

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAN INBAR

Appeal No. 2001-0252
Application 08/760,652

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2 through 12, 21 through 23 and 30 through 32. Subsequent to the final rejection appellant filed four amendments, of which only those filed on March 22, 1999 (Paper No. 20) and May 25, 1999 (Paper No. 24) were entered by the examiner. As a result of the entry of those amendments, the

Appeal No. 2001-0252
Application 08/760,652

examiner has indicated that claims 2, 3, 9 and 10 stand allowed. Accordingly, the appeal as to those claims is dismissed, leaving for our consideration on appeal claims 4 through 8, 11, 12, 21 through 23 and 30 through 32. Claims 1, 13 through 20, 24 through 29 and 33 through 40 have been canceled.

Appellant's invention relates to a transparency viewing device or viewbox for holding and illuminating X-rays and like transparencies. Independent claims 4, 21, 23, 30 and 31 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Krajian	2,722,762	Nov. 8,
1955		
Geluk	4,637,150	Jan. 20,
1987		

In making an obviousness-type double patenting rejection

Appeal No. 2001-0252
Application 08/760,652

of certain of the appealed claims, the examiner has additionally relied upon U.S. Patent No. 5,430,964, issued July 11, 1995 to Dan Inbar et al.

Claims 21 through 23 and 30 through 32 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,430,964.

Claims 4 through 6 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Krajian.

Claim 30 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Geluk.

Claims 7, 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Krajian.

Rather than reiterate the details of these rejections and

Appeal No. 2001-0252
Application 08/760,652

the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we refer to the examiner's answer (Paper No. 27, mailed August 13, 1999) and to appellant's brief (Paper No. 25, filed May 25, 1999) and reply brief (Paper No. 28, filed October 13, 1999) for a full exposition thereof.

OPINION

After careful consideration of appellant's specification and claims, the teachings of the applied references and each of the arguments and comments advanced by appellant and the examiner, we have reached the determinations which follow.

Turning first to the examiner's rejection of claims 21 through 23 and 30 through 32 under the judicially created doctrine of obviousness-type double patenting, we observe that the examiner's position as set forth on page 3 of the answer is that

[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because claim

Appeal No. 2001-0252
Application 08/760,652

1 of Patent No. 5,430,964 discloses all of the structure defined by the applicant in claims 21-23 and 30-32 except for detecting only two transparencies which is considered to be within one skilled in the art to modify claim 1 of Patent No. 5,430,964.

It is of great interest to us that the single difference pointed to by the examiner (i.e., detecting only two transparencies) is found only in independent claim 21 on appeal and does not appear in independent claims 23, 30 and 31 which are also subject to this ground of rejection. Thus, we are at a loss to understand exactly how the examiner has reached the conclusion that appellant's claims 23 and 30 through 32 are unpatentable under the judicially created doctrine of obviousness-type double patenting, since the examiner has identified no differences between those claims and claim 1 of U.S. Patent No. 5,430,964 and has provided no statement as to what is considered to have been obvious. Thus, the examiner has not established a prima facie case of obviousness-type double patenting. In reviewing claims 23 and 30 through 32, we note that there are clearly differences between the subject matter covered by those claims and the subject matter set forth in claim 1 of U.S. Patent No.

Appeal No. 2001-0252
Application 08/760,652

5,430,964 and that we agree with appellant's position set forth in the brief and reply brief as to those differences. Accordingly, we are constrained to reverse the examiner's double patenting rejection of claims 23 and 30 through 32.

As to claims 21 and 22, we share appellant's view as set forth on page 9 of the brief and pages 6 and 7 of the reply brief, that the examiner has not made out a prima facie case for obviousness since he has merely made a general assertion that the identified difference "is considered to be within one skilled in the art to modify claim 1 of Patent No. 5,430,964" (answer, page 3), without any evidence to support such a conclusion. Appellant has argued (reply brief, pages 6-7) that the modification urged by the examiner is not obvious and also provided reasons in support of that position. In the face of those arguments we have nothing from the examiner but speculation to support his conclusion. Thus, we will not sustain the examiner's rejection of claims 21 and 22 under the judicially created doctrine of obviousness-type double patenting.

