amendment, Hung discloses a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to modify Combination III by placing the SES and RES in a single module carried by a pole, as taught by Hung. When combined with Combination III, accordingly, a person skilled in the art would see this combination as obvious.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination III in view of Hung.

Claims 2, 5 and 74 are unpatentable under Combination III in view of Yang '163 or Wismeth

If the Examiner finds World Factory's § 131 Declaration lacking, Claim 2, 5 and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination III in view of either Yang '163 or Wismeth. Combination III discloses all the elements of Claim 2 and 74 and Yang '163 and Wismeth disclose a SES and a RES in a singular module that is carried by a pole. When combined with Combination III, accordingly, a person skilled in the art would see this combination as obvious.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination III in view of either Yang '163 or Wismeth.

Claims 2 and 4 are unpatentable under Combination IV

The Office Action rejected Claims 2 and 4 as being unpatentable over WO 93/00840 and Pan or Wu or JP 9-168415 or Mai or Yang which was deemed Combination IV. In response, World Factory amended Claim 2 by adding these limitations: 1) a power module carried by the pole portion above the canopy portion; 2) the power module has an upper portion and a lower portion; 3) the SES is carried by the upper portion of the module; and 4) the electrical power system is disposed in the lower portion of the power module. Lastly, World Factory submitted a Declaration in which the inventor attempts to swear behind Mai, Pan, and Yang.

World Factory has failed to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over WO 93/00840 and Wu or JP-9-168415. The changes to the claims mean that the SES and the RES reside in one singular component, with the SES found over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must have access to light. As such, the SES must be above the canopy portion, either on the

canopy itself or on the pole portion supporting the canopy. Additionally, having the RES below the SES would be obvious as well; having the RES above the SES would prevent the SES from receiving light and thereby preventing its operation. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems.

No amendments were made to Claim 4, which is dependent on Claim 2. The only additional limitation of Claim 4 is that the canopy has a plurality of rib members which carries the lighting system and that the rib members carry a plurality of light emitting diodes coupled to the RES. For Claim 4, the references disclose a canopy with multiple rib members and the use of lighting devices. All but WO 93/00480 disclose using light emitting diodes in various positions, some specifically on the ribs. As such, the arguments above that apply to Claim 2 apply to Claim 4.

Claims 2 and 4 are unpatentable under Combination IV in view of Hung

Alternately, Claim 2 and 4 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination IV in view of Hung. Combination IV discloses all the elements of former Claims 2 and 4, and Hung discloses the new elements added by the amendments: a SES and a RES in a singular module that is carried by a pole, the SES found in the upper portion and the RES found in a lower portion. It would have been obvious to a person skilled in the art to modify Combination IV by substituting a SES and a RES in a singular module that is carried by a pole, as taught by Hung, and thereby construct the invention of Claims 2 and 4.

The Rejection of Claims 2 and 4 under Combination IV in view of Yang '163 or Wismeth

If the Examiner finds the Declaration lacking, Claims 2 and 4 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Combination IV in view of either Yang '163 or Wismeth. Combination IV discloses all the elements of former Claims 2 and 4, and Yang '163 and Wismeth disclose the limitations added by the recent amendments: a SES and a

RES in a singular module that is carried by a pole. A person of ordinary skill in the art would have found it obvious to modify Combination IV by adding a SES and a RES in a singular module that is carried by a pole, as taught by Yang '163 or Wismeth, and thereby construct the claimed invention. Claims 2 and 4 are therefore unpatentable.

The Rejection of Claim 4 under Combination V

The Office Action rejected Claim 4 as being unpatentable over Phyle and Valdner and Wu or Pan or JP-9-168415 or Mai or Yang, which was deemed Combination V. Claim 4 was not amended; however, Claim 4 remained dependent upon Claim 2, which was amended as stated above. As such, it includes the limitations of Claim 2. For Claim 4, the limitations disclose a canopy with multiple rib members and the lighting elements being LEDs. Also, World Factory submitted a Declaration in which the inventor attempts to swear behind Mai, Pan, and Yang.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Combination V. The changes to the claims mean that the SES and the RES reside in one singular component, with the SES located over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must have access to light. As such, the SES must be above the canopy portion, either on the canopy itself or on the pole portion supporting the canopy. Additionally, having the RES below the SES would be obvious as well; having the RES above the SES would prevent the SES from receiving light and thereby preventing its operation. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems.

Claim 4 is unpatentable over Combination V in view of Hung

Alternately, Claim 4 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination V in view of Hung. Combination V discloses all the elements of previous Claim 4. Hung discloses a SES and a RES in a single module that is carried by a

pole. It would have been obvious to a person skilled in the art to have modified Combination V by providing a SES and a RES in a single module that is carried by a pole, as taught by Hung. Locating the module on the pole above the canopy is an obvious step, because a module located beneath the canopy would not be exposed to sunlight and could not collect energy. Claim 4 is therefore unpatentable as obvious over Combination V in view of Hung.

Claim 4 is unpatentable over Combination V in view of either Yang '163 or Wismeth

If the Examiner finds the Declaration lacking, Claim 4 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination V in view of either Yang '163 or Wismeth. Combination V discloses all the elements of former Claim 4. Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified Combination V by providing a SES and a RES in a single module that is carried by a pole, as taught by either Yang '163 or Wismeth. Locating the module on the pole above the canopy is an obvious step, because a module located beneath the canopy would not be exposed to sunlight and could not collect energy. Claim 4 is therefore unpatentable as obvious over Combination V in view of either Yang '163 or Wismeth.

The Rejection of Claims 49, 50 and 72 under Combination VIII (A)

The Office Action rejected Claims 49, 50 and 72 as being unpatentable over WO 93/00840 and Morgan or Rushing or Pan or JP 9-168415 or Mai which was deemed Combination VIII (A). World Factory responded by amending claims 49 and 72 by adding this limitation: each lighting element is recessed within the rib member and is conductively coupled to the rechargeable electrical power system by an electrical conductor that is also recessed within the rib member. Claim 50 was not amended, but is dependent on Claim 49, therefore taking in the limitation. In addition, World Factory submitted a Declaration in which the inventor attempted to swear behind Mai and Pan.

This amendment fails to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Combination VIII(A). The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. Such an element would

be obvious to a person skilled in the art in light of Combination VIII (A). The lighting elements and connecting wires must be carried by a reinforced structure of a canopy, which would be the rib members. Safety issues would make it obvious not to have wires protruding from the rib members. As such, the logical solution would be to recess the wires and lighting elements within the rib members.

Claims 49, 50 and 72 are obvious over Combination VIII (A) in view of Hale or Wu or Walker

Alternatively, Claims 49, 50 and 72 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII (A) in view of Hale or Wu or Walker. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). Walker discloses lighting elements and wires (32) that are recessed into channels (30) along the underside of the rib (16). It would have been obvious, and hence unpatentable, for a person skilled in the art to have modified Combination VIII(A) by recessing the wires and lighting elements into the rib members, as taught by either Hale or Wu or Walker. Claims 49, 50, and 72 are therefore unpatentable.

Claims 49, 50 and 72 are obvious over Combination VIII (A) in view of Lee '224 or Lee '856

If the Examiner finds the Rule 1.131 Declaration lacking, Claims 49, 50 and 72 are unpatentable under U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII (A) in view of Lee '224 or Lee '856. Former Claims 49, 50, and 72 have already been rejected as obvious over Combination VIII(A). Claims 49, 50, and 72 have now been amended to add the limitations that each lighting element is recessed within the rib member and is conductively coupled to the rechargeable electrical power system by an electrical conductor that is also recessed within the rib member. Lee '224 and Lee '856 disclose an umbrella that has a plurality of ribs 2 with trenches 3 throughout the bottoms of the ribs 2. Lamps 4 are partially retained within the trenches 3 of the ribs 2. Both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into the rib members with the

wires connected to a rechargeable power source. It would have been obvious to a person skilled in the art to have modified Combinaton VIII(A) by providing trenches in the bottoms of the ribs, with lighting elements and associated wiring recessed into the trenches as taught by Lee '224 and Lee '856 and thereby construct the claimed invention. Claims 49, 50, and 72 are therefore unpatentable under § 103(a).

The Rejection of Claims 51 and 55 under Combination VIII (B) in view of Wu or Hale

The Office Action rejected Claims 51 and 55 as being unpatentable over WO 93/00840 and Lee '856 which was deemed Combination VIII (B). Claim 51 was originally dependent on Claim 49, but World Factory amended Claim 51 to become independent, and incorporated the limitations of Claim 49, except that a single lighting element has replaced a plurality of lighting elements along a rib member. These additional limitations were added as well: 1) a translucent cover for covering the lighting elements; 2) the SES carried by a power unit coupled to the pole portion above the canopy portion; and 3) a portion of each lighting element extends beyond the corresponding rib member. Claim 55 was amended to depend from Claim 52, which is identical to Claim 51 except that it claims the lighting elements are fully recessed within the rib member. Claim 55 further claims that each wire is fully recessed within the rib member. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Lee '856.

Claims 51 and 55 as amended are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII(B) in view of Wu or Hale. The amendments made disclose the solar power system coupled to the pole portion in a removable manner. Hung has the same configuration. Alternatively, having an item coupled to another item is ubiquitous. Wu and Hale both disclose lighting elements that extend beyond the ribs. Additionally, whether a lighting element is fully recessed or extended from a rib does not have an inventive value. Wu has a translucent cover (322) that covers the lighting element (32). The wire elements for Wu and Hale are recessed within the rib members.

It would have been obvious to a person skilled in the art to modify Combination VIII(B) by coupling one item to another, to have lighting elements that extend beyond the ribs as taught by Wu or Hale, to recess wires within the rib members as taught by Wu or Hale, and to provide a translucent cover that covers a lighting element, as taught by Wu. Claims 51 and 55 are therefore unpatentable as obvious over § 103(a).

The Rejection of Claim 54 under Combination VIII(C)

The Office Action rejected Claim 54 as being unpatentable over WO 93/00840 and Pan or JP 9-168415 or Mai, which was deemed Combination VIII(C). World Factory did not amend Claim 54, but did amend Claim 49, from which Claim 54 depends. Claim 49 was amended by adding these limitations: 1) each lighting element is recessed within the rib member; and 2) is conductively coupled to the rechargeable electrical power system by an electrical conductor that is also recessed within the rib member. Claim 54 adds the limitation that the lighting elements are each an LED. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Pan and Mai.

Even if Pan and Mai are removed as references, these amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over WO 93/00840 and JP 9-168415. The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. The lighting elements and connecting wires must be carried by a reinforced structure of a canopy, which would be the rib members. Safety issues would make it obvious not to have protruding wires from the rib members. As such, the logical solution would be to recess the wires and lighting elements within the rib members. Such an element would be obvious to a person skilled in the art in light of WO 93/00840 and JP 9-168415.

Claim 54 is unpatentable over WO 93/00840 and JP 9-168415 in view of either Hale or Wu

Alternatively, Claim 54 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over WO 93/00840 and JP 9-168415 in view of either Hale or Wu. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P

and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). JP 9-168415 discloses using LEDs. A person skilled in the art would find it obvious to modify WO 93/00840 and JP 9-168415, which show all of the features of former Claim 54, by providing a recessed channel with the ribs into which the lighting elements and wires are recessed, as taught by Hale or Wu. Claim 54 is therefore unpatentable as obvious over WO 93/00840 and JP 9-168415 in view of either Hale or Wu.

If the Examiner finds World Factory's § 1.131 Declaration lacking, Claim 54 is unpatentable under U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII(C) in view of Lee '224 or Lee '856. Lee '224 and Lee '856 each disclose lighting elements and wires that are recessed into umbrella rib members. Combination VIII(C) discloses all of the elements of former Claim 54. The new limitations added to Claim 54 are shown in Lee '224 and Lee '856. It would be obvious to a person skilled in the art to modify Combination VIII(C) by recessing the lighting elements and wires into umbrella rib members, as taught by Lee '224 and Lee '856. Claim 54 is therefore unpatentably obvious over Combination VIII(C) in view of Lee '224 or Lee '856.

Claims 49, 50, and 72 are unpatentable under Phyle and Valdner, and Morgan or Rushing or JP 9-168415

The Office Action rejected claims 49, 50 and 72 as being unpatentable over Phyle and Valdner, and Morgan or Rushing or Pan or JP 9-168415 or Mai which was deemed Combination IX (A). World Factory amended Claims 49 and 72 (50 was not amended, but dependent on 49), by adding these limitations: 1) each lighting element is recessed within the rib member and being conductively coupled to the rechargeable electrical power system by an electrical conductor; and 2) the electrical conductor also is recessed within the rib member. Claim 72 further states the lighting element is recessed within the corresponding rib member. Additionally, World Factory submitted a Declaration that attempts to swear behind Pan and Mai.

Even if Pan and Mai are removed as prior art references, the amendments to Claims 49, 50 and 72 fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and

unpatentable over Phyle and Valdner, and Morgan or Rushing or JP 9-168415. The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. The lighting elements and connecting wires must be carried by a reinforced structure of a canopy, which would be the rib members. Safety issues would make it obvious not to have protruding wires from the rib members. As such, the logical solution would be to recess the wires and lighting elements within the rib members, which would be obvious to a person skilled in the art in light of the combination of Phyle and Valdner, and Morgan or Rushing or JP 9-168415.

Claims 49, 50, and 72 are unpatentable under Phyle and Valdner, and Morgan or Rushing or JP 9-168415 and further in view of Hale or Wu or Walker

Alternatively, Claims 49, 50 and 72 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Phyle and Valdner, and Morgan or Rushing or JP 9-168415 in view of Hale or Wu or Walker. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). Walker discloses lighting elements and wires (32) that are recessed into channels (30) along the underside of the rib (16). It would have been obvious to a person skilled in the art to have modified the combination of Phyle and Valdner, and Morgan or Rushing or JP 9-168415 by providing recesses in the ribs to receive the wires and lighting elements, as taught by Hale or Wu or Walker, and thereby construct the claimed invention.

Claims 49, 50, and 72 are unpatentable over Combination IX(A) in view of Lee '224 or Lee '856

If the Examiner finds World Factory's Rule 1.131 Declaration inadequate to establish a date of invention earlier than its filing date, Claims 49, 50 and 72 are unpatentable under U.S.C. § 103(a) as being obvious over Combination IX (A) in view of Lee '224 or Lee '856. Both Lee '224 and Lee '856 disclose an umbrella that has a plurality of ribs 2 with trenches 3 throughout the bottoms of the ribs 2. Lamps 4 are partially retained within the trenches 3 of

the ribs 2. Both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into the rib members with the wires connected to a power source. It would have been obvious to a person skilled in the art to modify Combination IX(A) by providing recesses in the bottom of the rib members with the lighting elements and wires received within the recesses, as taught by Lee '224 and Lee '856, and thereby construct the claimed invention.

Claims 51 and 55 are unpatentable under Combination IX (B)

The Office Action rejected Claims 51 and 55 as being unpatentable over Phyle, Valdner, and Lee '856, which was deemed Combination IX (B). Claim 51 was originally dependent on Claim 49, but World Factory amended Claim 51 to become independent, and incorporated the limitations of Claim 49, except that a single lighting element has replaced a plurality of lighting elements along a rib member. The additional limitations were added: 1) a translucent cover for covering the lighting elements; 2) the SES carried by a power unit coupled to the pole portion above the canopy portion; and 3) that a portion of each lighting element extends beyond the corresponding rib member. Claim 55 was amended to depend from Claim 52, which is identical to Claim 51 except that it claims that the lighting elements are fully recessed within the rib member. Claim 55 further claims that each wire is fully recessed within the rib member. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Lee '856.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Phyle and Valdner. The amendments have made the SES part of a power module, which Valdner discloses. The SES is attached to the pole portion of World Factory's invention. Valdner's SES is attached to the apex of the canopy portion, which would be the equivalent of the pole portion of World Factory's invention. Having a removable SES is not a novel concept either. The venting component (28) of Valdner is recessed in the rib members (26) of the canopy portion. It would have been obvious to a person skilled in the art to position the lights and wiring of Phyle within the venting component of Valdner and thereby construct the claimed invention.

Claims 51 and 55 are unpatentable under Combination IX (B)

Alternatively, Claims 51 and 55 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Phyle and Valdner, and Hung in view of Wu or Hale. The amendments made to Claims 51 and 55 disclose the solar power system coupled to the pole portion in a removable manner. Hung has the same configuration. Wu and Hale both disclose lighting elements that extend beyond the ribs. Additionally, the extent to the amount a lighting element is fully recessed or extended from a rib does not have an inventive value. Wu has a translucent cover (322) that covers the lighting element (32). The wire elements for Wu and Hale are fully recessed within the rib members. It would have been obvious to a person skilled in the art to have modified Combination IX(B) by providing a solar power system coupled to the pole portion in a removable manner, as taught by Hung, to provide lighting elements that extend beyond the ribs, as taught by Wu and Hale, and to provide a translucent cover, as taught by Wu, and thereby construct the claimed invention.

Claims 51 and 55 are unpatentable over Combination IX (B)

If the Examiner finds the Declaration lacking, Claims 51 and 55 are unpatentable under U.S.C. § 103(a) as being obvious over Combination IX (B) and Wu in view of Lee '224 or Lee '856. As previously discussed, both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into the rib members. It would have been obvious to a person skilled in the art to have modified Combination IX(B) by providing lighting elements and wires recessed into rib members, as taught by Lee '224 and Lee '856, and thereby construct the claimed invention.

Claim 54 is unpatentable over Combination IX (C)

The Office Action rejected Claim 54 as unpatentable over Phyle and Valdner, and Pan or JP 9-168415 or Mai which was deemed Combination IX (C). World Factory did not amend Claim 54, but did amend Claim 49, from which Claim 54 depends. Claim 49 was amended by adding these limitations: 1) each lighting element is recessed within the rib member; and 2) each lighting element is conductively coupled to the rechargeable electrical power system by an electrical conductor that is also recessed within the rib member. Claim

54 adds the limitation that the lighting elements are each an LED. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Pan and Mai.

Even if Pan and Mai were removed as prior art references, World Factory has failed to overcome the 35 U.S.C. § 103(a) rejections over Phyle and Valdner and JP 9-168415. The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. Phyle discloses the lighting elements (12) being carried by the rib portions (22). Valdner discloses its venting element (28) being recessed in the rib members (26). Using an LED as the lighting element would be obvious to one skilled in the art, and JP 9-168415 discloses the use of LEDs. The combination of recessing an LED and its wiring components within a rib member would be obvious to a person skilled in the art in light of Combination IX (C).

Claim 54 is unpatentable over Combination IX (C) in view of Hale or Wu

Alternatively, Claim 54 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination IX (C) in view of either Hale or Wu. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). It would have been obvious to a person skilled in the art to have modified Combination IX(C) by providing a recess in each rib into which lighting elements and wires are recessed, as taught by either Hale or Wu, and thereby construct the claimed invention.

Claim 54 is unpatentable over Combination IX (C) in view of Lee '224 or Lee '856.

If the Examiner finds the Rule 1.131 Declaration lacking, Claim 54 is unpatentable under U.S.C. § 103(a) as being obvious and unpatentable over Combination IX (C) in view of Lee '224 or Lee '856. As previously discussed, both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to have modified Combination IX(C) by providing lighting elements and wires recessed into rib members, as taught by either Lee '224 or Lee '856, and thereby construct the claimed invention.

ADDITIONAL PROPOSED REJECTIONS

Claim 1—Claim 1 is not patentable under 35 U.S.C. § 103(a) over Mueller and Rushing in view of Hung. Mueller discloses an umbrella apparatus (80), a base portion (28), a pole portion (16) coupled to the pole portion (28), a canopy portion hingedly coupled to the pole portion, the canopy portion having a plurality of rib members, a rechargeable electrical power system for providing power to the umbrella apparatus, and a SES (82) carried by a module coupled to the pole portion above the canopy portion, the SES being connected to the RES (26). Rushing discloses a lighting system having multiple discrete lighting elements (28) positioned along at least one of the rib members (12), and being conductively coupled to an electrical power system. Hung discloses a SES (32) carried by a module (10), the module being releaseably coupled to the pole portion (80). It would have been obvious to a person skilled in the art to have modified the umbrella of Mueller by providing a lighting system having multiple discrete lighting elements positioned along a rib member and being conductively coupled to an electrical power system, as taught by Rushing, and to substitute a SES carried by a module that is releasably coupled to the pole portion, as taught by Hung, and thereby construct the invention of Claim 1.

