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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,

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_____
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EXHIBIT E (1)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.:	**6,344,785**	
Issued:	February 5, 2002	Reexamination Control No.: Not Yet Assigned
Inventor:	Peter Lu et. al	Reexamination Filing Date: Herewith
Serial No.:	08/906,952	Art Unit: Not Yet Assigned
Filed:	August 6, 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. 6,344,785 ("the '785 patent"), a copy of which is attached as **Attachment A**, that issued from U.S. Patent Application No. 08/906,952, filed on August 6, 1997.

The '785 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 '785 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; 6,320,489; 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 1-34 of the '785 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 1-34 of the '785 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 1-34 of the '785 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

[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 '785 patent, the dates of these documents are May 12, 1987.

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 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 1-34 of the '785 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 '785 patent, it was not considered in view of the *Tischl*er reference as cited herein.

5. Claims 1-34 of the '785 patent are anticipated under 35 U.S.C. § 102(b), and/or 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 1-34 of the '785 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 during prosecution of the parent '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 August 2, 1996 Amendment, pg. 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 1-34 of the '785 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 1-34 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* 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 side wall with a bottom end,	***Gutierrez Patent***: Gutierrez describes a side wall with a bottom end (Col. 2, lines 37-47; Fig. 1).
a plurality of toroid transformers within the package, the 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 '785 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, each of the pins extending through the side wall and having a solder post with an end upon which the wires from the transformers are respectively wrapped and soldered thereon, each of the post ends extending beyond the bottom end of the 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). 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. The package of claim 1 wherein the plurality of toroid transformers are carried within the package by a soft silicone material.	***Gutierrez Patent***: *Gutierrez* discloses a cavity filled with a resilient plastic material, covering and encapsulating windings and a toroidal core, and forming a box-like package (Col. 3, lines 19-28).

Claim 3

3. The package of claim 1 wherein the side wall has an exterior surface which defines the periphery of the package and each of the solder post ends extends from within the periphery of the package and beyond the bottom of the 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). The side wall has an exterior surface which defines the periphery of the package and each of the pins extends from within the periphery of the package and beyond the bottom of the sidewall (Figs. 1-3).

Claim 4

4. The package of claim 1 wherein the side wall defines an interior space within the package and each of the post ends extends from the interior space and beyond the bottom of the 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). The side walls define an interior space and each of the pins extends from the interior space and beyond the bottom of the sidewall (Fig. 3).

Claim 5

5. The package of claim 4 wherein each of the solder post ends extends from within the periphery in a direction parallel to the 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) in a direction parallel to the side wall (Fig. 3).

Claim 6

6. The package of claim 1 wherein the construction package is one piece.	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package (Fig. 1; Col 2. lines 37-47).

Claim 7

7. The package of claim 1 wherein each of the pins has a notch near the post end upon which the wires from the transformers are wrapped.	***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 8

8. The package of claim 1 wherein the posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '785 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 9

9. 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 side wall and a standoff, the standoff defining a foot seating plane for the surface mount of the package, the side wall having a bottom end with an elevation higher than the standoff so as to be above and beyond the foot seating plane;	***Gutierrez Patent***: *Gutierrez* describes a side wall with a bottom end (Col. 2, lines 37-47; Fig. 1), as well as 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).
a plurality of toroid transformers within the package, the 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 '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 package, each of the pins having a solder post with an end upon which the wires from the transformers are respectively wrapped and soldered thereon, the solder post ends extending beyond the bottom end of the side wall to a position above the foot seating plane.	***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). 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 10

10. The package of claim 9 wherein each of the pins has a notch near the post end upon which the wires from the transformers are wrapped.	***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). These lead termination blocks or support members have notches in the form of a spool configuration, with opposed shoulders for retaining wound leads.

Claim 11

11. The package of claim 9 wherein the construction package is one piece.	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package (Fig. 1; Col 2. lines 37-47).

Claim 12

12. The package of claim 9 wherein the construction package has an open bottom.	***Gutierrez Patent***: Gutierrez describes a construction package having an open bottom (Fig. 1; Col. 2, lines 37-47).

Claim 13

13. The package of claim 9 wherein the posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '785 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 14

14. The package of claim 9 wherein the side wall defines an interior space within the package and each of the post ends extends from the interior space and beyond the bottom of the 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). The side walls define an interior space and each of the pins extends from the interior space and beyond the bottom of the sidewall (Fig. 3).

