

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BROOKS SUPPORT SYSTEMS, INC.

Appeal No. 97-3899
Reexamination Control No. 90/004,168¹

ON BRIEF

Before CALVERT, Administrative Patent Judge, McCANDLISH, Senior Administrative Patent Judge, and COHEN, Administrative Patent Judge.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

In this proceeding for reexamination of Patent No. 5,305,356, the patent owner² (hereinafter "appellant") has appealed from the final rejection of claims 1, 3 to 7 and 9 to 11, all the claims

¹ Reexamination proceeding of U.S. Patent No. 5,305,356 to Raymond J. Brooks, John M. Gay, Bruce A. Weir and Paul E. McEntee, granted April 19, 1994.

² It is not clear precisely who the patent owner is. According to the printed patent, the assignee is Brooks Support Systems, Inc., but in the Supplemental Brief filed on September 24, 1997, appellant states that the real party in interest is R. Brooks Associates, Inc.

2. Claims 1, 3 and 4, unpatentable over White in view of EPRI;
3. Claims 1 and 3, unpatentable over Brooks in view of EPRI.

Rejection 1

The Horn patent discloses apparatus consisting of a shaft 10 which is made up of two hinged sections 10a, 10b. A television camera 12 is mounted at the upper end of the shaft on a mounting assembly 14 which allows panning and tilting of the camera. A monitor 22 may be mounted on the shaft. The lower end 10b of the shaft houses telescopic monopod segments 46a, 46b which, when extended, "increase[] the overall shaft length for ground support" (col. 5, lines 9 to 20). The shaft-camera combination may be hand held at grips 41, 44 (Fig. 1) or may be mounted on a stationary tripod (col. 4, lines 56 to 59). As disclosed in col. 1, lines 18 to 22, the device can be used to view events which are inaccessible or too dangerous to view closely or directly (e.g., a gun fight around the corner of a building), or which are blocked from view by an object or person.

The EPRI article concerns the use of video cameras in nuclear power plants. In the portion of page 1-2 relied upon by the examiner, which is part of a section entitled "A Primer On Video Camera Systems," the article describes such cameras as using "either Vidicon or Newvicon tubes or solid state charge-coupled devices (CCDs)." The article further describes the advantages and disadvantages of each type, noting that tubes are more fragile, subject to mechanical or magnetic misalignment, and relatively large, as well as being more subject to "lag" and image "burn."

The examiner takes the position that it would have been obvious to one of ordinary skill to have substituted a CCD video camera for Horn's disclosed video camera, as an "obvious functional equivalent" (answer, page 5).

On pages 4 and 5 of the brief, appellant argues (numerals in brackets added):

There are three principle [sic] bases by which the Horn patent is distinguishable from the present invention. First, [1] Horn does not disclose a telescoping boom for extending the length of the inspection device. Horn's device is foldable (Reference Numeral 28) and only teaches the use of a [sic] spring loaded telescoping members for providing a monopod [sic] for ground support (48, 50). Further, as the Examiner conceded, [2] Horn does not disclose or suggest the use of a CCD camera, thus necessitating the proposed combination of the EPRI reference discussed below.

Finally, [3] there is no suggestion of applying Horn in nuclear applications. This is critical to the present invention. The claims of the present invention were amended during prosecution to be limited for use in nuclear power applications. Patentee argued that this preamble limitation, specifically added to distinguish over Horn, was necessary to give meaning and scope to the claims.

Considering first apparatus claims 1, 3 to 7, 9 and 10, we do not agree with appellant's basis [1]. The claims simply call for telescoping boom means for extending the device, and, as discussed above, Horn's telescopic members 46a, 46b are disclosed as, and clearly do, extend the length of the boom (shaft) 10.

As for basis [2], appellant further argues on page 5 of the answer that there is "no reason why one would combine a CCD camera with Horn," and "[t]here is not the slightest teaching in Horn which suggests the need for CCD technology." We disagree. First, as the examiner points out, EPRI

discloses that CCD and tube-type video cameras are both well known in the art, and it would have been but an obvious matter of choice to select a CCD camera as the camera 12 of Horn. If further motivation were needed, Horn discloses that camera 12 should be "compact and light weight" (col. 3, lines 10 to 12), and, as previously mentioned, EPRI discloses that tube-type cameras are larger than CCD cameras. Given the fact that it is acknowledged in appellant's original patent that "the advent of CCD image transducers has permitted television cameras to be fabricated in very small sizes" (col. 4, lines 19 to 21),⁵ it is surprising that this point is even argued.