Claim 2, 4, 5, 56, and 74—Claims 2, 4, 5, 56, and 74 are not patentable under 35 U.S.C. § 103(a) over Mueller and Phyle in light of Hung. Claim 2 recites a base, a pole, a canopy hingedly mounted to the pole, a power module attached to the pole above the canopy, and a lighting system carried by the canopy. Claim 4 depends from Claim 2 and adds the additional limitations that the canopy comprises a plurality of ribs and the lighting system comprises LEDs. Claim 5 depends from Claim 2 and adds the limitations that the canopy comprises a plurality of ribs and the lighting elements are fluorescent. Claim 56 recites a base, a pole, a canopy comprising a plurality of ribs, and a power module carried by the pole above the canopy. Claim 74 recites a base, a pole, a canopy, a lighting system carried by the canopy, and a power module carried by the pole above the canopy. It should also be noted that Claims 2 and 74 are identical as amended.

Mueller discloses an umbrella apparatus (80), a base portion (28), a pole portion (16) coupled to the pole portion (28), a canopy portion hingedly coupled to the pole portion, a

rechargeable electrical power system for providing power to the umbrella apparatus, and a SES (82) carried by a module coupled to the pole portion above the canopy portion, the SES being connected to the RES (26). It does not disclose a power module carried by the pole portion having an upper and lower portion, nor does it disclose the canopy carrying a lighting system that is coupled to the RES. Phyle does disclose a lighting system that is carried by the canopy that is coupled to the RES. Hung discloses a power module (10) carried by the pole portion (80), with the SES (32) in the upper portion and the RES (26) in the lower portion.

It would have been obvious to a person of ordinary skill in the art to have modified the umbrella apparatus of Mueller by providing a lighting system carried by the canopy that is coupled to the power module, as taught by Phyle, and to have the power module carried by the pole portion with the SES in the upper portion of the module and the RES in the lower portion. Claim 2 would therefore be obvious and unpatentable. The only element of Claim 4 not disclosed by this combination is that the lighting elements are LEDs. The type of lighting element used is trivial and cannot form the basis for patentability. In any event, JP 9-168415 discloses the use of LED lighting elements. The only element of Claim 5 not disclosed by this combination is that the lighting elements are fluorescent. The type of lighting element used is trivial and cannot form the basis for patentability. All of the elements of Claims 56 and 74 are shown in this combination.

Alternatively, if the Examiner finds the Declaration lacking, the combination of Mueller and Phyle in light of Yang '613 or Wismeth would make Claims 2, 46, and 74 obvious in the same manner. As previously discussed, Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified the previously discussed combination of Mueller and Phyle by providing a SES and a RES in a single module that is carried by a pole, as taught by either Yang '163 or Wismeth. Locating the module on the pole above the canopy is an obvious step, because a module located beneath the canopy would not be exposed to sunlight and could not collect energy.

Claim 47—Claim 47 is unpatentable under 35 U.S.C. 103(a) as being unpatentable over Phyle and Hung. Phyle discloses a patio umbrella apparatus (1), a base portion, a pole

portion (20) coupled to the base portion, a canopy portion hingedly coupled to the pole portion, and a RES for providing power to the umbrella apparatus. It does not disclose a power module carried by the pole portion having an upper and lower portion. Hung discloses a power unit (10) that has a SES (32) in the upper portion and a RES (26) in the lower portion, the unit coupled to the top portion of a pole (80). It would have been obvious to a person skilled in the art to modify the umbrella apparatus of Phyle by providing a power unit that has a SES in the upper portion and a RES in the lower portion, the unit coupled to the top portion of a pole as taught by Hung. Claim 47 would therefore have been obvious to a person skilled in the art.

Alternatively, if the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle and Yang '613 or Wismeth would make Claim 47 obvious in the same manner as Phyle and Hung. Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified Phyle by providing a SES and a RES in a single module that is carried by a pole, as taught by either Yang '163 or Wismeth.

Claim 48—Claim 48 is unpatentable under 35 U.S.C. 103(a) over Phyle, Valdner, and Hung in view of Hale. Valdner discloses all elements of Claim 48 except a plurality of lighting elements carried by the rib member, the lighting elements being recessed within the rib members and the RES and SES each forming a component part disposed in a power unit carried by the pole portion above the canopy. Phyle discloses most of the same, but further includes carrying lighting elements. Phyle does not have a SES. However, Valdner does disclose its venting mechanisms (28) being recessed within the rib members (26). Hale discloses its lighting elements (15) being recessed within its rib members (12). Hung discloses the power unit (10) coupled on top of the pole portion (80), with the SES being in the top portion and the RES being in the bottom portion. It would have been obvious to one skilled in the art to have modified the apparatus of Phyle or Valdner by providing the lighting elements recessed within the canopy rib members, as taught by Hale, and providing the power unit coupled on top of the pole portion, with the SES being in the top portion and the RES being in the bottom portion. Claim 48 is therefore unpatentable as obvious.

Additionally, if the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle, Valdner or Mueller and Yang '613 or Wismeth in view of Lee '224 or Lee '856 would make Claim 48 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified the previously discussed combination of Phyle and Valdner or Mueller by providing lighting elements and wires recessed into rib members, as taught by Lee '224 or Lee '856, and to combine a SES and a RES in a single module that is carried by a pole, as taught by Yang '163 and Wismeth, and thereby construct the claimed invention.

Claim 49, 50 and 54—Claim 49 is unpatentable under 35 U.S.C. § 103(a) over Mueller and Rushing in view of Hale. Mueller discloses all elements of Claim 49 except those dealing with the lighting system. Rushing discloses all of the lighting elements of Claim 49 except each lighting element being recessed within the rib member as well as the electrical conductor being recessed. Hale discloses each lighting element and electrical conductor being recessed within the rib member (see FIG. 1 and 9). It would have been obvious to a person skilled in the art to have modified the apparatus of Mueller to provide the lighting elements as taught by Rushing, recessing the lighting elements and wires as taught by Hale, and thereby construct the claimed invention.

Alternatively, if the Examiner finds the Declaration lacking, the combination of Mueller and Rushing in view of Lee '224 and Lee '856 would make Claims 49, 50 and 54 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to have modified the apparatus of Mueller to provide the lighting elements as taught by Rushing, recessing the lighting elements and wires as taught by Lee '224 and Lee '856, and thereby construct the claimed invention.

Additionally, Claim 50 is dependent on Claim 49, with the additional limitation that the lighting system includes multiple discrete lighting elements along each rib member.

Rushing discloses this feature, so Claim 50 would be obvious based on the same combination that renders Claim 49 unpatentable.

Claim 54 is also dependent on Claim 49, with the additional limitation that the multiple discrete lighting elements are each an LED. Having the lighting elements being an LED would be obvious to anyone skilled in the art. It is common practice to use LEDs in such applications which World Factory states in its Response to the Office Action. Alternatively, with the addition of JP 9-168415, which clearly discloses LEDs, Claim 54 would be obvious to one skilled in the art.

Claim 51—Claim 51 is unpatentable under 35 U.S.C. 103(a) over Phyle and Hung in view of Wu. Phyle discloses every element of Claim 51 except the power unit being releasably coupled to the pole, translucent covers for the lighting elements, and the lighting elements extending beyond the corresponding rib member. Hung discloses a power unit that comprises a SES that is releasably coupled to the pole portion. Wu discloses translucent covers (322) where the lighting elements extend beyond the rib member. It would have been obvious to a person skilled in the art to have modified the device of Phyle by providing a power unit that comprises a SES that is releasably coupled to the pole portion, as taught by Hung, and translucent covers where the lighting elements extend beyond the rib member, as taught by Wu.

Alternatively, if the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle and Yang '613 in view of Wu would make Claim 51 obvious in the same manner. Yang '613 discloses a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to modify the apparatus of Phyle to provide a SES and a RES in a single module that is carried by a pole, as taught by Yang '613, and translucent covers where the lighting elements extend beyond the rib member, as taught by Wu, thereby constructing the claimed invention.

Claim 52, 53, and 55—Claim 52 is unpatentable under 35 U.S.C. 103(a) over Mueller, Rushing, and Hale or Wu. Mueller contains all of the elements of Claim 52 except the canopy carrying a lighting system which includes multiple discrete lighting elements positioned along a rib member, wherein each lighting element is fully recessed within the

corresponding rib member. Rushing discloses the canopy portion carrying the lighting system, with multiple discrete lighting elements positioned along the rib members. Hale and Wu disclose the lighting elements being recessed within the corresponding rib member. However, being fully recessed in the rib member would be obvious to one skilled in the art. It would have been obvious to a person skilled in the art to have modified the apparatus of Mueller by providing that the canopy portion carry the lighting system, with multiple discrete lighting elements positioned along the rib members, as taught by Rushing, with the lighting elements being recessed within the corresponding rib member, as taught by Hale or Wu, thereby constructing the claimed invention.

Alternatively, if the Examiner finds the rule 1.131 Declaration lacking, the combination of Mueller, Rushing, and Lee '224 or Lee '856 would make Claim 52 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to modify the device of Mueller by providing that the canopy portion carry the lighting system, with multiple discrete lighting elements positioned along the rib members, as taught by Rushing, with lighting elements and wires that are recessed into rib members, as taught by Lee '224 and Lee '856, thereby constructing the claimed invention.

Claims 53 and 55 are dependent on Claim 52. Claim 55 has the further limitation that the wires for the lighting elements be fully recessed within the rib members. Hale, Wu, Lee '224, and Lee '856 disclose this limitation as well. Claim 53 adds the limitation that the lighting elements are covered by a translucent cover. Wu discloses this limitation. As such, the combination of Mueller, Rushing, and Lee '224 or Lee '856 would make Claims 53 and 55 obvious.

Claim 60—Claim 60 is unpatentable under 35 U.S.C. § 103(a) over Mueller and Wu. Mueller discloses every element of Claim 60 except for a lighting system that is carried by the canopy portion that is conductively coupled to and powered by the RES, wherein the lighting system includes a plurality of lighting elements, each lighting element being recessed within a corresponding rib member and being covered by a translucent cover carried by the corresponding rib member. Wu discloses these limitations. It would have been

obvious to a person skilled in the art to have modified the device of Mueller by providing a lighting system that is carried by the canopy portion that is conductively coupled to and powered by the RES, wherein the lighting system includes a plurality of lighting elements, each lighting element being recessed within a corresponding rib member and being covered by a translucent cover carried by the corresponding rib member, as taught by Wu, thereby constructing the claimed invention.

If the Examiner finds the Rule 1.131 Declaration lacking, the combination of Mueller and Wu in view of Lee '224 or Lee '856 would make Claim 60 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to have modified the device of Mueller by providing a lighting system that is carried by the canopy portion that is conductively coupled to and powered by the RES, wherein the lighting system includes a plurality of lighting elements, each lighting element being recessed within a corresponding rib member and being covered by a translucent cover carried by the corresponding rib member, as taught by Wu, with the lighting elements and wires recessed into rib members, as taught by Lee '224 and Lee '856, thereby constructing the claimed invention.

Alternatively, Claim 60 is unpatentable based on this combination and Hale. Hale discloses the lighting elements being recessed within a rib portion. As such, one skilled in the art would find Claim 60 obvious after observing this combination.

Claim 61—Claim 61 is unpatentable under 35 U.S.C. § 103(a) over Phyle, Mueller, and Hung. Phyle discloses a patio umbrella apparatus, a base portion, a pole portion coupled to the base portion, a canopy portion hingedly coupled to the pole portion, a RES for providing power to the umbrella apparatus, and the canopy carrying a lighting system, each lighting element carried by a rib member, as well as the wiring system. It does not disclose a power unit carried by the pole portion having an upper and lower portion. Mueller discloses a SES carried by the pole portion that recharges the RES. Hung discloses a power unit (10) that has a SES (32) in the upper portion and a RES (26) in the lower portion, the unit coupled to the top portion of a pole (80). It would have been obvious to a person skilled in the art to have modified the device of Phyle by providing a SES carried by the pole portion that

recharges the RES, as taught by Mueller, and a power unit that has a SES in the upper portion and a RES in the lower portion, the unit coupled to the top portion of a pole, as taught by Hung, thereby constructing the claimed invention.

If the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle, Mueller and Yang '613 or Wismeth would make Claim 61 obvious in the same manner. Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified the device of Phyle by providing a SES carried by the pole portion that recharges the RES, as taught by Mueller, and a power unit that has a SES in the upper portion and a RES in the lower portion, the unit coupled to the pole, as taught by Yang '163 and Wismeth, thereby constructing the claimed invention.

Claim 62—Claim 62 is unpatentable under 35 U.S.C. § 103(a) over Mueller and JP 9-168415. Mueller discloses all of the elements of Claim 62 except all limitations dealing with the lighting subassembly, its location and components. JP 9-168415 discloses a lighting subassembly (7) that is carried by the canopy portion, the lighting subassembly being conductively coupled (9) to the RES, wherein the lighting subassembly includes a plurality of LEDs (7), each LED being recessed relative to a corresponding rib member (3) and each LED being conductively coupled by a conductor (9) recessed relative to the corresponding rib member. It would have been obvious to a person skilled in the art to have modified the device of Mueller by providing a lighting subassembly that is carried by the canopy portion, the lighting subassembly being conductively coupled to the RES, wherein the lighting subassembly includes a plurality of LEDs, each LED being recessed relative to a corresponding rib member, and each LED being conductively coupled by a conductor recessed relative to the corresponding rib member, as taught by JP 9-168415, thereby constructing the claimed device.

Alternatively, this combination in view of Hale would make Claim 62 obvious to a person skilled in the art as well. Hale has a lighting subassembly (15) and conductor (36) that are recessed relative to the corresponding rib member (12). If the Examiner finds the

Declaration lacking, the combination above in view of Lee '224 or Lee '856 would make Claim 62 obvious in the same manner.

Claim 64 and 65—Claim 64 is unpatentable under 35 U.S.C. § 103(a) over Mueller or Valdner and Phyle or Rushing. Mueller and Valdner disclose all of the elements of Claim 64 except the lighting system portions. Valdner and Mueller both have discus-shaped modules that hold the SES. Phyle and Rushing disclose a lighting system being carried by the canopy portion. It would have been obvious to a person skilled in the art to have modified Mueller or Valdner by providing a lighting system being carried by the canopy portion, as taught by Phyle or Rushing, and thereby construct the claimed invention.

Alternatively, Claim 64 is unpatentable over the combination above in further view of Hung. The SES is contained in a discus-shaped module that is carried by a pole portion. As such, these combinations make Claim 64 obvious in the eyes of a person skilled in the art. If the Examiner finds the Declaration lacking, the combination above in light of Yang '613 would make Claim 64 obvious in the same manner.

Claim 65 has been amended to be dependent on Claim 64, with the only additional limitation that the discus-shaped module is releasably coupled to the pole portion. To the extent the term “discus-shaped module” can be understood, Hung’s module is releasably coupled to the pole portion, as is module in Yang '613. As such, this combination makes Claim 65 obvious.

Claim 66—Claim 66 is unpatentable under 35 U.S.C. § 103(a) over Phyle and Hung in view of Hale. Phyle discloses all of the elements of Claim 66 except for elements dealing with the SES and the RES forming a power unit fixed relative to the pole portion, with the SES forming the upper portion and the RES forming the lower portion. Additionally, Phyle does not disclose conductors recessed within the rib members. Hung discloses a power unit fixed relative to the pole portion that has the SES forming the upper portion and the RES forming the lower portion. Hale discloses conductors that are recessed within the rib members. As such, Claim 66 would be seen as obvious by one who was skilled in the art after referring to the above combination. If the Examiner finds the Declaration lacking, the

combination of Phyle and Yang '613 or Wismeth in view of Lee '224 or Lee '856 would make Claims 2, 46, and 74 obvious in the same manner.

Alternatively, Claim 66 is unpatentable in further view of the combination above and Mueller and Wu. Mueller discloses a SES carried by the pole portion of the umbrella, whereas Wu discloses the electrical conductors being recessed within the rib members.

Claims 70 and 71—Claims 70 and 71 are unpatentable under 35 U.S.C. § 103(a) over Mueller or Valdner and Wu. Mueller and Valdner disclose all of the elements of Claim 70 except each rib member having a recessed longitudinal channel and having a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the RES, the lighting system comprising a plurality of lighting elements carried by the rib members, each lighting element being disposed within the channel. Wu discloses a recessed longitudinal channel in each rib member (21 - See FIGS. 5, 7- 8). The lighting elements (32) are recessed within the rib member. As such, a person skilled in the art would view this combination and find Claim 70 obvious. Claim 71 is dependent on Claim 70, with the only additional element being that a transparent cover is disposed over each channel. Wu discloses a translucent cover being placed over the channel. As such, 71 is unpatentable as well for obviousness. If the Examiner finds the Declaration lacking, the combination of Mueller or Valdner in view of Lee '224 or Lee '856 would make Claim 70 obvious in the same manner, with the addition of Wu for Claim 71.

Alternatively, Claims 70 and 71 are unpatentable with Mueller or Valdner and Wu in further view of Hale. Hale has a recessed longitudinal channel (See FIGS. 3, 8, and 9) within which the lighting elements are disposed. Additionally, having a translucent cover over the lighting elements would be obvious in the view of a person skilled in the art.

Claim 72—Claim 72 is unpatentable under 35 U.S.C. § 103(a) over Mueller or Valdner and Rushing or Phyle in view of Wu or Hale. Mueller and Valdner disclose all of the elements of Claim 72 except a lighting system carried by the canopy portion, a plurality of discrete lighting elements carried by each rib member that is recessed within a corresponding rib member, and the electrical conductors also being recessed within the rib members. Rushing and Phyle disclose a lighting system carried by the canopy portion and a plurality of

discrete lighting elements carried by each rib member. Hale and Wu disclose the lighting elements and the electrical conductors being recessed within the rib members as well. As such, Claim 72 would be obvious to one skilled in the art in view of the above combination. If the Examiner finds the Declaration lacking, the combination Mueller or Valdner and Rushing or Phyle in light of Lee '224 or Lee '856 would make Claim 72 obvious in the same manner.

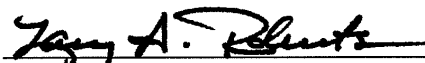
Compliance with 37 C.F.R. §§ 1.52 and 1.943

The foregoing Comments are submitted in 12 point nonscript type, 1-1/2 spaced, and do not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

CONCLUSION

In view of the foregoing, Southern Sales respectfully requests that the rejection of Claims 1, 2, 4, 5, 6, 7, 9, 49, 50, 51, 54, 55, 57, 72, 73 and 74 be maintained, and that Claims 1, 2, 4, 5, 47-56, 59-62, 64-66, 70-72, and 74 be rejected under 35 U.S.C. § 103(a) based upon the various combinations discussed above and any other various combinations that may be developed in further combination with the new prior art references cited herein and the other bases as set forth above.

Respectfully submitted:



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EXHIBIT H

**COPY OF APPELLANT'S COMMENTS OF SEPTEMBER 14, 2009,
REFORMATTED TO REDUCE FONT SIZE AND MARGINS**

**(This exhibit is provided for the sole purpose of showing that the comments
comply with the 50-page limit while still formatted in accordance with Patent
Office Rules.)**

Reexamination No. 95/000,104

**EXHIBIT 2 TO
APPEAL BRIEF OF THIRD-PARTY REQUESTER**

**Applicant's submission of 9/14/2009 reproduced with reduced margins and
reduced font size, images still present**

Total: 30 Pages

**For purposes only of illustrating effects of reduced margins, reduced font size,
and elimination of embedded images on total page length. NOT submitted for
substantive content as it relates to patentability of claims.**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Reexamination of:)
Gregory G. Kuelbs)
Control No. 95/000,104) Examiner: Margaret Rubin
Patent No.: 6,612,713) Art Unit: 3992
Issued: September 2, 2003)
Assignee: WORLD FACTORY, INC.)

REPLACEMENT COMMENTS OF THIRD PARTY REQUESTER TO PATENT OWNER'S RESPONSE IN *INTER PARTES*
REEXAMINATION AND TO OFFICE ACTION

Mail Stop Ex Parte Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madame:

In response to the Inter Partes Reexamination Communication dated August 28, 2009, third party requester, Southern Sales & Marketing Group, Inc. ("Southern Sales"), pursuant to 37 CFR §§ 1.947 and 1.948, hereby submits its replacement comments to the "Response to Office Action in *Inter Partes* Reexamination" by the patent owner, World Factory, Inc. ("World Factory"), filed April 17, 2009.

