Cranston J. Williams, Bar No. 162714
BAKER & HOSTETLER LLP
12100 Wilshire Boulevard, 15th Floor
Los Angeles, CA 90025-7120
Telephone: 310.820.8800
Facsimile: 310.820.8859
Email: cwilliams@bakerlaw.com

Kenneth J. Sheehan
A. Neal Seth
BAKER & HOSTETLER LLP
1050 Connecticut Ave NW, Ste 1100
Washington DC, 20036
Telephone: 202.861-1500
Facsimile: 202.861.1783
Email: ksheehan@bakerlaw.com
Email: nseth@bakerlaw.com

Attorneys for Defendant and Counterclaimant
WURTH ELECTRONICS MIDCOM, INC.

BAKER & HOSTETLER LLP
ATTORNEYS AT LAW
LOS ANGELES

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

HALO ELECTRONICS, INC.,

Plaintiff,

v.

BEL FUSE INC., ELEC & ELTEK (USA) CORPORATION, WURTH ELECTRONICS MIDCOM, INC., and XFMRS, INC.,

Defendants.

Case No. CV 07-06222 RMW

EXHIBITS IN SUPPORT OF MOTION OF DEFENDANT AND COUNTERCLAIMANT WURTH ELECTRONICS MIDCOM, INC. TO STAY THIS ACTION

Date: June 20, 2008
Time: 9:00 a.m.
Courtroom: 6 (Hon. Ronald M. Whyte)

Defendant and Counterclaimant Wurth Electronics Midcom, Inc. submits the following Exhibits, which are attached, in support of its motion to stay this action.

Exhibit A: Request for Ex Parte Reexamination Patent No. 5,656,985;

Exhibit B: Request for Ex Parte Reexamination Patent No. 6,297,720;

Exhibit C: Request for Ex Parte Reexamination Patent No. 6,297,721;

Exhibit D: Request for Ex Parte Reexamination Patent No. 6,320,489;

Exhibit E: Request for Ex Parte Reexamination Patent No. 6,344,785;

Exhibit F: Request for Ex Parte Reexamination Patent No. 6,662,431;

Exhibit G: United States Patent and Trademark Office filing data; and

Exhibit H: KLA-Tencor Corporation v. Nanometrics, Inc., 2006 WL708661 (N.D.Cal.)

Dated: May 6, 2008

Respectfully submitted,

BAKER & HOSTETLER LLP
CRANSTON J. WILLIAMS

BAKER & HOSTETLER LLP
KENNETH J. SHEEHAN
A. NEAL SETH

_____
Cranston J. Williams

Attorneys for Defendant and Counterclaimant
WURTH ELECTRONICS MIDCOM, INC.

BAKER & HOSTETLER LLP
ATTORNEYS AT LAW
LOS ANGELES

EXHIBIT A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.:	**5,656,985**		
Issued:	August 12, 1997	Reexamination Control No.:	Not Yet Assigned
Inventor:	Peter Lu et al.	Reexamination Filing Date:	Herewith
Serial No.:	08/513,573	Art Unit:	Not Yet Assigned
Filed:	August 10, 1995	Examiner:	Not Yet Assigned

For: ELECTRONIC SURFACE MOUNT PACKAGE

Mail Stop *Ex Parte* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR *EX PARTE* REEXAMINATION

Dear Sir:

Pursuant to 35 U.S.C. §§ 301-307 and 37 C.F.R. § 1.510, the undersigned on behalf of Wurth Electronics Midcom, Inc. ("Midcom") hereby requests an *ex parte* reexamination of U.S. Patent No. 5,656,985 ("the `985 patent"), a copy of which is appended hereto as **Attachment A**, that issued from U.S. Patent Application No. 08/513,573, filed on August 10, 1995.

The `985 patent, along with five other patents claiming priority back to the 08/513,573 application, is currently the subject of litigation in the U.S. District Court, Northern District of California, Case No. CV 07-06222 JCS ("the Halo Litigation"). That litigation was brought by Halo Electronics, Inc., the current owner of record of the `985 patent, against Midcom and three other companies. The other patents involved in the litigation are U.S. Patent Nos. 6,297,720; 6,297,721; 6,320,489; 6,344,785; and 6,662,431, for which Midcom is separately requesting *ex parte* reexamination. A copy of Halo's complaint is appended hereto as **Attachment B**. Midcom's Answer

and Counterclaim, as well as the Answer and Counterclaim of Elec & Eltek (USA) Corporation, are appended hereto as **Attachments C and D**, respectively. The Answer and Counterclaim, First Amended Answer and Counterclaim and Second Amended Answer and Counterclaim of XFMRS, Inc. are appended hereto as **Attachments E, F and G**, respectively. A copy of the Civil Action Docket Sheet for the Halo Litigation (obtained April 21, 2008) is appended hereto as **Attachment H**.

EX PARTE REEXAMINATION REQUIREMENTS UNDER 37 C.F.R § 1.510(a)-(f)

37 C.F.R. § 1.510(a) - Fee Payment

Payment for this reexamination request ($2,520, see 37 C.F.R. § 1.20(c)(1)) is enclosed.

37 CFR § 1.510(b)(1) - A Statement Pointing Out Each Substantial New Question of Patentability Based on Prior Patents and Printed Publications

1. Claims 1-8 of the '985 patent are rendered obvious under 35 U.S.C § 103(a) by U.S. Patent No. 5,212,345 ("*Gutierrez*"), which issued on May 18, 1993, appended hereto as **Attachment I**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown in such references as the article entitled "Mounting & Packaging Techniques For Toroidal Devices," authored by Harold Tischler, and published in the October 1993 *Proceedings: Electrical Electronics Insulation Conference and Electrical Manufacturing & Coil Winding Conference* ("*Tischler*"), appended hereto as **Attachment J**.

Gutierrez discloses a surface mount package for a toroidal transformer (or other circuit element). *Tischler* discloses mounting "one or several" (i.e., a plurality of) toroidal transformers within a single package, as well as molded-in terminations for surface mount pins.

2. Claims 1-8 of the '985 patent are rendered obvious under 35 U.S.C § 103(a) by the NPI catalog page for the 10BaseT Ethernet Surface Mount Transformers ("*NPI 10BaseT Catalog Page*") appended hereto as **Attachment K**, in view of the knowledge of those of ordinary skill in the art prior

to August 10, 1994, as shown by such references as the *Gongin H-16S* specification sheet, appended hereto as **Attachment L**, and the *Gongin RH-16* specification sheet, appended hereto as **Attachment M**.[1]

The *NPI 10BaseT Catalog Page* shows a surface mount package with a plurality of transformers. The *NPI 10BaseT Catalog Page* was publicly available prior to August 10, 1994, as confirmed by the NPI invoice to a customer, Xircom, appended hereto as **Attachment N**. That invoice shows that 10 of the 5366-30 devices included on the *NPI 10BaseT Catalog Page* were ordered and scheduled for delivery January 31, 1992. In addition, a later version of the *NPI 10BaseT Catalog Page* showing a June 1994 version date in the lower right hand corner, appended hereto as **Attachment O**, also confirms the public availability of the *NPI 10BaseT Catalog Page* prior to August 10, 1994.

The Gongin specification sheets show associated electronic component packages provided in surface mount and through-hole configurations that can be used in the manufacture of the products depicted in the *NPI 10BaseT Catalog Page*. The Gongin specification sheets also demonstrate that, by at least as early as May of 1987, through-hole packaging and surface mount packaging were known alternatives for electronic components.

3. Claims 1-8 of the '985 patent are rendered obvious under 35 U.S.C § 103(a) by the NPI catalog page for the Ethernet Isolation Transformers ("*NPI Isolation Transformers Catalog Page*"), appended hereto as **Attachment P**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by the *Gongin H-16S* (Attachment N).

The *NPI Isolation Transformers Catalog Page* depicts a through-hole package (Part Number NP5416) that includes a plurality of transformers. A copy of the *NPI Isolation Transformers Catalog Page* was publicly available prior to August 10, 1994, as demonstrated by the letter to NPI customer

[1] Although the Gongin specification sheets bear dates of 76.5.12, because these specifications were published in Taiwan and dated according to the Taiwanese Calendar, they use the 1911 founding of the Republic of China as a reference point in

Interphase dated October 28, 1991, appended hereto as **Attachment Q**, providing materials information regarding the NPI part number 5416. It is noted that page 2 of Attachment Q indicates that the 5416 part utilized silicone mummy compound for encasing the transformers in the device.

4. Claims 1-8 of the '985 patent are rendered obvious under 35 U.S.C § 103(a) by U.S. Patent No. 3,721,747 ("*Renskers*"), which issued on March 20, 1973, appended hereto as **Attachment R**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Tischler*. *Renskers* discloses a surface mount, dual in-line package containing a plurality of transformers. Although *Renskers* was considered during prosecution of the '985 patent, it was not considered in view of the *Tischl*er reference cited herein.

5. Claims 1-8 of the '985 patent are rendered obvious under 35 U.S.C § 103(a) by the article entitled "Surface Mount Transformers: A New Packaging Approach," authored by Brad J. McCormick et al., and published in the February 1993 issue of Surface Mount Technology ("*McCormick*"), appended hereto as **Attachment S**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Gutierrez* as cited herein. *McCormick* discloses a surface mount package containing a plurality of transformers.

6. Claims 1-8 of the '985 patent are rendered obvious under 35 U.S.C § 103(a) by JP 7161535 ("*Yuichi*") authored by Saito Yuichi, which published on June 23, 1995, appended hereto as **Attachment T** (including translation), in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Tischler*, *Renskers* or *McCormick*. *Yuichi* discloses a surface mount package containing a toroidal transformer.

It is noted that during prosecution of the '985 patent the applicant argued that "the present invention is directed toward applications for packages mounted on a printed circuit board in an electronic device, which requires very low current and voltages, and is for DC voltages only." *See*,

---

establishing the date. As measured against the '985 patent, the dates of these documents are May 12, 1987.

Amendment, filed August 2, 1996 (Page 5). Because all of the foregoing references fall within the scope of the invention as defined by the applicant, they are clearly "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385, 1397 (2007).

37 C.F.R. § 1.510(b)(2) - Claims for Which Reexamination is Requested and Detailed Explanation of Pertinency and Manner of Applying the Cited Prior Art to Every Claim for Which Reexamination is Requested.

Reexamination is requested of claims 1-8 of the '985 patent, i.e., all claims. A statement of the substantial new questions of patentability presented by this request for reexamination is provided below along with a detailed explanation of the pertinency and manner of applying the aforementioned references to each claim for which reexamination is requested.

1. Claims 1-8 Are Invalid Under 35 U.S. C §103 Over *Gutierrez* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package comprising:	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting (Col. 1, lines 5-9).
a one piece construction package having a side wall and an open bottom,	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package having a side wall and an open bottom (Col. 2, lines 37-47, Fig. 1).
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '985 patent itself ("Electronic surface mount packages

	are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of the said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).

Claim 2

2. An electronic surface mount package comprising:	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting (Col. 1, lines 5-9).
a construction package having a side wall and an open bottom,	***Gutierrez Patent***: *Gutierrez* discloses a construction package having a side wall and an open bottom (Fig. 1; Col. 2, lines 37-47).
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '985 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top),

	Renskers, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package (Fig. 1; Col 2. lines 37-47).

Claim 4

4. The package of claim 3 wherein said construction package has an open bottom.	***Gutierrez Patent***: *Gutierrez* discloses a construction package with an open bottom (Fig. 1; Col 2. lines 37-47).

Claim 5

5. The package of claim 4 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '985 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented

	without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the lead termination blocks disclosed in *Gutierrez* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 6

6. An electronic surface mount package for mounting on a printed circuit board in an electronic device, said electronic surface mount package comprising:	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting (Col. 1, lines 5-9). Variously throughout *Gutierrez* it states that the device is mounted to a PC board. *See*, e.g., Abstract.
a one piece construction package having a side wall and an open bottom,	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package having a side wall and an open bottom (Fig. 1; Col. 2, lines 37-47).
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '985 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and having a notched post upon	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each

which said wires from said transformers are wrapped and soldered thereon, respectively.	support member (Fig. 2; Col. 2, lines 53-62).

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***Gutierrez Patent***: *Gutierrez* discloses a standoff in the form of a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on the lead terminals (Fig. 3; Col. 3, lines 6-12).

Claim 8

8. An electronic surface mount package comprising:	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting (Col. 1, lines 5-9).
a construction package having a side wall and an open bottom,	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package having a side wall and an open bottom (Fig. 1; Col. 2, lines 37-47).
at least one toroid transformer carried within said package by a soft silicone material, said toroid transformer having a wire wrapped thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '985 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
at least one terminal pin molded within and extending from the bottom of said package, said pin	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (Items 18-32) extending laterally outward from the bottom ("base") of the body. These lead termination support members have notches in the form of a spool configuration, with

extending through a bottom of said side wall and having a notched post upon which said wire from said transformer is wrapped and soldered thereon.	opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).

2. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over the *NPI 10BaseT Catalog Page* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package comprising:	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a one piece construction package having a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package. By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of the said pins extending through a bottom of said side wall and having a notched post	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers

upon which said wires from said transformers are wrapped and soldered thereon, respectively.	are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 2

2. An electronic surface mount package comprising:	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a construction package having a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall. It would have been obvious to one of ordinary skill in the art to have an open bottom in view of the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top for which it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, forming an open bottom.
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package. By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art

having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference.*

Claim 4

4. The package of claim 3 wherein said construction package has an open bottom.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. It would have been obvious to one of ordinary skill in the art to have an open bottom in view of the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top for which it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings to instead configure it with an open bottom.

Claim 5

5. The package of claim 4 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '985 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e.,

	spacing, is also well known. Thus, the terminal leads disclosed in *NPI 10BaseT Catalog Page* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 6

6. An electronic surface mount package for mounting on a printed circuit board in an electronic device, said electronic surface mount package comprising:	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a one piece construction package having a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package. By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered.

and soldered thereon, respectively.	Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for containing a plurality of toroids, as indicated by the drawing on the Reference. It would have been obvious to utilize a standoff in connection with the 5366-30 package disclosed in the *NPI 10BaseT Catalog Page*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).

Claim 8

8. An electronic surface mount package comprising:	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a construction package having a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
at least one toroid transformer carried within said package by a soft	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package. By the early 1990's, it was known in this art to package a plurality of wire

silicone material, said toroid transformer having a wire wrapped thereon,	wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
at least one terminal pin molded within and extending from the bottom of said package, said pin extending through a bottom of said side wall and having a notched post upon which said wire from said transformer is wrapped and soldered thereon.	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

3. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over the *NPI Isolation Transformers Catalog Page* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites

	essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '985 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a one piece construction package having a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B).[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of the said pins extending through a bottom of said side wall and having a notched post upon which said wires from	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs

[2] Although not identified as such in the NPI Isolation Transformers Catalog Page, the transformers used in this device were indeed toroid transformers as shown in the April 28, 1994 Bill of Materials for the NP5417 part, appended hereto as **Attachment U**. As also shown in this Bill of Materials, a silicone paste was being used in construction of the device as was the Gongin RH-16 header. The NP5417 Bill of Materials was publicly available at least as early as September 15, 1994 when it was forwarded to Chris Nixon at 3Com Limited with the letter of **Attachment V**.

said transformers are wrapped and soldered thereon, respectively.	42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 2

2. An electronic surface mount package comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '985 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a construction package having a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall. It would have been obvious to one of ordinary skill in the art to have an open bottom in view of the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top for which it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, forming an open bottom.
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package.[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane

	material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference.*

Claim 4

4. The package of claim 3 wherein said construction package has an open bottom.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. It would have been obvious to one of ordinary skill in the art to have an open bottom in view of the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top for which it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, forming an open bottom.

Claim 5

5. The package of claim 4 wherein said posts are separated from one another	While the claim asserts that terminals should be separated to avoid arcing, the '985 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in

so as to avoid arcing.	accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the terminal leads disclosed in *NPI Isolation Transformers Catalog Page* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 6

6. An electronic surface mount package for mounting on a printed circuit board in an electronic device, said electronic surface mount package comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '985 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a one piece construction package having a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers carried within said package by a soft	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package.[2] Furthermore, by the early 1990's, it was

silicone material, said toroid transformers each having wires wrapped thereon,	known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a standoff in the form of "nubs" extending from the bottom of each package.

Claim 8

8. An electronic surface mount package comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*,

	which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '985 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a construction package having a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
at least one toroid transformer carried within said package by a soft silicone material, said toroid transformer having a wire wrapped thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package.[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers* (1973), which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
at least one terminal pin molded within and extending from the bottom of said package, said pin extending through a bottom of said side wall and having a notched post upon which said wire from said transformer is wrapped and soldered thereon.	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez* which discloses a plurality of pins (lead

	termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

4. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over *Renskers* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '985 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[3]
a one piece construction package having a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a one piece construction package having a side wall and open bottom (Figs. 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Renskers Patent***: Renskers discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material" (Figs. 2, 5; Col. 3, line 60).

[3] It is noted that the '985 patent recites that "**special design consideration** has been applied to thermal expansion of materials to ensure that the package will stand all normal reflow processes with low cost, easy manufacturing, and high reliability." Column 3, lines 7-11 (emphasis added). No detailed specifications regarding these "special design considerations" have been disclosed in the specification and thus, in addition to the issue regarding compliance with 35 U.S.C § 112, Paragraph 1, there is no support in the specification for distinguishing surface mount technology from other technologies such as through-hole mounting. In fact, twice in the specification the inventors specifically state that the invention is not limited to the disclosed embodiment. See Col. 1, line 65-Col. 2, line 4 and Col 3, lines 22-35.

a plurality of terminal pins molded within and extending from the bottom of said package, each of the said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).