Claim 15

15. The package of claim 14 wherein each of the post ends extends from within the periphery in a direction parallel to the 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) in a direction parallel to the side wall (Fig. 3).

Claim 16

16. The package of claim 9 wherein the plurality of toroid transformers are within the package and secured by a soft silicone material.	***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).

Claim 17

17. The package of claim 9 wherein the standoff is a	***Gutierrez Patent***: *Gutierrez* discloses end walls that include support pads 50, 58 and support pads 52, 44, respectively, that form standoffs

pair of end walls with the side wall extending on opposing sides therebetween.	between the surface of a printed circuit board and the terminal pins (Figs. 1, 3-5; Col. 6–13); the side walls extend between the end walls (Fig. 1).

Claim 18

18. An electronic surface mount package for mounting onto the surface of a circuit board, the 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 side wall having a bottom end;	***Gutierrez Patent***: Gutierrez describes a side wall with a bottom end (Col. 2, lines 37-47; Fig. 1).
a standoff for surface mounting the package to the 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).
a gap between the bottom end of the side wall and the standoff;	***Gutierrez Patent***: *Gutierrez* describes a construction package having a gap between the bottom end of the side wall and the stand off (Figs. 3 and 5).
a plurality of toroid transformers within the package, the toroid transformers each having 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 '785 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 package,	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body") having a plurality of pins (i.e., lead termination blocks or support

each of the pins having a solder post with an end upon which the wires from the transformers are respectively wrapped and soldered thereon, each of the solder post ends extending into and terminating within the gap.	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). 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 19

19. The package of claim 18 wherein the standoff is a pair of end walls with the side wall extending on opposing sides therebetween.	***Gutierrez Patent***: *Gutierrez* discloses end walls that include support pads 50, 58 and support pads 52, 44, respectively, that form standoffs between the surface of a printed circuit board and the terminal pins (Figs. 1, 3-5; Col. 6–13); the side walls extend between the end walls (Fig. 1).

Claim 20

20. The package of claim 18 wherein the construction package is one piece.	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package (Fig. 1; Col 2. lines 37-47).

Claim 21

21. The package of claim 18 wherein the construction package has an open bottom.	***Gutierrez Patent***: Gutierrez describes a construction package having an open bottom (Fig. 1; Col. 2, lines 37-47).

Claim 22

22. The package of claim 18 wherein the posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '785 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 23

23. The package of claim 18 wherein the side wall defines an interior space within the package and each of the post ends extends from the interior space and beyond the bottom of the 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). The side walls define an interior space and each of the pins extends from the interior space and beyond the bottom of the sidewall (Fig. 3).

Claim 24

24. The package of claim 23 wherein each of the post ends extends from within the periphery in a direction parallel to the 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) in a direction parallel to the side wall (Fig. 3).

Claim 25

25. The package of claim 18 wherein the plurality of toroid transformers are within the package and secured by a soft silicone material.	***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).

Claim 26

26. 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 package having an open bottom and a side	***Gutierrez Patent***: Gutierrez describes a one piece construction package having an open bottom and a side wall with a bottom end

wall with a bottom end;	(Fig. 1; Col. 2, lines 37-47).
a plurality of 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 '785 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).
means for encapsulating the plurality of toroid transformers within the package;	***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).
a plurality of terminal pins molded within and extending from the bottom of the package, each of the pins extending through the side wall and having a solder post with an end upon which the wires from the transformers are respectively 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 (Fig. 2; Col. 2, lines 53-62). 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 27

27. The package of claim 26 wherein the standoff is a pair of end walls with the side wall extending on opposing sides therebetween.	***Gutierrez Patent***: *Gutierrez* discloses end walls that include support pads 50, 58 and support pads 52, 44, respectively, that form standoffs between the surface of a printed circuit board and the terminal pins (Figs. 1, 3-5; Col. 6–13); the side walls extend between the end walls (Fig. 1).

Claim 28

28. The package of claim 26 wherein each of the post ends extends beyond the bottom end of the side wall.	***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. (Col. 2, lines 53-56, Fig. 2).

Claim 29

29. The package of claim 26 wherein the carrying means includes encapsulating the plurality of toroid transformers within the package by a soft silicone material.	***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).

Claim 30

30. The package of claim 26 wherein the construction package is one piece.	***Gutierrez Patent***: *Gutierrez* discloses a one piece construction package (Fig. 1; Col 2. lines 37-47).