CLAIMS 1, 47, 48, 51, AND 63 ARE UNPATENTABLE BECAUSE THEY BROADEN THE SCOPE OF THE PATENT

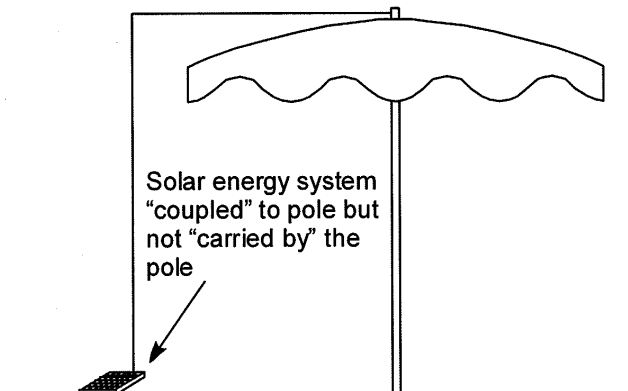
The Federal Circuit standard for determining whether a claim has been broadened is as follows: "A claim of a reissue application is broader in scope than the original claims if it contains within its scope any conceivable apparatus or process which would not have infringed the original patent..." *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d at 1037, 4 USPQ2d at 1453 n.2. The same broadening test is applied to claims in reexamination. *Anderson v. International Eng'g & Mfg.*, 160 F.3d at 1349, 48 USPQ2d at 1634.

For the purposes of the following analysis, the "conceivable apparatus" will be an apparatus that consists of the elements of the amended or new claim. If a device consisting of the elements of the amended or new claim does not infringe the patent claim, the amended or new claim impermissibly broadens the patent.

Amended Claim 1

Patent Claim 1—A device of amended Claim 1 does not infringe patent Claim 1. The device of amended Claim 1 lacks "an electrical charging system for recharging the rechargeable electrical power system, the electrical charging system being adapted to receive power from an AC power outlet." Thus a device according to amended Claim 1 does not infringe patent Claim 1.

Patent Claims 2-5—A device of amended Claim 1 does not infringe patent Claims 2-5. The device of patent Claims 2-5 requires "a solar energy system carried by the pole portion." "Carried" means "to sustain the weight or burden of." Thus patent Claims 2-5 require that the weight of the solar energy system be borne by the pole portion above the canopy portion. In contrast, amended Claim 1 requires only that the solar energy system be



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“carried by a module coupled to the pole.” Thus a hypothetical device according to amended Claim 1 could include a module sitting on the ground beside the umbrella, coupled to the pole portion above the canopy portion but without the weight of the module being borne by the pole portion (see diagram). Thus a hypothetical device could infringe amended Claim 1 without infringing patent Claims 2–5.

Patent Claims 6–8—A device according to amended Claim 1 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6–8. Thus a device according to amended Claim 1 does not infringe patent Claims 6–8.

Patent Claim 9—A device according to amended Claim 1 lacks a cooling system as required by patent Claim 9. Thus a device according to amended Claim 1 does not infringe patent Claim 9.

Patent Claims 10–14—A device according to amended Claim 1 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10–14. Thus a device according to amended Claim 1 does not infringe patent Claims 10–14.

CONCLUSION: Because a hypothetical device consisting of the limitations of amended Claim 1 would not infringe any of the claims of the original patent, Claim 1 as amended impermissibly broadens the scope of the patent and is not allowable.

New Claim 47

Patent Claim 1—A device according to new Claim 47 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 47 does not infringe patent Claim 1.

Patent Claims 2–5—A device according to new Claim 47 lacks a lighting system carried by the canopy portion, as required by patent Claims 2–5. Thus a device according to new Claim 47 does not infringe patent Claims 2–5.

Patent Claims 6–8—A device according to new Claim 47 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6–8. Thus a device according to new Claim 47 does not infringe patent Claims 6–8.

Patent Claim 9—A device according to new Claim 47 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 47 does not infringe patent Claim 9.

Patent Claims 10–14—A device according to new Claim 47 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10–14. Thus a device according to new Claim 47 does not infringe patent Claims 10–14.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 47 would not infringe any of the claims of the original patent, Claim 47 impermissibly broadens the scope of the patent and is not allowable.

New Claim 48

Patent Claim 1—A device according to new Claim 48 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 48 does not infringe patent Claim 1.

Patent Claims 2–5—A device according to new Claim 48 lacks a lighting system “being conductively coupled to and powered by the rechargeable electrical power system,” as required by patent Claims 2–5. Thus a device according to new Claim 48 does not infringe patent Claims 2–5.

Patent Claims 6–8—A device according to new Claim 48 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6–8. Thus a device according to new Claim 48 does not infringe patent Claims 6–8.

Patent Claim 9—A device according to new Claim 48 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 48 does not infringe patent Claim 9.

Patent Claims 10–14—A device according to new Claim 48 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10–14. Thus a device according to new Claim 48 does not infringe patent Claims 10–14.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 48 would not infringe any of the claims of the original patent, Claim 48 impermissibly broadens the scope of the patent and is not allowable.

New Claim 51

Patent Claim 1—A device according to new Claim 51 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 51 does not infringe patent Claim 1.

Patent Claims 2–5—Patent Claims 2–5 recite “a solar energy system carried by the pole portion above the canopy portion.” For the reasons set forth above with respect to amended Claim 1, a hypothetical device could infringe new Claim 51 without infringing patent Claims 2–5.

Patent Claims 6-8—A device according to new Claim 51 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6-8. Thus a device according to new Claim 51 does not infringe patent Claims 6-8.

Patent Claim 9—A device according to new Claim 51 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 51 does not infringe patent Claim 9.

Patent Claims 10-14—A device according to new Claim 51 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10-14. Thus a device according to new Claim 51 does not infringe patent Claim 9.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 51 would not infringe any of the claims of the original patent, Claim 51 impermissibly broadens the scope of the patent and is not allowable.

New Claim 63

Patent Claim 1—A device according to new Claim 63 lacks an electrical charging system being adapted to receive power from an AC power outlet, as required by patent Claim 1. Thus a device according to new Claim 63 does not infringe patent Claim 1.

Patent Claims 2-5—Patent Claims 2-5 recite “a solar energy system carried by the pole portion above the canopy portion.” “Carried” means “to sustain the weight or burden of.” Thus patent Claims 2-5 require that the weight of the solar energy system be borne by the pole portion above the canopy portion. In contrast, new Claim 63 requires only that the solar energy system be “coupled” to the pole. Thus a hypothetical device according to new Claim 63 could include a solar energy system sitting on the ground beside the umbrella, coupled to the pole portion above the canopy portion but without the weight of the solar energy system being borne by the pole portion. Thus a hypothetical device could infringe new Claim 63 without infringing patent Claims 2-5.

Patent Claims 6-8—A device according to new Claim 63 lacks an electromechanical opening and closing system for opening and closing the canopy portion, as required by patent Claims 6-8. Thus a device according to new Claim 63 does not infringe patent Claims 6-8.

Patent Claim 9—A device according to new Claim 63 lacks a cooling system as required by patent Claim 9. Thus a device according to new Claim 63 does not infringe patent Claim 9.

Patent Claims 10-14—A device according to new Claim 63 lacks a combination of two or more modules (lighting, cooling, canopy lift mechanism), as required by patent Claims 10-14. Thus a device according to new Claim 63 does not infringe patent Claims 10-14.

CONCLUSION: Because a hypothetical device consisting of the limitations of new Claim 63 would not infringe any of the claims of the original patent, Claim 63 impermissibly broadens the scope of the patent and is not allowable.

CLAIM 52 IS UNPATENTABLE FOR DOUBLE PATENTING

Claim 52 as added by patentee in the present reexamination is unpatentable over Claim 49 as added by patentee in the present reexamination under the judicially-created doctrine of double patenting.

49. (New) An umbrella apparatus, comprising:

a base support portion;

a pole portion coupled to the base support portion;

a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;

a rechargeable electrical power system for providing electrical power to the umbrella apparatus;

a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and

a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;

wherein the lighting system includes multiple discrete lighting elements positioned along a rib member, each lighting element being recessed within the rib member and being conductively coupled to the rechargeable electrical power system by an electrical conductor, the electrical conductor also being recessed within the rib member.

52. (New) An umbrella apparatus comprising:

a base support portion;

a pole portion coupled to the base support portion;
a canopy portion having a plurality of rib members, the canopy portion being hingedly coupled to the pole portion;
a rechargeable electrical power system for providing electrical power to the umbrella apparatus;
a solar energy system carried by the pole portion above the canopy portion, the solar energy system being adapted to collect solar energy and convert the solar energy into electrical energy, the solar energy system being conductively coupled to the rechargeable electrical power system, such that the solar energy collected and converted into electrical energy recharges the rechargeable electrical power system; and
a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the rechargeable electrical power system;
wherein the lighting system includes multiple discrete lighting elements positioned along a rib member; and
wherein each lighting element is fully recessed within the corresponding rib member.

The preamble and first six body paragraphs of each claim are identical. The only difference between the two claims is that Claim 49 recites that each lighting element is recessed within the corresponding rib member, whereas Claim 52 recites that each lighting element is fully recessed within the corresponding rib member.

The only way in which the terms “fully recessed” and “recessed” can differ is if Claim 49 covers a situation in which a lighting element is only partially recessed. However, there is no support in the specification of the '713 patent of a lighting element that is only partially recessed. All of the disclosed embodiments describe only lighting elements that are fully recessed. The term “recessed” in Claim 49 can only be interpreted to cover a lighting element that is “fully” recessed.

Because the '713 patent lacks support for any recess other than “fully” recessed, the terms “recessed” and “fully recessed” must be construed identically. Claim 49 is identical to Claim 52 and therefore constitutes double-patenting.

THE PROVISIONAL PATENT APPLICATIONS OF FEBRUARY 7, 2001, FAIL TO SUPPORT CLAIMS 1, 2, 4-7, 45-48, 51, 56, 61, 64-66, AND 74 OF THE PATENT

Patentee is not entitled to the filing dates of the provisional patent application of February 7, 2001 with respect to Claims 1, 2, 4-7, 45-48, 51, 56, 61, 64-66, and 74, because the 2/7/01 provisional application fails to disclose elements of these claims.

The 2/7/01 provisional does not disclose a “module” or “power unit” as required by Claims 1, 2, 4-7, 45-48, 51, 56, 61, 64-66, and 74. Rather, the solar cell is carried directly atop the pole. Similarly, the 2/7/01 provisional does not disclose a “rechargeable electrical power system” located above the canopy, as required by Claims 1, 2, 4-7, 45-48, 51, 56, 61, 64-66, and 74. Accordingly, these claims are not entitled to the February 7, 2001, filing date of this provisional.

THE DECLARATIONS UNDER RULE 131 ARE INSUFFICIENT TO SWEAR BEHIND THE REFERENCES

It is the patentee's responsibility to establish conception and, where necessary, diligence in reduction to practice from a time prior to the effective date of the cited references until the date of reduction to practice. Kuelbs' second Declaration, even when taken in combination with Kuelbs' first Declaration and the Quillen Declaration, fail to establish diligence. Large blocks of unexplained inactivity remain, and the patentee has therefore failed to establish diligence.

Declarant's statements in Paragraph 2 of the Declaration are conclusory, self-serving, and uncorroborated.

Declarant's statements in Paragraph 3 of the Declaration are uncorroborated.

Declarant's statements in Paragraph 4 of the Declaration are uncorroborated.

The copy of the passport pages (Exhibit A) referenced in Paragraph 5 of the Declaration establish, at best, that Declarant visited China in July and October 1999. The passport pages do not contain any information about a solar-powered umbrella. Declarant's statements about the purpose of the trip are uncorroborated.

The notes (Exhibit B) referenced in Paragraph 6 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 6 of the Declaration are uncorroborated.

The notes (Exhibit C) referenced in Paragraph 7 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 7 of the Declaration are uncorroborated.

The notes (Exhibit D) referenced in Paragraph 8 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 8 of the Declaration are uncorroborated.

Paragraph 9 misstates the law. Exhibits B, C, and D are only drawings and, while possibly relevant to the issue of conception, do not constitute a reduction to practice, as they do not constitute making and using the invention and proving it useful for its intended purpose. Declarant's statements in Paragraph 9 of the Declaration are uncorroborated.

The notes (Exhibit E) referenced in Paragraph 10 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 10 of the Declaration are uncorroborated.

The notes (Exhibit F) referenced in Paragraph 11 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 11 of the Declaration are uncorroborated.

The notes (Exhibit G) referenced in Paragraph 12 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 12 of the Declaration are uncorroborated.

The notes (Exhibit H) referenced in Paragraph 13 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. The notes are undated. While they bear the notation "Proposed Discussion Notes China Trip - July-Aug 99," the notes could have been prepared contemporaneously with the trip or months earlier. Declarant's statements in Paragraph 13 of the Declaration are uncorroborated.

The notes (Exhibit I) referenced in Paragraph 14 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. Declarant's statements in Paragraph 14 of the Declaration are uncorroborated.

The proposed itinerary (Exhibit J) referenced in Paragraph 15 of the Declaration is uncorroborated. Its existence prior to the critical date has not been attested to by any independent party. A proposed itinerary is not proof that a trip was ever made. The proposed itinerary contains no information about the alleged invention or any efforts to reduce it to practice. Declarant's statements in Paragraph 15 of the Declaration are uncorroborated.

The receipt for currency exchange (Exhibit K) referenced in Paragraph 16 of the Declaration establishes, at best, that Declarant was in the Hong Kong airport on October 20, 1999. Declarant's presence in the Hong Kong airport is no indicator of the purpose of Declarant's trip and most certainly does not establish any element of the claimed invention. Declarant's statements in Paragraph 16 of the Declaration are uncorroborated.

The e-mail (Exhibit L) referenced in Paragraph 17 of the Declaration establishes, at best, that Declarant received an e-mail from an Eric Li on October 11, 1999. The e-mail does not establish any element of the claimed invention and does not even reference a stated purpose for a proposed visit. Declarant's statements in Paragraph 17 of the Declaration beyond his assertion that he received an e-mail are uncorroborated.

The e-mail (Exhibit M) referenced in Paragraph 18 of the Declaration establishes, at best, that Declarant received an e-mail from an Eric Li on October 14, 1999. The e-mail does not establish any element of the claimed invention and does not even reference a stated purpose for a proposed visit. Declarant's statements in Paragraph 18 of the Declaration beyond his assertion that he received an e-mail are uncorroborated.

The e-mail (Exhibit N) referenced in Paragraph 19 of the Declaration establishes, at best, that Declarant received an e-mail from an Eric Li on October 16, 1999. The e-mail does not establish any element of the claimed invention and does not even reference a stated purpose for a proposed visit. Declarant's statements in Paragraph 19 of the Declaration beyond his assertion that he received an e-mail are uncorroborated.

The drawings (Exhibits O, P, and Q) referenced in Paragraph 20 of the Declaration are uncorroborated. Their existence prior to the critical date has not been attested to by any independent party. The drawings are undated. Declarant's statements in Paragraph 20 of the Declaration are uncorroborated.

The screen shot (Exhibit R) referenced in Paragraph 22 of the Declaration at best establishes that there are files on a computer bearing modified dates as shown. There is no corroboration that the screen shot has not been altered or modified. There is no corroboration that the files identified in Paragraph 22 of the Declaration relate in any way to the claimed invention.

Patentee's statements in Paragraphs 25 and 26 of the Declaration that he worked diligently on the invention from a date prior to 30 April, 1999, through the filing date of U.S. Provisional Application No. 60/267,018, *i.e.*, 7 February 2001, are uncorroborated and conclusory.

Patentee's statements in Paragraphs 27, 28, and 30 of the Declaration that he worked diligently on the invention from a date prior to 30 April, 1999, through the filing date of U.S. Provisional Application No. 60/335,933, *i.e.*, 2 November 2001, are uncorroborated and conclusory.

Exhibit V was prepared on 26 April 2006, seven years after the events described therein. No contemporaneous notes are produced. No reason for the statement is given, leading to the inescapable conclusion that the document was produced solely for the purpose of this reexamination and, most likely, that the patentee instructed the author what to say. No specific dates are given except for July 1999, and it is unclear from the document when

work on the project was discontinued. Thus the document fails to explain any period of inactivity during the critical period. Declarant's statements in Paragraph 20 of the Declaration are uncorroborated.

EVEN IF ALL OF DECLARANT'S STATEMENTS ARE ARGUENDO PRESUMED ACCURATE, THEY FAIL TO ESTABLISH DILIGENCE

An inventor's date of invention is his date of conception, IF he is thereafter diligent in reducing the invention to practice. The Patentee in this case seems to be alleging acts directed toward both an actual reduction to practice (making and using the invention) and a constructive reduction to practice (the filing of a patent application). To establish a valid date of invention, the Patentee must establish diligence in reducing the invention to practice from a time just prior to the effective date of a prior art reference until the filing date of the patent application. However, even if all of the facts alleged in the Patentee's § 1.131 Declaration are assumed to be correct for the sake of argument, there are large unexplained gaps of inactivity in his alleged efforts to reduce the invention to practice that preclude a date of invention any earlier than the filing date of the application.

A time line of the Patentee's activities shows the following:¹

Date	Activity	Delay Since Previous Activity (days)
4/30/1999	Earliest possible date of conception (4, 6-8)	—
6/30/1999	Preparation of sketches of an umbrella (10)	61
7/30/1999	Trip to China (5)	30
7/31/1999	Notes in preparation for trip to China (11, 12, 13)	1
9/30/1999	Notes and sketches of umbrella (14)	61
10/11/1999	E-mail from Eric Li re Real Faith factory in China (17)	11
10/14/1999	E-mail from Eric Li re Jiangsu Metal & Minerals Import and Export (18)	3
10/16/1999	Memo from Eric Li re Mr. Bakula (19)	2
10/20/1999	Trip to China (5, 16)	4
10/23/2000	Quillen works on drawings (20, 22)	369
11/9/2000	Correspondence to patent attorney re preparation of patent application (21)	17
2/7/2001	Provisional patent application filed (23)	90

Patentee has unexplained periods of inactivity of 61, 30, 61, 369, and 90 days. Thus even if the Patentee's declaration did not suffer fatal flaws of lack of corroboration, any one of these unexplained prolonged periods of inactivity preclude a finding of diligence in reduction to practice.

For the reasons set forth above, the declarations submitted by patentee are insufficient to swear behind the references.

CLAIMS 1, 2, 4-7, 9, 47-57, 59-62, 64-66, AND 70-74 ARE UNPATENTABLE OVER THE PRIOR ART

Additional Prior Art Submitted Under 37 CFR § 1.948

For the Examiner's benefit, new prior art applicable to World Factory's amendments has been found. Pursuant to 37 CFR § 1.948, Southern Sales files herewith the following additional prior art references that address features of the amended Claims 1-5, 47-56, 59-62, 64-66, 70-72, and 74 not present in the original claims:

Patent No./App. No.	Inventor	Effective Date	Exhibit No.
5,055,984	Hung et al.	Aug. 11, 1989	13
5,758,948	Hale	July 10, 1996	14
6,406,163	T. Yang	Nov. 27, 2000	15
6,729,742	Wismeth	May 10, 2002	16

¹ Where Patentee's Declaration does not specify a day but specifies only a month and year (e.g., "6-99" in ¶ 10, "7-99" in ¶ 11), it is assumed that the event occurred on the last day of the month.

These submissions are made in response to the new amendments submitted by World Factory. Southern Sales believes that an overview of the newly submitted prior art would benefit the reexamination process.

World Factory has submitted a Second Declaration Under 37 C.F.R. § 1.131 in which the inventor swears behind the effective dates of the Cathel, Lee '856, Mai, Pan, Lee '224, Yang, Molnar, Vivian, Farr, and Lai references. The reference date alleged in the Second Declaration is April of 1999. The effective date of the newly submitted Hung and Hale prior art references predates April 1999. Thus even if the Examiner finds the Second Declaration effective in establishing a date of invention of April 1999, the new Hung and Hale prior art submissions would still constitute prior art.