Claim 2

2. An electronic surface mount package comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '985 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a construction package having a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a construction package having a side wall and open bottom. (Figs. 2, 3, 5; Col. 3, lines 63-66)
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having	***Renskers Patent***: Renskers discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material." (Figs. 2, 5; Col. 3, line 60)

wires wrapped thereon,	
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***Renskers Patent***: *Renskers* discloses a one piece construction package. (Figs. 2, 3, 5; Col. 3, lines 63-66)

Claim 4

4. The package of claim 3 wherein said construction package has an open bottom.	***Renskers Patent***: *Renskers* discloses a one piece construction package having a side wall and open bottom. (Figs. 2, 3, 5; Col. 3, lines 63-66)

Claim 5

5. The package of claim 4 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '985 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics

	is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the terminal leads disclosed in *Renskers* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 6

6. An electronic surface mount package for mounting on a printed circuit board in an electronic device, said electronic surface mount package comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '985 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a one piece construction package having a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a one piece construction package having a side wall and open bottom. (Figs. 2, 3, 5; Col. 3, lines 63-66)
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Renskers Patent***: *Renskers* discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material" (Figs. 2, 3, 5; Col. 3, line 60).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped and soldered thereon,	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into

respectively.	the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***Renskers Patent***: *Renskers* discloses standoffs 24, as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9).

Claim 8

8. An electronic surface mount package comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '985 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a construction package having a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a construction package having a side wall and open bottom. (Figs. 2, 3, 5; Col. 3, lines 63-66)
at least one toroid transformer carried within said package by a soft silicone material, said toroid transformer having a wire wrapped thereon,	***Renskers Patent***: Renskers discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material." (Figs. 2, 3, 5; Col. 3, line 60)

at least one terminal pin molded within and extending from the bottom of said package, said pin extending through a bottom of said side wall and having a notched post upon which said wire from said transformer is wrapped and soldered thereon.	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).

5. Claims 1-8 Are Invalid Under 35 U.S.C §103 Over *McCormick* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package comprising:	***McCormick Reference***: *McCormick* discloses an electronic surface mount package (Page 27).
a one piece construction package having a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a one piece housing with a side wall and an open bottom (Illustration, Page 27).
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids (Illustration, Page 27). *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to encapsulate the entire unit (Page 27). The cup is formed from molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of the said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which

wrapped and soldered thereon, respectively.	discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 2

2. An electronic surface mount package comprising:	***McCormick Reference***: *McCormick* discloses an electronic surface mount package (Page 27).
a construction package having a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a construction package ("housing") with a side wall and an open bottom (Illustration, Page 27).
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids. (Illustration, Page 27) *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to encapsulate the entire unit. (Page 27) The cup is formed from molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***McCormick Reference***: *McCormick* discloses a one piece construction package ("housing") (Illustration, Page 27).

Claim 4

4. The package of claim 3 wherein said construction	***McCormick Reference***: *McCormick* discloses a one piece construction package ("housing") with an open bottom (Illustration, Page 27).

package has an open bottom.	

Claim 5

5. The package of claim 4 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '985 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the terminal leads disclosed in *McCormick* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 6

6. An electronic surface mount package for mounting on a printed circuit board in an electronic device, said electronic surface mount package comprising:	***McCormick Reference***: *McCormick* discloses an electronic surface mount package that is soldered to a printed circuit board (PCB) (Pages 27, 31).
a one piece construction package having a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a one piece construction package ("housing") with a side wall and an open bottom (Illustration, Page 27).
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids (Illustration, Page 27). *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to encapsulate the entire unit (Page 27). The cup is formed from molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).

a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***McCormick Reference***: *McCormick* discloses fully molded and potted toroids in a housing suited for automatic surface mount placement and high temperature assembly (Illustration, Page 27). It would have been necessary and obvious to utilize a standoff in connection with the device disclosed in *McCormick*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).

Claim 8

8. An electronic surface mount package comprising:	***McCormick Reference***: *McCormick* discloses an electronic surface mount package (Page 27).
a construction package having a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a construction package ("housing") with a side wall and an open bottom (Illustration, Page 27).
at least one toroid transformer carried within said package by a soft silicone material, said toroid	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids (Illustration, Page 27). *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to

transformer having a wire wrapped thereon,	encapsulate the entire unit (Page 27). The cup is formed from molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).
at least one terminal pin molded within and extending from the bottom of said package, said pin extending through a bottom of said side wall and having a notched post upon which said wire from said transformer is wrapped and soldered thereon.	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

6. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over *Yuichi* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for a transformer with a recess open to the mounting face side of the package (Section [0003]).
a one piece construction package having a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall and an open bottom (Figs. 1, 4).
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '985 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top),

	Renskers, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of the said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally from, and through, the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 2

2. An electronic surface mount package comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for a transformer with a recess open to the mounting face side of the package (Section [0003]).
a construction package having a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall and an open bottom (Figs. 1, 4).
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '985 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids

	(Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally from, and through, the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 (Figs. 1, 4).

Claim 4

4. The package of claim 3 wherein said construction package has an open bottom.	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has an open bottom (Figs. 1, 4).

Claim 5

5. The package of claim 4 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '985 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e.,

	spacing, is also well known. It is presumed, therefore, that the terminal leads disclosed in the *Yuichi* Patent are spaced apart by an amount sufficient to avoid arcing.

Claim 6

6. An electronic surface mount package for mounting on a printed circuit board in an electronic device, said electronic surface mount package comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for a transformer with a recess open to the mounting face side of the package (Section [0003]). *Yuichi* further discloses the package for mounting on a printed circuit board ("IC Card") (Section [0004]).
a one piece construction package having a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall and an open bottom (Figs. 1, 4).
a plurality of toroid transformers carried within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '985 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom of said side wall and having a notched post upon which said wires from said transformers are wrapped	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally from, and through, the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for

and soldered thereon, respectively.	retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***Yuichi Patent***: *Yuichi's* standoff 2c maintains the distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).

Claim 8

8. An electronic surface mount package comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for a transformer with a recess open to the mounting face side of the package (Section [0003]). *Yuichi* further discloses the package for mounting on a printed circuit board ("IC Card") (Section [0004]).
a construction package having a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall and an open bottom (Figs. 1, 4).
at least one toroid transformer carried within said package by a soft silicone material, said toroid transformer having a wire wrapped thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '985 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
at least one terminal pin	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending

molded within and extending from the bottom of said package, said pin extending through a bottom of said side wall and having a notched post upon which said wire from said transformer is wrapped and soldered thereon.	laterally from, and through, the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

37 CFR § 1.510(b)(3) - A Copy of Every Patent or Printed Publication Relied Upon or Referred to in Paragraph (b)(1) and (2)

Copies of every patent or printed publication relied upon or referred to in Paragraph (b)(1) and (2) are attached as Attachments I-V.

37 C.F.R. § 1.510(b)(4) - Copy of the '985 Patent

A double-column copy of the subject '985 patent with the Certificate of Correction dated December 23, 1997 is enclosed as **Attachment A** to this Request for Reexamination.

37 C.F.R § 1.510(b)(5) - A Certification That a Copy of the Request Filed by a Person Other Than the Patent Owner Has Been Served in its Entirety on the Patent Owner at the Address as Provided for in § 1.33(c)

A certification that a copy of the request filed has been served to the patent owner at the address as provided for in § 1.33(c) is attached.

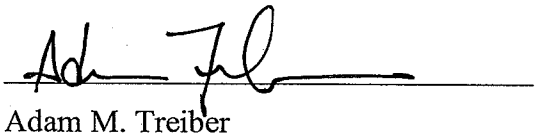
37 C.F.R. § 1.510(f) - Statement of Representative Capacity

This request for *ex parte* reexamination is made on behalf of Midcom pursuant to 37 C.F.R. § 1.510(a). The undersigned attorney, Adam M. Treiber (Reg. No. 48,000) hereby confirms that he is acting in a representative capacity for Midcom in this matter pursuant to 37 C.F.R. § 1.34.

CONCLUSION

The patents and references cited in this request for reexamination present a substantial new question of patentability with respect to claims 1-8 of the '985 patent. Therefore, *ex parte* reexamination of the '985 patent is respectively requested pursuant to 35 U.S.C. §§ 301-307 and 37 C.F.R. § 1.510.

Respectively submitted,

Date: May 5, 2008 By: 

Adam M. Treiber
Registration No. 48,000
Attorney for Requestor

#102247488_2

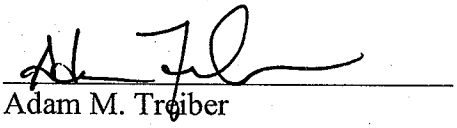
INDEX OF "ATTACHMENTS" TO REQUEST FOR REEXAMINATION

Attachment A:	U.S. Patent Number 5,656,985 (Lu et al.)
Attachment B:	Plaintiff Halo's Complaint
Attachment C:	Defendant Midcom's Answer and Counterclaim
Attachment D:	Defendant Elec & Eltek (USA) Corporation Answer and Counterclaim
Attachment E:	Defendant XFMRS, Inc.'s Answer and Counterclaim
Attachment F:	Defendant XFMRS, Inc.'s First Amended Answer and Counterclaim
Attachment G:	Defendant XFMRS, Inc.'s Second Amended Answer and Counterclaim
Attachment H:	Civil Action Docket Sheet
Attachment I:	U.S. Patent Number 5,212,345 (*Gutierrez*)
Attachment J:	*Tischler* Reference
Attachment K:	*NPI 10BaseT Catalog Page*
Attachment L:	*Gongin H-16S* Specification Sheet
Attachment M:	*Gongin RH-16* Specification Sheet
Attachment N:	NPI/Xircom Invoice
Attachment O:	NPI 10BaseT June 1996 Catalog Page
Attachment P:	*NPI Isolation Transformers Catalog Page*
Attachment Q:	NPI/Interphase October 28, 1991 Letter
Attachment R:	U.S. Patent Number 3,721,747 (*Renskers*)
Attachment S:	*McCormick* Reference
Attachment T:	*Yuichi* Patent – JP7161535
Attachment U:	NP5417 Bill of Materials
Attachment V:	September 15, 1995 Letter to Chris Nixon of 3Com Limited

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Request for *Ex Parte* Reexamination was concurrently served by first-class mail on Halo Electronics, Inc., at the address provided for under 37 C.F.R. § 1.33(c):

Haynes, Mark (30846)
Beffel, Ernest Jr (43489)
Wolfeld, Warren (31454)
Haynes Beffel & Wolfeld LLP
P.O. Box 366
Half Moon Bay, CA 94019



Adam M. Treiber
Registration No. 48,000
Baker & Hostetler LLP

EXHIBIT B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.:	**6,297,720**	
Issued:	October 2, 2001	Reexamination Control No.: Not Yet Assigned
Inventor:	Peter Lu et. al	Reexamination Filing Date: Herewith
Serial No.:	08/773,555	Art Unit: Not Yet Assigned
Filed:	December 27, 1996	Examiner: Not Yet Assigned
For:	ELECTRONIC SURFACE MOUNT PACKAGE	

Mail Stop *Ex Parte* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR *EX PARTE* REEXAMINATION

Dear Sir:

Pursuant to 35 U.S.C. §§ 301-307 and 37 C.F.R. § 1.510, the undersigned on behalf of Wurth Electronics Midcom, Inc. ("Midcom") hereby requests an *ex parte* reexamination of U.S. Patent No. 6,297,720 ("the '720 patent"), a copy of which is attached as **Attachment A**, that issued from U.S. Patent Application No. 08/773,555, filed on December 27, 1996.

The '720 patent, along with five other patents claiming priority back to the same parent application, U.S. Ser. No. 08/513,573, is currently the subject of litigation in the U.S. District Court, Northern District of California, Case No. CV 07-06222 JCS ("the Halo Litigation"). That litigation was brought by Halo Electronics, Inc., the current owner of record of the '720 patent, against Midcom and three other companies. The other patents involved in the litigation are U.S. Patent Nos. 5,656,985; 6,297,721; 6,320,489; 6,344,785; and 6,662,431, for which Midcom is separately requesting *ex parte* reexamination. A copy of Halo's complaint is appended hereto as **Attachment B**. Midcom's Answer and Counterclaim as well as the Answer and Counterclaim of Elec & Eltek (USA) Corporation are

appended hereto as **Attachments C and D**, respectively. The Answer and Counterclaim, First Amended Answer and Counterclaim and Second Amended Answer and Counterclaim of XFMRS, Inc. are appended hereto as **Attachments E, F and G**, respectively. A copy of the Civil Action Docket Sheet for the Halo Litigation (obtained April 21, 2008) is appended hereto as **Attachment H**.

EX PARTE REEXAMINATION REQUIREMENTS UNDER 37 C.F.R § 1.510(a)-(f)

37 C.F.R. § 1.510(a) - Fee Payment

Payment for this reexamination request ($2,520, see 37 C.F.R. § 1.20(c)(1)) is enclosed.

37 CFR § 1.510(b)(1) - A Statement Pointing Out Each Substantial New Question of Patentability Based on Prior Patents and Printed Publications

1. Claims 1-8 of the '720 patent are rendered obvious under 35 U.S.C § 103(a) by U.S. Patent No. 5,212,345 ("*Gutierrez*"), which issued on May 18, 1993, appended hereto as **Attachment I**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown in such references as the article entitled "Mounting & Packaging Techniques For Toroidal Devices," authored by Harold Tischler, and published in the October 1993 *Proceedings of Electrical Electronics Insulation Conference and Electrical Manufacturing & Coil Winding Conference* ("*Tischler*"), appended hereto as **Attachment J**.

Gutierrez discloses a surface mount package for a toroidal transformer (or other circuit element). *Tischler* discloses mounting "one or several" (i.e., a plurality of) toroidal transformers within a single package, as well as molded-in terminations for surface mount pins.

2. Claims 1-8 of the '720 patent are rendered obvious under 35 U.S.C § 103(a) by the NPI catalog page for the 10BaseT Ethernet Surface Mount Transformers ("*NPI 10BaseT Catalog Page*") appended hereto as **Attachment K**, in view of the knowledge of those of ordinary skill in the art prior

to August 10, 1994, as shown by such references as the *Gongin H-16S* specification sheet, appended hereto as **Attachment L**, and the *Gongin RH-16* specification sheet, appended hereto as **Attachment M**.[1]

The *NPI 10BaseT Catalog Page* shows a surface mount package with a plurality of transformers. The *NPI 10BaseT Catalog Page* was publicly available prior to August 10, 1994, as confirmed by the NPI invoice to a customer, Xircom, appended hereto as **Attachment N**. That invoice shows that 10 of the 5366-30 devices included on the *NPI 10BaseT Catalog Page* were ordered and scheduled for delivery January 31, 1992. In addition, a later version of the *NPI 10BaseT Catalog Page* showing a June 1994 version date in the lower right hand corner, appended hereto as **Attachment O**, also confirms the public availability of the *NPI 10BaseT Catalog Page* prior to August 10, 1994.

The Gongin specification sheets show associated electronic component packages provided in surface mount and through-hole configurations that can be used in the manufacture of the products depicted in the *NPI 10BaseT Catalog Page*. The Gongin specification sheets also demonstrate that, by at least as early as May of 1987, through-hole packaging and surface mount packaging were known alternatives for electronic components.

3. Claims 1-8 of the '720 patent are rendered obvious under 35 U.S.C § 103(a) by the NPI catalog page for the Ethernet Isolation Transformers ("*NPI Isolation Transformers Catalog Page*"), appended hereto as **Attachment P**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by the *Gongin H-16S* (Attachment N). The *NPI Isolation Transformers Catalog Page* depicts a through-hole package (Part Number NP5416) that includes a plurality of transformers. A copy of the *NPI Isolation Transformers Catalog Page* was publicly available prior to

[1] Although the *Gongin* specification sheets bear dates of 76.5.12, because these specifications were published in Taiwan and dated according to the Taiwanese Calendar, they use the 1911 founding of the Republic of China as a reference point in establishing the date. As measured against the '720 patent, the dates of these documents are May 12, 1987.

August 10, 1994, as demonstrated by the letter to NPI customer Interphase dated October 28, 1991, appended hereto as **Attachment Q**, providing materials information regarding the NPI part number 5416. It is noted that page 2 of Attachment Q indicates that the 5416 part utilized silicone mummy compound for encasing the transformers in the device.

4. Claims 1-8 of the '720 patent are rendered obvious under 35 U.S.C § 103(a) by U.S. Patent No. 3,721,747 ("*Renskers*"), which issued on March 20, 1973, appended hereto as **Attachment R**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Tischler*. Although *Renskers* was considered during prosecution of the '720 patent, it was not considered in view of the *Tischle*r reference as cited herein.

5. Claims 1-8 of the '720 patent are rendered obvious under 35 U.S.C § 103(a) by the article entitled "Surface Mount Transformers: A New Packaging Approach," authored by Brad J. McCormick et al., and published in the February 1993 issue of Surface Mount Technology ("*McCormick*"), appended hereto as **Attachment S**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Gutierrez* as cited herein.

6. Claims 1-8 of the '720 patent are rendered obvious under 35 U.S.C § 103(a) by JP 7161535 ("*Yuichi*") authored by Saito Yuichi, which published on June 23, 1995, appended hereto as **Attachment T** (including translation), in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Tischler*, *Renskers* or *McCormick.*

It is noted that the '720 patent is a continuation-in-part of parent patent 5,656,985. Disclosure added to the '720 patent included the following language found at Col. 2, lines 32-36: "As will be described in more detail below, the present invention is directed toward applications for packages mounted on a printed circuit board in an electronic device, which requires very low current and voltages, and is for DC voltages only." Because all of the foregoing references fall within the scope of

the invention as defined by the applicant, they are clearly "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007).