Claim 31

31. The package of claim 26 wherein the posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '785 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 32

32. The package of claim 26	***Gutierrez Patent***: *Gutierrez* discloses a molded package ("body")

wherein the side wall defines an interior space within the package and each of the post ends extends from the interior space and beyond the bottom of the side wall.	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). The side walls define an interior space and each of the pins extends from the interior space and beyond the bottom of the sidewall (Fig. 3).

Claim 33

33. The package of claim 32 wherein each of the post ends extends from within the periphery in a direction parallel to the 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) in a direction parallel to the side wall (Fig. 3).

Claim 34

34. The package of claim 26 wherein the package includes a standoff defining a foot seating plane for the surface mount of the package, the side wall having a bottom end with an elevation higher than the standoff so as to be above and beyond the foot seating plane, the post ends extending beyond the bottom end of the side wall to a position above the foot seating plane.	***Gutierrez Patent***: *Gutierrez* describes a side wall with a bottom end (Col. 2, lines 37-47; Fig. 1), as well as 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). The side wall has a bottom end with an elevation higher than the standoff support pads 50, 58 and support pads 52, 44, with post ends extending beyond the bottom end of the side wall to a position above a foot seating plane (Fig. 3).

2. Claims 1-34 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 side wall with a bottom end,	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a construction package that has a side wall with a bottom end.
a plurality of toroid transformers within the package, the 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 the side wall, each of the pins extending through the side wall and having a solder post with an end upon which the wires from the transformers are respectively wrapped and soldered thereon, each of the post ends extending beyond the bottom end of the side wall.	***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.

Claim 2

2. The package of claim 1 wherein the plurality of toroid transformers are carried within the package by a soft silicone material.	***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).

Claim 3

3. The package of claim 1 wherein the side wall has an exterior surface which defines the periphery of the package and each of the solder post ends extends from within the periphery of the package and beyond the bottom of the side wall.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a construction package that has a sidewall with an exterior surface that defines the periphery of the package, where each of the solder post ends extends from within the periphery of the package and beyond the bottom of the side wall.

Claim 4

4. The package of claim 1 wherein the side wall defines an interior space within the package and each of the post ends extends from the interior space and beyond the bottom of the side wall.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a construction package that has a sidewall that defines an interior space within the package, where each of the solder post ends extends from the interior space and beyond the bottom of the side wall.

Claim 5

5. The package of claim 4 wherein each of the solder post ends extends from within the periphery in a direction parallel to the side wall.	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* describes a plurality of terminal pins extending from the package. It would have been obvious to one of ordinary skill in the art, in view of the *Gongin H-16S Reference*, for example, to have the solder post ends extend from within the periphery in a direction parallel to the side wall.

Claim 6

6. The package of claim 1 wherein the construction package is one piece.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a construction package, and it would have been obvious to those of ordinary skill in the art to utilize a one piece construction package, as shown, for example, by the *Gongin H-16S Reference*.

Claim 7

7. The package of claim 1	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page*

wherein each of the pins has a notch near the post end upon which the wires from the transformers are wrapped.	discloses a plurality of terminal pins. 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 8

8. The package of claim 1 wherein the posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '785 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 9

9. 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 side wall and a standoff, the standoff defining a foot seating plane for the surface mount of the package, the side wall having a bottom	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package with a sidewall. 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

end with an elevation higher than the standoff so as to be above and beyond the foot seating plane;	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).
a plurality of toroid transformers within the package, the 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 the package, each of the pins having a solder post with an end upon which the wires from the transformers are respectively wrapped and soldered thereon, the solder post ends extending beyond the bottom end of the side wall to a position above the foot seating plane.	***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.

Claim 10

10. The package of claim 9 wherein each of the pins has a notch near the post end upon which the wires from	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* discloses a plurality of terminal pins. 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.

the transformers are wrapped.	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 11

11. The package of claim 9 wherein the construction package is one piece.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a construction package, and it would have been obvious to those of ordinary skill in the art to utilize a one piece construction package, as shown, for example, by the *Gongin H-16S Reference*.

Claim 12

12. The package of claim 9 wherein the construction package has an open bottom.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses 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 13

13. The package of claim 9 wherein the posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '785 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 14

14. The package of claim 9 wherein the side wall defines an interior space within the package and each of the post ends extends from the interior space and beyond the bottom of the side wall.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a construction package that has a sidewall that defines an interior space within the package, where each of the solder post ends extends from the interior space and beyond the bottom of the side wall.