U.S. Patent No. 5,055,984 to Hung et al. (hereafter "Hung") discloses a solar rechargeable lamp for outdoor use. The device contains a solar energy system (hereafter "SES") (32) that collects and converts solar energy into electrical energy, which the SES (32) stores in a rechargeable electrical system (hereafter "RES") (26, a battery) to which it is connected (Col. 3, 26-39). The two power systems are found in one housing (FIG. 5), the SES (32) found above the RES (26), which is releasably coupled to a pole (80) (See FIG. 2). The RES powers a lighting system (18)(FIG. 5).

U.S. Patent No. 5,758,948 to Hale (hereafter "Hale") discloses a seasonal light display device. The device contains an apparatus comprising a pole portion (3) and has a plurality of ribs (12) hingedly coupled to the pole portion, and a lighting system, wherein the lighting system includes multiple discrete lighting elements (15) positioned along a rib member (12), each lighting element being recessed (12, 22 and 24) within the rib member and being conductively coupled to an electrical power system by an electrical conductor (36), the electrical conductor also being recessed within the rib member(12, 22 and 24).

If World Factory is successful in establishing a date of invention of April 1999, the newly submitted Yang and Wismeth prior art references may not constitute prior art. However, in the likely event that the Examiner finds the Second Declaration lacking, the following new prior art submissions would be highly useful in the reexamination.

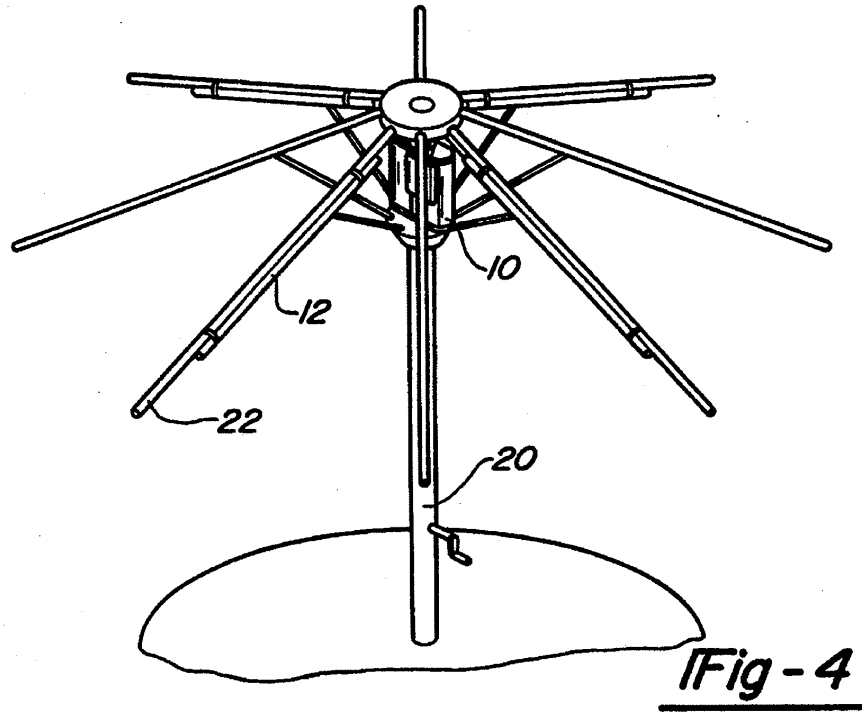
U.S. Patent No. 6,406,143 to Yang (hereafter "Yang '163") (Exhibit 13) discloses a solar cell lighting fixture. The device contains a SES that collects and converts solar energy into electrical energy, which it stores in the RES to which the SES is connected (Col. 2, 62 – Col. 3, 18, FIG. 2). These two power systems are found in one module which is releasably coupled to a pole portion of the device (Col. 5, 11-18, FIG. 15). The SES is found in the upper portion of the module while the RES is found in the lower portion of the module. The RES powers a lighting system carried by the device (Col. 3, 4-10, FIG. 2).

U.S. Patent No. 6,729,742 to Wismeth et al. (hereafter "Wismeth") discloses a solar lamp for outdoor use. The device contains a solar energy system that collects and converts solar energy into electrical energy, which the SES stores in a RES to which it is connected (Col. 1, 53-59, Col. 2, 47-64). The two power systems are found in the cubic housing, the SES found above the RES (Col. 2, 38-58). The housing is coupled to a pole (Col. 2, 38-42, FIG. 1). The RES powers a lighting system (Col. 1, 53-57, Col. 2, 58-59).

Summary of Previously Presented Prior Art in View of Patentee's Amendments

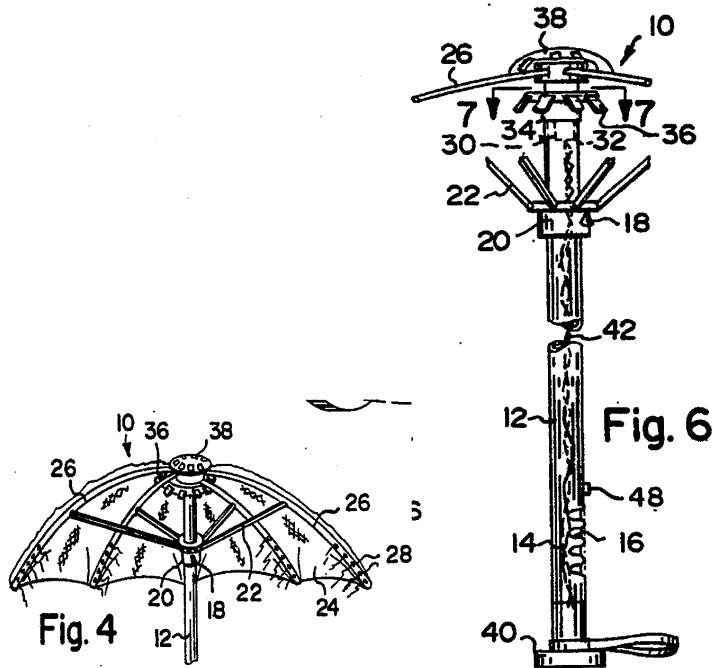
While the following patents have previously been presented, a recap of their relevance is appropriate in view of the amendments made and new claims submitted by the patentee.

Phyle - U.S. Patent No. 5,584,564



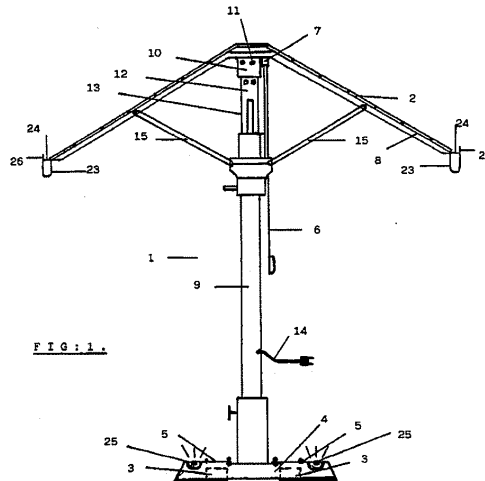
Phyle discloses an apparatus that has an illumination device 12 carried by the canopy ribs. Battery (10) is rechargeable and is carried by the pole at an upper portion 20.

Valdner - US Patent No. 5,349,975



Valdner includes a solar power electrical system 38 found above the canopy 24, and carried by the rod (pole) 12. The solar power electrical system 38 has a discus-shape. The apparatus has a rechargeable battery pack that can be connected at the bottom 40 of the rod 12.

WO 93/00840



US2000 11990440.1

YOT-1003-1623

Includes a solar collector 2 carried by the canopy that charges batteries 3 in the base 4. The batteries 3 can power a light 12.

Benton - U.S. Patent No. 6,017,188

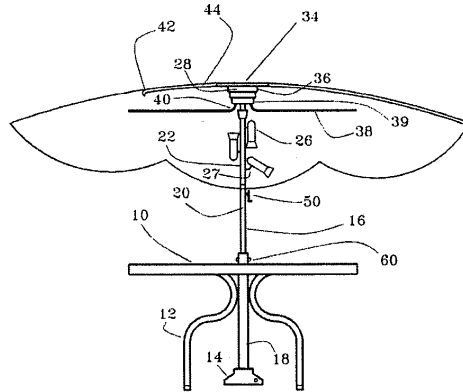
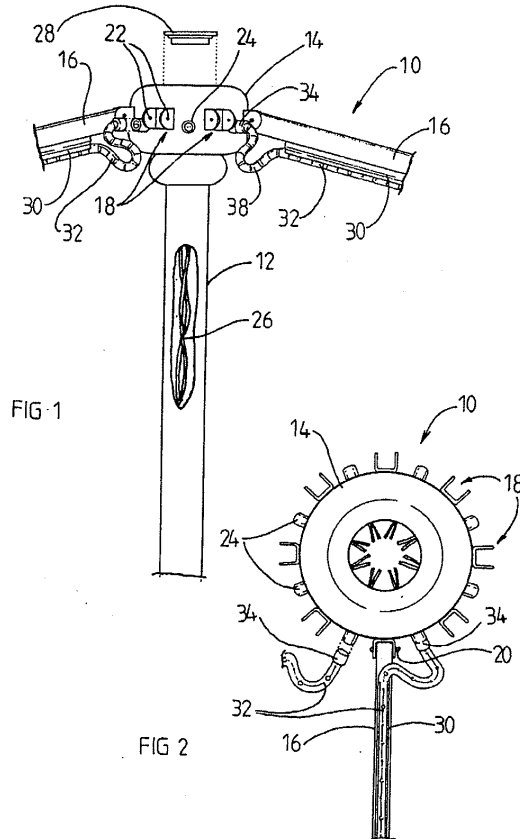


FIG. 1

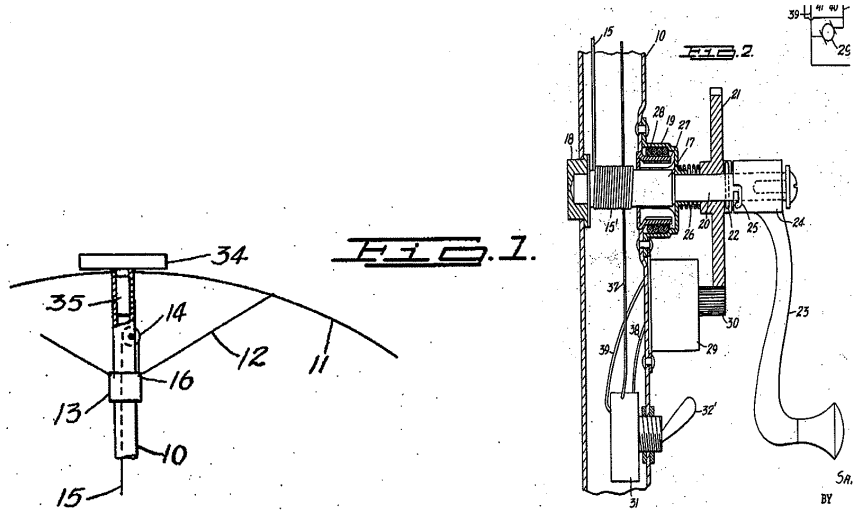
Benton describes an umbrella supported by an upper portion 22 of a pole. The pole 22 supports lights 26. A solar panel 34 positioned on top of the canopy of the umbrella can power a motor 36 of a fan 28. The motor and lights may be powered through an AC connection 27.

Walker – US Patent No. 5,911,493



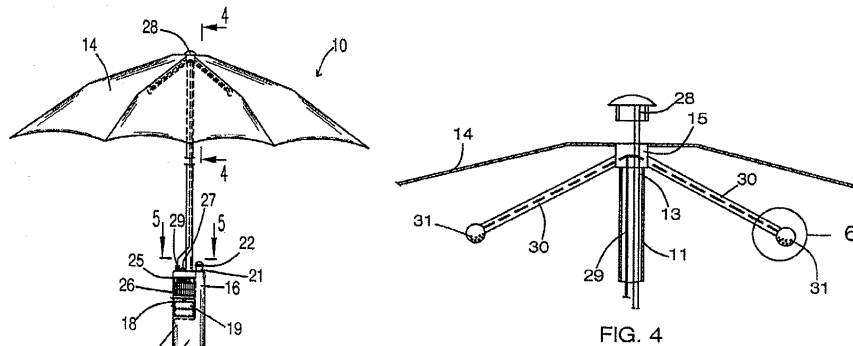
Walker discloses an umbrella 10 that includes hollow tubes 30 that carry light ropes 32 carried by the ribs 16 of the umbrella 10.

Small – US Patent No. 6,126,293



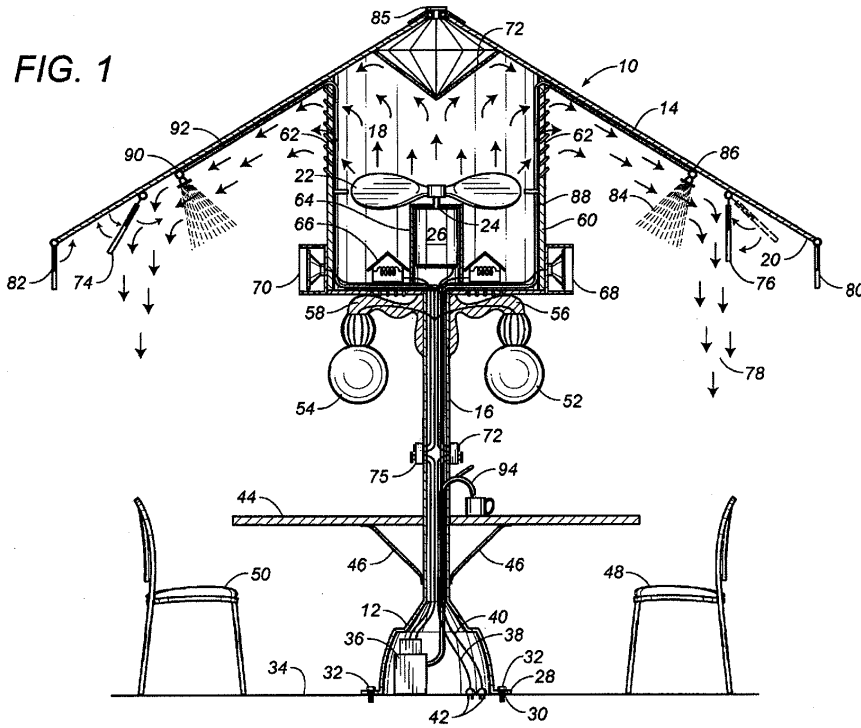
Small discloses an umbrella supported by a post 10. The umbrella employs a motor 29 to open and close the canopy. The motor may be powered by a solar battery 34 and a storage battery 35. The solar battery 34 charges the storage battery 35. The storage battery 35 may be found in other positions along the post 10. However, as shown in FIG. 1, the storage battery 35 is located below the solar battery 34 and is carried by the upper portion of the post 10.

Farr – US Patent App. Pub. No. 2002/0078985



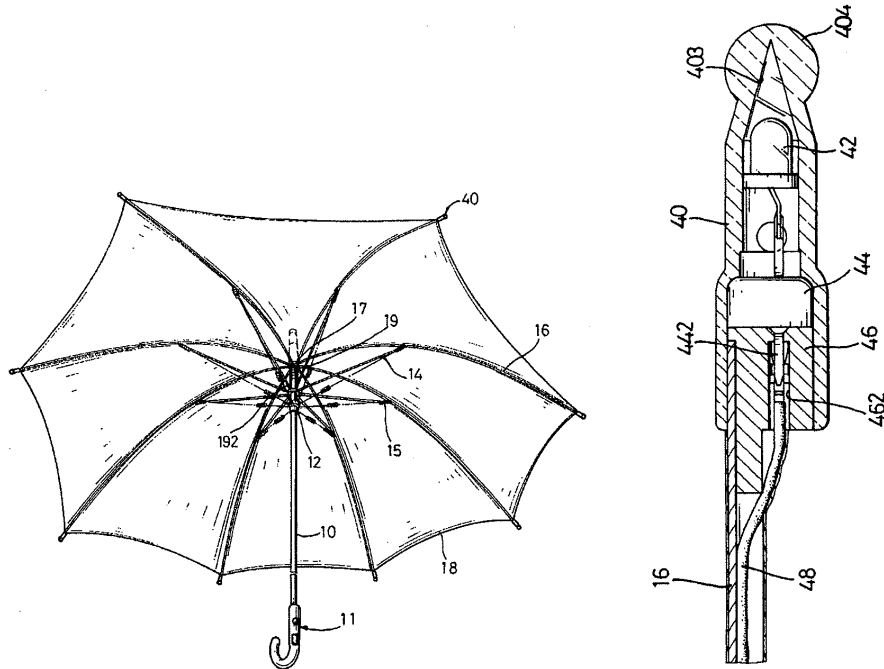
Farr discloses an umbrella 10 with a cooling device. A tube supports the canopy 14 of the umbrella. The cooling device 16 is carried by the tube and may be detached from the tube. A battery 19 is contained within the cooling device 16, and is connected to a solar collector 28. The solar collector 28 is detachably connected to the tube, as shown in FIG. 4.

Molnar - US Patent No. 6,298,866



Molnar discloses an umbrella 10 that includes a fan 18 and lights 54. A battery 36 that powers the fan and lights may be housed in the base 12 of the umbrella 10.

Yang - US Patent No. 6,341,873



Yang discloses an umbrella that has illumination devices mounted above the canopy 18 and in the tips 40 of each rib 16. The illumination device 40 includes a transparent tip 40 and an LED 42, so arguably, the LED 42 is within the rib 16.

Lee - US Patent No. 6,666,224 and 6,499,856

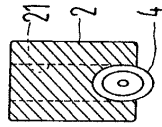


FIG. 4

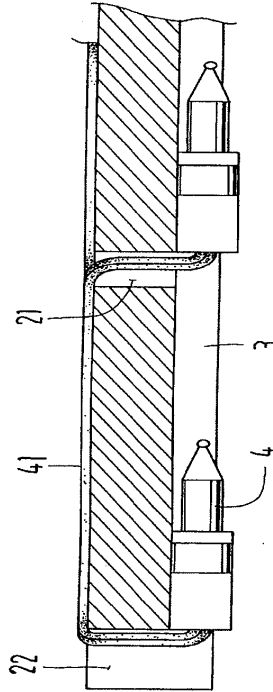
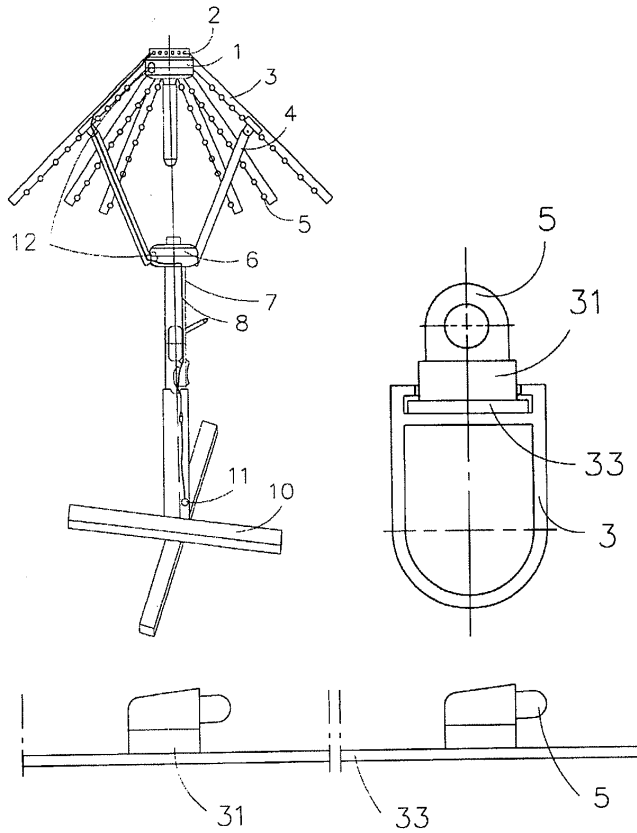


FIG. 3

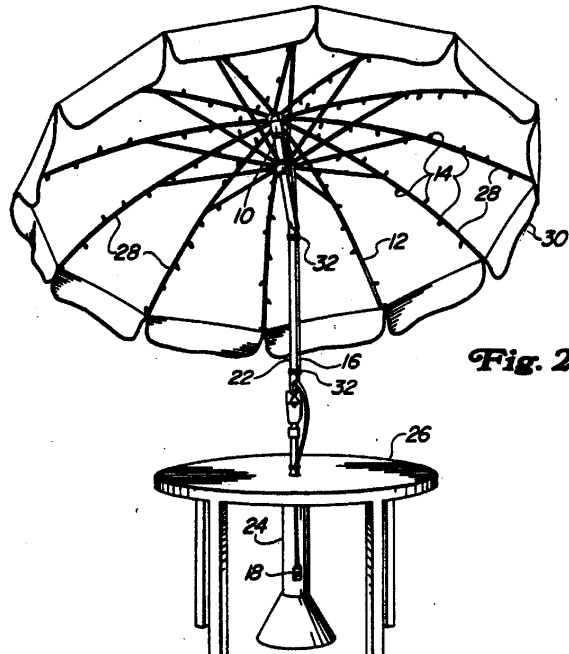
Lee discloses an umbrella that has a plurality of ribs 2 with trenches 3 throughout the bottoms of the ribs 2. Lamps 4 are partially retained within the trenches 3 of the ribs 2.