37 C.F.R. § 1.510(b)(2) - Claims for Which Reexamination is Requested and Detailed Explanation of Pertinency and Manner of Applying the Cited Prior Art to Every Claim for Which Reexamination is Requested.

Reexamination is requested of claims 1-8 of the '720 patent, i.e., all claims. A statement of the substantial new questions of patentability presented by this request for reexamination is provided below along with a detailed explanation of the pertinency and manner of applying the aforementioned references to each claim for which reexamination is requested.

1. Claims 1-8 are Invalid Under 35 U.S.C §103 Over *Gutierrez* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said package comprising:	***Gutierrez Patent***: *Gutierrez* describes an electronic surface mount component package (Col. 1, lines 5-9). Variously throughout *Gutierrez* it states that the device is mounted to a PC board. *See*, e.g., Abstract.
a one piece open construction package having a side wall,	***Gutierrez Patent***: Gutierrez describes a one piece construction package having a side wall (Col. 2, lines 37-47; Fig. 1).
a plurality of toroid transformers within said package, said toroid transformers each having wires wound thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '720 patent itself ("Electronic surface

	mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the terminal pins forming solder posts and extending through and below the bottom of said side wall,	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body (Fig. 2; Col. 2, lines 53-62).
said solder posts each having an hour-glass shaped notch upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Gutierrez Patent***: *Gutierrez's* lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).
the other end of each of the terminal pins extending in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***Gutierrez Patent***: Gutierrez describes lead termination blocks or support members extending in a gull wing fashion "outwardly" from opposite sides at the base thereof. (Fig. 2; Col. 2, lines 53-56).

Claim 2

2. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Gutierrez Patent***: *Gutierrez* describes an electronic surface mount component package (Col. 1, lines 5-9). Variously throughout *Gutierrez* it states that the device is mounted to a PC board. *See*, e.g., Abstract.
a one piece open construction package having a side wall,	***Gutierrez Patent***: Gutierrez describes a one piece construction package having a side wall (Col. 2, lines 37-47; Fig. 1).
a plurality of toroid transformers within said	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core,

package in a soft silicone material, said toroid transformers each having wires wound thereon,	and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '720 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the terminal pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).
the other end of each of the terminal pins extending outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***Gutierrez Patent***: Gutierrez describes lead termination blocks or support members extending "outwardly" from opposite sides at the base thereof for mounting onto the surface of the printed circuit board. (Fig. 2; Col. 2, lines 53-56).

Claim 3

3. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Gutierrez Patent***: *Gutierrez* describes an electronic surface mount component package (Col. 1, lines 5-9). Variously throughout *Gutierrez* it states that the device is mounted to a PC board. *See*, e.g., Abstract.
a construction package having a side wall and an	***Gutierrez Patent***: Gutierrez describes construction package having a side wall and an open bottom (Fig. 1; Col. 2, lines 37-47).

open bottom,	
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '720 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).

Claim 4

4. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said electronic surface mount package comprising:	***Gutierrez Patent***: *Gutierrez* describes an electronic surface mount component package (Col. 1, lines 5-9). Variously throughout *Gutierrez* it states that the device is mounted to a PC board. *See*, e.g., Abstract.
a one piece open construction package having a side wall,	***Gutierrez Patent***: Gutierrez describes a one piece construction package having a side wall (Col. 2, lines 37-47; Fig. 1).

a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '720 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends molded pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).

Claim 5

5. The package as in claim 4 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***Gutierrez Patent***: *Gutierrez* discloses a standoff in the form of a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on the lead terminals (Fig. 3; Col. 3, lines 6-12).

Claim 6

6. An electronic surface mount package for mounting onto the surface of a printed	***Gutierrez Patent***: *Gutierrez* describes an electronic surface mount component package (Col. 1, lines 5-9). Variously throughout *Gutierrez* it states that the device is mounted to a PC board. *See*, e.g.,

circuit board comprising:	Abstract.
an open construction package having a side wall,	***Gutierrez Patent***: Gutierrez describes a one piece construction package having a side wall (Col. 2, lines 37-47; Fig. 1).
at least one toroid transformer within said package in a soft silicone material, said toroid transformer having a wire wound thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '720 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
at least one terminal pin molded within the side wall of said package, said one end forming a solder post extending through and below the bottom of said side wall said solder post having a notched post upon which said wire from said transformer is wrapped and soldered thereon.	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).

Claim 7

7. The package as in claim 6 wherein the package includes an end wall to form a safe guard and wherein said one end of said terminal pin extends below the bottom of the side wall but does not extend below the safe guard.	***Gutierrez Patent***: *Gutierrez* discloses a package that includes an extension 58 that forms a portion of the side wall, as well as the end wall, and acts as a safe guard (Fig. 3; Col. 3, lines 6-18).

Claim 8

8. The package as in claim 7 wherein the terminal pin has another end which extends in wing like fashion through the other side of the side wall below the bottom of the package to form a surface mounting portion for mounting on the surface of the printed circuit board.	Prior to August 10, 1994, it would have been obvious to a practitioner skilled in the art to have the other end of each of the terminal pins extending in a wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board. For example, the *Gongin H-16S Reference* shows terminal pins with another end extending in a wing like fashion through the other side of the side wall below the bottom of the package to form a surface mounting portion for mounting on the surface of the printed circuit board. Thus, it would have been obvious to one skilled in the art at the time of the filing of the '720 patent to mount the device on a printed circuit board in an electronic device.

2. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over the *NPI 10BaseT Catalog Page* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said package comprising:	***NPI 10BaseT Catalog Page***: *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a one piece open construction package having a side wall,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall.
a plurality of toroid transformers within said package, said toroid transformers each having wires wound thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B). By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a single package (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a single package (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Text and Illustration, Page 27).
a plurality of terminal pins	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page*

molded within the side wall of said package, the ends of the terminal pins forming solder posts and extending through and below the bottom of said side wall,	discloses a plurality of terminal pins whose ends form solder posts. It was known in this art to have molded in pins extending through and below the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted.
said solder posts each having an hour-glass shaped notch upon which said wires from said transformers are wrapped and soldered thereon, respectively,	Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62). It would be further obvious to one skilled in the art that these notches would be in an "hour-glass" shape, upon which transformer wires are wrapped and soldered thereon.
the other end of each of the terminal pins extending in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.

Claim 2

2. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a one piece open construction package having a side wall,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall.
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package. By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*,

	which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the terminal pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
the other end of each of the terminal pins extending outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, so that the other end of each of the terminal pins extends outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.

Claim 3

3. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a construction package having a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece

	construction package as shown by the *Gongin H-16S Reference*, which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B). By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 4

4. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said electronic	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.

surface mount package comprising:	
a one piece open construction package having a side wall,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall.
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B). By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends molded pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 5

5. The package as in claim 4 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for containing a plurality of toroids, as indicated by the drawing on the Reference. It would have been obvious to utilize a standoff in connection with the 5366-30 package disclosed in the *NPI 10BaseT Catalog Page*. The utilization

board.	of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).

Claim 6

6. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
an open construction package having a side wall,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall.
at least one toroid transformer within said package in a soft silicone material, said toroid transformer having a wire wound thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B). By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
at least one terminal pin molded within the side wall of said package, said one end forming a solder post extending through and below the bottom of said side wall said solder post having a notched post upon which said wire from said transformer is	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered.

wrapped and soldered thereon.	Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 7

7. The package as in claim 6 wherein the package includes an end wall to form a safe guard and wherein said one end of said terminal pin extends below the bottom of the side wall but does not extend below the safe guard.	It would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings of *Gongin H-16S Reference,* thereby having the ends of the terminal pins forming solder posts extending below the bottom of the side wall, but not below the safe guard.

Claim 8

8. The package as in claim 7 wherein the terminal pin has another end which extends in wing like fashion through the other side of the side wall below the bottom of the package to form a surface mounting portion for mounting on the surface of the printed circuit board.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package having pins which extend in wing like fashion from the side wall for mounting to a printed circuit board.

3. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over the *NPI Isolation Transformers Catalog Page* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said package	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*,

comprising:	which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '720 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a one piece open construction package having a side wall,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall.
a plurality of toroid transformers within said package, said toroid transformers each having wires wound thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* describes a plurality of wound toroid transformers carried within a package (Center Drawing Between Package A and Package B).[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Text and Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the terminal pins forming solder posts and extending through and below the bottom of said side wall,	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted.
said solder posts each having	Prior to August 10, 1994, it was already known in this art to utilize

[2] Although not identified as such in the NPI Isolation Transformers Catalog Page, the transformers used in this device were indeed toroid transformers as shown in the April 28, 1994 NP5417 part Bill of Materials, appended hereto as Attachment U. As also shown in this Bill of Materials, the Gongin RH-16 header was used in the construction of this device as was a silicone paste. The NP5417 Bill of Materials was publicly available at least as early as September 15, 1994 when it was forwarded to Chris Nixon at 3Com Limited with the letter of Attachment V.

an hour-glass shaped notch upon which said wires from said transformers are wrapped and soldered thereon, respectively,	notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62). It would be further obvious to one skilled in the art that these notches would be in an "hour-glass" shape, upon which transformer wires are wrapped and soldered thereon.
the other end of each of the terminal pins extending in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.

Claim 2

2. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages.
a one piece open construction package having a side wall,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall.
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* describes a plurality of wound toroid transformers carried within a package.[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which

	discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the terminal pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the sidewall (Package B). It would have been obvious to one skilled in the art in view of the *Gongin H-16S Reference* to reverse the lead bending of the gull-wings, thereby having the ends of the terminal pins forming solder posts that extend through and below the bottom of the sidewall. Additionally, it would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
the other end of each of the terminal pins extending outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top, but it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, so that the other end of each of the terminal pins extends outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.

Claim 3

3. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of

	the packages.
a construction package having a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill of the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings, thereby forming an open bottom.
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* describes a plurality of wound toroid transformers carried within a package.[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the sidewall (Package B). It would have been obvious to one skilled in the art in view of the *Gongin H-16S Reference* to reverse the lead bending of the gull-wings, thereby having the ends of the terminal pins forming solder posts that extend through and below the bottom of the sidewall. Additionally, it would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 4

4. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said electronic surface mount package comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages.
a one piece open construction package having a side wall,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill of the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings, thereby forming an open bottom.
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* describes a plurality of wound toroid transformers carried within a package. (Center Drawing Between Package A and Package B).[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends molded pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon,	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the sidewall (Package B). It would have been obvious to one skilled in the art in view of the *Gongin H-16S Reference* to reverse the lead bending of the gull-wings, thereby having the ends of the terminal pins forming solder posts that extend through and below the bottom of the sidewall. Additionally, it would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the

respectively.	transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 5

5. The package as in claim 4 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a standoff in the form of "nubs" extending from the bottom of the package, for the purpose of maintaining a distance between the bottom of the pins and the printed circuit board.

Claim 6

6. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages.
an open construction package having a side wall,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall.
at least one toroid transformer within said package in a soft silicone material, said toroid transformer having a wire wound thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* describes a plurality of wound toroid transformers carried within a package.[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single

	package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
at least one terminal pin molded within the side wall of said package, said one end forming a solder post extending through and below the bottom of said side wall said solder post having a notched post upon which said wire from said transformer is wrapped and soldered thereon.	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the sidewall (Package B). It would have been obvious to one skilled in the art in view of the *Gongin H-16S Reference* to reverse the lead bending of the gull-wings, thereby having the ends of the terminal pins forming solder posts that extend through and below the bottom of the sidewall. Additionally, it would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

Claim 7

7. The package as in claim 6 wherein the package includes an end wall to form a safe guard and wherein said one end of said terminal pin extends below the bottom of the side wall but does not extend below the safe guard.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a standoff in the form of "nubs" extending from the bottom of the package, for the purpose forming a safeguard. It would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings of *Gongin H-16S Reference,* thereby having the ends of the terminal pins forming solder posts extending below the bottom of the side wall, but not below the safe guard.

Claim 8

8. The package as in claim 7 wherein the terminal pin has another end which extends in wing like fashion through the other side of the side wall below the bottom of the package to form a surface mounting portion for mounting on the surface of	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a through-hole package configuration. Prior to August 10, 1994, it would have been obvious to one skilled in the art to configure the device as surface mount. For example, the *Gongin H-16S Reference*, which was publicly available prior to August 10, 1994, discloses a surface mount package. It would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings of *Gongin H-16S Reference,*, thereby having another end which extends in wing like fashion through the other side

the printed circuit board.	of the side wall below the bottom of the package to form a surface mounting portion for mounting on the surface of the printed circuit board.

4. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over *Renskers* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said package comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '720 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[3]
a one piece open construction package having a side wall,	***Renskers Patent***: *Renskers* discloses a one piece construction package having a side wall (Figs. 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid transformers within said package, said toroid transformers each having wires wound thereon,	***Renskers Patent***: *Renskers* discloses a plurality (i.e., four) wire-wrapped toroid transformers within his package (Fig. 2; Col. 3, lines 6-15).
a plurality of terminal pins molded within the side wall	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board

[3] It is noted that the '720 patent recites that "**special design consideration** has been applied to thermal expansion of materials to ensure that the package will stand all normal reflow processes with low cost, easy manufacturing, and high reliability." Column 3, line 67 to Col. 4, line 4 (emphasis added). No detailed specifications regarding these "special design considerations" have been disclosed in the specification and thus, in addition to the issue regarding compliance with 35 U.S.C § 112, Paragraph 1, there is no support in the specification for distinguishing surface mount technology from other technologies such as through-hole mounting. In fact, twice in the specification the inventors specifically state that the invention is not limited to the disclosed embodiment. See Col. 2, line 25-31 and Col 5, lines 7-20.

of said package, the ends of the terminal pins forming solder posts and extending through and below the bottom of said side wall,	(Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12 (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).
said solder posts each having an hour-glass shaped notch upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Renskers Patent***: *Renskers's* lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). It would be obvious to one skilled in the art that these notches would be in an "hour-glass" shape, upon which transformer wires are wrapped and soldered thereon.
the other end of each of the terminal pins extending in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***Renskers Patent***: *Renskers's* Lugs 32 extend from, through, and below the bottom of the package (Col. 3, lines 30-44, Figs. 3, 5). The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.

Claim 2

2. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '720 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which

	cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[2]
a one piece open construction package having a side wall,	***Renskers Patent***: *Renskers* discloses a one piece construction package having a side wall (Figs. 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***Renskers Patent***: *Renskers* discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material" (Figs. 2, 3, 5; Col. 3, line 60).
a plurality of terminal pins molded within the side wall of said package, the ends of the terminal pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).
the other end of each of the terminal pins extending outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***Renskers Patent***: *Renskers's* Lugs 32 extend from, through, and below the bottom of the package (Col. 3, lines 30-44, Figs. 3, 5). The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.

Claim 3

3. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and

	surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '720 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[2]
a construction package having a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a construction package having a side wall and an open bottom (Figs, 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***Renskers Patent***: *Renskers* discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material" (Figs. 2, 3, 5; Col. 3, line 60).
a plurality of terminal pins molded within the side wall of said package, the ends of the pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).

Claim 4

4. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said electronic surface mount package	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and

comprising:	surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '720 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[2]
a one piece open construction package having a side wall,	***Renskers Patent***: *Renskers* discloses a construction package having a side wall (Figs, 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***Renskers Patent***: *Renskers* discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material" (Figs. 2, 3, 5; Col. 3, line 60).
a plurality of terminal pins molded within the side wall of said package, the ends molded pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).

Claim 5

5. The package as in claim 4 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***Renskers Patent***: *Renskers* discloses standoffs 24, as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9).

Claim 6

6. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '720 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[2]
an open construction package having a side wall,	***Renskers Patent***: *Renskers* discloses a construction package having a side wall (Figs, 2, 3, 5; Col. 3, lines 63-66).
at least one toroid transformer within said package in a soft silicone material, said toroid transformer having a wire wound thereon,	***Renskers Patent***: *Renskers* discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material" (Figs. 2, 3, 5; Col. 3, line 60).
at least one terminal pin molded within the side wall of said package, said one end forming a solder post extending through and below the bottom of said side wall said solder post having a notched post upon which said wire from said transformer is wrapped and soldered thereon.	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).

Claim 7

7. The package as in claim 6 wherein the package includes an end wall to form a safe guard and wherein said one end of said terminal pin extends below the bottom of the side wall but does not extend below the safe guard.	***Renskers Patent:*** *Renskers* discloses end walls (14) and side walls (12). These side walls are castellated to provide alternate elevations (20) and depressions (22). *Renskers* also describes posts or stand-offs (24) extending upwardly above the castellated line at the corners. (Col. 2, ln. 64 – Col. 3, ln. 5) *Renskers* depicts, in Fig. 5, the pins ("lead legs," 42) extending from the bottom of the package and in Figs. 5 and 6, pins (36) extending through a bottom of said side wall. It would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings of *Gongin H-16S Reference,* thereby having the ends of the terminal pins forming solder posts extending below the bottom of the side wall, but not below the safe guard.

Claim 8

8. The package as in claim 7 wherein the terminal pin has another end which extends in wing like fashion through the other side of the side wall below the bottom of the package to form a surface mounting portion for mounting on the surface of the printed circuit board.	It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, for example, by forming terminal lugs 32 into a wing-like shape, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. In particular, the *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in a wing-like fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.