Accordingly, we agree with the examiner that it would have been obvious in view of EPRI to utilize a CCD-type video camera as the camera 12 of Horn. The question therefore remains, and is raised by appellant's basis [3], whether the recitations in the apparatus claims concerning nuclear power applications distinguish these claims over the Horn-EPRI combination of references.

We note initially that "[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable." In re Schreiber, ___ F.3d ___, _____, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Moreover, the preamble generally does not limit the claims. DeGeorge v. Bernier, 768 F.2d 1318, 1322 n. 3, 226 USPQ 758, 761 n. 3 (Fed. Cir. 1985).

Turning to claim 1, the two elements thereof are both defined in terms of "means plus function,"

⁵ Although not essential to our decision, we note that an admission may properly form a basis of a rejection in a reexamination proceeding. Ex parte Successor in Interest of McGaughey, 6 USPQ2d 1334, 1338-39 (BPAI 1988).

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and therefore must be "construed to cover the corresponding structure ... described in the specification and equivalents thereof." 35 U.S.C. § 112, sixth paragraph; In re Donaldson Co., Inc., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994). The two elements recited in claim 1 are:

telescoping booms [sic] means for extending said device to a difficult to reach position to be inspected within a nuclear power plant; and
video camera means comprising a charge-couple [sic] device affixed to an end of ~~shibm~~
means for permitting the visual inspection of said difficult to reach position to be inspected within said nuclear power plant.

Looking at the disclosure of appellant's patent, the structure which corresponds to these means, and therefore is covered by claim 1, is a boom 12 comprising a plurality of telescoping members 16, and a CCD-type video camera 14 mounted on the end of the boom by a pan and tilt mechanism 22. This structure is, however, the same structure which, we have concluded, would have been obvious over Horn in view of EPRI. We find no structure disclosed in appellant's patent which would uniquely adapt the disclosed apparatus for use in inspecting nuclear power plants, but rather, the disclosed apparatus would appear to be equally usable for inspecting any other types of power plants, for inspecting other types of structures, and even for the purpose of Horn's apparatus, i.e., viewing an event not directly accessible. In fact, the patent specifically discloses that "the inspection device of the present invention is in no way limited to nuclear power plant inspection and may be utilized for a large number of non-nuclear related applications" (col. 3, lines 38 to 43). We therefore do not consider that appellant's basis [3] constitutes a viable basis for distinguishing the subject matter of claim 1 over the prior art.

The other apparatus claims, 3 to 7, 9 and 10, are grouped by appellant with claim 1 (brief, page 3), and likewise do not recite any structure which would not have been obvious over Horn in view of EPRI.

The rejection of claims 1, 3 to 7, 9 and 10 as unpatentable over Horn in view of EPRI will be sustained.

Claim 11 is drawn to a method which the examiner evidently also considers would have been obvious over Horn in view of EPRI, stating that (answer, page 5):

to have use Horn's video camera for inspecting within a nuclear power station, as suggested by EPRI, would have been obvious to one having ordinary skill in the art.

However, claim 11 includes the step of "extending a telescoping hand-held boom to a difficult to reach position to be inspected within a nuclear power station" (emphasis added). While it certainly would have been obvious, as a general proposition, to employ video cameras in a nuclear power station in view of the EPRI article, the examiner does not point out, nor do we find, any disclosure therein of the use of a hand-held video camera for making inspections. Absent any such teaching, we do not consider that it would have been obvious to use the apparatus disclosed by Horn in a method of making inspections in a nuclear power plant, as the examiner proposes. We therefore will not sustain the rejection of claim 11.