Claim 15

15. The package of claim 14 wherein each of the post ends extends from within the periphery in a direction parallel to the side wall.	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* describes a plurality of terminal pins extending from the package. It would have been obvious to one of ordinary skill in the art, in view of the *Gongin H-16S Reference*, for example, to have the solder post ends extend from within the periphery in a direction parallel to the side wall.

Claim 16

16. The package of claim 9 wherein the plurality of toroid transformers are within the package and secured by a soft silicone material.	***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).

Claim 17

17. The package of claim 9 wherein the standoff is a pair of end walls with the side wall extending on	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for a plurality of toroids. It would have been obvious to utilize a standoff, consisting of a pair of end walls joined by side walls, in connection with the 5366-30 package

opposing sides therebetween.	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 18

18. An electronic surface mount package for mounting onto the surface of a circuit board, the package comprising:	***NPI 10BaseT Catalog Page***: *NPI 10BaseT Catalog Page* discloses an electronic surface mount package configuration.
a side wall having a bottom end;	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a construction package that has a side wall with a bottom end.
a standoff for surface mounting the package to the circuit board;	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for containing a plurality of toroids. 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).
a gap between the bottom end of the side wall and the standoff;	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for containing a plurality of toroids. It would have been obvious to provide a gap between the side wall and the standoff. The utilization of a such 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).
a plurality of toroid transformers within the package, the toroid transformers each having wire 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 the package, each of the pins having a solder post with an end upon which the wires from the transformers are respectively wrapped and soldered thereon, each of the solder post ends extending into and terminating within the gap.	***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.

Claim 19

19. The package of claim 18 wherein the standoff is a pair of end walls with the side wall extending on opposing sides	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for a plurality of toroids. It would have been obvious to utilize a standoff, consisting of a pair of end walls joined by side walls, in connection with the 5366-30 package disclosed in the *NPI 10BaseT Catalog Page*. The utilization of a

therebetween.	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 20

20. The package of claim 18 wherein the construction package is one piece.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a construction package, and it would have been obvious to those of ordinary skill in the art to utilize a one piece construction package, as shown, for example, by the *Gongin H-16S Reference.*

Claim 21

21. The package of claim 18 wherein the construction package has an open bottom.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses 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 22

22. The package of claim 18 wherein the posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '785 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 23

23. The package of claim 18 wherein the side wall defines an interior space within the package and each of the post ends extends from the interior space and beyond the bottom of the side wall.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a construction package that has a sidewall that defines an interior space within the package, where each of the solder post ends extends from the interior space and beyond the bottom of the side wall.

Claim 24

24. The package of claim 23 wherein each of the post ends extends from within the periphery in a direction parallel to the side wall.	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page* describes a plurality of terminal pins extending from the package. It would have been obvious to one of ordinary skill in the art, in view of the *Gongin H-16S Reference*, for example, to have the solder post ends extend from within the periphery in a direction parallel to the side wall.

Claim 25

25. The package of claim 18 wherein the plurality of toroid transformers are within the package and secured by a soft silicone material.	***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), *Yulchi*, 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).

Claim 26

26. 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 one piece package having an open bottom and a side wall with a bottom end;	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a package that has a side wall with a bottom end. The *Gongin H-16S Reference* illustrates a one piece electronic package with a side wall an open top, and it would have been obvious to one skilled in the art to reverse the lead bending of the gull-wings to configure it with an open bottom.
a plurality of 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).
means for encapsulating the plurality of toroid transformers within the package;	***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 the package, each of the pins extending through the side wall and having a	***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

solder post with an end upon which the wires from the transformers are respectively wrapped and soldered thereon.	inverted.

Claim 27

27. The package of claim 26 wherein the standoff is a pair of end walls with the side wall extending on opposing sides therebetween.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for a plurality of toroids. It would have been obvious to utilize a standoff, consisting of a pair of end walls joined by side walls, 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 28

28. The package of claim 26 wherein each of the post ends extends beyond the bottom end of the side wall.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* disclosew a construction package that has post ends extending below the bottom end of the side wall.

Claim 29

29. The package of claim 26 wherein the carrying means includes encapsulating the plurality of toroid transformers within the package by a soft silicone material.	***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).