5. Claims 1-8 are Invalid Under 35 U.S.C §103 Over McCormick in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said package comprising:	***McCormick Reference***: *McCormick* describes an electronic surface mount package, soldered to a printed circuit board (PCB) (Pages 27, 31).
a one piece open construction package having a side wall,	***McCormick Reference***: *McCormick* discloses a one piece construction package ("housing") with a side wall (Illustration, Page 27).
a plurality of toroid	***McCormick Reference***: *McCormick* discloses two fully molded and

transformers within said package, said toroid transformers each having wires wound thereon,	potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the terminal pins forming solder posts and extending through and below the bottom of said side wall,	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer, and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27).
said solder posts each having an hour-glass shaped notch upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***McCormick Reference***: *McCormick* describes solder posts upon which the wires from the transformers are wrapped and soldered thereon. Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Additionally, prior to August 10, 1994, it would have been obvious to one skilled in the art to use hour-glass shaped notches upon which the wires from the transformers are wrapped.
the other end of each of the terminal pins extending in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***McCormick Reference***: *McCormick* describes terminal pins acting as a connection between the magnet wire and the traces on the printed circuit board (Page 27). *McCormick* describes J Leaded pin termination for surface mount PCB attachment. Use of pins extending in gull wing fashion in lieu of pins extending in J-leaded fashion would be obvious to one of ordinary skill in the art in view of *McCormick*.

Claim 2

2. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***McCormick Reference***: *McCormick* describes an electronic surface mount package, soldered to a printed circuit board (PCB) (Pages 27, 31).
a one piece open construction package having a side wall,	***McCormick Reference***: *McCormick* discloses a one piece construction package ("housing") with a side wall (Illustration, Page 27).

a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids (Illustration, Page 27). *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to encapsulate the entire unit (Page 27). The cup is formed from molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the terminal pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer, and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
the other end of each of the terminal pins extending outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***McCormick Reference***: *McCormick* describes terminal pins acting as a connection between the magnet wire and the traces on the printed circuit board (Page 27). *McCormick* describes J Leaded pin termination for surface mount PCB attachment. Use of pins extending in gull wing fashion in lieu of pins extending in J-leaded fashion would be obvious to one of ordinary skill in the art in view of *McCormick*.

Claim 3

3. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***McCormick Reference***: *McCormick* describes an electronic surface mount package, soldered to a printed circuit board (PCB) (Pages 27, 31).
a construction package having a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a one piece housing with a side wall and an open bottom (Illustration, Page 27).
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids (Illustration, Page 27). *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to encapsulate the entire unit (Page 27). The cup is formed from

wires wound thereon,	molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer, and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 4

4. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said electronic surface mount package comprising:	***McCormick Reference***: *McCormick* describes an electronic surface mount package, soldered to a printed circuit board (PCB) (Pages 27, 31).
a one piece open construction package having a side wall,	***McCormick Reference***: *McCormick* discloses a one piece construction package ("housing") with a side wall (Illustration, Page 27).
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids (Illustration, Page 27). *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to encapsulate the entire unit (Page 27). The cup is formed from molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends molded pins forming solder posts extending through and below the bottom of said side	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer, and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*,

wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 5

5. The package as in claim 4 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***McCormick Reference***: *McCormick* discloses fully molded and potted toroids in a housing suited for automatic surface mount placement and high temperature assembly (Illustration, Page 27). It would have been necessary and obvious to utilize a standoff in connection with the device disclosed in *McCormick*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).

Claim 6

6. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***McCormick Reference***: *McCormick* describes an electronic surface mount package, soldered to a printed circuit board (PCB) (Pages 27, 31).
an open construction package having a side wall,	***McCormick Reference***: *McCormick* discloses a one piece construction package ("housing") with a side wall (Illustration, Page 27).
at least one toroid transformer within said package in a soft silicone material, said toroid transformer having a wire wound thereon,	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids (Illustration, Page 27). *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to encapsulate the entire unit (Page 27). The cup is formed from molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).

at least one terminal pin molded within the side wall of said package, said one end forming a solder post extending through and below the bottom of said side wall said solder post having a notched post upon which said wire from said transformer is wrapped and soldered thereon.	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer, and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 7

7. The package as in claim 6 wherein the package includes an end wall to form a safe guard and wherein said one end of said terminal pin extends below the bottom of the side wall but does not extend below the safe guard.	***McCormick Reference***: McCormick describes a package ("Molding Cup") which holds the completed transformer assembly (Page 27). It would have been obvious, in view of a necessity for compatibility with pick-and-place equipment, and for inspection of legs when soldered to a Printed Circuit Board (PCB) to include standoffs, such as at the corners of the molding cup. Moreover, a continuous standoff laterally across each end of the molding cup is an obvious variation to one of ordinary skill in the art.

Claim 8

8. The package as in claim 7 wherein the terminal pin has another end which extends in wing like fashion through the other side of the side wall below the bottom of the package to form a surface mounting portion for mounting on the surface of the printed circuit board.	***McCormick Reference***: McCormick describes a package ("Molding Cup") which holds the completed transformer assembly (Page 27). Each terminal pin has a first end upon which a toroid wire is wrapped and soldered, as well as another end which extends through the package and is formed in J-leaded Fashion (Fig. 2). Prior to August 10, 1994, it would have been obvious to one skilled in the art to have leads in a "wing like fashion" in lieu of a J-leaded fashion. For example, the *Gongin H-16S Reference* shows terminal pins with another end extending in a wing like fashion through the other side of the side wall below the bottom of the package to form a surface mounting portion for mounting on the surface of the printed circuit board.

6. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over *Yuichi* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said package comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") (Sections [0003, 0004]).
a one piece open construction package having a side wall,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall (Figs. 1, 4).
a plurality of toroid transformers within said package, said toroid transformers each having wires wound thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer (Figs. 1, 4; Section [0003]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '720 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 13-16). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the terminal pins forming solder posts and extending through and below the bottom of said side wall,	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally through and below the bottom of the package side wall (Fig. 2).
said solder posts each having an hour-glass shaped notch upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Yuichi Patent:*** *Yuichi* describes molded terminal pins coming out of the package extending below the bottom. By the early 1990's, it was well known in this art to have notches upon the pins. For example, in *Renskers* (1972), the posts ("legs") have notches (Col. 3, lines 30, Figs. 3, 5) and it would be further obvious to one skilled in the art that these notches would be in an "hour-glass" shape, upon which transformer wires are wrapped and soldered thereon

	Yuichi Patent: Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Furthermore, it would be further obvious to one skilled in the art that these notches would be in an "hour-glass" shape. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
the other end of each of the terminal pins extending in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***Yuichi Patent:*** *Yuichi* describes molded terminal pins that have one end extending outwardly from below the bottom in a gull wing fashion for mounting onto the surface of the printed circuit board (Figs. 1, 4; Section [0018]; Claim 1).

Claim 2

2. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") (Sections [0003, 0004]).
a one piece open construction package having a side wall,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall (Figs. 1, 4).
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '720 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality

	of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the terminal pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending through and below the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
the other end of each of the terminal pins extending outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.	***Yuichi Patent:*** *Yuichi* describes molded terminal pins that have one end extending outwardly from the side wall, and below the bottom of the package, for mounting onto the surface of the printed circuit board (Figs. 1, 4; Section [0018]; Claim 1).

Claim 3

3. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") (Sections [0003, 0004]).
a construction package having a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall and an open bottom (Figs. 1, 4).
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section

	of the '720 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends of the pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending through and below the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 4

4. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said electronic surface mount package comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") (Sections [0003, 0004]).
a one piece open construction package having a side wall,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall (Figs. 1, 4).
a plurality of toroid transformers within said package in a soft silicone material, said toroid transformers each having wires wound thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section

	of the '720 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within the side wall of said package, the ends molded pins forming solder posts extending through and below the bottom of said side wall, said solder posts each having a notched post upon which said wires from said transformers are wrapped and soldered thereon, respectively.	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending through and below the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 5

5. The package as in claim 4 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***Yuichi Patent***: It is noted that the '720 patent is a continuation-in-part of the parent patent 5,656,985 and that language added to the specification of the '720 patent includes that at column 4, lines 54-56 which describes using a portion of the case as a standoff. *Yuichi* discloses a standoff 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Sections 0017, 0018; Fig. 4).

Claim 6

6. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") (Sections [0003, 0004]).
an open construction package having a side wall,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall (Figs. 1, 4).
at least one toroid	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal

transformer within said package in a soft silicone material, said toroid transformer having a wire wound thereon,	transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '720 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
at least one terminal pin molded within the side wall of said package, said one end forming a solder post extending through and below the bottom of said side wall said solder post having a notched post upon which said wire from said transformer is wrapped and soldered thereon.	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending through and below the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

Claim 7

7. The package as in claim 6 wherein the package includes an end wall to form a safe guard and wherein said one end of said terminal pin extends below the bottom of the side wall but does not extend below the safe guard.	***Yuichi Patent***: *Yuichi* discloses wires that have an end below the depth of the side wall (8), but above the safeguard (through the topmost and bottom-most "bottom faces" 2(c) in Fig. 4), that are wrapped to the terminal pin (7) (Figs. 2, 3, 4).

Claim 8

8. The package as in claim 7 wherein the terminal pin has another end which extends in wing like fashion through the other side of the side wall below the bottom of the package to form a surface mounting portion for mounting on the surface of the printed circuit board.	***Yuichi Patent***: *Yuichi* discloses a terminal pin extending in a wing like fashion below the bottom of the package where it forms a surface mounting portion for mounting on the surface of the printed circuit board through the other side of the side wall (Fig. 2).

37 CFR § 1.510(b)(3) - A Copy of Every Patent or Printed Publication Relied Upon or Referred to in Paragraph (b)(1) and (2)

Copies of every patent or printed publication relied upon or referred to in Paragraph (b)(1) and (2) are attached as Attachments I-V.

37 C.F.R. § 1.510(b)(4) - Copy of the '720 Patent

A double-column copy of the subject '720 is enclosed as **Attachment A** to this Request for Reexamination.

37 C.F.R § 1.510(b)(5) - A Certification That a Copy of the Request Filed by a Person Other Than the Patent Owner Has Been Served in its Entirety on the Patent Owner at the Address as Provided for in § 1.33(c)

A certification that a copy of the request filed has been served to the patent owner at the address as provided for in § 1.33(c) is attached.

37 C.F.R. § 1.510(f) - Statement of Representative Capacity

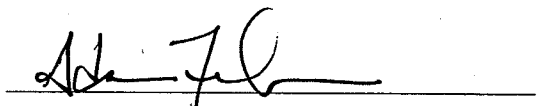
This request for *ex parte* reexamination is made on behalf of Midcom pursuant to 37 C.F.R. § 1.510(a). The undersigned attorney, Adam M. Treiber (Reg. No. 48,000) hereby confirms that he is acting in a representative capacity for Midcom in this matter pursuant to 37 C.F.R. § 1.34.

CONCLUSION

The patents and references cited in this request for reexamination present a substantial new question of patentability with respect to claims 1-8 of the '720 patent. Therefore, *ex parte* reexamination of the '720 patent is respectively requested pursuant to 35 U.S.C. §§ 301-307 and 37 C.F.R. § 1.510.

Respectively submitted,

Date: May 5, 2008

By: 

Adam M. Treiber
Registration No. 48,000
Attorney for Requestor

#102246945_2

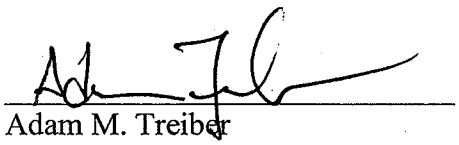
INDEX OF "ATTACHMENTS" TO REQUEST FOR REEXAMINATION

Attachment A:	U.S. Patent Number 6,297,720 (Lu et al.)
Attachment B:	Plaintiff Halo's Complaint
Attachment C:	Defendant Midcom's Answer and Counterclaim
Attachment D:	Defendant Elec & Eltek (USA) Corporation Answer and Counterclaim
Attachment E:	Defendant XFMRS, Inc.'s Answer and Counterclaim
Attachment F:	Defendant XFMRS, Inc.'s First Amended Answer and Counterclaim
Attachment G:	Defendant XFMRS, Inc.'s Second Amended Answer and Counterclaim
Attachment H:	Civil Action Docket Sheet
Attachment I:	U.S. Patent Number 5,212,345 (*Gutierrez*)
Attachment J:	*Tischler* Reference
Attachment K:	*NPI 10BaseT Catalog Page*
Attachment L:	*Gongin H-16S* Specification Sheet
Attachment M:	*Gongin RH-16* Specification Sheet
Attachment N:	NPI/Xircom Invoice
Attachment O:	NPI 10BaseT June 1996 Catalog Page
Attachment P:	*NPI Isolation Transformers Catalog Page*
Attachment Q:	NPI/Interphase October 28, 1991 Letter
Attachment R:	U.S. Patent Number 3,721,747 (*Renskers*)
Attachment S:	*McCormick* Reference
Attachment T:	*Yuichi* Patent – JP7161535
Attachment U:	NP5417 Bill of Materials
Attachment V:	September 15, 1995 Letter to Chris Nixon of 3Com Limited

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Request for *Ex Parte* Reexamination was concurrently served by first-class mail on Halo Electronics, Inc., at the address provided for under 37 C.F.R. § 1.33(c):

Haynes, Mark (30846)
Beffel, Ernest Jr (43489)
Wolfeld, Warren (31454)
Haynes Beffel & Wolfeld LLP
P.O. Box 366
Half Moon Bay, CA 94019



Adam M. Treiber
Registration No. 48,000
Baker & Hostetler LLP

EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.:	**6,297,721**	
Issued:	October 2, 2001	Reexamination Control No.: Not Yet Assigned
Inventor:	Peter Lu et. al	Reexamination Filing Date: Herewith
Serial No.:	08/977,407	Art Unit: Not Yet Assigned
Filed:	November 24, 1997	Examiner: Not Yet Assigned
For:	ELECTRONIC SURFACE MOUNT PACKAGE	

Mail Stop *Ex Parte* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR *EX PARTE* REEXAMINATION

Dear Sir:

Pursuant to 35 U.S.C. §§ 301-307 and 37 C.F.R. § 1.510, the undersigned on behalf of Wurth Electronics Midcom, Inc. ("Midcom") hereby requests an *ex parte* reexamination of U.S. Patent No. 6,297,721 ("the '721 patent"), a copy of which is attached as **Attachment A**, that issued from U.S. Patent Application No. 08/977,407, filed on November 24, 1997.

The '721 patent, along with five other patents claiming priority back to the same parent application, U.S. Ser. No. 08/513,573, is currently the subject of litigation in the U.S. District Court, Northern District of California, Case No. CV 07-06222 JCS ("the Halo Litigation"). That litigation was brought by Halo Electronics, Inc., the current owner of record of the '721 patent, against Midcom and three other companies. The other patents involved in the litigation are U.S. Patent Nos.: 5,656,985; 6,297,720; 6,320,489; 6,344,785; 6,662,431, for which Midcom is separately requesting *ex parte* reexamination. A copy of Halo's complaint is appended hereto as **Attachment B**. Midcom's Answer and Counterclaim as well as the Answer and Counterclaim of Elec & Eltek (USA) Corporation

are appended hereto as **Attachments C and D**, respectively. The Answer and Counterclaim, First Amended Answer and Counterclaim and Second Amended Answer and Counterclaim of XFMRS, Inc. are appended hereto as **Attachments E, F and G**, respectively. A copy of the Civil Action Docket Sheet for the Halo Litigation (obtained April 21, 2008) is appended hereto as **Attachment H**.

EX PARTE REEXAMINATION REQUIREMENTS UNDER 37 C.F.R § 1.510(a)-(f)

37 C.F.R. § 1.510(a) - Fee Payment

Payment for this reexamination request ($2,520, see 37 C.F.R. § 1.20(c)(1)) is enclosed.

37 CFR § 1.510(b)(1) - A Statement Pointing Out Each Substantial New Question of Patentability Based on Prior Patents and Printed Publications

1. Claims 1-7 of the '721patent are rendered obvious under 35 U.S.C § 103(a) by U.S. Patent No. 5,212,345 ("*Gutierrez*"), which issued on May 18, 1993, appended hereto as **Attachment I**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown in such references as the article entitled "Mounting & Packing Techniques For Toroidal Devices," authored by Harold Tischler, and published in the October 1993 *Proceedings of Electrical Electronics Insulation Conference and Electrical Manufacturing & Coil Winding Conference* ("*Tischler*"), appended hereto as **Attachment J**.

Gutierrez discloses a surface mount package for a toroidal transformer (or other circuit element). *Tischler* discloses mounting "one or several" (i.e., a plurality of) toroidal transformers within a single package, as well as molded-in terminations for surface mount pins.

2. Claims 1-7 of the '721 patent are rendered obvious under 35 U.S.C § 103(a) by the NPI catalog page for the 10BaseT Ethernet Surface Mount Transformers ("*NPI 10BaseT Catalog Page*") appended hereto as **Attachment K**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as the *Gongin H-16S* specification sheet, appended

hereto as **Attachment L**, and the *Gongin RH-16* specification sheet, appended hereto as **Attachment M**.[1]

The *NPI 10BaseT Catalog Page* shows a surface mount package with a plurality of transformers. The *NPI 10BaseT Catalog Page* was publicly available prior to August 10, 1994, as confirmed by the NPI invoice to a customer, Xircom, appended hereto as **Attachment N**. That invoice shows that 10 of the 5366-30 devices included on the *NPI 10BaseT Catalog Page* were ordered and scheduled for delivery January 31, 1992. In addition, a later version of the *NPI 10BaseT Catalog Page* showing a June 1994 version date in the lower right hand corner, appended hereto as **Attachment O**, also confirms the public availability of the *NPI 10BaseT Catalog Page* prior to August 10, 1994.

The Gongin specification sheets show associated electronic component packages provided in surface mount and through-hole configurations that can be used in the manufacture of the products depicted in the *NPI 10BaseT Catalog Page*. The Gongin specification sheets also demonstrate that, by at least as early as May of 1987, through-hole packaging and surface mount packaging were known alternatives for electronic components.