Rejections 2 and 3

In both of these rejections, the primary reference, White or Brooks, discloses a device for inspecting a nuclear power plant utilizing a video camera on a telescopic boom, and the examiner contends that it would have been obvious in view of EPRI to employ a CCD camera as the video camera. Appellant's only argument as to each of these rejections is that the systems of the primary references are not hand held, i.e., "[t]he White reference specifically teaches away from a hand-held, easily maneuverable system such as that claimed in the present invention "(brief, page 5), and the Brooks system "is not hand-held but is elevated by means of an elbow joint" (id., page 6).

The problem with appellant's arguments is that the claims to which these rejections are applied do not require that the claimed apparatus be hand-held. Appellant's arguments are, therefore, not commensurate with the scope of the subject matter claimed.

The rejection of claims 1, 3 and 4 as unpatentable over White in view of EPRI, and of claims 1 and 3 as unpatentable over Brooks in view of EPRI, will be sustained.

Rejection Under 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 1 and 3 to 5 are rejected under 35 U.S.C. § 305, in that they are broader than the corresponding claims of appellant's original patent.

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Claim 1, as amended by the amendment filed on September 26, 1996 (Paper No. 8) , omits from original patent claim 1 the expression "said video camera means ... said boom means" (col. 6, lines 4 to 6). Claim 1 (and claims 3 to 5 dependent from it) is therefore of broader scope than original patent claim 1 and as such, violates the third sentence of 35 U.S.C. § 305. Thermalloy Inc. v. Aavid Eng'g. Inc., 121 F.3d 691, 692 , 43 USPQ2d 1846, 1847 (Fed. Cir. 1997).

Conclusion

The examiner's decision to reject claims 1, 3 to 7, 9 and 10 is affirmed, and to reject claim 11 is reversed. Claims 1 and 3 to 5 are rejected pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, 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, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

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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 (37 CFR § 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 35 § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . .

Should appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b) (1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to

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Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

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

AFFIRMED-IN-PART
37 CFR § 1.196(b)

IAN A. CALVERT)
Administrative Patent Judge)
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HARRISON E. McCANDLISH) BOARD OF PATENT
Senior Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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)
IRWIN CHARLES COHEN)
Administrative Patent Judge)

APPENDIX

1. A nuclear power plant inspection device comprising:

telescoping booms means for extending said device to a difficult to reach position to be inspected within a nuclear power plant; and

video camera means comprising a charge couple device affixed to an end of said boom means for permitting the visual inspection of said difficult to reach position to be inspected within said nuclear power plant;

3. The device of Claim 1 wherein said boom means comprises a plurality of telescoping members.

4. The device of Claim 1 further comprising means for supporting said device in a vertical position.

5. The device of Claim 1 further comprising a video receiver attached to the boom means for receiving video images of the inspected position.

6. A nuclear power plant inspection device comprising:

hand-held telescoping boom means for extending to a difficult to reach position in a nuclear power plant to be inspected; and

CCD means affixed to an end of said boom means for permitting the visual inspection of said position in said nuclear power plant to be inspected.

7. The device of Claim 6 wherein said video camera is affixed to a pan and tilt mechanism attached to the end of said boom means.

9. The device of Claim 7 wherein said pan and tilt means is controlled by a control box affixed to said boom means.

10. The device of Claim 9 further comprising a video receiver attached to the boom means for viewing the inspected position by an operator of the inspection device.

11. A method for inspecting difficult to reach portions of a nuclear power station comprising:

extending a telescoping hand-held boom to a difficult to reach position to be inspected within a nuclear power station, said boom having a CCD camera attached to an end thereof for permitting the visual inspection of said difficult to reach position to be inspected.

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SCOTT J. FIELDS
KLHR, HARRISON, HARVEY,
BRANZBURG & ELLERS
1401 WALNUT STREET
PHILADELPHIA, PA 19102-3163

JOEL MILLER
17 WESTWOOD DRIVE SOUTH
WEST ORANGE, NJ 07052

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Date: 12/09/97

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**JUDGE CALVERT
JUDGE COHEN
SENIOR JUDGE MCCANDLISH**

**DECISION: AFFIRMED-IN-PART
37 CFR 1.196(b)**

**APPLICANTS: BROOKS SUPPORT SYSTEMS INC.
REEXAMINATION CONTROL NO. 90/004,168
Art Unit: 2204**