Pan et al. - US Patent No. 6,439,249



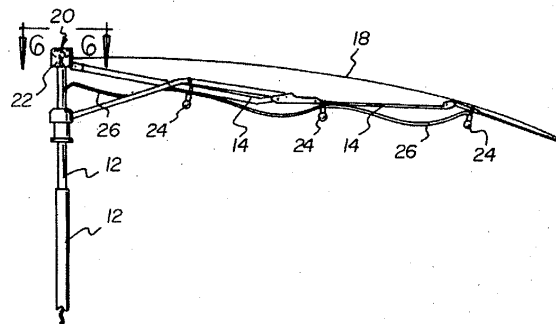
Pan et al discloses an umbrella that includes a plurality of hollow ribs 3. Along each rib is a trench (32, not shown in these figures) that retain light sources 5. The light sources may be connected with an illuminating connector 31.

Rushing - US Patent No. 5,053,931



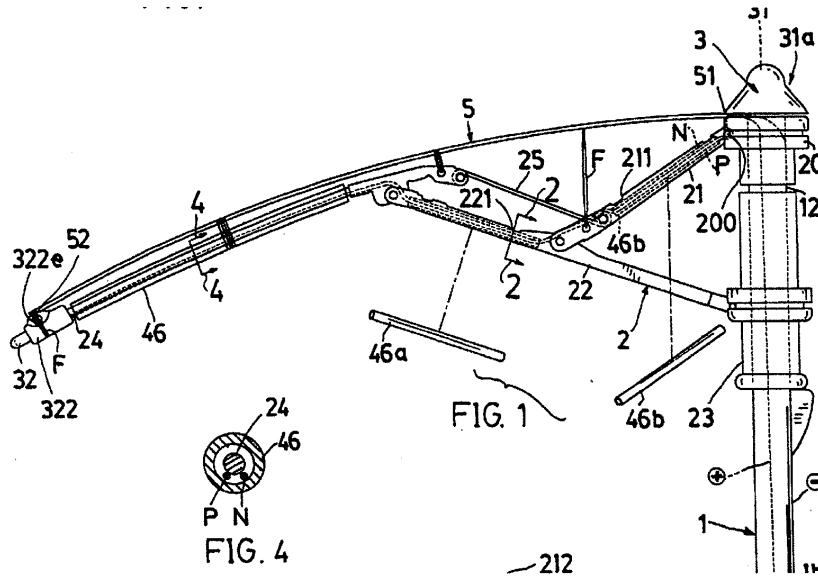
Rushing discloses an umbrella having a central support pole 22 that supports a plurality of ribs 28 that support a canopy 30. Light strings 12 with miniature lights 14 are attached to the ribs 28.

Morgan - US Patent No. 5,611,614



Morgan discloses an umbrella 20 with a plurality of ribs 14 that support a canopy 18 and electrical bulbs 24 and electrical connectors 26.

Wu - US Patent No. 6,126,293



Wu discloses an umbrella that has rib members 24 that have tip illuminators 32. The tip illuminators 23 may be LEDs.

REJECTIONS UNDER 35 U.S.C. §§ 102 AND/OR 103

The Rejection of Claim 1 under Combination I

The Office Action rejected Claim 1 as being obvious and unpatentable over WO 93/00840 and Valdner which was designated Combination I. In response, World Factory amended Claim 1 by adding these limitations: 1) a canopy portion has a plurality of rib members; 2) the SES is carried by a module coupled to the pole portion above the canopy portion; 3) the module is releasably coupled to the pole portion; and 4) the lighting system is carried by the canopy portion and coupled to and powered by the RES. Additionally, World Factory deleted the requirement that the RES be adapted to receive power from an AC power outlet.

The introduction of these limitations fails to overcome the § 103(a) rejections over Combination I. WO 93/00840 and Valdner both disclose a canopy having a plurality of ribs. WO 93/00840 discloses an umbrella having a base 4, a pole 9, a canopy carried by the pole, and a solar collector 2 carried by the canopy that charges batteries 3 in the base 4. The batteries 3 can power a light 12. WO 93/00840 fails to show a lighting system carried by the canopy portion. In Valdner, the ribs carry the ventilation shafts. It would be obvious to a person of ordinary skill in the art at the time of the invention of the '713 patent to have the lighting system of WO 93/00840 carried by ribs such as those of Valdner, which carries the ventilation shafts along its ribs. Additionally, Valdner's solar cell is connected to the rechargeable system, so that the absence of the electrical system being able to receive power from an AC outlet would be a trivial change on their devices. Logically, the solar power system must be located at a position in which it may receive solar power. If the solar power system is located on the umbrella device, the solar panel may only be located on top of the umbrella, which can be either on the canopy itself or the pole portion of an umbrella, which would be obvious to a person skilled in the art. Finally, the solar portion being releasably coupled to the pole portion is not a novel concept. A component being releasably coupled to any device is ubiquitous.

The Rejection of Claim 1 under Combination I in view of Hung

Claim 1 is further unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination I in view of Hung. The teachings of Combination I are discussed in the preceding paragraph. Hung discloses a SES that is releasably coupled to a pole portion. Hung discloses a solar panel (32) on the upper portion of the housing for the light (10) which is removable from the pole portion (80). Thus, to the extent that Combination I

does not expressly disclose a solar panel removably mounted to the upper portion of a pole, Hung provides this missing teaching. Claim 1 is therefore unpatentable under 35 U.S.C. § 103(a) as being obvious over Combination I in view of Hung.

The Rejection of Claims 2, 5 and 74 under Combination II

The Office Action rejected Claims 2 and 5 as being obvious and unpatentable over WO 93/00840 and Phyle, which was deemed Combination II. In response, World Factory amended Claim 2 by adding these limitations: 1) a power module is carried by the pole portion above the canopy portion; 2) the power module has an upper portion and a lower portion; 3) the SES is carried by the upper portion of the module; and 4) the RES is disposed in the lower portion of the power module. No amendments were made to Claim 5, which is dependent on claim 2. The only additional limitation of Claim 5 is the canopy has a plurality of rib members and that each rib member carries a fluorescent light.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections based on WO 93/00840 and Phyle. In addition, Claim 74 claims the same elements and has identical amendments, so it too should be found rejected based upon Combination II as well. The changes to the claims mean that the SES and the RES naturally reside in one singular component, with the SES found over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must have access to light. Accordingly, the SES must be above the canopy portion, either on the canopy itself or on the pole portion supporting the canopy. Additionally, placing the RES below the SES would be obvious as well; placing the RES above the SES would block sunlight from reaching the SES, preventing the SES from operating. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems. For Claim 5, both references disclose a canopy with multiple rib members. One skilled in the art would find it obvious to have the lighting system carried by the rib members, especially the use of fluorescent lights. Phyle itself carries fluorescent lights.

The Rejection of Claims 2, 5 and 74 under Combination II in view of Hung

Alternately, Claims 2, 5 and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination II and further view of Hung. Combination II discloses all the elements of Claim 2 and 74 except for the amendments above, but Hung discloses a SES and a RES in a power module that is carried by a pole, the SES found in the upper portion and the RES found in the lower portion of the module. Accordingly, a person skilled in the art would find it obvious to modify Combination II by adding the power module carried by a pole, as taught by Hung. Additionally, claims 2 and 74 are identical. As such, one or the other should be cancelled even if the claims are allowed.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination II in view of Hung.

The Rejection of Claims 2, 5 and 74 under Combination II in view of Yang '163 or Wismeth

If the Examiner finds World Factory's § 131 Declaration lacking, Claims 2, 5, and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination II in further view of Yang '163 or Wismeth. Both Yang '163 and Wismeth disclose a SES and a RES in a power module that is carried by a pole, the SES found in the upper portion and the RES found in the lower portion of the module. Because an SES, if mounted to the umbrella, must be mounted above the canopy if it is to be exposed to sunlight, it would have been obvious to one of ordinary skill in the art to have mounted a SES and a RES in a power module carried by the pole, as taught by Yang '163 or Wismeth, and to affix it to a portion of the pole above the canopy so it will be exposed to sunlight. Claims 2, 5, and 74 are therefore obvious, and therefore unpatentable, over Combination II in view of Yang '163 or Wismeth.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination II in further view of Yang '163 or Wismeth.

The Rejection of Claims 2, 5 and 74 under Combination III

The Office Action rejected Claims 2, 5, and 74 as being unpatentable over Phyle and Valdner which was deemed Combination III. In response, World Factory amended Claims 2 and 74 by adding these limitations: 1) a power module carried by the pole portion above the canopy portion; 2) the power module has an upper portion and a lower portion; 3) the SES is carried by the upper portion of the module; and 4) the RES is disposed in the lower portion of the power module. No amendments were made to Claim 5, which is dependent on claim 2. The only additional limitation of Claim 5 is

that the canopy has a plurality of rib members and that each rib member carries a fluorescent light. For Claim 5, both references disclose a canopy with multiple rib members. Phyle discloses fluorescent lights (12) attached to its rib members.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Phyle and Valdner. The changes to the claims mean that the SES and the RES reside in one singular component, with the SES found over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must be exposed to light. As such, the SES must be above the canopy portion, either on the canopy itself or on the pole portion supporting the canopy. Additionally, having the RES below the SES would be obvious as well, as having the RES above the SES would prevent the SES from receiving sunlight and thereby prevent its operation. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems.

The Rejection of Claims 2, 5 and 74 under Combination III in view of Hung

Alternately, Claim 2, 5, and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination III in view of Hung. Combination III discloses all the elements of former Claims 2 and 74. As to the features added by amendment, Hung discloses a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to modify Combination III by placing the SES and RES in a single module carried by a pole, as taught by Hung. When combined with Combination III, accordingly, a person skilled in the art would see this combination as obvious.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination III in view of Hung.

Claims 2, 5 and 74 are unpatentable under Combination III in view of Yang '163 or Wismeth

If the Examiner finds World Factory's § 131 Declaration lacking, Claim 2, 5 and 74 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination III in view of either Yang '163 or Wismeth. Combination III discloses all the elements of Claim 2 and 74 and Yang '163 and Wismeth disclose a SES and a RES in a singular module that is carried by a pole. When combined with Combination III, accordingly, a person skilled in the art would see this combination as obvious.

Claim 5 adds only the limitations that ribs are attached to the canopy, and fluorescent lights are mounted to the ribs. The type of lighting used, whether incandescent, fluorescent, LED, or the like is a trivial modification. And because of the elongated structure of fluorescent bulbs, mounting them to the umbrella ribs would be an obvious expedient. Claim 5 is thus also obvious over Combination III in view of either Yang '163 or Wismeth.

Claims 2 and 4 are unpatentable under Combination IV

The Office Action rejected Claims 2 and 4 as being unpatentable over WO 93/00840 and Pan or Wu or JP 9-168415 or Mai or Yang which was deemed Combination IV. In response, World Factory amended Claim 2 by adding these limitations: 1) a power module carried by the pole portion above the canopy portion; 2) the power module has an upper portion and a lower portion; 3) the SES is carried by the upper portion of the module; and 4) the electrical power system is disposed in the lower portion of the power module. Lastly, World Factory submitted a Declaration in which the inventor attempts to swear behind Mai, Pan, and Yang.

World Factory has failed to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over WO 93/00840 and Wu or JP-9-168415. The changes to the claims mean that the SES and the RES reside in one singular component, with the SES found over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must have access to light. As such, the SES must be above the canopy portion, either on the canopy itself or on the pole portion supporting the canopy. Additionally, having the RES below the SES would be obvious as well; having the RES above the SES would prevent the SES from receiving light and thereby preventing its operation. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems.

No amendments were made to Claim 4, which is dependent on Claim 2. The only additional limitation of Claim 4 is that the canopy has a plurality of rib members which carries the lighting system and that the rib members carry a plurality of light emitting diodes coupled to the RES. For Claim 4, the references disclose a canopy with multiple rib members and the use of lighting devices. All but WO 93/00480 disclose using light emitting diodes in various positions, some specifically on the ribs. As such, the arguments above that apply to Claim 2 apply to Claim 4.

Claims 2 and 4 are unpatentable under Combination IV in view of Hung

Alternately, Claim 2 and 4 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination IV in view of Hung. Combination IV discloses all the elements of former Claims 2 and 4, and Hung discloses the new elements added by the amendments: a SES and a RES in a singular module that is carried by a pole, the SES found in the upper portion and the RES found in a lower portion. It would have been obvious to a person skilled in the art to modify Combination IV by substituting a SES and a RES in a singular module that is carried by a pole, as taught by Hung, and thereby construct the invention of Claims 2 and 4.

The Rejection of Claims 2 and 4 under Combination IV in view of Yang '163 or Wismeth

If the Examiner finds the Declaration lacking, Claims 2 and 4 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Combination IV in view of either Yang '163 or Wismeth. Combination IV discloses all the elements of former Claims 2 and 4, and Yang '163 and Wismeth disclose the limitations added by the recent amendments: a SES and a RES in a singular module that is carried by a pole. A person of ordinary skill in the art would have found it obvious to modify Combination IV by adding a SES and a RES in a singular module that is carried by a pole, as taught by Yang '163 or Wismeth, and thereby construct the claimed invention. Claims 2 and 4 are therefore unpatentable.

The Rejection of Claim 4 under Combination V

The Office Action rejected Claim 4 as being unpatentable over Phyle and Valdner and Wu or Pan or JP-9-168415 or Mai or Yang, which was deemed Combination V. Claim 4 was not amended; however, Claim 4 remained dependent upon Claim 2, which was amended as stated above. As such, it includes the limitations of Claim 2. For Claim 4, the limitations disclose a canopy with multiple rib members and the lighting elements being LEDs. Also, World Factory submitted a Declaration in which the inventor attempts to swear behind Mai, Pan, and Yang.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Combination V. The changes to the claims mean that the SES and the RES reside in one singular component, with the SES located over the RES that is located on top of a patio umbrella. Such a combination would be obvious to a person skilled in the art. For the SES to convert light into electrical energy, it must have access to light. As such, the SES must be above the canopy portion, either on the canopy itself or on the pole portion supporting the canopy. Additionally, having the RES below the SES would be obvious as well; having the RES above the SES would prevent the SES from receiving light and thereby preventing its operation. Combining the SES and RES in one power module is obvious to a person skilled in the art because combining the two systems into one module greatly reduces the need for wire to connect the two systems as well as increases the ease of access to repair of the electrical systems.

Claim 4 is unpatentable over Combination V in view of Hung

Alternately, Claim 4 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination V in view of Hung. Combination V discloses all the elements of previous Claim 4. Hung discloses a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified Combination V by providing a SES and a RES in a single module that is carried by a pole, as taught by Hung. Locating the module on the pole above the canopy is an obvious step, because a module located beneath the canopy would not be exposed to sunlight and could not collect energy. Claim 4 is therefore unpatentable as obvious over Combination V in view of Hung.

Claim 4 is unpatentable over Combination V in view of either Yang '163 or Wismeth

If the Examiner finds the Declaration lacking, Claim 4 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination V in view of either Yang '163 or Wismeth. Combination V discloses all the elements of former Claim 4. Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified Combination V by providing a SES and a RES in a single module that is carried by a pole, as taught by either Yang '163 or Wismeth. Locating the module on the pole above the canopy is an obvious step, because a module located beneath the canopy would not be exposed to sunlight and could not collect energy. Claim 4 is therefore unpatentable as obvious over Combination V in view of either Yang '163 or Wismeth.

The Rejection of Claims 49, 50 and 72 under Combination VIII (A)

The Office Action rejected Claims 49, 50 and 72 as being unpatentable over WO 93/00840 and Morgan or Rushing or Pan or JP 9-168415 or Mai which was deemed Combination VIII (A). World Factory responded by amending claims 49 and 72 by adding this limitation: each lighting element is recessed within the rib member and is conductively coupled to the rechargeable electrical power system by an electrical conductor that is also recessed within the rib member. Claim 50 was not amended, but is dependent on Claim 49, therefore taking in the limitation. In addition, World Factory submitted a Declaration in which the inventor attempted to swear behind Mai and Pan.

This amendment fails to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Combination VIII(A). The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. Such an element would be obvious to a person skilled in the art in light of Combination VIII (A). The lighting elements and connecting wires must be carried by a reinforced structure of a canopy, which would be the rib members. Safety issues would make it obvious not to have wires protruding from the rib members. As such, the logical solution would be to recess the wires and lighting elements within the rib members.

Claims 49, 50 and 72 are obvious over Combination VIII (A) in view of Hale or Wu or Walker

Alternatively, Claims 49, 50 and 72 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII (A) in view of Hale or Wu or Walker. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). Walker discloses lighting elements and wires (32) that are recessed into channels (30) along the underside of the rib (16). It would have been obvious, and hence unpatentable, for a person skilled in the art to have modified Combination VIII(A) by recessing the wires and lighting elements into the rib members, as taught by either Hale or Wu or Walker. Claims 49, 50, and 72 are therefore unpatentable.

Claims 49, 50 and 72 are obvious over Combination VIII (A) in view of Lee '224 or Lee '856

If the Examiner finds the Rule 1.131 Declaration lacking, Claims 49, 50 and 72 are unpatentable under U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII (A) in view of Lee '224 or Lee '856. Former Claims 49, 50, and 72 have already been rejected as obvious over Combination VIII(A). Claims 49, 50, and 72 have now been amended to add the limitations that each lighting element is recessed within the rib member and is conductively coupled to the rechargeable electrical power system by an electrical conductor that is also recessed within the rib member. Lee '224 and Lee '856 disclose an umbrella that has a plurality of ribs 2 with trenches 3 throughout the bottoms of the ribs 2. Lamps 4 are partially retained within the trenches 3 of the ribs 2. Both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into the rib members with the wires connected to a rechargeable power source. It would have been obvious to a person skilled in the art to have modified Combination VIII(A) by providing trenches in the bottoms of the ribs, with lighting elements and associated wiring recessed into the trenches as taught by Lee '224 and Lee '856 and thereby construct the claimed invention. Claims 49, 50, and 72 are therefore unpatentable under § 103(a).

The Rejection of Claims 51 and 55 under Combination VIII (B) in view of Wu or Hale

The Office Action rejected Claims 51 and 55 as being unpatentable over WO 93/00840 and Lee '856 which was deemed Combination VIII (B). Claim 51 was originally dependent on Claim 49, but World Factory amended Claim 51 to become independent, and incorporated the limitations of Claim 49, except that a single lighting element has replaced a plurality of lighting elements along a rib member. These additional limitations were added as well: 1) a translucent cover for covering the lighting elements; 2) the SES carried by a power unit coupled to the pole portion above the canopy portion; and 3) a portion of each lighting element extends beyond the corresponding rib member. Claim 55 was amended to depend from Claim 52, which is identical to Claim 51 except that it claims the lighting elements are fully recessed within the rib member. Claim 55 further claims that each wire is fully recessed within the rib member. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Lee '856.

Claims 51 and 55 as amended are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII(B) in view of Wu or Hale. The amendments made disclose the solar power system coupled to the pole portion in a removable manner. Hung has the same configuration. Alternatively, having an item coupled to another item is ubiquitous. Wu and Hale both disclose lighting elements that extend beyond the ribs. Additionally, whether a lighting element is fully recessed or extended from a rib does not have an inventive value. Wu has a translucent cover (322) that covers the lighting element (32). The wire elements for Wu and Hale are recessed within the rib members.