3. Claims 1-7 of the '721 patent are rendered obvious under 35 U.S.C § 103(a) by the NPI catalog page for the Ethernet Isolation Transformers ("*NPI Isolation Transformers Catalog Page*"), appended hereto as **Attachment P**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by the *Gongin H-16S* (Attachment N). The *NPI Isolation Transformers Catalog Page* depicts a through-hole package (Part Number NP5416) that includes a plurality of transformers. A copy of the *NPI Isolation Transformers Catalog Page* was publicly available prior to

[1] Although the Gongin specification sheets bear dates of 76.5.12, because these specifications were published in Taiwan and dated according to the Taiwanese Calendar, they use the 1911 founding of the Republic of China as a reference point in establishing the date. As measured against the '721 patent, the dates of these documents are May 12, 1987.

August 10, 1994, as demonstrated by the letter to NPI customer Interphase dated October 28, 1991, appended hereto as **Attachment Q**, providing materials information regarding the NPI part number 5416. It is noted that page 2 of Attachment Q indicates that the 5416 part utilized silicone mummy compound for encasing the transformers in the device.

4. Claims 1-7 of the '721 patent are rendered obvious under 35 U.S.C § 103(a) by U.S. Patent No. 3,721,747 ("*Renskers*"), which issued on March 20, 1973, appended hereto as **Attachment R**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Tischler*. Although *Renskers* was considered during prosecution of the '721 patent, it was not considered in view of the *Tischl*er reference as cited herein.

5. Claims 1-7 of the '721 patent are rendered obvious under 35 U.S.C § 103(a) by the article entitled "Surface Mount Transformers: A New Packaging Approach," authored by Brad J. McCormick et al., and published in the February 1993 issue of Surface Mount Technology ("*McCormick*"), appended hereto as **Attachment S**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Gutierrez* as cited herein.

6. Claims 1-7 of the '721 patent are rendered obvious under 35 U.S.C § 103(a) by JP 7161535 ("*Yuichi*") authored by Saito Yuichi, which published on June 23, 1995, appended hereto as **Attachment T** (including translation), in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Tischler*, *Renskers* or *McCormick*.

It is noted that the '721 patent is a continuation-in-part of parent patent 5,656,985. Disclosure added to the '721 patent included the following language found at Col. 2, lines 32-36: "As will be described in more detail below, the present invention is directed toward applications for packages mounted on a printed circuit board in an electronic device, which requires very low current and voltages, and is for DC voltages only." Because all of the foregoing references fall within the scope of

the invention as defined by the applicant, they are clearly "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385, 1397 (2007).

37 C.F.R. § 1.510(b)(2) - Claims for Which Reexamination is Requested and Detailed Explanation of Pertinency and Manner of Applying the Cited Prior Art to Every Claim for Which Reexamination is Requested.

Reexamination is requested of claims 1-7 of the '721 patent, i.e., all claims. A statement of the substantial new questions of patentability presented by this request for reexamination is provided below along with a detailed explanation of the pertinency and manner of applying the aforementioned references to each claim for which reexamination is requested.

1. Claims 1-7 Are Invalid Under 35 U.S. C §103 Over *Gutierrez* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto a printed circuit board comprising:	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting (Col. 1, lines 5-9).
a one piece construction package having a side wall and an open bottom,	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package having a side wall and an open bottom (Col. 2, lines 37-47, Fig. 1).
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '721 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid

	transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***Gutierrez Patent***: Gutierrez describes lead termination blocks or support members extending in a gull wing fashion "outwardly" from opposite sides at the base thereof. (Fig. 2; Col. 2, lines 53-56).
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***Gutierrez Patent:*** *Gutierrez* describes a body 12 having a rectangular box-like configuration (Fig. 1; Col. 2, lines 38-42). The end walls function as lateral reinforcement beams to provide improved mechanical strength.

Claim 2

2. An electronic surface mount package for mounting onto a printed circuit board comprising:	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting (Col. 1, lines 5-9).
a construction package having a side wall and an	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package having a side wall and an open bottom (Col. 2, lines 37-47,

open bottom,	Fig. 1).
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '721 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***Gutierrez Patent***: Gutierrez describes lead termination blocks or support members extending in a gull wing fashion "outwardly" from opposite sides at the base thereof. (Fig. 2; Col. 2, lines 53-56).
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***Gutierrez Patent:*** *Gutierrez* describes a body 12 having a rectangular box-like configuration (Fig. 1; Col. 2, lines 38-42). The end walls function as lateral reinforcement beams to provide improved mechanical strength.

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package (Col 2. lines 37-47; Fig. 1)

Claim 4

4. The package of claim 3 wherein said construction package has an open bottom.	***Gutierrez Patent***: *Gutierrez* discloses a construction package with an open bottom (Col 2. lines 37-47; Fig. 1).

Claim 5

5. The package of claim 4 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '721 patent provides no guidance or specifications regarding the requirements for such separation. The problem of arcing in electronics was well known by August 10, 1994 and the principal method of preventing arcing, i.e., spacing, was also well known. Enablement in accordance with 35 U.S.C § 112 requires that "...the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation." *Genentech, Inc. v. Novo Nordisk, A/S,* 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright,* 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from the lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. Thus, the terminal leads disclosed in *Gutierrez* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 6

6. An electronic surface mount package for mounting onto a printed circuit board in an electronic device, said electronic surface mount package comprising:	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting (Col. 1, lines 5-9).
a one piece construction package having a side wall	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package having a side wall and an open bottom (Col. 2, lines 37-47,

and an open bottom,	Fig. 1).
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '721 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 6-9). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***Gutierrez Patent***: Gutierrez describes lead termination blocks or support members extending in a gull wing fashion "outwardly" from opposite sides at the base thereof. (Fig. 2; Col. 2, lines 53-56).
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***Gutierrez Patent:*** *Gutierrez* describes a body 12 having a rectangular box-like configuration (Fig. 1; Col. 2, lines 38-42). The end walls function as lateral reinforcement beams to provide improved mechanical strength.

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between said terminal pins and said printed circuit board.	***Gutierrez Patent***: *Gutierrez* discloses a standoff in the form of a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on the lead terminals (Fig. 3; Col. 3, lines 6-12).

2. Claims 1-y Are Invalid Under 35 U.S.C § 103 Over the *NPI 10BaseT Catalog Page* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto a printed circuit board comprising:	***NPI 10BaseT Catalog Page***: *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a one piece construction package having a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B). By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a single package (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a single package (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are

pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top which at the end wall comprises a reinforcement beam located laterally along the bottom of the package to provide improved mechanical strength of the package, and it would have been obvious to one skilled in the art to modify the *NPI 10BaseT Catalog Page* construction package in accordance with the teachings of The *Gongin H-16S Reference*.

Claim 2

2. An electronic surface mount package for mounting onto a printed circuit board comprising:	***NPI 10BaseT Catalog Page***: *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a construction package having a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.

a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B). By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a single package (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a single package (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.
at least one reinforcement beam located laterally along the bottom of said package to provide improved	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top which at the end wall comprises a reinforcement beam located laterally along

mechanical strength of said package.	the bottom of the package to provide improved mechanical strength of the package, and it would have been obvious to one skilled in the art to modify the *NPI 10BaseT Catalog Page* construction package in accordance with the teachings of The *Gongin H-16S Reference*.

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a one piece construction package.

Claim 4

4. The package of claim 3 wherein said construction package has an open bottom.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. It would have been obvious to one of ordinary skill in the art to have an open bottom in view of the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top for which it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings to instead configure it with an open bottom.

Claim 5

5. The package of claim 4 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '721 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the terminal leads disclosed in *NPI 10BaseT Catalog Page* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 6

6. An electronic surface mount package for	***NPI 10BaseT Catalog Page***: *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.

mounting onto a printed circuit board in an electronic device, said electronic surface mount package comprising:	
a one piece construction package having a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B). By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a single package (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a single package (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top which at the end wall comprises a reinforcement beam located laterally along the bottom of the package to provide improved mechanical strength of the package, and it would have been obvious to one skilled in the art to modify the *NPI 10BaseT Catalog Page* construction package in accordance with the teachings of The *Gongin H-16S Reference*.

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between said terminal pins and said printed circuit board.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for containing a plurality of toroids, as indicated by the drawing on the Reference. It would have been obvious to utilize a standoff in connection with the 5366-30 package disclosed in the *NPI 10BaseT Catalog Page*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).

3. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over the *NPI Isolation Transformers Catalog Page* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto a printed	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one

circuit board comprising:	skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '721 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a one piece construction package having a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* describes a plurality of wound toroid transformers carried within a package (Center Drawing Between Package A and Package B).[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Text and Illustration, Page 27).
a plurality of terminal pins molded within and	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins

[2] Although not identified as such in the NPI Isolation Transformers Catalog Page, the transformers used in this device were indeed toroid transformers as shown in the April 28, 1994 NP5417 part Bill of Materials, appended hereto as Attachment U. As also shown in this Bill of Materials, the Gongin RH-16 header was used in the construction of this device as was a silicone paste. The NP5417 Bill of Materials was publicly available at least as early as September 15, 1994 when it was forwarded to Chris Nixon at 3Com Limited with the letter of Attachment V.

extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***NPI Catalog Reference***: The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top which at the end wall comprises a reinforcement beam located laterally along the bottom of the package to provide improved mechanical strength of the package, and it would have been obvious to one skilled in the art to modify the *NPI Isolation Transformers Catalog Page* construction package in accordance with the teachings of The *Gongin H-16S Reference*.

Claim 2

2. An electronic surface mount package for mounting onto a printed circuit board comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to

	give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '721 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a construction package having a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* describes a plurality of wound toroid transformers carried within a package (Center Drawing Between Package A and Package B).[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).

the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***NPI Catalog Reference***: The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top which at the end wall comprises a reinforcement beam located laterally along the bottom of the package to provide improved mechanical strength of the package, and it would have been obvious to one skilled in the art to modify the *NPI Isolation Transformers Catalog Page* construction package in accordance with the teachings of The *Gongin H-16S Reference*.

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference.*

Claim 4

4. The package of claim 3 wherein said construction package has an open bottom.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. It would have been obvious to one of ordinary skill in the art to have an open bottom in view of the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top for which it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, forming an open bottom.

Claim 5

5. The package of claim 4 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '721 patent provides no guidance or specifications regarding the requirements for such separation. The problem of arcing in electronics was well known by August 10, 1994 and the principal method of preventing arcing, i.e., spacing, was also well known. Enablement in accordance with 35 U.S.C § 112 requires that "...the

	specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation." *Genentech, Inc. v. Novo Nordisk, A/S,* 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright,* 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from the lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. Thus, the terminal leads disclosed in the *NPI Isolation Transformers Catalog Page* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 6

6. An electronic surface mount package for mounting onto a printed circuit board in an electronic device, said electronic surface mount package comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '721 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a one piece construction package having a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having a side wall. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package, said toroid transformers each having	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* describes a plurality of wound toroid transformers carried within a package (Center Drawing Between Package A and Package B).[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal

wires wrapped thereon,	transformers in a single device. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***NPI Catalog Reference***: The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. The *Gongin H-16S Reference* illustrates an electronic package with an open top which at the end wall comprises a reinforcement beam located laterally along the bottom of the package to provide improved mechanical strength of the package, and it would have been obvious to one skilled in the art to modify the *NPI Isolation Transformers Catalog Page* construction package in accordance with the teachings of The *Gongin H-16S Reference*.

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between said terminal pins and said printed circuit board.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a standoff in the form of "nubs" extending from the bottom of the package, for the purpose forming a safeguard. It would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings of *Gongin H-16S Reference,* thereby having the ends of the terminal pins forming solder posts extending below the bottom of the side wall, but not below the safe guard.

4. Claims 1-7 Are Invalid Under 35 U.S.C § 103 Over *Renskers* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto a printed circuit board comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '721 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[3]
a one piece construction package having a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a one piece construction package having a side wall and open bottom (Figs. 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid	***Renskers Patent***: *Renskers* discloses a plurality (i.e., four) wire-

[3] It is noted that the '721 patent recites that "**special design consideration** has been applied to thermal expansion of materials to ensure that the package will stand all normal reflow processes with low cost, easy manufacturing, and high reliability." Column Col. 4, lines 1-5 (emphasis added). No detailed specifications regarding these "special design considerations" have been disclosed in the specification and thus, in addition to the issue regarding compliance with 35 U.S.C § 112, Paragraph 1, there is no support in the specification for distinguishing surface mount technology from other technologies such as through-hole mounting. In fact, twice in the specification the inventors specifically state that the invention is not limited to the disclosed embodiment. See Col. 2, line 25-31 and Col 5, lines 7-20.

transformers within said package, said toroid transformers each having wires wrapped thereon,	wrapped toroid transformers within his package (Fig. 2; Col. 3, lines 6-15).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***Renskers Patent***: *Renskers's* lugs 32 extend from, through, and below the bottom of the package (Col. 3, lines 30-44, Figs. 3, 5). The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***Renskers Patent:*** *Renskers* discloses a floor 16 and end walls 14 that constitute reinforcement beams located laterally along the bottom of the package to provide improved mechanical strength of the package (Figs. 1, 5).

Claim 2

2. An electronic surface mount package for mounting onto a printed circuit board comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations.

	Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '721 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[3]
a construction package having a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a one piece construction package having a side wall and open bottom (Figs. 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***Renskers Patent***: *Renskers* discloses a plurality (i.e., four) wire-wrapped toroid transformers within his package (Fig. 2; Col. 3, lines 6-15).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***Renskers Patent***: *Renskers's* lugs 32 extend from, through, and below the bottom of the package (Col. 3, lines 30-44, Figs. 3, 5). The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the printed circuit board.
at least one reinforcement beam located laterally along	***Renskers Patent:*** *Renskers* discloses a floor 16 and end walls 14 that constitute reinforcement beams located laterally along the bottom of

the bottom of said package to provide improved mechanical strength of said package.	the package to provide improved mechanical strength of the package (Figs. 1, 5).

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***Renskers Patent***: *Renskers* discloses a one piece construction package. (Figs. 2, 3, 5; Col. 3, lines 63-66)

Claim 4

4. The package of claim 3 wherein said construction package has an open bottom.	***Renskers Patent***: *Renskers* discloses a one piece construction package having a side wall and open bottom (Figs. 2, 3, 5; Col. 3, lines 63-66).

Claim 5

5. The package of claim 4 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '721 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "...the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the terminal leads disclosed in *Renskers* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 6

6. An electronic surface mount package for mounting onto a printed circuit board in an electronic device, said electronic	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'*

surface mount package comprising:	device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '721 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[3]
a one piece construction package having a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a one piece construction package having a side wall and open bottom (Figs. 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***Renskers Patent***: *Renskers* discloses a plurality (i.e., four) wire-wrapped toroid transformers within his package (Fig. 2; Col. 3, lines 6-15).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board,	***Renskers Patent***: *Renskers's* lugs 32 extend from, through, and below the bottom of the package (Col. 3, lines 30-44, Figs. 3, 5). The *Gongin H-16S Reference* illustrates an electronic package with an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings, thereby having the terminal pins extend in gull wing fashion outwardly from the side wall and below the bottom of the package for mounting onto the surface of the

and	printed circuit board.
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***Renskers Patent:*** *Renskers* discloses a floor 16 and end walls 14 that constitute reinforcement beams located laterally along the bottom of the package to provide improved mechanical strength of the package (Figs. 1, 5).

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between said terminal pins and said printed circuit board.	***Renskers Patent***: *Renskers* discloses standoffs 24, as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9).

5. Claims 1-7 Are Invalid Under 35 U.S.C §103 Over *McCormick* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto a printed circuit board comprising:	***McCormick Reference***: *McCormick* describes an electronic surface mount package, soldered to a printed circuit board (PCB) (Pages 27, 31).
a one piece construction package having a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a one piece housing with a side wall and an open bottom (Illustration, Page 27).
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***McCormick Reference***: *McCormick* discloses two fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for

wrapped and soldered thereon, respectively,	retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***McCormick Reference***: *McCormick* describes terminal pins acting as a connection between the magnet wire and the traces on the printed circuit board (Page 27). *McCormick* describes J Leaded pin termination for surface mount PCB attachment. Use of pins extending in gull wing fashion in lieu of pins extending in J-leaded fashion would be obvious to one of ordinary skill in the art in view of *McCormick*.
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***McCormick Reference:*** *McCormick* describes end walls constituting reinforcement beams located laterally along the bottom of the package to provide improved mechanical strength of the package (Illustration, Fig. 1; Page 27).

Claim 2

2. An electronic surface mount package for mounting onto a printed circuit board comprising:	***McCormick Reference***: *McCormick* describes an electronic surface mount package, soldered to a printed circuit board (PCB) (Pages 27, 31).
a construction package having a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a one piece housing with a side wall and an open bottom (Illustration, Page 27).
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***McCormick Reference***: *McCormick* discloses two fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for

thereon, respectively,	retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***McCormick Reference***: *McCormick* describes terminal pins acting as a connection between the magnet wire and the traces on the printed circuit board (Page 27). *McCormick* describes J Leaded pin termination for surface mount PCB attachment. Use of pins extending in gull wing fashion in lieu of pins extending in J-leaded fashion would be obvious to one of ordinary skill in the art in view of *McCormick*.
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***McCormick Reference:*** *McCormick* describes end walls constituting reinforcement beams located laterally along the bottom of the package to provide improved mechanical strength of the package (Illustration, Fig. 1; Page 27).

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***McCormick Reference***: *McCormick* discloses a one piece construction package ("housing") (Illustration, Page 27).

Claim 4

4. The package of claim 3 wherein said construction package has an open bottom.	***McCormick Reference***: *McCormick* discloses a one piece construction package ("housing") with an open bottom (Illustration, Page 27).