Claim 30

30. The package of claim 26 wherein the construction package is one piece.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a construction package, and it would have been obvious to those of ordinary skill in the art to utilize a one piece construction package, as shown, for example, by the *Gongin H-16S Reference*.

Claim 31

31. The package of claim 26 wherein the posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '785 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 32

32. The package of claim 26 wherein the side wall defines an interior space within the package and each of the post ends extends from the interior space and beyond the bottom of the side wall.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a construction package that has a sidewall that defines an interior space within the package, where each of the solder post ends extends from the interior space and beyond the bottom of the side wall.

Claim 33

33. The package of claim 32	***NPI 10BaseT Catalog Page:*** The *NPI 10BaseT Catalog Page*

wherein each of the post ends extends from within the periphery in a direction parallel to the side wall.	describes a plurality of terminal pins extending from the package. It would have been obvious to one of ordinary skill in the art, in view of the *Gongin H-16S Reference*, for example, to have the solder post ends extend from within the periphery in a direction parallel to the side wall.

Claim 34

34. The package of claim 26 wherein the package includes a standoff defining a foot seating plane for the surface mount of the package, the side wall having a bottom end with an elevation higher than the standoff so as to be above and beyond the foot seating plane, the post ends extending beyond the bottom end of the side wall to a position above the foot seating plane.	***NPI 10BaseT Catalog Page***: The *NPI 10BaseT Catalog Page* discloses a surface mount package for a plurality of toroids. It would have been obvious to utilize a standoff that has an elevation lower than the side wall, 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 1-34 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 '785 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 side wall with a bottom end,	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer Catalog Page* discloses a construction package that has a side wall with a bottom end.
a plurality of toroid transformers within the package, the 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]
a plurality of terminal pins molded within the side wall, each of the pins extending through the side wall and having a solder post with an end upon which the wires from the transformers are respectively wrapped and soldered thereon, each of the post ends extending beyond the bottom end of the 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.

Claim 2

2. The package of claim 1 wherein the plurality of toroid transformers are carried within the package by a soft silicone material.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package. 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

[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.

	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).

Claim 3

3. The package of claim 1 wherein the side wall has an exterior surface which defines the periphery of the package and each of the solder post ends extends from within the periphery of the package and beyond the bottom of the side wall.	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer Catalog Page* discloses a construction package that has a sidewall with an exterior surface that defines the periphery of the package, where each of the solder post ends extends from within the periphery of the package and beyond the bottom of the side wall.

Claim 4

4. The package of claim 1 wherein the side wall defines an interior space within the package and each of the post ends extends from the interior space and beyond the bottom of the side wall.	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer Catalog Page* discloses a construction package that has a sidewall that defines an interior space, where each of the solder post ends extends from the interior space and beyond the bottom of the side wall.

Claim 5

5. The package of claim 4 wherein each of the solder post ends extends from within the periphery in a direction parallel to the side wall.	***NPI Isolation Transformer Catalog Page:*** The *NPI Isolation Transformer Catalog Page* discloses a plurality of terminal pins, as well as the pins to be molded within and extending from the bottom of the package. It would have been obvious to one of ordinary skill in the art, in view of the *Gongin H-16S Reference*, for example, to have the solder post ends extend from within the periphery in a direction parallel to the side wall.

Claim 6

6. The package of claim 1 wherein the construction package is one piece.	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer Catalog Page* discloses a construction package, and it would have been obvious to those of ordinary skill in the art to utilize a one piece construction package, as shown, for example, by the *Gongin H-16S Reference*.

Claim 7

7. The package of claim 1 wherein each of the pins has a notch near the post end upon which the wires from the transformers are wrapped.	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins. 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 8

8. The package of claim 1 wherein the posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '785 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 9

9. 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 '785 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 side wall and a standoff, the standoff defining a foot seating plane for the surface mount of the package, the side wall having a bottom end with an elevation higher than the standoff so as to be above and beyond the foot seating plane;	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer Catalog Page* discloses a side wall and 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. The elevation of the bottom end of the side wall is higher than the "nub."
a plurality of toroid transformers within the package, the 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).
a plurality of terminal pins molded within the package, each of the pins having a solder post with an end upon which the wires from the transformers are respectively wrapped and soldered thereon, the solder post ends extending beyond the bottom end of the side wall to a position above the foot seating plane.	***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.