It would have been obvious to a person skilled in the art to modify Combination VIII(B) by coupling one item to another, to have lighting elements that extend beyond the ribs as taught by Wu or Hale, to recess wires within the rib members as taught by Wu or Hale, and to provide a translucent cover that covers a lighting element, as taught by Wu. Claims 51 and 55 are therefore unpatentable as obvious over § 103(a).

The Rejection of Claim 54 under Combination VIII(C)

The Office Action rejected Claim 54 as being unpatentable over WO 93/00840 and Pan or JP 9-168415 or Mai, which was deemed Combination VIII(C). World Factory did not amend Claim 54, but did amend Claim 49, from which Claim 54 depends. Claim 49 was amended by adding these limitations: 1) each lighting element is recessed within the rib member; and 2) is conductively coupled to the rechargeable electrical power system by

an electrical conductor that is also recessed within the rib member. Claim 54 adds the limitation that the lighting elements are each an LED. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Pan and Mai.

Even if Pan and Mai are removed as references, these amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over WO 93/00840 and JP 9-168415. The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. The lighting elements and connecting wires must be carried by a reinforced structure of a canopy, which would be the rib members. Safety issues would make it obvious not to have protruding wires from the rib members. As such, the logical solution would be to recess the wires and lighting elements within the rib members. Such an element would be obvious to a person skilled in the art in light of WO 93/00840 and JP 9-168415.

Claim 54 is unpatentable over WO 93/00840 and JP 9-168415 in view of either Hale or Wu

Alternatively, Claim 54 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over WO 93/00840 and JP 9-168415 in view of either Hale or Wu. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). JP 9-168415 discloses using LEDs. A person skilled in the art would find it obvious to modify WO 93/00840 and JP 9-168415, which show all of the features of former Claim 54, by providing a recessed channel with the ribs into which the lighting elements and wires are recessed, as taught by Hale or Wu. Claim 54 is therefore unpatentable as obvious over WO 93/00840 and JP 9-168415 in view of either Hale or Wu.

If the Examiner finds World Factory's § 1.131 Declaration lacking, Claim 54 is unpatentable under U.S.C. § 103(a) as being obvious and unpatentable over Combination VIII(C) in view of Lee '224 or Lee '856. Lee '224 and Lee '856 each disclose lighting elements and wires that are recessed into umbrella rib members. Combination VIII(C) discloses all of the elements of former Claim 54. The new limitations added to Claim 54 are shown in Lee '224 and Lee '856. It would be obvious to a person skilled in the art to modify Combination VIII(C) by recessing the lighting elements and wires into umbrella rib members, as taught by Lee '224 and Lee '856. Claim 54 is therefore unpatentably obvious over Combination VIII(C) in view of Lee '224 or Lee '856.

Claims 49, 50, and 72 are unpatentable under Phyle and Valdner, and Morgan or Rushing or JP 9-168415

The Office Action rejected claims 49, 50 and 72 as being unpatentable over Phyle and Valdner, and Morgan or Rushing or Pan or JP 9-168415 or Mai which was deemed Combination IX (A). World Factory amended Claims 49 and 72 (50 was not amended, but dependent on 49), by adding these limitations: 1) each lighting element is recessed within the rib member and being conductively coupled to the rechargeable electrical power system by an electrical conductor; and 2) the electrical conductor also is recessed within the rib member. Claim 72 further states the lighting element is recessed within the corresponding rib member. Additionally, World Factory submitted a Declaration that attempts to swear behind Pan and Mai.

Even if Pan and Mai are removed as prior art references, the amendments to Claims 49, 50 and 72 fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Phyle and Valdner, and Morgan or Rushing or JP 9-168415. The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. The lighting elements and connecting wires must be carried by a reinforced structure of a canopy, which would be the rib members. Safety issues would make it obvious not to have protruding wires from the rib members. As such, the logical solution would be to recess the wires and lighting elements within the rib members, which would be obvious to a person skilled in the art in light of the combination of Phyle and Valdner, and Morgan or Rushing or JP 9-168415.

Claims 49, 50, and 72 are unpatentable under Phyle and Valdner, and Morgan or Rushing or JP 9-168415 and further in view of Hale or Wu or Walker

Alternatively, Claims 49, 50 and 72 are unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Phyle and Valdner, and Morgan or Rushing or JP 9-168415 in view of Hale or Wu or Walker. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). Walker discloses lighting elements and wires (32) that are recessed into channels (30) along the underside of the rib (16). It would have been obvious to a person skilled in the art to have modified the combination of Phyle and Valdner, and Morgan or Rushing or JP 9-168415 by providing recesses in the ribs to receive the wires and lighting elements, as taught by Hale or Wu or Walker, and thereby construct the claimed invention.

Claims 49, 50, and 72 are unpatentable over Combination IX(A) in view of Lee '224 or Lee '856

If the Examiner finds World Factory's Rule 1.131 Declaration inadequate to establish a date of invention earlier than its filing date, Claims 49, 50 and 72 are unpatentable under U.S.C. § 103(a) as being obvious over Combination IX (A) in view of Lee '224 or Lee '856. Both Lee '224 and Lee

'856 disclose an umbrella that has a plurality of ribs 2 with trenches 3 throughout the bottoms of the ribs 2. Lamps 4 are partially retained within the trenches 3 of the ribs 2. Both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into the rib members with the wires connected to a power source. It would have been obvious to a person skilled in the art to modify Combination IX(A) by providing recesses in the bottom of the rib members with the lighting elements and wires received within the recesses, as taught by Lee '224 and Lee '856, and thereby construct the claimed invention.

Claims 51 and 55 are unpatentable under Combination IX (B)

The Office Action rejected Claims 51 and 55 as being unpatentable over Phyle, Valdner, and Lee '856, which was deemed Combination IX (B). Claim 51 was originally dependent on Claim 49, but World Factory amended Claim 51 to become independent, and incorporated the limitations of Claim 49, except that a single lighting element has replaced a plurality of lighting elements along a rib member. The additional limitations were added: 1) a translucent cover for covering the lighting elements; 2) the SES carried by a power unit coupled to the pole portion above the canopy portion; and 3) that a portion of each lighting element extends beyond the corresponding rib member. Claim 55 was amended to depend from Claim 52, which is identical to Claim 51 except that it claims that the lighting elements are fully recessed within the rib member. Claim 55 further claims that each wire is fully recessed within the rib member. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Lee '856.

These amendments fail to overcome the 35 U.S.C. § 103(a) rejections as being obvious and unpatentable over Phyle and Valdner. The amendments have made the SES part of a power module, which Valdner discloses. The SES is attached to the pole portion of World Factory's invention. Valdner's SES is attached to the apex of the canopy portion, which would be the equivalent of the pole portion of World Factory's invention. Having a removable SES is not a novel concept either. The venting component (28) of Valdner is recessed in the rib members (26) of the canopy portion. It would have been obvious to a person skilled in the art to position the lights and wiring of Phyle within the venting component of Valdner and thereby construct the claimed invention.

Claims 51 and 55 are unpatentable under Combination IX (B)

Alternatively, Claims 51 and 55 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Phyle and Valdner, and Hung in view of Wu or Hale. The amendments made to Claims 51 and 55 disclose the solar power system coupled to the pole portion in a removable manner. Hung has the same configuration. Wu and Hale both disclose lighting elements that extend beyond the ribs. Additionally, the extent to the amount a lighting element is fully recessed or extended from a rib does not have an inventive value. Wu has a translucent cover (322) that covers the lighting element (32). The wire elements for Wu and Hale are fully recessed within the rib members. It would have been obvious to a person skilled in the art to have modified Combination IX(B) by providing a solar power system coupled to the pole portion in a removable manner, as taught by Hung, to provide lighting elements that extend beyond the ribs, as taught by Wu and Hale, and to provide a translucent cover, as taught by Wu, and thereby construct the claimed invention.

Claims 51 and 55 are unpatentable over Combination IX (B)

If the Examiner finds the Declaration lacking, Claims 51 and 55 are unpatentable under U.S.C. § 103(a) as being obvious over Combination IX (B) and Wu in view of Lee '224 or Lee '856. As previously discussed, both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into the rib members. It would have been obvious to a person skilled in the art to have modified Combination IX(B) by providing lighting elements and wires recessed into rib members, as taught by Lee '224 and Lee '856, and thereby construct the claimed invention.

Claim 54 is unpatentable over Combination IX (C)

The Office Action rejected Claim 54 as unpatentable over Phyle and Valdner, and Pan or JP 9-168415 or Mai which was deemed Combination IX (C). World Factory did not amend Claim 54, but did amend Claim 49, from which Claim 54 depends. Claim 49 was amended by adding these limitations: 1) each lighting element is recessed within the rib member; and 2) each lighting element is conductively coupled to the rechargeable electrical power system by an electrical conductor that is also recessed within the rib member. Claim 54 adds the limitation that the lighting elements are each an LED. In addition, World Factory submitted a Declaration in which the inventor attempts to swear behind Pan and Mai.

Even if Pan and Mai were removed as prior art references, World Factory has failed to overcome the 35 U.S.C. § 103(a) rejections over Phyle and Valdner and JP 9-168415. The amendments to the claims relate to the positioning of lighting elements and wires within the rib members. Phyle discloses the lighting elements (12) being carried by the rib portions (22). Valdner discloses its venting element (28) being recessed in the rib members (26). Using an LED as the lighting element would be obvious to one skilled in the art, and JP 9-168415 discloses the use of LEDs. The combination of recessing an LED and its wiring components within a rib member would be obvious to a person skilled in the art in light of Combination IX (C).

Claim 54 is unpatentable over Combination IX (C) in view of Hale or Wu

Alternatively, Claim 54 is unpatentable under 35 U.S.C. § 103(a) as being obvious and unpatentable over Combination IX (C) in view of either Hale or Wu. Wu specifically discloses a recessed rib (21) into which the lighting elements (32) and wires (P and N) are recessed. Hale also discloses lighting elements (15) and wires (36) that are recessed into the rib members (12). It would have been obvious to a person skilled in the art to have modified Combination IX(C) by providing a recess in each rib into which lighting elements and wires are recessed, as taught by either Hale or Wu, and thereby construct the claimed invention.

Claim 54 is unpatentable over Combination IX (C) in view of Lee '224 or Lee '856.

If the Examiner finds the Rule 1.131 Declaration lacking, Claim 54 is unpatentable under U.S.C. § 103(a) as being obvious and unpatentable over Combination IX (C) in view of Lee '224 or Lee '856. As previously discussed, both Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to have modified Combination IX(C) by providing lighting elements and wires recessed into rib members, as taught by either Lee '224 or Lee '856, and thereby construct the claimed invention.

ADDITIONAL PROPOSED REJECTIONS

Claim 1—Claim 1 is not patentable under 35 U.S.C. § 103(a) over Mueller and Rushing in view of Hung. Mueller discloses an umbrella apparatus (80), a base portion (28), a pole portion (16) coupled to the pole portion (28), a canopy portion hingedly coupled to the pole portion, the canopy portion having a plurality of rib members, a rechargeable electrical power system for providing power to the umbrella apparatus, and a SES (82) carried by a module coupled to the pole portion above the canopy portion, the SES being connected to the RES (26). Rushing discloses a lighting system having multiple discrete lighting elements (28) positioned along at least one of the rib members (12), and being conductively coupled to an electrical power system. Hung discloses a SES (32) carried by a module (10), the module being releasably coupled to the pole portion (80). It would have been obvious to a person skilled in the art to have modified the umbrella of Mueller by providing a lighting system having multiple discrete lighting elements positioned along a rib member and being conductively coupled to an electrical power system, as taught by Rushing, and to substitute a SES carried by a module that is releasably coupled to the pole portion, as taught by Hung, and thereby construct the invention of Claim 1.

Claim 2, 4, 5, 56, and 74—Claims 2, 4, 5, 56, and 74 are not patentable under 35 U.S.C. § 103(a) over Mueller and Phyle in light of Hung. Claim 2 recites a base, a pole, a canopy hingedly mounted to the pole, a power module attached to the pole above the canopy, and a lighting system carried by the canopy. Claim 4 depends from Claim 2 and adds the additional limitations that the canopy comprises a plurality of ribs and the lighting system comprises LEDs. Claim 5 depends from Claim 2 and adds the limitations that the canopy comprises a plurality of ribs and the lighting elements are fluorescent. Claim 56 recites a base, a pole, a canopy comprising a plurality of ribs, and a power module carried by the pole above the canopy. Claim 74 recites a base, a pole, a canopy, a lighting system carried by the canopy, and a power module carried by the pole above the canopy. It should also be noted that Claims 2 and 74 are identical as amended.

Mueller discloses an umbrella apparatus (80), a base portion (28), a pole portion (16) coupled to the pole portion (28), a canopy portion hingedly coupled to the pole portion, a rechargeable electrical power system for providing power to the umbrella apparatus, and a SES (82) carried by a module coupled to the pole portion above the canopy portion, the SES being connected to the RES (26). It does not disclose a power module carried by the pole portion having an upper and lower portion, nor does it disclose the canopy carrying a lighting system that is coupled to the RES. Phyle does disclose a lighting system that is carried by the canopy that is coupled to the RES. Hung discloses a power module (10) carried by the pole portion (80), with the SES (32) in the upper portion and the RES (26) in the lower portion.

It would have been obvious to a person of ordinary skill in the art to have modified the umbrella apparatus of Mueller by providing a lighting system carried by the canopy that is coupled to the power module, as taught by Phyle, and to have the power module carried by the pole portion with the SES in the upper portion of the module and the RES in the lower portion. Claim 2 would therefore be obvious and unpatentable. The only element of Claim 4 not disclosed by this combination is that the lighting elements are LEDs. The type of lighting element used is trivial and cannot form the basis for patentability. In any event, JP 9-168415 discloses the use of LED lighting elements. The only element of Claim 5 not disclosed by this combination is that the lighting elements are fluorescent. The type of lighting element used is trivial and cannot form the basis for patentability. All of the elements of Claims 56 and 74 are shown in this combination.

Alternatively, if the Examiner finds the Declaration lacking, the combination of Mueller and Phyle in light of Yang '613 or Wismeth would make Claims 2, 46, and 74 obvious in the same manner. As previously discussed, Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified the previously discussed combination of Mueller and Phyle by providing a SES and a RES in a single module that is carried by a pole, as taught by either Yang '163 or Wismeth. Locating the module on

the pole above the canopy is an obvious step, because a module located beneath the canopy would not be exposed to sunlight and could not collect energy.

Claim 47—Claim 47 is unpatentable under 35 U.S.C. 103(a) as being unpatentable over Phyle and Hung. Phyle discloses a patio umbrella apparatus (1), a base portion, a pole portion (20) coupled to the base portion, a canopy portion hingedly coupled to the pole portion, and a RES for providing power to the umbrella apparatus. It does not disclose a power module carried by the pole portion having an upper and lower portion. Hung discloses a power unit (10) that has a SES (32) in the upper portion and a RES (26) in the lower portion, the unit coupled to the top portion of a pole (80). It would have been obvious to a person skilled in the art to modify the umbrella apparatus of Phyle by providing a power unit that has a SES in the upper portion and a RES in the lower portion, the unit coupled to the top portion of a pole as taught by Hung. Claim 47 would therefore have been obvious to a person skilled in the art.

Alternatively, if the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle and Yang '613 or Wismeth would make Claim 47 obvious in the same manner as Phyle and Hung. Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified Phyle by providing a SES and a RES in a single module that is carried by a pole, as taught by either Yang '163 or Wismeth.

Claim 48—Claim 48 is unpatentable under 35 U.S.C. 103(a) over Phyle, Valdner, and Hung in view of Hale. Valdner discloses all elements of Claim 48 except a plurality of lighting elements carried by the rib member, the lighting elements being recessed within the rib members and the RES and SES each forming a component part disposed in a power unit carried by the pole portion above the canopy. Phyle discloses most of the same, but further includes carrying lighting elements. Phyle does not have a SES. However, Valdner does disclose its venting mechanisms (28) being recessed within the rib members (26). Hale discloses its lighting elements (15) being recessed within its rib members (12). Hung discloses the power unit (10) coupled on top of the pole portion (80), with the SES being in the top portion and the RES being in the bottom portion. It would have been obvious to one skilled in the art to have modified the apparatus of Phyle or Valdner by providing the lighting elements recessed within the canopy rib members, as taught by Hale, and providing the power unit coupled on top of the pole portion, with the SES being in the top portion and the RES being in the bottom portion. Claim 48 is therefore unpatentable as obvious.

Additionally, if the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle, Valdner or Mueller and Yang '613 or Wismeth in view of Lee '224 or Lee '856 would make Claim 48 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified the previously discussed combination of Phyle and Valdner or Mueller by providing lighting elements and wires recessed into rib members, as taught by Lee '224 or Lee '856, and to combine a SES and a RES in a single module that is carried by a pole, as taught by Yang '163 and Wismeth, and thereby construct the claimed invention.

Claim 49, 50 and 54—Claim 49 is unpatentable under 35 U.S.C. § 103(a) over Mueller and Rushing in view of Hale. Mueller discloses all elements of Claim 49 except those dealing with the lighting system. Rushing discloses all of the lighting elements of Claim 49 except each lighting element being recessed within the rib member as well as the electrical conductor being recessed. Hale discloses each lighting element and electrical conductor being recessed within the rib member (see FIG. 1 and 9). It would have been obvious to a person skilled in the art to have modified the apparatus of Mueller to provide the lighting elements as taught by Rushing, recessing the lighting elements and wires as taught by Hale, and thereby construct the claimed invention.

Alternatively, if the Examiner finds the Declaration lacking, the combination of Mueller and Rushing in view of Lee '224 and Lee '856 would make Claims 49, 50 and 54 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to have modified the apparatus of Mueller to provide the lighting elements as taught by Rushing, recessing the lighting elements and wires as taught by Lee '224 and Lee '856, and thereby construct the claimed invention.

Additionally, Claim 50 is dependent on Claim 49, with the additional limitation that the lighting system includes multiple discrete lighting elements along each rib member. Rushing discloses this feature, so Claim 50 would be obvious based on the same combination that renders Claim 49 unpatentable.

Claim 54 is also dependent on Claim 49, with the additional limitation that the multiple discrete lighting elements are each an LED. Having the lighting elements being an LED would be obvious to anyone skilled in the art. It is common practice to use LEDs in such applications which World Factory states in its Response to the Office Action. Alternatively, with the addition of JP 9-168415, which clearly discloses LEDs, Claim 54 would be obvious to one skilled in the art.

Claim 51—Claim 51 is unpatentable under 35 U.S.C. 103(a) over Phyle and Hung in view of Wu. Phyle discloses every element of Claim 51 except the power unit being releasably coupled to the pole, translucent covers for the lighting elements, and the lighting elements extending beyond the corresponding rib member. Hung discloses a power unit that comprises a SES that is releasably coupled to the pole portion. Wu discloses translucent covers (322) where the lighting elements extend beyond the rib member. It would have been obvious to a person skilled in the art to have modified the device of Phyle by providing a power unit that comprises a SES that is releasably coupled to the pole portion, as taught by Hung, and translucent covers where the lighting elements extend beyond the rib member, as taught by Wu.

Alternatively, if the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle and Yang '613 in view of Wu would make Claim 51 obvious in the same manner. Yang '613 discloses a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to modify the apparatus of Phyle to provide a SES and a RES in a single module that is carried by a pole, as taught by Yang '613, and translucent covers where the lighting elements extend beyond the rib member, as taught by Wu, thereby constructing the claimed invention.

Claim 52, 53, and 55—Claim 52 is unpatentable under 35 U.S.C. 103(a) over Mueller, Rushing, and Hale or Wu. Mueller contains all of the elements of Claim 52 except the canopy carrying a lighting system which includes multiple discrete lighting elements positioned along a rib member, wherein each lighting element is fully recessed within the corresponding rib member. Rushing discloses the canopy portion carrying the lighting system, with multiple discrete lighting elements positioned along the rib members. Hale and Wu disclose the lighting elements being recessed within the corresponding rib member. However, being fully recessed in the rib member would be obvious to one skilled in the art. It would have been obvious to a person skilled in the art to have modified the apparatus of Mueller by providing that the canopy portion carry the lighting system, with multiple discrete lighting elements positioned along the rib members, as taught by Rushing, with the lighting elements being recessed within the corresponding rib member, as taught by Hale or Wu, thereby constructing the claimed invention.