Claim 5

5. The package of claim 4 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '721 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the

	applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the terminal leads disclosed in *McCormick* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 6

6. An electronic surface mount package for mounting onto a printed circuit board in an electronic device, said electronic surface mount package comprising:	***McCormick Reference***: *McCormick* describes an electronic surface mount package, soldered to a printed circuit board (PCB) (Pages 27, 31).
a one piece construction package having a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a one piece housing with a side wall and an open bottom (Illustration, Page 27).
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***McCormick Reference***: *McCormick* discloses two fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for	***McCormick Reference***: *McCormick* describes terminal pins acting as a connection between the magnet wire and the traces on the printed circuit board (Page 27). *McCormick* describes J Leaded pin termination for surface mount PCB attachment. Use of pins extending in gull wing fashion in lieu of pins extending in J-leaded fashion

mounting onto the surface of the printed circuit board, and	would be obvious to one of ordinary skill in the art in view of *McCormick*.
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***McCormick Reference:*** *McCormick* describes end walls constituting reinforcement beams located laterally along the bottom of the package to provide improved mechanical strength of the package (Illustration, Fig. 1; Page 27).

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between said terminal pins and said printed circuit board.	***McCormick Patent***: *McCormick* discloses fully molded and potted toroids in a housing suited for automatic surface mount placement and high temperature assembly (Illustration, Page 27). It would have been necessary and obvious to utilize a standoff in connection with the device disclosed in *McCormick*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).

6. Claims 1-7 Are Invalid Under 35 U.S.C § 103 Over *Yuichi* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto a printed circuit board comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") (Sections [0003, 0004]).
a one piece construction package having a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall and an open bottom (Figs. 1, 4).
a plurality of toroid	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal

transformers within said package, said toroid transformers each having wires wrapped thereon,	transformer (Figs. 1, 4; Section [0003]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '721 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 13-16). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally from, and through, the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board, and	***Yuichi Patent:*** *Yuichi* describes molded terminal pins that have one end extending outwardly from below the bottom in a gull wing fashion for mounting onto the surface of the printed circuit board (Figs. 1, 4; Section [0018]; Claim 1).
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***Yuichi Patent:*** *Yuichi* discloses bottom face 2c sides that provide for improved mechanical strength of the package (Fig. 4).

Claim 2

2. An electronic surface mount package for mounting onto a printed circuit board comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") (Sections [0003, 0004]).
a construction package having a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall and an open bottom (Figs. 1, 4).
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer (Figs. 1, 4; Section [0003]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '721 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 13-16). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally from, and through, the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface of the printed circuit board,	***Yuichi Patent:*** *Yuichi* describes molded terminal pins that have one end extending outwardly from below the bottom in a gull wing fashion for mounting onto the surface of the printed circuit board (Figs. 1, 4; Section [0018]; Claim 1).

and	
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***Yuichi Patent:*** *Yuichi* discloses bottom face 2c sides that provide for improved mechanical strength of the package (Fig. 4).

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 (Figs. 1, 4).

Claim 4

4. The package of claim 3 wherein said construction package has an open bottom.	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has an open bottom (Figs. 1, 4).

Claim 5

5. The package of claim 4 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '721 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. It is presumed, therefore, that the terminal leads disclosed in the *Yuichi* Patent are spaced apart by an amount sufficient to avoid arcing.

Claim 6

6. An electronic surface	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting

mount package for mounting onto a printed circuit board in an electronic device, said electronic surface mount package comprising:	on a printed circuit board ("IC Card") (Sections [0003, 0004]).
a one piece construction package having a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has a side wall and an open bottom (Figs. 1, 4).
a plurality of toroid transformers within said package, said toroid transformers each having wires wrapped thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer (Figs. 1, 4; Section [0003]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '721 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 13-16). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending through and below a bottom of said side wall, one end of each of said pins having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally from, and through, the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
the other end of each of said terminal pins extending in gull wing fashion outwardly from and below the bottom of the side wall for mounting onto the surface	***Yuichi Patent:*** *Yuichi* describes molded terminal pins that have one end extending outwardly from below the bottom in a gull wing fashion for mounting onto the surface of the printed circuit board (Figs. 1, 4; Section [0018]; Claim 1).

of the printed circuit board, and	
at least one reinforcement beam located laterally along the bottom of said package to provide improved mechanical strength of said package.	***Yuichi Patent:*** *Yuichi* discloses bottom face 2c sides that provide for improved mechanical strength of the package (Fig. 4).

Claim 7

7. The package as in claim 6 further including a standoff for maintaining a distance between said terminal pins and said printed circuit board.	***Yuichi Patent***: It is noted that the '720 patent is a continuation-in-part of the parent patent 5,656,985 and that language added to the specification of the '720 patent includes that at column 4, lines 54-56 which describes using a portion of the case as a standoff. *Yuichi* discloses a standoff 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Sections 0017, 0018; Fig. 4).

37 CFR § 1.510(b)(3) - A Copy of Every Patent or Printed Publication Relied Upon or Referred to in Paragraph (b)(1) and (2)

Copies of every patent or printed publication relied upon or referred to in Paragraph (b)(1) and (2) are attached as Attachments I-V.

37 C.F.R. § 1.510(b)(4) - Copy of the '721 Patent

A double-column copy of the subject '721 patent is enclosed as **Attachment A** to this Request for Reexamination.

37 C.F.R § 1.510(b)(5) - A Certification That a Copy of the Request Filed by a Person Other Than the Patent Owner Has Been Served in its Entirety on the Patent Owner at the Address as Provided for in § 1.33(c)

A certification that a copy of the request filed has been served to the patent owner at the address as provided for in § 1.33(c) is attached.

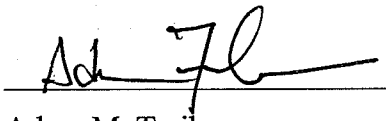
37 C.F.R. § 1.510(f) - Statement of Representative Capacity

This request for *ex parte* reexamination is made on behalf of Midcom pursuant to 37 C.F.R. § 1.510(a). The undersigned attorney, Adam M. Treiber (Reg. No. 48,000) hereby confirms that he is acting in a representative capacity for Midcom in this matter pursuant to 37 C.F.R. § 1.34.

CONCLUSION

The patents and references cited in this request for reexamination present a substantial new question of patentability with respect to claims 1-7 of the '721 patent. Therefore, *ex parte* reexamination of the '721 patent is respectively requested pursuant to 35 U.S.C. §§ 301-307 and 37 C.F.R. § 1.510.

Respectively submitted,

Date: May 5, 2008 By: 

Adam M. Treiber
Registration No. 48,000
Attorney for Requestor

#102246815_2

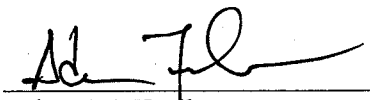
INDEX OF "ATTACHMENTS" TO REQUEST FOR REEXAMINATION

Attachment A:	U.S. Patent Number 6,297,721 (Lu et al.)
Attachment B:	Plaintiff Halo's Complaint
Attachment C:	Defendant Midcom's Answer and Counterclaim
Attachment D:	Defendant Elec & Eltek (USA) Corporation Answer and Counterclaim
Attachment E:	Defendant XFMRS, Inc.'s Answer and Counterclaim
Attachment F:	Defendant XFMRS, Inc.'s First Amended Answer and Counterclaim
Attachment G:	Defendant XFMRS, Inc.'s Second Amended Answer and Counterclaim
Attachment H:	Civil Action Docket Sheet
Attachment I:	U.S. Patent Number 5,212,345 (*Gutierrez*)
Attachment J:	*Tischler* Reference
Attachment K:	*NPI 10BaseT Catalog Page*
Attachment L:	*Gongin H-16S* Specification Sheet
Attachment M:	*Gongin RH-16* Specification Sheet
Attachment N:	NPI/Xircom Invoice
Attachment O:	NPI 10BaseT June 1996 Catalog Page
Attachment P:	*NPI Isolation Transformers Catalog Page*
Attachment Q:	NPI/Interphase October 28, 1991 Letter
Attachment R:	U.S. Patent Number 3,721,747 (*Renskers*)
Attachment S:	*McCormick* Reference
Attachment T:	*Yuichi* Patent – JP7161535
Attachment U:	NP5417 Bill of Materials
Attachment V:	September 15, 1995 Letter to Chris Nixon of 3Com Limited

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Request for *Ex Parte* Reexamination was concurrently served by first-class mail on Halo Electronics, Inc., at the address provided for under 37 C.F.R. § 1.33(c):

Haynes, Mark (30846)
Beffel, Ernest Jr (43489)
Wolfeld, Warren (31454)
Haynes Beffel & Wolfeld LLP
P.O. Box 366
Half Moon Bay, CA 94019



Adam M. Treiber
Registration No. 48,000
Baker & Hostetler LLP

EXHIBIT D

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.:	**6,320,489**	
Issued:	November 20, 2001	Reexamination Control No.: Not Yet Assigned
Inventor:	Peter Lu et. al	Reexamination Filing Date: Herewith
Serial No.:	08/977,400	Art Unit: Not Yet Assigned
Filed:	November 24, 1997	Examiner: Not Yet Assigned
For:	ELECTRONIC SURFACE MOUNT PACKAGE WITH EXTENDED SIDE RETAINING WALL	

Mail Stop *Ex Parte* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR *EX PARTE* REEXAMINATION

Dear Sir:

Pursuant to 35 U.S.C. §§ 301-307 and 37 C.F.R. § 1.510, the undersigned on behalf of Wurth Electronics Midcom, Inc. ("Midcom") hereby requests an *ex parte* reexamination of U.S. Patent No. 6,320,489 ("the '489 patent"), a copy of which is attached as **Attachment A**, that issued from U.S. Patent Application No. 08/977,400, filed on November 24, 1997. Each claim of the '489 patent recites the feature of the end walls of the device having first and second heights which is supported by disclosure added in that continuation-in-part application and thus, each claim is entitled only to a the November 24, 1997 filing date as its priority date.

The '489 patent, along with five other patents claiming priority back to the same parent application, U.S. Ser. No. 08/513,573, is currently the subject of litigation in the U.S. District Court, Northern District of California, Case No. CV 07-06222 JCS ("the Halo Litigation"). That litigation was brought by Halo Electronics, Inc., the current owner of record of the '489 patent, against Midcom

and three other companies. The other patents involved in the litigation are U.S. Patent Nos. 5,656,985; 6,297,720; 6,297,721; 6,344,785; 6,662,431, for which Midcom is separately requesting *ex parte* reexamination. A copy of Halo's complaint is appended hereto as **Attachment B**. Midcom's Answer and Counterclaim as well as the Answer and Counterclaim of Elec & Eltek (USA) Corporation are appended hereto as **Attachments C and D**, respectively. The Answer and Counterclaim, First Amended Answer and Counterclaim and Second Amended Answer and Counterclaim of XFMRS, Inc. are appended hereto as **Attachments E, F and G**, respectively. A copy of the Civil Action Docket Sheet for the Halo Litigation (obtained April 21, 2008) is appended hereto as **Attachment H**.

EX PARTE REEXAMINATION REQUIREMENTS UNDER 37 C.F.R § 1.510(a)-(f)

37 C.F.R. § 1.510(a) - Fee Payment

Payment for this reexamination request ($2,520, see 37 C.F.R. § 1.20(c)(1)) is enclosed.

37 CFR § 1.510(b)(1) - A Statement Pointing Out Each Substantial New Question of Patentability Based on Prior Patents and Printed Publications

1. Claims 1-8 of the '489 patent are rendered obvious under 35 U.S.C § 103(a) by U.S. Patent No. 5,212,345 ("*Gutierrez*"), which issued on May 18, 1993, appended hereto as **Attachment I**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown in such references as the article entitled "Mounting & Packing Techniques For Toroidal Devices," authored by Harold Tischler, and published in the October 1993 *Proceedings of Electrical Electronics Insulation Conference and Electrical Manufacturing & Coil Winding Conference* ("*Tischler*"), appended hereto as **Attachment J**.

Gutierrez discloses a surface mount package for a toroidal transformer (or other circuit element). *Tischler* discloses mounting "one or several" (i.e., a plurality of) toroidal transformers within a single package, as well as molded-in terminations for surface mount pins.

2. Claims 1-8 of the '489 patent are rendered obvious under 35 U.S.C § 103(a) by JP 7161535 ("*Yuichi*") authored by Saito Yuichi, which published on June 23, 1995, appended hereto as **Attachment K** (including translation), in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Tischler*, *Renskers* or *McCormick*.

3. Claims 1-8 of the '489 patent are rendered obvious under 35 U.S.C § 103(a) by the NPI catalog page for the 10BaseT Ethernet Surface Mount Transformers ("*NPI 10BaseT Catalog Page*") appended hereto as **Attachment L**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as the *Gongin H-16S* specification sheet, appended hereto as **Attachment M**, and the *Gongin RH-16* specification sheet, appended hereto as **Attachment N**.[1]

The *NPI 10BaseT Catalog Page* shows a surface mount package with a plurality of transformers. The *NPI 10BaseT Catalog Page* was publicly available prior to August 10, 1994, as confirmed by the NPI invoice to a customer, Xircom, appended hereto as **Attachment O**. That invoice shows that 10 of the 5366-30 devices included on the *NPI 10BaseT Catalog Page* were ordered and scheduled for delivery January 31, 1992. In addition, a later version of the *NPI 10BaseT Catalog Page* showing a June 1994 version date in the lower right hand corner, appended hereto as **Attachment P**, also confirms the public availability of the *NPI 10BaseT Catalog Page* prior to August 10, 1994.

The Gongin specification sheets show associated electronic component packages provided in surface mount and through-hole configurations that can be used in the manufacture of the products depicted in the *NPI 10BaseT Catalog Page*. The Gongin specification sheets also demonstrate that, by

[1] Although the Gongin specification sheets bear dates of 76.5.12, because these specifications were published in Taiwan and dated according to the Taiwanese Calendar, they use the 1911 founding of the Republic of China as a reference point in establishing the date. As measured against the '489 patent, the dates of these documents are May 12, 1987.

at least as early as May of 1987, through-hole packaging and surface mount packaging were known alternatives for electronic components.

4. Claims 1-8 of the '489 patent are rendered obvious under 35 U.S.C § 103(a) by the NPI catalog page for the Ethernet Isolation Transformers ("*NPI Isolation Transformers Catalog Page*"), appended hereto as **Attachment Q**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by the *Gongin H-16S* (Attachment N). The *NPI Isolation Transformers Catalog Page* depicts a through-hole package (Part Number NP5416) that includes a plurality of transformers. A copy of the *NPI Isolation Transformers Catalog Page* was publicly available prior to August 10, 1994, as demonstrated by the letter to NPI customer Interphase dated October 28, 1991, appended hereto as **Attachment R**, providing materials information regarding the NPI part number 5416. It is noted that page 2 of Attachment Q indicates that the 5416 part utilized silicone mummy compound for encasing the transformers in the device.

5. Claims 1-8 of the '489 patent are rendered obvious under 35 U.S.C § 103(a) by U.S. Patent No. 3,721,747 ("*Renskers*"), which issued on March 20, 1973, appended hereto as **Attachment S**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Tischler*. Although *Renskers* was considered during prosecution of the '489 patent, it was not considered in view of the *Tischle*r reference as cited herein.

6. Claims 1-8 of the '489 patent are rendered obvious under 35 U.S.C § 103(a) by the article entitled "Surface Mount Transformers: A New Packaging Approach," authored by Brad J. McCormick et al., and published in the February 1993 issue of Surface Mount Technology ("*McCormick*"), appended hereto as **Attachment T**, in view of the knowledge of those of ordinary skill in the art prior to August 10, 1994, as shown by such references as *Gutierrez* as cited herein.

It is noted that the '489 patent is a continuation-in-part of parent patent 5,656,985. Disclosure added to the '489 patent included the following language found at Col. 2, lines 32-36: "As will be described in more detail below, the present invention is directed toward applications for packages mounted on a printed circuit board in an electronic device, which requires very low current and voltages, and is for DC voltages only." Because all of the foregoing references fall within the scope of the invention as defined by the applicant, they are clearly "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385, 1397 (2007).

37 C.F.R. § 1.510(b)(2) - Claims for Which Reexamination is Requested and Detailed Explanation of Pertinency and Manner of Applying the Cited Prior Art to Every Claim for Which Reexamination is Requested.

Reexamination is requested of claims 1-8 of the '489 patent, i.e., all claims. A statement of the substantial new questions of patentability presented by this request for reexamination is provided below along with a detailed explanation of the pertinency and manner of applying the aforementioned references to each claim for which reexamination is requested.

1. Claims 1-8 Are Invalid Under 35 U.S. C §103 Over *Gutierrez* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting (Col. 1, lines 5-9).
a one piece construction	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction

package having end walls, a side wall and an open bottom,	package that has end walls, side walls and an open bottom (Col. 2, lines 37-47, Fig. 1).
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon;	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '489 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 19-21). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively;	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Gutierrez Patent***: *Gutierrez* discloses end walls that include support pads 50, 58 and support pads 52, 44, respectively, that form standoffs or safe guards between the surface of a printed circuit board and the terminal pins (Figs. 1, 3-5; Col. 6–13).
the outer portion of said side wall extending between said end walls and having a	***Gutierrez Patent***: *Gutierrez* discloses support members 24, 32 and support members 18, 26 that form outer portions of each respective side wall that have a height less than the height of the support pads 50,

second height H2 which is less than said first height H1.	58 and 52, 44, respectively (Fig. 3).