Claim 10

10. The package of claim 9 wherein each of the pins has a notch near the post end upon which the wires from	***NPI Isolation Transformers Catalog Page:*** The *NPI Isolation Transformers Catalog Page* discloses a plurality of terminal pins. 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

the transformers are wrapped.	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 11

11. The package of claim 9 wherein the construction package is one piece.	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer Catalog Page* discloses a construction package, and it would have been obvious to those of ordinary skill in the art to utilize a one piece construction package, as shown, for example, by the *Gongin H-16S Reference*.

Claim 12

12. The package of claim 9 wherein the 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 13

13. The package of claim 9 wherein the posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '785 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 14

14. The package of claim 9 wherein the side wall defines an interior space within the package and each of the post ends extends from the interior space and beyond the bottom of the side wall.	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer Catalog Page* discloses a construction package that has a sidewall that defines an interior space, where each of the solder post ends extends from the interior space and beyond the bottom of the side wall.

Claim 15

15. The package of claim 14 wherein each of the post ends extends from within the periphery in a direction parallel to the side wall.	***NPI Isolation Transformer Catalog Page:*** The *NPI Isolation Transformer Catalog Page* discloses a plurality of terminal pins, as well as the pins to be molded within and extending from the bottom of the package. It would have been obvious to one of ordinary skill in the art, in view of the *Gongin H-16S Reference*, for example, to have the solder post ends extend from within the periphery in a direction parallel to the side wall.

Claim 16

16. The package of claim 9 wherein the plurality of toroid transformers are within the package and secured by a soft silicone material.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package. 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).

Claim 17

17. The package of claim 9	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation*

wherein the standoff is a pair of end walls with the side wall extending on opposing sides therebetween.	*Transformer Catalog Page* discloses a standoff in the form of "nubs" extending from the bottom of the package, with the package side walls extending between the "nubs" (e.g., Package B).

Claim 18

18. An electronic surface mount package for mounting onto the surface of a circuit board, the 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 '785 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 side wall having a bottom end;	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer Catalog Page* discloses a construction package that has a side wall with a bottom end.
a standoff for surface mounting the package to the circuit board;	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer 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.
a gap between the bottom end of the side wall and the standoff;	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer Catalog Page* discloses discloses a standoff in the form of "nubs." It would have been obvious to provide a gap between the bottom end of the side wall and the standoff, as such 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).
a plurality of toroid transformers within the package, the toroid transformers each having wire 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).
a plurality of terminal pins molded within the package, each of the pins having a solder post with an end upon which the wires from the transformers are respectively wrapped and soldered thereon, each of the solder post ends extending into and terminating within the gap.	***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.

Claim 19

19. The package of claim 18 wherein the standoff is a pair of end walls with the side wall extending on opposing sides therebetween.	***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. It would have been obvious to utilize a standoff, consisting of a pair of end walls joined by side walls, 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 20

20. The package of claim 18 wherein the construction package is one piece.	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer Catalog Page* discloses a construction package, and it would have been obvious to those of ordinary skill in the art to utilize a one piece construction package, as shown, for example, by the *Gongin H-16S Reference*.

Claim 21

21. The package of claim 18 wherein the 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 22

22. The package of claim 18 wherein the posts are separated from one another so as to avoid arcing.	While the claim asserts that terminals should be separated to avoid arcing, the '785 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 23

23. The package of claim 18 wherein the side wall defines an interior space within the package and each of the post ends extends from the interior space and	***NPI Isolation Transformer Catalog Page***: The *NPI Isolation Transformer Catalog Page* discloses a construction package that has a sidewall that defines an interior space, where each of the solder post ends extends from the interior space and beyond the bottom of the side wall.

beyond the bottom of the side wall.	

Claim 24

24. The package of claim 23 wherein each of the post ends extends from within the periphery in a direction parallel to the side wall.	***NPI Isolation Transformer Catalog Page:*** The *NPI Isolation Transformer Catalog Page* discloses a plurality of terminal pins, as well as the pins to be molded within and extending from the bottom of the package. It would have been obvious to one of ordinary skill in the art, in view of the *Gongin H-16S Reference*, for example, to have the solder post ends extend from within the periphery in a direction parallel to the side wall.

Claim 25

25. The package of claim 18 wherein the plurality of toroid transformers are within the package and secured by a soft silicone material.	***NPI Isolation Transformers Catalog Page***: The *NPI Isolation Transformers Catalog Page* discloses a plurality of transformers carried within a package. 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).

Claim 26

26. 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 '785 patent is surface mount technology disclosed or