Alternatively, if the Examiner finds the rule 1.131 Declaration lacking, the combination of Mueller, Rushing, and Lee '224 or Lee '856 would make Claim 52 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to modify the device of Mueller by providing that the canopy portion carry the lighting system, with multiple discrete lighting elements positioned along the rib members, as taught by Rushing, with lighting elements and wires that are recessed into rib members, as taught by Lee '224 and Lee '856, thereby constructing the claimed invention.

Claims 53 and 55 are dependent on Claim 52. Claim 55 has the further limitation that the wires for the lighting elements be fully recessed within the rib members. Hale, Wu, Lee '224, and Lee '856 disclose this limitation as well. Claim 53 adds the limitation that the lighting elements are covered by a translucent cover. Wu discloses this limitation. As such, the combination of Mueller, Rushing, and Lee '224 or Lee '856 would make Claims 53 and 55 obvious.

Claim 60—Claim 60 is unpatentable under 35 U.S.C. § 103(a) over Mueller and Wu. Mueller discloses every element of Claim 60 except for a lighting system that is carried by the canopy portion that is conductively coupled to and powered by the RES, wherein the lighting system includes a plurality of lighting elements, each lighting element being recessed within a corresponding rib member and being covered by a translucent cover carried by the corresponding rib member. Wu discloses these limitations. It would have been obvious to a person skilled in the art to have modified the device of Mueller by providing a lighting system that is carried by the canopy portion that is conductively coupled to and powered by the RES, wherein the lighting system includes a plurality of lighting elements, each lighting element being recessed within a corresponding rib member and being covered by a translucent cover carried by the corresponding rib member, as taught by Wu, thereby constructing the claimed invention.

If the Examiner finds the Rule 1.131 Declaration lacking, the combination of Mueller and Wu in view of Lee '224 or Lee '856 would make Claim 60 obvious in the same manner. Lee '224 and Lee '856 disclose lighting elements and wires that are recessed into rib members. It would have been obvious to a person skilled in the art to have modified the device of Mueller by providing a lighting system that is carried by the canopy portion that is conductively coupled to and powered by the RES, wherein the lighting system includes a plurality of lighting elements, each lighting element being recessed within a corresponding rib member and being covered by a translucent cover carried by the corresponding rib member, as taught by Wu, with the lighting elements and wires recessed into rib members, as taught by Lee '224 and Lee '856, thereby constructing the claimed invention.

Alternatively, Claim 60 is unpatentable based on this combination and Hale. Hale discloses the lighting elements being recessed within a rib portion. As such, one skilled in the art would find Claim 60 obvious after observing this combination.

Claim 61—Claim 61 is unpatentable under 35 U.S.C. § 103(a) over Phyle, Mueller, and Hung. Phyle discloses a patio umbrella apparatus, a base portion, a pole portion coupled to the base portion, a canopy portion hingedly coupled to the pole portion, a RES for providing power to the umbrella apparatus, and the canopy carrying a lighting system, each lighting element carried by a rib member, as well as the wiring system. It does not disclose a power unit carried by the pole portion having an upper and lower portion. Mueller discloses a SES carried by the pole portion that recharges the RES.

Hung discloses a power unit (10) that has a SES (32) in the upper portion and a RES (26) in the lower portion, the unit coupled to the top portion of a pole (80). It would have been obvious to a person skilled in the art to have modified the device of Phyle by providing a SES carried by the pole portion that recharges the RES, as taught by Mueller, and a power unit that has a SES in the upper portion and a RES in the lower portion, the unit coupled to the top portion of a pole, as taught by Hung, thereby constructing the claimed invention.

If the Examiner finds the Rule 1.131 Declaration lacking, the combination of Phyle, Mueller and Yang '613 or Wismeth would make Claim 61 obvious in the same manner. Yang '163 and Wismeth disclose a SES and a RES in a single module that is carried by a pole. It would have been obvious to a person skilled in the art to have modified the device of Phyle by providing a SES carried by the pole portion that recharges the RES, as taught by Mueller, and a power unit that has a SES in the upper portion and a RES in the lower portion, the unit coupled to the pole, as taught by Yang '163 and Wismeth, thereby constructing the claimed invention.

Claim 62—Claim 62 is unpatentable under 35 U.S.C. § 103(a) over Mueller and JP 9-168415. Mueller discloses all of the elements of Claim 62 except all limitations dealing with the lighting subassembly, its location and components. JP 9-168415 discloses a lighting subassembly (7) that is carried by the canopy portion, the lighting subassembly being conductively coupled (9) to the RES, wherein the lighting subassembly includes a plurality of LEDs (7), each LED being recessed relative to a corresponding rib member (3) and each LED being conductively coupled by a conductor (9) recessed relative to the corresponding rib member. It would have been obvious to a person skilled in the art to have modified the device of Mueller by providing a lighting subassembly that is carried by the canopy portion, the lighting subassembly being conductively coupled to the RES, wherein the lighting subassembly includes a plurality of LEDs, each LED being recessed relative to a corresponding rib member, and each LED being conductively coupled by a conductor recessed relative to the corresponding rib member, as taught by JP 9-168415, thereby constructing the claimed device.

Alternatively, this combination in view of Hale would make Claim 62 obvious to a person skilled in the art as well. Hale has a lighting subassembly (15) and conductor (36) that are recessed relative to the corresponding rib member (12). If the Examiner finds the Declaration lacking, the combination above in view of Lee '224 or Lee '856 would make Claim 62 obvious in the same manner.

Claim 64 and 65—Claim 64 is unpatentable under 35 U.S.C. § 103(a) over Mueller or Valdner and Phyle or Rushing. Mueller and Valdner disclose all of the elements of Claim 64 except the lighting system portions. Valdner and Mueller both have discuss-shaped modules that hold the SES. Phyle and Rushing disclose a lighting system being carried by the canopy portion. It would have been obvious to a person skilled in the art to have modified Mueller or Valdner by providing a lighting system being carried by the canopy portion, as taught by Phyle or Rushing, and thereby construct the claimed invention.

Alternatively, Claim 64 is unpatentable over the combination above in further view of Hung. The SES is contained in a discuss-shaped module that is carried by a pole portion. As such, these combinations make Claim 64 obvious in the eyes of a person skilled in the art. If the Examiner finds the Declaration lacking, the combination above in light of Yang '613 would make Claim 64 obvious in the same manner.

Claim 65 has been amended to be dependent on Claim 64, with the only additional limitation that the discuss-shaped module is releasably coupled to the pole portion. To the extent the term "discuss-shaped module" can be understood, Hung's module is releasably coupled to the pole portion, as is module in Yang '613. As such, this combination makes Claim 65 obvious.

Claim 66—Claim 66 is unpatentable under 35 U.S.C. § 103(a) over Phyle and Hung in view of Hale. Phyle discloses all of the elements of Claim 66 except for elements dealing with the SES and the RES forming a power unit fixed relative to the pole portion, with the SES forming the upper portion and the RES forming the lower portion. Additionally, Phyle does not disclose conductors recessed within the rib members. Hung discloses a power unit fixed relative to the pole portion that has the SES forming the upper portion and the RES forming the lower portion. Hale discloses conductors that are recessed within the rib members. As such, Claim 66 would be seen as obvious by one who was skilled in the art after referring to the above combination. If the Examiner finds the Declaration lacking, the combination of Phyle and Yang '613 or Wismeth in view of Lee '224 or Lee '856 would make Claims 2, 46, and 74 obvious in the same manner.

Alternatively, Claim 66 is unpatentable in further view of the combination above and Mueller and Wu. Mueller discloses a SES carried by the pole portion of the umbrella, whereas Wu discloses the electrical conductors being recessed within the rib members.

Claims 70 and 71—Claims 70 and 71 are unpatentable under 35 U.S.C. § 103(a) over Mueller or Valdner and Wu. Mueller and Valdner disclose all of the elements of Claim 70 except each rib member having a recessed longitudinal channel and having a lighting system carried by the canopy portion, the lighting system being conductively coupled to and powered by the RES, the lighting system comprising a plurality of lighting elements carried by the rib members, each lighting element being disposed within the channel. Wu discloses a recessed longitudinal channel in each rib member (21 - See FIGS. 5, 7- 8). The lighting elements (32) are recessed within the rib member. As such, a person skilled in the art would view this

combination and find Claim 70 obvious. Claim 71 is dependent on Claim 70, with the only additional element being that a transparent cover is disposed over each channel. Wu discloses a translucent cover being placed over the channel. As such, 71 is unpatentable as well for obviousness. If the Examiner finds the Declaration lacking, the combination of Mueller or Valdner in view of Lee '224 or Lee '856 would make Claim 70 obvious in the same manner, with the addition of Wu for Claim 71.

Alternatively, Claims 70 and 71 are unpatentable with Mueller or Valdner and Wu in further view of Hale. Hale has a recessed longitudinal channel (See FIGS. 3, 8, and 9) within which the lighting elements are disposed. Additionally, having a translucent cover over the lighting elements would be obvious in the view of a person skilled in the art.

Claim 72—Claim 72 is unpatentable under 35 U.S.C. § 103(a) over Mueller or Valdner and Rushing or Phyle in view of Wu or Hale. Mueller and Valdner disclose all of the elements of Claim 72 except a lighting system carried by the canopy portion, a plurality of discrete lighting elements carried by each rib member that is recessed within a corresponding rib member, and the electrical conductors also being recessed within the rib members. Rushing and Phyle disclose a lighting system carried by the canopy portion and a plurality of discrete lighting elements carried by each rib member. Hale and Wu disclose the lighting elements and the electrical conductors being recessed within the rib members as well. As such, Claim 72 would be obvious to one skilled in the art in view of the above combination. If the Examiner finds the Declaration lacking, the combination Mueller or Valdner and Rushing or Phyle in light of Lee '224 or Lee '856 would make Claim 72 obvious in the same manner.


Compliance with 37 C.F.R. §§ 1.52 and 1.943

The foregoing Comments are submitted in 12 point nonscript type, 1-1/2 spaced, and do not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

CONCLUSION

In view of the foregoing, Southern Sales respectfully requests that the rejection of Claims 1, 2, 4, 5, 6, 7, 9, 49, 50, 51, 54, 55, 57, 72, 73 and 74 be maintained, and that Claims 1, 2, 4, 5, 47-56, 59-62, 64-66, 70-72, and 74 be rejected under 35 U.S.C. § 103(a) based upon the various combinations discussed above and any other various combinations that may be developed in further combination with the new prior art references cited herein and the other bases as set forth above.

Respectfully submitted:



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Attorney Docket: 45639-316477

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Reexamination of:)
)
Gregory G. Kuelbs)
) Examiner: Margaret Rubin
Control No. **95/000,104**)
) Art Unit: 3992
Patent No.: **6,612,713**)
)
Issued: **September 2, 2003**)
)
Assignee: **WORLD FACTORY, INC.**)

CERTIFICATE OF SERVICE

This is to certify that I have this day served a true and correct copy of the foregoing "Appeal Brief of Appellant Third-Party Requestor" by depositing same in the United States mail, properly addressed with sufficient first class postage affixed thereto to ensure delivery to:

James E. Walton, Esq.
1169 N. Burleson Boulevard
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This 14th day of September, 2009.


Larry A. Roberts

Electronic Patent Application Fee Transmittal				
Application Number:	95000104			
Filing Date:	12-Aug-2005			
Title of Invention:	UMBRELLA APPARATUS			
First Named Inventor/Applicant Name:	6612713			
Filer:	Larry A. Roberts./Andrea Cummings			
Attorney Docket Number:	45639-316477			
Filed as Large Entity				
inter partes reexam Filing Fees				
Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Filing a brief in support of an appeal	1402	1	540	540
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:	YOT-1003-1646			

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Total in USD (\$)				540

Electronic Acknowledgement Receipt

EFS ID:	9843992
Application Number:	95000104
International Application Number:	
Confirmation Number:	5847
Title of Invention:	UMBRELLA APPARATUS
First Named Inventor/Applicant Name:	6612713
Customer Number:	38441
Filer:	Larry A. Roberts./Andrea Cummings
Filer Authorized By:	Larry A. Roberts.
Attorney Docket Number:	45639-316477
Receipt Date:	08-APR-2011
Filing Date:	12-AUG-2005
Time Stamp:	16:49:25
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	yes
Payment Type	Credit Card
Payment was successfully received in RAM	\$ 540
RAM confirmation Number	3752
Deposit Account	
Authorized User	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part / .zip	Pages (if appl.)
				YOT-1003-1648	

1	Appeal Brief - Third Party Requester	appeal_brief.pdf	10612340 87a217749a5eaa20d60e2df8b0058e7d5b1fd2	no	204
Warnings:					
Information:					
2	Reexam Certificate of Service	316477_certificate.pdf	85633 dbfd5d555b219e5715cbe24d1a8dbbe4ab9be10e	no	1
Warnings:					
Information:					
3	Fee Worksheet (PTO-875)	fee-info.pdf	29596 ca836fdcd811cedf08af6530e01e78fe68543ea99	no	2
Warnings:					
Information:					
Total Files Size (in bytes):				10727569	
<p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p><u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p>					

YOT-1003-1649

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT OFFICE BOARD OF APPEALS AND INTERFERENCES**

In the Reexamination of:)
Gregory G. Kuelbs)
Control No. **95/000,104**) Examiner: **Margaret Rubin**
Patent No.: **6,612,713**) Art Unit: **3992**
Issued: **September 2, 2003**)
Assignee: **WORLD FACTORY, INC.**)

TRANSMITTAL OF SUBSTITUTE APPEAL BRIEF TO CORRECT INFORMALITIES

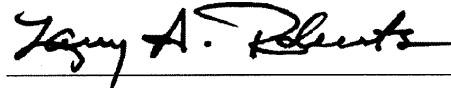
Appellant Southern Sales & Marketing Group, Inc. submits the accompanying replacement brief to correct certain informalities resulting from clerical error, to wit:

- To correct the unintentional omission of counsel's signature;
- To correct a clerical error in heading II.A.; and
- To correct an inaccurate date on the certificate of service.

No substantive changes or new arguments are introduced by this substitute brief.

This 18th day of April, 2011.

Respectfully submitted:



Larry A. Roberts
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Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE


In the Reexamination of:)
)
Gregory G. Kuelbs)
) Examiner: Margaret Rubin
Control No. **95/000,104**)
) Art Unit: 3992
Patent No.: **6,612,713**)
)
Issued: **September 2, 2003**)
)
Assignee: **WORLD FACTORY, INC.**)

CERTIFICATE OF SERVICE

This is to certify that I have this day served a true and correct copy of the accompanying "Substitute Appeal Brief" by depositing same in the United States mail, properly addressed with sufficient first class postage affixed thereto to ensure delivery to:

James E. Walton, Esq.
1169 N. Burleson Boulevard
Suite 107-328
Burleson, Texas 76028

This 18th day of April, 2011.


Larry A. Roberts

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In the Reexamination of:)
Gregory G. Kuelbs)
Control No. **95/000,104**) Examiner: **Margaret Rubin**
Patent No.: **6,612,713**) Art Unit: **3992**
Issued: **September 2, 2003**)
Assignee: **WORLD FACTORY, INC.**)

SUBSTITUTE APPEAL BRIEF OF APPELLANT THIRD-PARTY REQUESTOR

Appellant/Third Party Requester Southern Sales & Marketing Group, Inc., submits this substitute appeal brief to correct certain informalities in the original brief filed April 8, 2011.

The Examiner overstepped her bounds in requiring the Appellant/Third Party Requestor to remove, rather than correct, non-complying material in the Comments dated September 14, 2009. The Examiner also failed to provide the Appellant with an opportunity to correct Comments that exceeded the 50 page limit. Further, Appellant did, in fact, meet the 50-page limit, and to the extent it didn't, it was a matter of formality. Having expunged the September 14, 2009, Comments of the Appellant without considering them, the Examiner has allowed claims that are clearly unpatentable. Appellant therefore requests that the Examiner's decision not to consider the Appellant's Comments of the TPR be reversed and that the case be remanded to the Examiner for further prosecution.

Real party in interest. The Appellant real party in interest is Southern Sales & Marketing Group, Inc.

Related appeals and interferences. Other than those disclosed by the Patent Owner, of which the Appellant has no personal knowledge, the Appellant is not aware of any related appeals or interferences.

Status of claims. Claims 4, 5, and 10-14 have been confirmed without amendment. New or amended claims 2, 3, 8, 49, 50, 52, 53, 55-58, 60, 61, 65, 70-72 have been determined to be patentable. Claims 15-44 have been canceled. Claims 1, 6, 7, 9, 45-48, 51, 54, 59, 62-64, 66-69, and 73 are rejected. Appellant appeals the examiner's determination favorable to patentability of Claims 2, 49, 50, 52, 53, 55-58, 60, 61, 65, 70-72, and 74.

Status of amendments. Respondent submitted amendments to Claims 1, 6, 7, 9, 45-48, 51, 65, 67, and 73 after the Action Closing Prosecution, but the examiner did not enter the amendments.

Summary of claimed subject matter. Appellant appeals the examiner's determination of patentability of independent claims 2, 3, 8, 10, 49, 52, 56, 57, 60, 61, 70, 72, 74. A brief summary of each of the appealed independent claims is now set forth.

Limitations common to all appealed claims

All of the claims under appeal relate generally to an umbrella apparatus (11, 111, 211) having a base support portion (stand portion 118, 218). The umbrella apparatus further comprises a pole portion (15, 115, 215) coupled to the base support portion, and a canopy portion (17, 117, 217) hingedly coupled to the pole portion (3:23–26; 5:26–31; 7:40–45; 12:40, 41).

All of the claims under appeal further recite a rechargeable electrical power system (e.g., a rechargeable battery) (50, 150, 250, 725, 825, 955) conductively coupled to a solar energy system (35, 135, 235, 727, 827, 957) to recharge the electrical power system when the sun is shining (4:49–57).

In addition to the features described above as common to all claims, Claim 2 recites a power module (725) that is carried by the pole above the canopy (12:35–40), the solar energy system being located in the upper portion of the power module (12:32–34), and the rechargeable electrical power system being located in the lower portion of the power module. There is no support for the rechargeable electrical power system in the apparatus of FIGS. 6–9; only a “battery compartment” (707, 807, 907) is recited with no mention of batteries (12:34, 35).

Claim 8 includes an electro-mechanical system (40) for opening and closing the canopy (17) (3:61–64), the electro-mechanical system being powered by the battery and including an electric motor (49), a control system, gears, cables, and pulleys (43) operatively connected to the electric motor for raising and lowering the canopy.

In Claim 49 there are lighting elements and electrical conductors recessed within the ribs (FIGS. 4A–C; 9:42–44).

Claim 50 depends from Claim 49 and adds the additional limitation that the lighting system includes multiple discrete lighting elements along each rib member (*see* FIGS. 4A–C).

Claim 52 recites multiple discrete lighting elements fully recessed within a corresponding rib (*see* FIGS. 4A–C).

Claim 56 recites that the solar energy system and the rechargeable electrical power system each form a separate part of a power module (12:31, 32; 12:34, 35).

Claim 57 recites that the rechargeable electrical power system (55) is disposed below the canopy (4:24–27).

Claim 58 depends from Claim 57 and recites a switch (47) carried by the crank housing (44) for controlling the system for opening and closing the canopy portion (4:13–15).

In Claim 60 each light (307) is recessed within a rib member (301) and covered by a translucent cover (305)(*see* FIGS. 4A–C).

Claim 61 recites a power unit (725) carried by the pole portion (719) above the canopy (717), wherein the rechargeable electrical power system (12:34, 35; recites a “battery compartment” (707, 807, 907) but no mention of the batteries) and the solar energy system (727) are component parts of the power unit. Further, the conductors (709) carrying power from the rechargeable electrical power system are carried by the corresponding rib member (717).

In Claim 70 each rib member has a recessed channel, and the lighting elements are disposed within the channel (*see* FIGS. 4A–C).

Claim 72 is similar to Claim 70, but in addition to the lighting elements being recessed within the channels, the electrical conductors are also recessed within the channels. Again, *see* FIGS. 4A–C.

In Claim 74 the power module (725) has upper and lower portions, with the solar panel (727) located in the upper portion of the power module and the battery located in the lower portion. There is no disclosure of a battery, only of the compartment within which the batteries are to reside.

ISSUES TO BE REVIEWED ON APPEAL

The issues to be reviewed on appeal are:

Did the Examiner err in concluding that Appellant’s submission of September 14, 2009, contained material outside the scope of permitted content pursuant to 37 CFR § 1.948, where the new prior art was submitted in response to arguments raised by the Respondent?