Claim 2

2. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting (Col. 1, lines 5-9).
a construction package having end walls, a side wall and an open bottom,	***Gutierrez Patent***: *Gutierrez* discloses a construction package that has end walls, side walls and an open bottom (Col. 2, lines 37-47, Fig. 1).
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '489 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 19-21). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having notched solder posts upon which said wires from said transformers are wrapped and soldered	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).

thereon, respectively;	
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Gutierrez Patent***: *Gutierrez* discloses end walls that include support pads 50, 58 and support pads 52, 44, respectively, that form standoffs or safe guards between the surface of a printed circuit board and the terminal pins (Figs. 1, 3-5; Col. 6–13).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	***Gutierrez Patent***: *Gutierrez* discloses support members 24, 32 and support members 18, 26 that form outer portions of each respective side wall that have a height less than the height of the support pads 50, 58 and 52, 44, respectively (Fig. 3).

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package (Fig. 1; Col 2. lines 37-47).

Claim 4

4. The package of claim 3 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '489 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the lead termination blocks disclosed in *Gutierrez* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 5

5. An electronic surface mount package for	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting in an electronic device (Col. 1, lines 5-

mounting onto the surface of a printed circuit board in an electronic device, said electronic surface mount package comprising:	9).
a one piece construction package having end walls, a side wall and an open bottom,	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package that has end walls, side walls and an open bottom (Col. 2, lines 37-47, Fig. 1).
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '489 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 19-21). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).
said end walls having a first height H1 to form a standoff or safe guard between the	***Gutierrez Patent***: *Gutierrez* discloses end walls that include support pads 50, 58 and support pads 52, 44, respectively, that form standoffs or safe guards between the surface of a printed circuit board and the

surface of a printed circuit board and said terminal pins;	terminal pins (Figs. 1, 3-5; Col. 6–13).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	***Gutierrez Patent***: *Gutierrez* discloses support members 24, 32 and support members 18, 26 that form outer portions of each respective side wall that have a height less than the height of the support pads 50, 58 and 52, 44, respectively (Fig. 3).

Claim 6

6. The package as in claim 5 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***Gutierrez Patent***: *Gutierrez* discloses a standoff in the form of a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on the lead terminals (Fig. 3; Col. 3, lines 6-12).

Claim 7

7. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting (Col. 1, lines 5-9).
a construction package having end walls, a side wall and an open bottom,	***Gutierrez Patent***: *Gutierrez* discloses a construction package that has end walls, side walls and an open bottom (Col. 2, lines 37-47, Fig. 1).
at least one toroid transformer within said package by a soft silicone material, said toroid transformer having a wire wrapped thereon,	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '489 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 19-21). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped

	toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
at least one terminal pin molded within and extending from the bottom of said package, said pin extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wire from said transformer is wrapped and soldered thereon,	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Gutierrez Patent***: *Gutierrez* discloses end walls that include support pads 50, 58 and support pads 52, 44, respectively, that form standoffs or safe guards between the surface of a printed circuit board and the terminal pins (Figs. 1, 3-5; Col. 6–13).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	***Gutierrez Patent***: *Gutierrez* discloses support members 24, 32 and support members 18, 26 that form outer portions of each respective side wall that have a height less than the height of the support pads 50, 58 and 52, 44, respectively (Fig. 3).

Claim 8

8. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said package comprising:	***Gutierrez Patent***: *Gutierrez* discloses an electronic surface mount package for surface mounting in an electronic device (Col. 1, lines 5-9).
a one piece open construction package having end walls, side walls and an open bottom,	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package that has end walls, side walls and an open bottom (Col. 2, lines 37-47, Fig. 1).
a plurality of toroid transformers within said	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a plastic material, covering and encapsulating windings and a toroidal core, and

package, said toroid transformers each having a side wall and wires wound thereon,	forming a box-like package (Col. 3, lines 19-28). While *Gutierrez's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Gutierrez's* package, as suggested within the Background section of the '489 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 19-21). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending through a bottom of said side wall and below the inner portion of said side wall, each of said pins having a hour-glass shaped notched solder post upon which said wires from said transformers are wrapped thereon, respectively,	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body. These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads. A lead from one end of each coil on a core extends to and terminates as a winding on each support member (Fig. 2; Col. 2, lines 53-62). It would be further obvious to one skilled in the art that these notches would be in an "hour-glass" shape, upon which transformer wires are wrapped and soldered thereon.
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Gutierrez Patent***: *Gutierrez* discloses end walls that include support pads 50, 58 and support pads 52, 44, respectively, that form standoffs or safe guards between the surface of a printed circuit board and the terminal pins (Figs. 1, 3-5; Col. 6–13).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	***Gutierrez Patent***: *Gutierrez* discloses support members 24, 32 and support members 18, 26 that form outer portions of each respective side wall that have a height less than the height of the support pads 50, 58 and 52, 44, respectively (Fig. 3).

2. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over the *Yuichi* patent in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") (Sections [0003, 0004]).
a one piece construction package having end walls, a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has end walls, side walls and an open bottom (Figs. 1, 4).
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon;	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '489 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 19-21). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wires from said transformers are	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally from, and through, the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-

wrapped and soldered thereon, respectively;	44).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Yuichi Patent:*** *Yuichi* discloses bottom faces 2c that function as standoffs between the surface of the printed circuit board and the terminal pin (Figs. 1, 4).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	***Yuichi Patent:*** Yuichi discloses grooved portions 8 having a second height that is less than the height of the respective bottom faces 2c (Fig. 1)

Claim 2

2. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") (Sections [0003, 0004]).
a construction package having end walls, a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a construction package 2 that has end walls, side walls and an open bottom (Figs. 1, 4).
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '489 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 19-21). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids

	(Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having notched solder posts upon which said wires from said transformers are wrapped and soldered thereon, respectively;	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally from, and through, the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Yuichi Patent:*** *Yuichi* discloses bottom faces 2c that function as standoffs between the surface of the printed circuit board and the terminal pin (Figs. 1, 4).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	***Yuichi Patent:*** Yuichi discloses grooved portions 8 having a second height that is less than the height of the respective bottom faces 2c (Fig. 1)

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 (Figs. 1, 4).

Claim 4

4. The package of claim 3 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '489 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*,

	999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. It is presumed, therefore, that the terminal leads disclosed in the *Yuichi* Patent are spaced apart by an amount sufficient to avoid arcing.

Claim 5

5. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said electronic surface mount package comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") in an electronic device (Sections [0003, 0004]).
a one piece construction package having end walls, a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has end walls, side walls and an open bottom (Figs. 1, 4).
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '489 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 19-21). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally from, and through, the bottom of the package side wall

extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	(Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Yuichi Patent:*** *Yuichi* discloses bottom faces 2c that function as standoffs between the surface of the printed circuit board and the terminal pin (Figs. 1, 4).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	***Yuichi Patent:*** Yuichi discloses grooved portions 8 having a second height that is less than the height of the respective bottom faces 2c (Fig. 1)

Claim 6

6. The package as in claim 5 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***Yuichi Patent***: *Yuichi's* standoff 2c maintains the distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).

Claim 7

7. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") (Sections [0003, 0004]).
a construction package having end walls, a side wall and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a construction package 2 that has end walls, side walls and an open bottom (Figs. 1, 4).

at least one toroid transformer within said package by a soft silicone material, said toroid transformer having a wire wrapped thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer having wires wrapped thereon (Figs. 1, 4; Section [0003]). *Yuichi* discloses adhesives of a silicone system or a urethane system formed between the wall of the package and the peripheries of the winding member (Section [0021]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '489 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 19-21). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
at least one terminal pin molded within and extending from the bottom of said package, said pin extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wire from said transformer is wrapped and soldered thereon,	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally from, and through, the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Yuichi Patent:*** *Yuichi* discloses bottom faces 2c that function as standoffs between the surface of the printed circuit board and the terminal pin (Figs. 1, 4).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	***Yuichi Patent:*** Yuichi discloses grooved portions 8 having a second height that is less than the height of the respective bottom faces 2c (Fig. 1)

Claim 8

8. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said package comprising:	***Yuichi Patent***: *Yuichi* discloses a surface mount package for mounting on a printed circuit board ("IC Card") in an electronic device (Sections [0003, 0004]).
a one piece open construction package having end walls, side walls and an open bottom,	***Yuichi Patent***: *Yuichi* depicts a one piece construction package 2 that has end walls, side walls and an open bottom (Figs. 1, 4).
a plurality of toroid transformers within said package, said toroid transformers each having a side wall and wires wound thereon,	***Yuichi Patent***: *Yuichi* discloses a package containing a toroidal transformer (Figs. 1, 4; Section [0003]). While *Yuichi's* exemplary package includes a single toroidal transformer, it would have been obvious to include a plurality of toroidal transformers within *Yuichi's* package, as suggested within the Background section of the '489 patent itself ("Electronic surface mount packages are utilized in applications in which one or more individual toroid transformers are embodied within the surface mount package" Col. 1, lines 13-16). Numerous examples can also be found in the prior art, such as *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) toroidal transformers in a single package (Page 262, Top), *Renskers*, which discloses four (i.e., a plurality of) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Illustration, Page 27).
a plurality of terminal pins molded within and extending through a bottom of said side wall and below the inner portion of said side wall, each of said pins having a hour-glass shaped notched solder post upon which said wires from said transformers are wrapped thereon, respectively,	***Yuichi Patent:*** *Yuichi* depicts molded, lead terminals 7 extending laterally from, and through, the bottom of the package side wall (Fig. 2). Although *Yuichi* does not depict notches in his pins, prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44). It would be further obvious to one skilled in the art that these notches would be in an "hour-glass" shape, upon which transformer wires are wrapped and soldered thereon.
said end walls having a first	***Yuichi Patent:*** *Yuichi* discloses bottom faces 2c that function as

height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	standoffs between the surface of the printed circuit board and the terminal pin (Figs. 1, 4).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	***Yuichi Patent:*** Yuichi discloses grooved portions 8 having a second height that is less than the height of the respective bottom faces 2c (Fig. 1)

3. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over the *NPI 10BaseT Catalog Page* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***NPI 10BaseT Catalog Page***: *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a one piece construction package having end walls, a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having end walls and side walls. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon;	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package. By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page*

molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively;	discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for containing a plurality of toroids, as indicated by the drawing on the Reference. It would have been obvious to utilize a standoff in connection with the 5366-30 package disclosed in the *NPI 10BaseT Catalog Page*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 2

2. An electronic surface mount package for	***NPI 10BaseT Catalog Page***: *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.

mounting onto the surface of a printed circuit board comprising:	
a construction package having end walls, a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having end walls and side walls. It would have been obvious to those of ordinary skill in the art to utilize a construction package as shown by the *Gongin H-16S Reference,* which illustrates a package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package. By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having notched solder posts upon which said wires from said transformers are wrapped and soldered thereon, respectively;	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
said end walls having a first height H1 to form a standoff	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for containing a plurality of toroids,

or safe guard between the surface of a printed circuit board and said terminal pins;	as indicated by the drawing on the Reference. It would have been obvious to utilize a standoff in connection with the 5366-30 package disclosed in the *NPI 10BaseT Catalog Page*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a construction package. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference.*

Claim 4

4. The package of claim 3 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '489 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "...the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the terminal leads disclosed in *NPI*

	10BaseT Catalog Page are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 5

5. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said electronic surface mount package comprising:	***NPI 10BaseT Catalog Page***: *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a one piece construction package having end walls, a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having end walls and side walls. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package. By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wires from	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches

said transformers are wrapped and soldered thereon, respectively,	50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for containing a plurality of toroids, as indicated by the drawing on the Reference. It would have been obvious to utilize a standoff in connection with the 5366-30 package disclosed in the *NPI 10BaseT Catalog Page*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 6

6. The package as in claim 5 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for containing a plurality of toroids, as indicated by the drawing on the Reference. It would have been obvious to utilize a standoff in connection with the 5366-30 package disclosed in the *NPI 10BaseT Catalog Page*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12),

	Renskers, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).

Claim 7

7. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***NPI 10BaseT Catalog Page***: *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a construction package having end walls, a side wall and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having end walls and side walls. It would have been obvious to those of ordinary skill in the art to utilize a construction package as shown by the *Gongin H-16S Reference,* which illustrates a package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
at least one toroid transformer within said package by a soft silicone material, said toroid transformer having a wire wrapped thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package. By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
at least one terminal pin molded within and extending from the bottom of said package, said pin extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wire from said	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches

transformer is wrapped and soldered thereon,	50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for containing a plurality of toroids, as indicated by the drawing on the Reference. It would have been obvious to utilize a standoff in connection with the 5366-30 package disclosed in the *NPI 10BaseT Catalog Page*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 8

8. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said package comprising:	***NPI 10BaseT Catalog Page***: *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a one piece open construction package having end walls, side walls and an open bottom,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* drawings disclose a package having end walls and side walls. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and

	reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package, said toroid transformers each having a side wall and wires wound thereon,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B). By the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a single package (Fig. 2; Col. 3, line 60), *Yuichi*, which discloses a wire wrapped toroid carried within a single package (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending through a bottom of said side wall and below the inner portion of said side wall, each of said pins having a hour-glass shaped notched solder post upon which said wires from said transformers are wrapped thereon, respectively,	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. It was known in this art to have molded in pins extending from the bottom of a side wall. For example, the *Gongin H-16S Reference* discloses molded in terminations that extend through the bottom once the leads are inverted. It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62). It would be further obvious to one skilled in the art that these notches would be in an "hour-glass" shape, upon which transformer wires are wrapped and soldered thereon.
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for containing a plurality of toroids, as indicated by the drawing on the Reference. It would have been obvious to utilize a standoff in connection with the 5366-30 package disclosed in the *NPI 10BaseT Catalog Page*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of

	downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

4. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over the *NPI Isolation Transformers Catalog Page* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '489 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a one piece construction package having end walls, a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having end walls and side walls. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-

	wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon;	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B).[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively;	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a standoff in the form of "nubs" extending from the bottom of each package.

[2] Although not identified as such in the NPI Isolation Transformers Catalog Page, the transformers used in this device were indeed toroid transformers as shown in the April 28, 1994 Bill of Materials for the NP5417 part, appended hereto as **Attachment U**. As also shown in this Bill of Materials, a silicone paste was being used in construction of the device as was the Gongin RH-16 header. The NP5417 Bill of Materials was publicly available at least as early as September 15, 1994 when it was forwarded to Chris Nixon at 3Com Limited with the letter of **Attachment V**.

the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 2

2. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '489 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a construction package having end walls, a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having end walls and side walls. It would have been obvious to those of ordinary skill in the art to utilize a construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B).[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane

	material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having notched solder posts upon which said wires from said transformers are wrapped and soldered thereon, respectively;	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a standoff in the form of "nubs" extending from the bottom of each package.
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a construction package. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference.*

Claim 4

4. The package of claim 3 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '489 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the terminal leads disclosed in *NPI Isolation Transformers Catalog Page* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 5

5. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said electronic surface mount package comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '489 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a one piece construction package having end walls, a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having end walls and side walls. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-

	wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B).[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a standoff in the form of "nubs" extending from the bottom of each package.
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

H1.	

Claim 6

6. The package as in claim 5 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a standoff in the form of "nubs" extending from the bottom of each package.

Claim 7

7. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '489 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a construction package having end walls, a side wall and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having end walls and side walls. It would have been obvious to those of ordinary skill in the art to utilize a construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
at least one toroid transformer within said package by a soft silicone material, said toroid transformer having a wire wrapped thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B).[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material.

	Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
at least one terminal pin molded within and extending from the bottom of said package, said pin extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wire from said transformer is wrapped and soldered thereon,	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a standoff in the form of "nubs" extending from the bottom of each package.
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 8

8. An electronic surface mount package for mounting onto the surface of a printed circuit board in	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses an electronic through-hole mount package configuration. It would have been obvious to one skilled in the art prior to August 10, 1994, to configure the device of

an electronic device, said package comprising:	the *NPI Isolation Transformers Catalog Page* as a surface mount device as demonstrated by the *Gongin RH-16 and H-16S References*, which depict associated through-hole and surface mount variations of the packages. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '489 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.
a one piece open construction package having end walls, side walls and an open bottom,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* drawings disclose a package having end walls and side walls. It would have been obvious to those of ordinary skill in the art to utilize a one piece construction package as shown by the *Gongin H-16S Reference,* which illustrates a one piece electronic package with an open top, and reverse the lead bending of the gull-wings to instead configure it with an open bottom.
a plurality of toroid transformers within said package, said toroid transformers each having a side wall and wires wound thereon,	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package (Center Drawing Between Package A and Package B).[2] Furthermore, by the early 1990's, it was known in this art to package a plurality of wire wrapped toroidal transformers in a single device in soft silicone material. Numerous examples can be found in the prior art, such as *Renskers*, which discloses four (i.e., a plurality of) wire wrapped toroids in a highly yieldable material (Fig. 2; Col. 3, line 60), *Yuichi* which discloses a wire wrapped toroid carried within a silicone or urethane material (Section 0013), *Tischler*, which discloses mounting "one or several" (i.e., a plurality of) wrapped toroidal transformers in a single package in epoxy (Page 261-2), or *McCormick*, which discloses two (i.e., a plurality of) fully molded and potted toroids in epoxy or similar material (Text and Illustration, Page 27).
a plurality of terminal pins molded within and extending through a bottom of said side wall and below the inner portion of said side wall, each of said pins having a hour-glass shaped notched solder post upon	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins molded within, and extending from, the bottom of the package (Package B). It would have been obvious to one of ordinary skill in the art to have notches on the posts upon which wires from the transformers are wrapped and soldered. Numerous examples can be found in the prior

which said wires from said transformers are wrapped thereon, respectively,	art, such as *Renskers*, which discloses terminal lugs 32 with lead legs 42 that have notches 50 upon which the wires from the transformers are wrapped and soldered (Fig. 2), or *Gutierrez*, which discloses a plurality of pins (lead termination blocks or support members 18, 20, 22, 24, 26, 28, 30, 32) extending laterally outward from the bottom ("base") of the body having notches in the form of a spool configuration, with opposed shoulders for retaining wound leads (Fig. 2; Col. 2, lines 53-62). It would be further obvious to one skilled in the art that these notches would be in an "hour-glass" shape, upon which transformer wires are wrapped and soldered thereon.
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a standoff in the form of "nubs" extending from the bottom of each package.
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

5. Claims 1-8 Are Invalid Under 35 U.S.C § 103 Over *Renskers* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '489 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is

	not necessary to give meaning to the claim.[3]
a one piece construction package having end walls, a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a one piece construction package having end walls, side walls and open bottom (Figs. 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon;	***Renskers Patent***: Renskers discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material" (Figs. 2, 5; Col. 3, line 60).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively;	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Renskers Patent***: *Renskers* discloses standoffs 24, as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9).

