

REMARKS / ARGUMENTS

Status of Claims

Claims 35-58 are pending in the application. Claims 1-34 were previously cancelled. Claims 35-50 and 54-58 stand rejected. Claims 51-53 are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant makes no claim amendments in this response paper, leaving Claims 35-58 for further consideration in view of the accompanying remarks.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §102(b)

Claims 35-44, 46-50 and 54-58 stand rejected under pre-AIA 35 U.S.C. §102(b) as being anticipated by Zhang (U.S. Patent No. 7,722,227, hereinafter Zhang).

Applicant overcomes this rejection for the following reasons.

Applicant respectfully submits that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the *** claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’

a prior art reference.” *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (quoting *Titanium Metals Corp. of Am. V. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)).

“[A] prior art reference may anticipate without disclosing a feature of the claimed invention if that characteristic is *necessarily* present, or inherent, in the single anticipating reference.” *Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004) (emphasis added) (citing *Schering Corp. v. Geneva Pharmaceuticals, Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003)).

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Independent Claim 35 recites, inter alia:

“...wherein the power conditioner is disposed, configured and sized to fit at least partially within an interior space of: a nominally sized can light fixture; **and**, a nominally sized electrical junction box.” (Emphasis added).

Independent Claim 58 recites, inter alia:

“...wherein the power conditioner is disposed, configured and sized to fit at least partially within an interior space of: a nominally sized can light fixture; **and**, a nominally sized electrical junction box...”. (Emphasis added).

Here, Applicant is claiming not only a power conditioner, but a power conditioner that is specifically disposed, configured and sized to fit at least partially within an interior

space of a nominally sized can light fixture, **and** is specifically disposed, configured and sized to fit at least partially within an interior space of a nominally sized electrical junction box.

In alleging anticipation, the Examiner fails to show how Zhang anticipates the claim limitation directed to the power conditioner being disposed, configured and sized to fit at least partially within an interior space of: a nominally sized can light fixture; **and**, a nominally sized electrical junction box, as claimed. Applicant finds Zhang to be absent any disclosure of a can light fixture **and** an electrical junction box. In fact, a search for the term “junction box” or “junction” finds no such terms, and even a cursory review of the drawings shows no such structure.

As such, Applicant submits that Zhang fails to disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory.

In the event that the Examiner relies on anticipation by inherency, Applicant respectfully submits that anticipation by inherency requires that the missing element **necessarily** be present in the reference relied upon, which Applicant submits Zhang fails to do, as Zhang is specifically directed to “a recessed lighting fixture that provides improved heat dissipation and grounding” (col. 1, lines 16-17). Nowhere in Zhang does Applicant find even a hint of Zhang’s power conditioner (driver 42) being configured and sized to fit at least partially within an interior space of a nominally sized electrical junction box.

Regarding Claim 41 more specifically, here Applicant is claiming a continuous and uninterrupted heat flow path through the heat spreader and the heat sink. In alleging anticipation, the Examiner merely refers to Fig. 7 without any explanation as to where Zhang’s continuous and uninterrupted flow path is. In fact, Zhang specifically discloses a non-continuous and interrupted heat flow path between the heat spreader (trim cap 112, Fig. 5) and the heat sink (100, Fig. 5), as evidenced by the disassembled assembly drawing of Fig. 5 showing that the two parts are separate from one another, contrary to the claimed invention.

Regarding Claim 43 more specifically, here Applicant is claiming that the power conditioner be configured and sized to fit completely within an interior space of a nominally sized electrical junction box, which Applicant submits Zhang fails to disclose or even suggest, for reasons remarked upon above.

Regarding Claim 46 more specifically, here Applicant is claiming that the heat sink forms a trim plate (one and the same feature) that is disposed completely external of the can light fixture or the electrical junction box. In alleging anticipation, the Examiner merely refers to Fig. 1A without any explanation as to how the heat sink (100) forms the trim plate (44 in Fig. 1A, 52 in Fig. 5), to be one and the same feature, where they are both disposed completely external of the can light fixture. In fact, Zhang specifically discloses the heat sink (100) being disposed completely internal of the can light fixture (see Fig. 1A, for example), contrary to the claimed invention.

Regarding Claim 54 more specifically, here Applicant is claiming a specific structure where the heat spreader has mounting holes for securing it to an electrical junction box. In alleging anticipation, the Examiner merely refers to Fig. 1A without any explanation as to where Zhang's heat spreader (trim cap 112, see Fig. 5) has holes for mounting it to an electrical junction box. In fact, Zhang specifically discloses a complete absence of an electrical junction box (see Fig. 1A, for example), contrary to the claimed invention.

Regarding Claim 55 more specifically, here Applicant is claiming that the power conditioner be configured and sized to fit at least partially within an interior space of a nominally sized four-inch electrical junction box, which Applicant submits Zhang fails to disclose or even suggest, for reasons remarked upon above.

Regarding Claim 57 more specifically, here Applicant is claiming that the heat sink also serves as a trim plate (one and the same feature), where the heat sink/trim plate and the outer optic in combination have an overall height H , where the heat sink/trim plate has an overall diameter D , and where the ratio H/D is equal to or less than 0.25. In alleging anticipation, the Examiner merely refers to Fig. 7 without any explanation of how Zhang's heat sink (100) forms the trim plate (44 in Fig. 1A, 52 in Fig. 5), to be one

and the same feature, where the heat sink/trim plate (100 and 44, 52 in combination) have an overall height H that satisfies the claimed ratio H/D being equal to or less than 0.25.

Regarding Claim 58 more specifically, here Applicant is claiming, in addition to other remarks provided herein above, that the heat sink forms a trim plate (one and the same feature) that is disposed completely external of the can light fixture or the electrical junction box. In alleging anticipation, the Examiner does not specifically address this limitation of Claim 58 (see pp. 2-3 of the Office action, for example). However, with respect to Claim 46, which includes a similar limitation, the Examiner merely refers to Fig. 1A without any explanation as to how the heat sink (100) forms the trim plate (44 in Fig. 1A, 52 in Fig. 5), to be one and the same feature, where they are both disposed completely external of the can light fixture. In fact, Zhang specifically discloses the heat sink being disposed completely internal of the can light fixture (see Fig. 1A, for example), contrary to the claimed invention.

Dependent claims inherit all of the limitations of the respective base claim and any respective intervening claim.

In view of the foregoing remarks, Applicant submits that Zhang does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the rejection under 35 U.S.C. §102(b) has been traversed, and requests reconsideration and withdrawal of this rejection.

Rejections Under 35 U.S.C. §103(a)

Claim 45 stands rejected under pre-AIA 35 U.S.C. §103(a) as being unpatentable over Zhang in view of Roberge et al, (U.S. Patent No. 7,828,465, hereinafter Roberge).

Applicant overcomes these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of

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