Did the Examiner exceed her authority by demanding that the appellant remove allegedly improper proposed arguments rather than correct alleged defects, where MPEP § 2666.05 specifically provides for replacement comments and contains no requirement that alleged defects be removed?

Did the Examiner err in refusing to consider Appellant’s comments of September 14, 2009, for violating the 50-page limit on submissions, where:

- removal of drawings from prior art references would have brought the page count below 50;
- a simple reformatting of the document to reduce font size and margins would have brought the page count below 50; and
- the Examiner failed to afford Appellant the notice and opportunity to correct specifically required by MPEP § 2667 I.B.2?

Did the Examiner err by failing to reject Claims 51 and 56 for failure to comply with the written description requirement of § 112(1)?

ARGUMENT

This case involves not only issues of patentability of the claims but also procedural errors made by the Examiner that prevented Appellant from introducing new prior art and having comments considered before the Action Closing Prosecution issued. Accordingly, a brief summary of the prosecution history will now be presented.

I. PROCEDURAL ERRORS IN THE REEXAMINATION PROSECUTION

Relevant Prosecution History

The Examiner issued the First Office Action on September 28, 2005. The Respondent filed a response to the Office Action on November 21, 2005, but the Examiner issued a Notification of Informal or Nonresponsive Amendment on December 5, 2005, declining to enter that response. The Respondent filed a corrected Amendment on December 12, 2005.

The Respondent filed an amendment on December 12, 2005, adding new Claims 45–74, a total of thirty new claims (there were only thirteen claims in the patent as issued). Of the new claims, twenty-two of the thirty were independent claims. For the first time Respondent attempted to claim a feature in which the rechargeable electrical power system and the solar energy system were contained in a common housing (Claims 45–48, 56, 59, 61, 64–66, 69–71).

The Examiner issued a Notice of Defective Paper on February 7, 2006, declining to enter the Respondent's amendment of December 12, 2005, and requiring correction. The Respondent filed a substitute amendment on February 7, 2006. In the subsequent Office Action of December 5, 2006, the Examiner noted that this submission was still noncompliant, but the legal staff of the CRU *sua sponte* made the necessary changes, and the submission was accepted by the Examiner.

Thus it was only *after* the Office Action of December 5, 2006, that the newly added claims 45–74 were compliant.

In response to the Office Action of December 5, 2006, the Respondent submitted an amendment on February 7, 2007, and the Appellant submitted responsive comments on March 9, 2007. But on July 27, 2008, the Examiner determined that the Respondent's submission of February 7, 2007, was defective and required correction. Respondent filed a corrected submission on August 27, 2008.

On March 20, 2009, the Examiner issued a Notice of Defective Paper that Respondent's corrected submission of August 27, 2008, was still defective. On April 21, 2009, the Respondent submitted a substitute amendment. In response, the Appellant submitted comments on May 18, 2009, which included new grounds for rejection.

On August 28, 2009, the Examiner issued a Notice of Defective Paper. On page 2 of the Notice, the Examiner rejected the Appellant's submission of May 18, 2009, because the proposed new rejections did not adequately discuss the pertinency of the new references. The Examiner stated that "in order for the examiner to properly evaluate the new proposed rejections, the third party requester's comments must present the newly proposed rejections in compliance with the guidelines set forth in MPEP § 2617." On p. 9 the Notice contended that the Appellant's submission of 14 September 2009 contains material outside the permitted content pursuant to 37 CFR § 1.948. The Examiner then stated: "The third party requester is given fifteen days to rectify and refile comments removing the improper proposed rejections." (Emphasis in original).

Requester filed corrected comments on September 14, 2009. Requester did not remove the proposed rejections but instead presented the newly proposed rejections in compliance with MPEP § 2617. Requester added more text to the original comments such that the 50 page limit set by 37 CFR § 1.943 was unintentionally exceeded. On October 22, 2009, the Examiner *sua sponte* returned the Appellant's comments of May 18, 2009, and had them expunged from the record. Appellant's comments of May 18, 2009, were not considered by the Examiner in the subsequent Action Closing Prosecution and are not part of the file history.

Because Appellant's comments of September 14, 2009, have been expunged from the record, a copy is attached as Exhibit B.

On November 16, 2009, Appellant filed five petitions seeking relief from the Examiner's determination of non-compliance on the basis of having exceeded the 50-page limit for the comments submitted September 14, 2009. All five petitions were either denied or dismissed by decisions dated March 1, 2010.

A. The Patent Office Erred in Expunging Appellant's Comments for Failing to Comply with MPEP § 2666.05.

1. The Appellant's submission of September 14, 2009, does not contain material outside the scope of permitted content pursuant to 37 CFR § 1.948.

The Examiner refused to enter Appellant's comments on the further basis that the submission included additional prior art, which the Examiner contends violates 37 CFR § 1.948. The examiner is in error, because the additional prior art rebuts a response of the patent owner. 37 CFR § 1.948(a)(2).

During prosecution the Respondent added a claim limitation not found in the claims of the original patent, *i.e.*, that the solar energy system and the rechargeable electrical power system both be contained within a common housing. Because this feature had not been claimed in the original patent, Appellant had not cited prior art in the Request for Reexamination that showed this feature.

To rebut Respondent's new claims, Appellant cited the following new prior art, copies of which are attached:

Patent No./App. No.	Inventor	Exhibit No.
5,055,984	Hung et al.	C
5,758,948	Hale	D
6,406,163	T. Yang	E
6,729,742	Wismeth	F

Each of these references relates to a feature covered by new claims that were not in the original patent. It was improper for the Examiner to refuse consideration of these references under 37 CFR § 1.948, and the case should be sent back to the Examiner for further prosecution.

2. The Examiner Exceeded Her Authority by Demanding that the Appellant Remove Allegedly Improper Proposed Arguments.

In the Office Action dated August 28, 2009, the examiner identified a number of allegedly improper new arguments in Requester's Comments of May 18, 2009. The examiner did not afford the Requester an opportunity to correct the alleged defects but instead, citing MPEP § 2666.05, limited Requester's remedies to removing the allegedly improper remarks, stating "The third party requester is given fifteen days to rectify and refile comments removing the improper proposed rejections."¹ (emphasis in original).

MPEP § 2666.05 does not require removing an improper proposed rejection. Rather, that section requires only that

[a]ny replacement comments submitted in response to the notification must be strictly limited to (*i.e.*, must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

Appellant's comments were strictly limited to the comments in the original. No new arguments or prior art were added, and no new basis for rejection was proposed. The only text added was to bring the existing comments into compliance with the guidelines set forth in MPEP § 2617.

If MPEP § 2666.05 were meant to require a party always to remove allegedly improper proposed rejections, it would have said so. Instead, it gives the party the latitude to add new text so long as the comments are strictly limited to the comments in the original. The Examiner's refusal to consider Appellant's remarks of May 18, 2009, because Appellant did not yield to the Examiner's improper requirement to delete the remarks is improper and should be reversed.

¹ Notice Re Defective Paper dated August 28, 2009, p. 2.

B. The Patent Office Erred in Expunging Appellant's Comments for Exceeding 50 Pages, Because the Submission Was in Actual Compliance with the 50-Page Limit.

The examiner's objections in the notice of deficiency of October 22, 2009, found the requester's Second Comments defective on the basis that they exceeded the 50-page limit, and the Second Comments were expunged from the record. However, the Third Party Requestor's Comments of September 14, 2009, were in full compliance with 37 C.F.R. § 1.943(b), and it was error for the examiner to expunge the comments from the record.

C.F.R. § 1.943(b) provides that "... written comments by the third party requester shall not exceed 50 pages in length, excluding ... reference materials such as prior art references." (Emphasis added.) Pages 16–27 of the Requester's Second Comments were devoted to a recap of the prior art in view of amendments made to the claims by the Patent Owner. To facilitate discussion of the prior art references, relevant drawing figures of the prior art were inserted into the text. These figures from prior art references constitute "reference materials such as prior art references" and do not count toward the 50-page limit. When these reference materials from prior art references are removed, the Third Party Requester's Second Comments fall well below the 50-page limit.

Attached as Exhibit G is a copy of Requester's Second Comments filed September 14, 2009. The document has been changed only in that the drawings from prior art references have been removed. Wording, spacing, fonts, and margins are unchanged from the original document. With the prior art reference drawing figures removed and no other changes made, the document is only 45 pages in length, well below the 50-page limit.

Because a majority of the drawings included within the body of the Comments constitute reference materials such as prior art references, they do not count toward the 50-page limit. Requester's Second Comments filed September 14, 2009, are in full compliance with the page limitations set by C.F.R. § 1.943(b). It was error for the examiner to expunge the comments from the record, and the examiner's confirmation of the claims should be reversed.

C. It Was Error for the General Counsel Not to Waive the Rules Regarding the 50-Page Limit

37 C.F.R. § 104.3 provides that, in extraordinary situations, when the interest of justice requires, the General Counsel may waive or suspend the rules of this part, *sua sponte* or on petition of an interested party to the Director, subject to such requirements as the General Counsel may impose.

The examiner's objections on October 22, 2009 (Second Objections), found the requester's Second Comments defective on the basis that they exceeded the 50-page limit, and the Second

Comments were expunged from the record. Requester requested that the 50-page limit be waived, as the submission was in substantial compliance.

Requester's Second Comments filed September 14, 2009, contained 55 pages. Notwithstanding the comments being 5 pages over the limit imposed by 37 C.F.R. § 1.943(b), the document was in substantial compliance with the regulation.

This is a classic case of form over substance. The 50-page limit of 37 C.F.R. § 1.943(b) is not imposed for the purpose of restricting the amount of paper that can be filed, but for restricting the number and length of arguments that can be submitted to the examiner.

37 C.F.R. § 1.52 states that documents filed with the USPTO, including reexamination, must be on either A4 size (21 cm x 29.7 cm) or 8-1/2 x 11 inch (letter size) paper. The top, right, and bottom margins must be at least 3/4 inch (2 cm), and the left margin must be at least 1 inch (2.5 cm). In addition, documents submitted to the PTO must be printed in type that is at least 12 point, non-script type and at least one-and-one-half spaced.

Requester filed the comments in question on letter-sized paper having margins of 1.5 inches top and 1 inch left, right, and bottom. Further, Requester's comments were filed in a larger typeface, 12.5 pts., and double spaced. Typeface selection changes not only the height of each line but also the amount of space between lines and the number of characters per line.

Attached as Exhibit H is a copy of Requester's Second Comments filed September 14, 2009. The document has been changed only in the following respects:

- the margins have been decreased to 1 inch on the left and 3/4 inch on the top, right, and bottom, as permitted by 37 C.F.R. § 1.52;
- the typeface is a smaller, non-script font, as permitted by 37 C.F.R. § 1.52, specifically Times New Roman 12 pt. font; and
- the spacing between lines has been decreased from double spaced to 1-1/2 spaced, as permitted by 37 C.F.R. § 1.52.

Not one word of the document has been changed, and all of the drawings remain in their original sizes. Simply by changing font and margins alone, the document has decreased from 57 to 43 pages, well under the 50-page limit.

By providing larger margins and a larger typeface, the requester's original submission did not contain any arguments that could not have been submitted, *verbatim*, in 43 pages. The 50-page limit has therefore been substantially met. The interest of justice requires a waiver or suspension of the rules.

As further evidence that this was an extraordinary situation in when the interest of justice requires a waiver or suspension of the rules, the disparity between the Examiner's treatments of the

Respondent and Appellant should be noted. On not one but TWO occasions, the Examiner made concessions on behalf of Respondent as to matters of form.

1. On November 21, 2005, Respondent filed an amendment in response to the office action of September 28, 2005. The examiner deemed the amendment defective by notice dated December 5, 2005. Respondent then filed a substitute amendment on December 19, 2005. In the subsequent Office Action of December 5, 2006, the examiner concluded that the substitute amendment was still defective as to a matter of form, but the legal staff of the CRU *sua sponte* made the necessary changes, and the submission was accepted by the Examiner.

2. On July 25, 2008, the Examiner imposed a Notice of Defective Paper relating to Respondent's amendment of February 7, 2007. On August 28, 2008, Respondent filed a substitute amendment. On March 20, 2009, the Examiner issued a SECOND Notice of Defective Paper, this time finding Respondent's substitute amendment of August 28, 2008, deficient. Respondent thus had a second opportunity to comply with the Notice of Defective paper, and did so in a substitute response dated April 21, 2009.

Appellant does not begrudge the leniency and common-sense approach afforded Respondent in making these corrections. It should be the goal of the patent office to be helpful and to address the substantive issues to determine whether a reexamined patent should be confirmed, rather than placing form over substance. But in the interest of equity and fairness, Appellant should have been afforded the same opportunities given to Respondent. In view of the fact that Appellant's 55-page brief could have been reformatted to less than 50 pages without changing a single word, it was error—a classic case of “form over substance”—not to waive the 50-page limit for the Replacement Comments filed September 14, 2009.

Because the Examiner has expunged Appellant's comments filed September 14, 2009 from the record and refused to consider the prior art or arguments contained therein, claims have been affirmed that are clearly invalid. This does injustice not only to Appellant but also to the public at large, in whose best interest it is to get invalid claims and patents removed from the books.

D. The Examiner Failed To Comply With the Requirements of M.P.E.P. § 2667 I.B.2

M.P.E.P. § 2667 I.B.2 provides that, where the length of the third party requester submission exceeds that permitted by 37 CFR 1.943, a Notice will be issued by the examiner and mailed to the third party requester permitting the third party requester to exercise one of the following two options:

- Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or

- File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement. (Emphasis added.)

The objections to requester's comments as exceeding the 50-page limit were raised for the first time in the Decision of October 22, 2009. The comments should not have immediately been expunged. Rather, the Examiner should have issued a notice to the Appellant under M.P.E.P. § 2667 to correct the submission to bring the submission below the 50-page limit. In this case the requester was never given notice under M.P.E.P. § 2667 that a submission exceeded the 50-page limit and was never afforded an opportunity to correct the submission, either by filing a re-drafted response or by redacting pages.

The examiner may argue that M.P.E.P. § 2666.05 "trumps" the notice provisions of M.P.E.P. § 2667, in that M.P.E.P. § 2666.05 provides for only a single opportunity by a requester to cure defective comments. But there is no suggestion anywhere in the M.P.E.P. or the C.F.R. that the notice requirement and opportunity to correct of M.P.E.P. § 2667 is in any way overruled by or of less import and effect than M.P.E.P. § 2666.05. There is nothing in M.P.E.P. § 2667 that makes the notice provision for exceeding the 50-page limit optional, nor is there anything suggesting that this provision does not apply when M.P.E.P. § 2666.05 is involved. The provision simply states that a notice WILL BE ISSUED to give a third party requestor an opportunity to revise a submission from a length of more than 50 pages to a length of 50 pages or less. The Examiner's position that MPEP § 2666.05 supersedes the notice provision of MPEP § 2667 lacks any authority in support. The Examiner's decision to simply ignore the notice provisions of M.P.E.P. § 2667 denied the Third Party Requester due process and are a grounds for reversal.

II. REJECTIONS UNDER 35 U.S.C. § 112(1)

A. Claims 2, 49, 52-58, 61, 62, 65, and 74 Fail to Satisfy the Written Description Requirement of § 112(1).

The Examiner has already rejected Claim 1 under 35 U.S.C. § 112(1) for failure to satisfy the "written description" requirement. Claims 56 and 61 contain the same limitations as Claim 1 that the Examiner determined there was no "written description," and so Claims 56 and 61 are similarly unpatentable for failure to comply with the written description requirement of § 112(1).

In the action closing prosecution dated March 2, 2010, at p. 14-15 the Examiner pointed out in her rejection of Claim 1 under § 112(1)²,

² Cite to ACP

With regard to claim 1, the base patent does not support an arrangement, where a solar energy system is carried by a module (power unit 725) on the same umbrella apparatus having “multiple discrete lighting elements positioned along at least one of the rib members” because only one light subassembly 721 is disclosed as being placed on an individual rib (Figure 6).

Claim 56 recites a rechargeable electrical power system and solar energy system each forming a separate component part of a power module. Claim 56 further recites a “lighting system comprising a plurality of lighting elements...” Claim 61 recites a “power unit” of which the rechargeable electrical system and the solar energy system are both component parts. Claim 61 further recites a “lighting system ... having a plurality of lighting elements...”

Claims 56 and 61 suffer the same defect. The base patent does not show a “power module” or “power unit” on the same umbrella apparatus having “a plurality of lighting elements,” as required by Claims 56 and 61. The examiner should have applied the same criteria to Claims 56 and 61 as he applied to Claim 1 and found Claims 56 and 61 unpatentable for failure to satisfy the written description requirement of § 112(1).

Claim 49 also fails to satisfy the written description requirement. Claim 49 does not limit in any way the location of the rechargeable electrical system. This is far broader in scope than what is contained in the written description. This language would literally permit the battery to be located on or in a rib of the umbrella, on the outside of the pole, or 100 feet away connected by a long wire. However, there is no written description of any of these embodiments. The specification discloses the battery as being located (a) within the post, (b) in the base (Fig. 3A), or in a housing above the canopy. A patentee cannot make a minor contribution to the art by disclosing only a few embodiments and then claim every possible way of accomplishing that result. Claim 49 is invalid under 35 U.S.C. § 112(1) for failing to comply with the written description requirement.

Claim 50 depends from Claim 49 and does not add any limitations regarding the location of the battery. Claim 50 thus also fails to satisfy the written description requirement.

Claim 52 suffers the same defect as Claim 49, in that the specification provides no support for the location of the rechargeable electrical power system except for the three identified with respect to Claim 49. Claims 53 and 54 depend from Claim 52 and add no additional limitations with regard to the location of the rechargeable electrical power system. Claims 53 and 55 are therefore unpatentable for failure to comply with the written description requirement.

Claim 57 fails to satisfy the written description requirement for the same reasons set forth above with respect to Claim 49, *i.e.*, there is no written support for the batteries to be located in any position other than the three named above.

Claim 58 depends from Claim 57 and does not further limit the location of the rechargeable electrical system. Claim 58 is therefore unpatentable for failure to satisfy the written description requirement for the same reasons as Claim 57.

Claims 2, 56, 61, 62, 65, and 74 are unpatentable for failure to satisfy the written description requirement of § 112(1). These claims relate to the embodiment of Figs. 6–9, in that they all recite the rechargeable electrical power system and solar power system contained in a common housing. However, the specification does not disclose a rechargeable electrical power system with respect to Figs. 6–9. Instead, the specification recites only an interior battery compartment. (“A bottom portion 705 of power unit 725 defines an interior battery compartment 707.” 12:34-35. “A bottom portion 805 of power unit 825 defines an interior battery compartment 807.” 13:12-13. “A bottom portion 905 of power unit 955 defines an interior battery compartment 907. 13:41-42. “A bottom portion 1005 of power unit 1055 defines an interior battery compartment 1007.” 14:9–11.). The battery compartment is not even disclosed as being in conductive contact with the solar cell. The battery compartment is not a “rechargeable electrical power system.” Claims 2, 56, 61, 62, 65, and 74 are thus all unpatentable for failure to comply with the written description requirement of § 112(1).

B. Claim 65 is obvious over Phyle and Small

Claim 65 depends from Claim 64, which stands rejected as being obvious under § 103(a) over Phyle and Small, for the reasons set forth by the Examiner in the ACP at pp. 40–42. The only feature of Claim 65 that is arguably not shown by the combination of Phyle and Small is the feature that the module is “releasably coupled” to the pole.

Making an element separable is generally not a grounds for patentability. The Examiner stated so at p. 28 of the ACP with respect to Claim 1:

“What WO 93/00840 fails to show is a module carrying the solar energy system that is releasably coupled to the pole portion.... These differences are obvious in light of the teachings of Small and Pan or Wu or JP 9-168415 or Yang or Mai.”

...

[M]aking a structure portable or movable is not sufficient to patentably distinguish over an otherwise old device. Likewise, making an old device separable has not been found to be an obvious modification.

See also M.P.E.P. 2144.04(V)(C)).

Further, the motivation for making a module removable is clear—to permit replacement of the module without having to replace the entire umbrella.

For the same reasons set forth by the Examiner with respect to Claim 1 at p. 28 in the ACP, merely making a module releasably coupled to the pole does not patentably distinguish over the