

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. RUBEN

Appeal No. 95-3797
Application 07/975,764¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and
MEISTER and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's
final rejection of claims 1-3 and 5. Claims 4, 6-8 and 9 have
been canceled and claim 10 is allowed.

¹ Application for patent filed November 13, 1992.

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Appellant's claimed subject matter is a real image viewfinder which includes a first and second optical path. Claim 1 is exemplary of the subject matter on appeal and recites:

1. A real image viewfinder for use in a camera, the viewfinder having an objective lens, an image reflecting optic unit having first, second, third, and fourth reflecting surfaces, and an eyepiece lens that define a first optical path in which a first real image plane is located between the objective lens and the eyepiece lens, further having a movable variator lens that varies the magnification of the viewfinder as the variator lens is moved, wherein:

the second and third reflecting surfaces of the image reflecting optic unit are movable to compensate for variation in the position of the first real image plane with respect to the eyepiece lens such that the first real image plane moves simultaneously with movement of the reflecting surfaces and the fourth reflecting surface is adapted to define a second optical path through the viewfinder such that a second real image plane is fixedly located at a focal plane of the eyepiece lens and can be viewed through the eyepiece lens, said real image viewfinder further including a display, located at the second real image plane, that displays data items that can be viewed through the eyepiece lens.

THE REFERENCES

The following references were relied on by the examiner:

Asano et al. (Asano)	4,165,932	Aug. 28, 1979
Bentensky et al. (Bentensky)	5,155,517	Oct. 13, 1992

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THE REJECTIONS

Claims 1-3 and 5 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Bentensky in view of Asano.

Rather than reiterate the entire arguments of the examiner and the appellant in support of their respective positions, reference is made to the appellant's brief (Paper No. 13) and the examiner's answer (Paper No. 14) for the full exposition thereof.

OPINION

In reaching our conclusions on issues raised in this appeal we have carefully considered appellant's specification, the appealed claims, the applied references, and the respective viewpoints advanced by the appellant and the examiner. As a consequence of our review, we have made the determination that the rejection should not be sustained. Our reasons for this determination follow.

We initially note that, for reasons stated infra. in our, new rejections under the provisions of 37 CFR § 1.196(b), we are of the opinion that claim 1 fails to satisfy the

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requirements of 35 U.S.C. § 112, second paragraph. Normally a claim which fails to comply with the second paragraph of § 112 will not be analyzed as to whether it is patentable over the prior art since to do so would of necessity require speculation as to the meets and bounds of the claimed subject matter. See In re Steel, 305, F.2d 859, 862-863, 134 USPQ 292, 295-296 (CCPA 1962); and In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Nevertheless, in this instance, in an effort to avoid piecemeal appellate review (See Ex parte Saceman, 27 USPQ2d 1472, 1474 (BPAI 1993) and Ex parte Ionescu, 222 USPQ 537, 540 (Bd.App.1984)), we make the following interpretation of the terminology appearing in claim 1 for the purpose of reaching the rejection based on prior art. In claim 1, line 13, we interpret "the reflecting surfaces" to be "the second and third reflecting surfaces."

We now turn to the examiner's rejection of claims 1-3 and 5 as unpatentable over Bentensky in view of Asano. In the examiner's view, Bentensky discloses each element of claim 1 except:

...the fourth reflecting surface (M4)
adapted to define a second optical path
through the viewfinder such that a second

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real image plane is fixedly located at a focal plane of the eyepiece lens and can be viewed through the eyepiece lens; the real image viewfinder further including a display, located at the second real image plane, that displays data items that can be viewed through the eyepiece lens.

[Examiner's Answer at page 4]

The examiner relies on Asano for teaching (1) "a stationary semi-transparent reflecting surface (6) that permits the second optical path (optical axis Z) to extend from the eyepiece through the semi-transparent reflecting surface to the second real image plane (window plate 18)", (2) "that the display items (data carrying plate 12 and bright frame S) can be viewed through the eyepiece lens" and (3) "that the display can be solely illuminated by light passing through the viewfinder along the second optical path. (Examiner's Answer at pages 4-5)" The examiner concludes:

Given the teachings of Asano et al, it would have been obvious to one having ordinary skill in the art to modify the fourth reflecting surface (M4) of Bentensky et al to define a second undeviated straight optical path which extend[s] through the viewfinder from the eyepiece lens such that a display is fixedly located at a focal plane of eyepiece lens for the purpose of viewing data display through the eyepiece with the view of the object to be photographed observed through the objective

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lens of the viewfinder optical system.
[Examiner's Answer at page 5].

Appellant argues that Asano does not disclose a second real image plane fixedly located at a focal plane of the eyepiece lens and at which a display is located. We note that The Academic Press Dictionary of Science and Technology (Academic Press, San Diego 1992) defines "focal plane" as a plane that is perpendicular to the principal axis and passes through the focal point of the axis of a mirror, lens, or lens system. As such, the focal plane of eyepiece 8 in Asano is perpendicular to axis X. Clearly, the display 12 depicted in Asano is disposed on axis Z which is not located at a focal plane of eyepiece 8. The examiner while recognizing that display 12 is not disposed in the focal plane of eyepiece 8 states:

Nevertheless, Asano et al clearly teaches that a display can be placed in the second optical path. Thus, it would have been obvious to modify the fourth reflecting surface (M4) to be a stationary semi-transparent reflecting surface to define a second optical path through the viewfinder because this modification would provide the shortest and an undeviated, straight line-of-sight optical path. [Examiner's Answer at pages 6-7].

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While it is true that if the device disclosed in Bentensky were modified as proposed by the examiner the display would be located at the focal plane of eyepiece 8, this fact, however, does not provide the proper motivation for modifying the Betensky device as proposed. It is the teachings of the prior art taken as a whole which must provide the motivation or suggestion for the modification. See Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Interconnect Planning Corp. v. Feil 774 F.2d 1132, 1143,

227 USPQ 543, 551 (Fed. Cir. 1985); In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). Here, only the appellant have suggested that a display be placed on a second optical path at the focal plane of the eyepiece. As the court in Uniroyal 837 F.2d at 1051, 5 USPQ at 1438 stated : "it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." In view of the foregoing, we will not

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sustain the examiner's rejection of claims 1-3 and 5 under 35 U.S.C. § 103.

Under the provision 37 CFR § 1.196(b) we make the following new rejection.

Claims 1-3 and 5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, in line 13 recites "the reflecting surfaces." It is not clear from this recitation whether this phrase refers to the "first, second, third and fourth reflecting surfaces" (line 3) or the "second and third reflecting surfaces" (line 9).

In summary, the decision of the examiner is reversed.

A new rejection of claims 1-3 and 5 has been made under 35 U.S.C. § 112, second paragraph.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10,

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1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED (196(b))

	HARRISON E. McCANDLISH, Senior)	
	Administrative Patent Judge)	
)	
)	
)	
	JAMES M. MEISTER)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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