We turn next to the examiner's rejection of claim 30 under 35 U.S.C. § 102(b) as being anticipated by Geluk. In this instance, appellant has presented arguments on pages 10 and 11 of the brief and on pages 8 and 9 of the reply brief which we find persuasive. Like appellant, we consider the examiner's position equating "the center spot on the screen" in Geluk (answer, page 4) to appellant's "guide" set forth in claim 30 to be untenable. Unlike appellant's guide seen in Figures 4A, 4B of the present application, the imaginary center spot identified by the examiner on the screen (2) of Geluk is not capable of "guiding the transparency into a predetermined mounting position" as at (42) of Figure 4A, or of cooperating with a second transparency having a second predetermined mounting position (44 in Fig. 4A) as is set forth in appellant's claim 30 so that the guide "separates and determines the two predetermined mounting positions." As for the examiner's position (answer, page 8) that appellant "fails to define any structure with regard to the guide," we find this position to be in error, since the limitation as set forth in claim 30 on appeal with regard to the "guide" would

Appeal No. 2001-0252
Application 08/760,652

invoke an interpretation under 35 U.S.C. § 112, sixth paragraph. Thus, we will not sustain the examiner's rejection of claim 30 under 35 U.S.C. § 102(b) based on Geluk.

As for the examiner's rejection of claims 4 through 6 and 8 under 35 U.S.C. § 102(b) based on Krajian, we share appellant's view that the "faceplate adapted for holding a film transparency having an area thereon" of claim 4 on appeal is not readable on the layer (13) in the device of Krajian as urged by the examiner, since the layer (13) is not capable of "holding" a film transparency thereon. Moreover, we observe that the device of Krajian lacks a "means for rotating said housing [enclosing the light source] so that light is emitted from the first aperture to scan said transparency" (emphasis ours) as set forth in appellant's claim 4. As for the remaining claims subject to this rejection, we agree with appellant's arguments as set forth on pages 7 and 8 of the brief and on pages 2 through 6 of the reply brief. Thus, we will not sustain the examiner's rejection of independent claim 4, or of claims 5, 6 and 8 which depend therefrom, under 35

Appeal No. 2001-0252
Application 08/760,652

U.S.C. § 102(b) based on Krajian.

Regarding the examiner's rejection of dependent claims 7, 11 and 12 under 35 U.S.C. § 103 based on Krajian, we observe that these claims include the limitations noted above in claim 4, and for that reason alone define over the device of Krajian. Moreover, we agree with appellant's position that the examiner's reasoning regarding modification of the device in Krajian to meet the limitations of these claims lacks any evidential basis and stems entirely from speculation and conjecture. Accordingly, the examiner's rejection of claims 7, 11 and 12 under 35 U.S.C. § 103 based on Krajian will also not be sustained.

In summary:

The examiner's decision rejecting claims 21 through 23 and 30 through 32 under the judicially created doctrine of obviousness-type double patenting is reversed.

The examiner's decision rejecting claims 4 through 6 and

Appeal No. 2001-0252
Application 08/760,652

8 under 35 U.S.C. § 102(b) as being anticipated by Krajian is reversed, as is the examiner's decision rejecting claims 7, 11 and 12 under 35 U.S.C. § 103 based on Krajian.

In addition, the examiner's decision rejecting claim 30 under 35 U.S.C. § 102(b) as being anticipated by Geluk is reversed.

Thus, the decision of the examiner rejecting claims 4 through 8, 11, 12, 21 through 23 and 30 through 32 of this application is reversed.

REVERSED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
JOHN P. McQUADE)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES

Appeal No. 2001-0252
Application 08/760,652

JEFFREY V. NASE)
Administrative Patent Judge)

CEF:pgg
Greenblum & Bernstein
Intellectual Property Causes
1941 Roland Clarke Place
Reston, VA 20191