[3] It is noted that the '489 patent recites that "**special design consideration** has been applied to thermal expansion of materials to ensure that the package will stand all normal reflow processes with low cost, easy manufacturing, and high reliability." Column Col. 4, lines 52-56 (emphasis added). No detailed specifications regarding these "special design considerations" have been disclosed in the specification and thus, in addition to the issue regarding compliance with 35 U.S.C § 112, Paragraph 1, there is no support in the specification for distinguishing surface mount technology from other technologies such as through-hole mounting. In fact, twice in the specification the inventors specifically state that the invention is not limited to the disclosed embodiment. See Col. 3, line 10-16 and Col 8, lines 3-14.

the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 2

2. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '489 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[3]
a construction package having end walls, a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a construction package having end walls, side walls and open bottom (Figs. 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Renskers Patent***: Renskers discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material" (Figs. 2, 5; Col. 3, line 60).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of

portion of said side wall and having notched solder posts upon which said wires from said transformers are wrapped and soldered thereon, respectively;	wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Renskers Patent***: *Renskers* discloses standoffs 24, as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 3

3. A package as in claim 2 wherein said construction package is one piece.	***Renskers Patent***: *Renskers* discloses a one piece construction package. (Figs. 2, 3, 5; Col. 3, lines 63-66)

Claim 4

4. The package of claim 3 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '489 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "…the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the terminal leads disclosed in *Renskers* are spaced apart by an amount that may be presumed to be

	sufficient to avoid arcing.

Claim 5

5. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said electronic surface mount package comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '489 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[3]
a one piece construction package having end walls, a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a one piece construction package having end walls, side walls and open bottom (Figs. 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***Renskers Patent***: Renskers discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material" (Figs. 2, 5; Col. 3, line 60).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wires from said transformers are wrapped and soldered	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known.

thereon, respectively,	*See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Renskers Patent***: *Renskers* discloses standoffs 24, as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 6

6. The package as in claim 5 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit board.	***Renskers Patent***: *Renskers* discloses standoffs 24, as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9).

Claim 7

7. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '489 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[3]

a construction package having end walls, a side wall and an open bottom,	***Renskers Patent***: *Renskers* discloses a construction package having end walls, side walls and open bottom (Figs. 2, 3, 5; Col. 3, lines 63-66).
at least one toroid transformer within said package by a soft silicone material, said toroid transformer having a wire wrapped thereon,	***Renskers Patent***: Renskers discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box containing a "highly yieldable material" (Figs. 2, 5; Col. 3, line 60).
at least one terminal pin molded within and extending from the bottom of said package, said pin extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wire from said transformer is wrapped and soldered thereon,	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***Renskers Patent***: *Renskers* discloses standoffs 24, as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 8

8. An electronic surface mount package for mounting onto the surface of a printed circuit board in	***Renskers Patent***: *Renskers* discloses a dual in-line package, for mounting on a circuit board, that has a body with a cavity for housing four toroidal transformers (or other circuit elements) (Figs. 1, 2; Col. 2, line 57 to Col. 3, line 55). It would have been obvious to one

an electronic device, said package comprising:	skilled in the art prior to August 10, 1994 to configure *Renskers'* device as a surface mount device, as demonstrated by the *Gongin RH-16 and H-16S* references, which depict associated through-hole and surface mount package variations. Moreover, language in a preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005). Nowhere in the specification or claims of the '489 patent is surface mount technology disclosed or identified as an "essential structure" that is important to the invention. Moreover, there are no limitations in the claims which cannot be understood without reference to the preamble and thus the preamble is not necessary to give meaning to the claim.[3]
a one piece open construction package having end walls, side walls and an open bottom,	***Renskers Patent***: *Renskers* discloses a construction package having end walls, side walls and open bottom (Figs. 2, 3, 5; Col. 3, lines 63-66).
a plurality of toroid transformers within said package, said toroid transformers each having a side wall and wires wound thereon,	***Renskers Patent***: Renskers discloses a plurality (i.e., four) wire-wrapped toroid transformers (Fig. 2; Col. 3, lines 6-15) mounted in the cavity of the box (Figs. 2, 5; Col. 3, line 60).
a plurality of terminal pins molded within and extending through a bottom of said side wall and below the inner portion of said side wall, each of said pins having a hour-glass shaped notched solder post upon which said wires from said transformers are wrapped thereon, respectively,	***Renskers Patent***: *Renskers* discloses eight terminal lugs 32 (i.e., pins) that connect the four toroidal transformers 30 to the circuit board (Figs. 1-3, 5, 6). Each terminal lug 30 includes a narrow point 36 adapted for circuit board insertion, a short mounting leg 40, and a lead leg 42 to which the transformer leads are connected (Col. 3, lines 17-23). Lugs 32 extend from, and through, the bottom of the side walls 12, while lead legs 42 include notches 50 which provide a point of wrap for the transformer leads (Col. 3, lines 30-44). Although *Renskers* does not explicitly disclose molding the pins into the package, it would have been obvious to one skilled in the art prior to August 10, 1994 to utilize pins molded within the package and extending through the bottom of the side wall, as was widely known. *See*, e.g., *Tischler*, which discloses surface mount platforms with molded-in terminations (Page 261). It would be further obvious to one skilled in the art that these notches would be in an "hour-glass" shape, upon which transformer wires are wrapped and soldered thereon.
said end walls having a first	***Renskers Patent***: *Renskers* discloses standoffs 24, as well as prior art

height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

6. Claims 1-8 Are Invalid Under 35 U.S.C §103 Over *McCormick* in View of the Knowledge of Those of Ordinary Skill in the Art

Claim 1

1. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***McCormick Reference***: *McCormick* discloses an electronic surface mount package (Page 27).
a one piece construction package having end walls, a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a one piece housing with end walls, side walls and an open bottom (Illustration, Page 27).
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon;	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids (Illustration, Page 27). *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to encapsulate the entire unit (Page 27). The cup is formed from molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for

having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively;	retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***McCormick Patent***: *McCormick* discloses fully molded and potted toroids in a housing suited for automatic surface mount placement and high temperature assembly (Illustration, Page 27). It would have been necessary and obvious to utilize a standoff in connection with the device disclosed in *McCormick*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 2

2. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***McCormick Reference***: *McCormick* discloses an electronic surface mount package (Page 27).
a construction package having end walls, a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a housing with end walls, side walls and an open bottom (Illustration, Page 27).
a plurality of toroid transformers within said package by a soft silicone material, said toroid	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids (Illustration, Page 27). *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to

transformers each having wires wrapped thereon,	encapsulate the entire unit (Page 27). The cup is formed from molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).
a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having notched solder posts upon which said wires from said transformers are wrapped and soldered thereon, respectively;	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***McCormick Patent***: *McCormick* discloses fully molded and potted toroids in a housing suited for automatic surface mount placement and high temperature assembly (Illustration, Page 27). It would have been necessary and obvious to utilize a standoff in connection with the device disclosed in *McCormick*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 3

3. A package as in claim 2	***McCormick Reference***: *McCormick* discloses a one piece construction

wherein said construction package is one piece.	package ("housing") (Illustration, Page 27).

Claim 4

4. The package of claim 3 wherein said posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '489 patent provides no guidance or specifications regarding the requirements for such separation. Enablement in accordance with 35 U.S.C § 112 requires that "...the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 U.S.P.Q.2D (BNA) 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2D (BNA) 1510, 1513 (Fed. Cir. 1993)). Thus, it is presumed from this lack of disclosure that the applicant admits that such information was well known to those of ordinary skill in the art at the time of filing, and could be implemented without undue experimentation. The problem of arcing in electronics is well known and the principal method of preventing arcing, i.e., spacing, is also well known. Thus, the terminal leads disclosed in *McCormick* are spaced apart by an amount that may be presumed to be sufficient to avoid arcing.

Claim 5

5. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said electronic surface mount package comprising:	***McCormick Reference***: *McCormick* discloses an electronic surface mount package (Page 27).
a one piece construction package having end walls, a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a one piece housing with end walls, side walls and an open bottom (Illustration, Page 27).
a plurality of toroid transformers within said package by a soft silicone material, said toroid transformers each having wires wrapped thereon,	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids (Illustration, Page 27). *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to encapsulate the entire unit (Page 27). The cup is formed from molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).

a plurality of terminal pins molded within and extending from the bottom of said package, each of said pins extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wires from said transformers are wrapped and soldered thereon, respectively,	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***McCormick Patent***: *McCormick* discloses fully molded and potted toroids in a housing suited for automatic surface mount placement and high temperature assembly (Illustration, Page 27). It would have been necessary and obvious to utilize a standoff in connection with the device disclosed in *McCormick*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 6

6. The package as in claim 5 further including a standoff for maintaining a distance between the bottom of said pins and said printed circuit	***McCormick Patent***: *McCormick* discloses fully molded and potted toroids in a housing suited for automatic surface mount placement and high temperature assembly (Illustration, Page 27). It would have been necessary and obvious to utilize a standoff in connection with the device disclosed in *McCormick*. The utilization of a standoff was well

board.	known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).

Claim 7

7. An electronic surface mount package for mounting onto the surface of a printed circuit board comprising:	***McCormick Reference***: *McCormick* discloses an electronic surface mount package (Page 27).
a construction package having end walls, a side wall and an open bottom,	***McCormick Reference***: *McCormick* discloses a housing with end walls, side walls and an open bottom (Illustration, Page 27).
at least one toroid transformer within said package by a soft silicone material, said toroid transformer having a wire wrapped thereon,	***McCormick Reference***: *McCormick* discloses a plurality of fully molded and potted toroids (Illustration, Page 27). *McCormick* discloses a molding cup which holds the completed transformer assembly, which is filled with an epoxy or similar material to encapsulate the entire unit (Page 27). The cup is formed from molded thermoset, epoxy/glass thermoplastic, or machined material depending on thermal and other considerations. *McCormick* also shows wire wrapping multiple toroids (Page 27).
at least one terminal pin molded within and extending from the bottom of said package, said pin extending through a bottom portion of said side wall and below the inner portion of said side wall and having a notched solder post upon which said wire from said transformer is wrapped and soldered thereon,	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44).

said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***McCormick Patent***: *McCormick* discloses fully molded and potted toroids in a housing suited for automatic surface mount placement and high temperature assembly (Illustration, Page 27). It would have been necessary and obvious to utilize a standoff in connection with the device disclosed in *McCormick*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

Claim 8

8. An electronic surface mount package for mounting onto the surface of a printed circuit board in an electronic device, said package comprising:	***McCormick Reference***: *McCormick* discloses an electronic surface mount package (Page 27).
a one piece open construction package having end walls, side walls and an open bottom,	***McCormick Reference***: *McCormick* discloses a one piece housing with end walls, side walls and an open bottom (Illustration, Page 27).
a plurality of toroid transformers within said package, said toroid transformers each having a side wall and wires wound	***McCormick Reference***: *McCormick* discloses two fully molded and potted wire-wrapped toroids (Illustration, Page 27).

thereon,	
a plurality of terminal pins molded within and extending through a bottom of said side wall and below the inner portion of said side wall, each of said pins having a hour-glass shaped notched solder post upon which said wires from said transformers are wrapped thereon, respectively,	***McCormick Reference***: *McCormick* discloses magnet wire that forms the windings in a transformer and pins that act as an intermediate connection between the magnet wire and the traces on the printed circuit board (Page 27). Prior to August 10, 1994, it was already known in this art to utilize notched posts to wrap and solder the wire. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses lead termination blocks or support members 18, etc., that have notches in the form of spools with opposed shoulders for retaining wound leads (Col. 2, lines 53-62, Fig. 2), or *Renskers*, which discloses terminal lugs 32 that include lead legs 42 with notches 50 that provide a point of wrap for the transformer leads (Col. 3, lines 30-44). It would be further obvious to one skilled in the art that these notches would be in an "hour-glass" shape, upon which transformer wires are wrapped and soldered thereon.
said end walls having a first height H1 to form a standoff or safe guard between the surface of a printed circuit board and said terminal pins;	***McCormick Patent***: *McCormick* discloses fully molded and potted toroids in a housing suited for automatic surface mount placement and high temperature assembly (Illustration, Page 27). It would have been necessary and obvious to utilize a standoff in connection with the device disclosed in *McCormick*. The utilization of a standoff was well known in the art prior to August 10, 1994. Numerous examples can be found in the prior art, such as *Gutierrez*, which discloses a body member formed with a plurality of downwardly depending feet or support pads which directly engage the surface of a PC board, without the necessity of its resting on (i.e. independent of) the lead terminals (Fig. 3; Col. 3, lines 6-12), *Renskers*, which discloses standoffs 24 as well as prior art that includes stand-off provisions (Figs. 1–3, 5, 6; Col. 1, lines 4-9), and *Yuichi*, which discloses standoffs 2c for maintaining a distance between the bottom of the pins and the printed circuit board (Fig. 4; Section 0017, 0018).
the outer portion of said side wall extending between said end walls and having a second height H2 which is less than said first height H1.	It would have been an obvious variant to have a second portion of the side wall having a second height which is less than the first height. Examples of these obvious variants are found in *Gutierrez* and *Yuichi*.

37 CFR § 1.510(b)(3) - A Copy of Every Patent or Printed Publication Relied Upon or Referred to in Paragraph (b)(1) and (2)

Copies of every patent or printed publication relied upon or referred to in Paragraph (b)(1) and (2) are attached as Attachments I-V.

37 C.F.R. § 1.510(b)(4) - Copy of the '489 Patent

A double-column copy of the subject '489 patent is enclosed as **Attachment A** to this Request for Reexamination.

37 C.F.R § 1.510(b)(5) - A Certification That a Copy of the Request Filed by a Person Other Than the Patent Owner Has Been Served in its Entirety on the Patent Owner at the Address as Provided for in § 1.33(c)

A certification that a copy of the request filed has been served to the patent owner at the address as provided for in § 1.33(c) is attached.

37 C.F.R. § 1.510(f) - Statement of Representative Capacity

This request for *ex parte* reexamination is made on behalf of Midcom pursuant to 37 C.F.R. § 1.510(a). The undersigned attorney, Adam M. Treiber (Reg. No. 48,000) hereby confirms that he is acting in a representative capacity for Midcom in this matter pursuant to 37 C.F.R. § 1.34.

CONCLUSION

The patents and references cited in this request for reexamination present a substantial new question of patentability with respect to claims 1-8 of the '489 patent. Therefore, *ex parte* reexamination of the '489 patent is respectively requested pursuant to 35 U.S.C. §§ 301-307 and 37 C.F.R. § 1.510.

Respectively submitted,

Date: May 5, 2008 By: 

Adam M. Treiber
Registration No. 48,000
Attorney for Requestor

#102246833_2

INDEX OF "ATTACHMENTS" TO REQUEST FOR REEXAMINATION

Attachment A: U.S. Patent Number 6,320,489 (Lu et al.)

Attachment B: Plaintiff Halo's Complaint

Attachment C: Defendant Midcom's Answer and Counterclaim

Attachment D: Defendant Elec & Eltek (USA) Corporation Answer and Counterclaim

Attachment E: Defendant XFMRS, Inc.'s Answer and Counterclaim

Attachment F: Defendant XFMRS, Inc.'s First Amended Answer and Counterclaim

Attachment G: Defendant XFMRS, Inc.'s Second Amended Answer and Counterclaim

Attachment H: Civil Action Docket Sheet

Attachment I: U.S. Patent Number 5,212,345 (*Gutierrez*)

Attachment J: *Tischler* Reference

Attachment K: *Yuichi* Patent – JP7161535

Attachment L: *NPI 10BaseT Catalog Page*

Attachment M: *Gongin RH-16* Specification Sheet

Attachment N: *Gongin H-16S* Specification Sheet

Attachment O: NPI/Xircom Invoice

Attachment P: NPI 10BaseT June 1996 Catalog Page

Attachment Q: *NPI Isolation Transformers Catalog Page*

Attachment R: NPI/Interphase October 28, 1991 Letter

Attachment S: U.S. Patent Number 3,721,747 (*Renskers*)

Attachment T: *McCormick* Reference

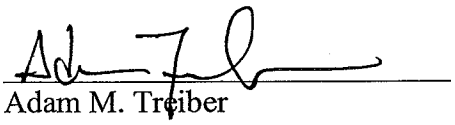
Attachment U: NP5417 Bill of Materials

Attachment V: September 15, 1995 Letter to Chris Nixon of 3Com Limited

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Request for *Ex Parte* Reexamination was concurrently served by first-class mail on Halo Electronics, Inc., at the address provided for under 37 C.F.R. § 1.33(c):

Haynes, Mark (30846)
Beffel, Ernest Jr (43489)
Wolfeld, Warren (31454)
Haynes Beffel & Wolfeld LLP
P.O. Box 366
Half Moon Bay, CA 94019



Adam M. Treiber
Registration No. 48,000
Baker & Hostetler LLP