

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

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN A. AYERS  
AND MICHAEL E. SALMON

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Appeal No. 1998-2606  
Application 08/446,415

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ON BRIEF

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Before THOMAS, FLEMING and GROSS, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 21, which constitute all the claims in the application.

Representative claim 1 is reproduced below:

1. An image display apparatus characterized by:

a substrate wherein said substrate acts as a base having an integrated circuit and electrical connections;

a driver mounted on said substrate and electrically connected to said integrated circuit, said driver including a controllable rotatably positionable drive providing a plurality of drive rotational positions in response to electrical signal inputs;

a generally planar image disc having at least one radially disposed indication on a generally planar portion thereof; said image disc being driven by said drive for rotational movement thereby; and

a light source electrically connected to said integrated circuit for illuminating said indication upon juxtaposition with said light source via rotational positioning of said image disc and illumination of said light source.

The following references are relied on by the examiner:

Whittlesey 1956	2,749,541	June 5,
Watkins 1970	3,492,615	Jan. 27,
Fales 1972	3,660,814	May 2,
Ikeda 1989	4,884,058	Nov. 28,
Ayres et al. (Ayres) 1995	5,442,338	Aug. 15,
		(filed May 3, 1993)



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Claims 1 through 21 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 through 18 of U.S. Patent 5,442,338 of which this application is a continuation-in-part. Claims 1 through 12 and 14 through 21 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Long in view of Fales as to claims 1 through 3, 8, 14 through 16 and 18 through 21 as the basic rejection. To this basic combination of references, the examiner adds Ehle's publication as to claim 4; Whittlesey as to claims 5 through 7 and 17; Ikeda as to claim 9 and Watkins as to claims 10 through 12. As indicated at the bottom page 11 of the answer, the examiner has only objected to claim 13 as being dependent upon a rejected base claim and has not rejected this claim under 35 U.S.C. § 103.

Rather than repeat the positions of the appellants and the examiner, reference is made to the briefs and the answers for the respective details thereof.

#### OPINION

Turning first to the rejection of claims 1 through 21

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under the judicially created doctrine obviousness-double patenting, we sustain this rejection as to claims 1 through 4, 16, 17 and 21. Pages 1 through 5 of the principal brief on appeal indicate that appellants have conceded the unpatentability of claims 1 through 4 and 21. Appellants attempt to exclude in the reply brief independent claim 21 from this initial concession in the principal brief on appeal since the subject matter urged at pages 1 and 3 of the reply brief concerning the recitation of the "light absorbing shield" of claim 21 excludes it from this rejection. As noted by the examiner in the answer, the subject matter of claim 21 includes the features of claims 1, 3 and 4. Since appellants have never waived from their view that patentability of these claims has been conceded in the brief and reply brief, the rejection is sustained as to claim 21 as well.

With respect to the other claims, claims 5 through 20, we make the following findings. The claims of U.S. Patent 5,442,338 recite in part "an image strip carrier having a series of images." To ascertain the meaningfulness of this recitation, we turn to the specification of that patent for enlightenment. At the outset, however, we note that while the

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patent disclosure may not be used as prior art in a double patenting rejection, the disclosure may be consulted to determine the meaning of terms in the patent claim. In re Avery, 518 F.2d 1228, 186 USPQ 161 (CCPA 1975). Following this permissive analytical approach, column 2, lines 27-28 of the earlier patent states that "[a] series of images are carried on a continuous loop of transparent film." The image strip 4 in the remaining parts of the disclosure and the figures is not otherwise described. It is thus apparent that the subject matter of claims 16 and 17 on appeal are properly subjected to this doctrine. The showings of the image strip 4 in the various figures indicate that an opaque coating was disposed on the transparent substrate to impart the noted image in claim 17 on appeal and the images of the claims in the patent.

On the other hand, at first blush the subject matter of the light sheet of dependent claim 5 on appeal would appear to have been encompassed by the recitation of "a cover ... having a window opening to view said image strip" as recited in the claims of U.S. Patent 5,442,338 thus meeting the limitation of present claim 5 on appeal. Following the guidance provided by

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In re Avery, the noted language of the claims reciting a cover having window opening is only corresponding to the showing of the cover 19 with the window opening 20 in the showings in the Figures 6 and 7 embodiments. The language is not otherwise used to describe the cover 6 and the screen 7 attached thereto describing the embodiment shown in Figure 1. Therefore, the subject matter of the cover having a window opening does not appear, when viewed in light of the specification of the original patent, to read upon the showing of the cover 6 and the screen 7 of the Figure 1 embodiment in such a manner as to have rendered obvious within the doctrine the claimed light sheet of claim 5 on appeal.

As to the other claims, claims 6 through 15 and 18 through 20, we agree generally with appellants' views that the subject matter in these claims relates to subject matter first included in this CIP application which was not present in the parent application U.S. Patent 5,442,338. As to the rejection of claims 1 through 21 under the judicially created doctrine of obviousness-double patenting, we sustain this rejection only as to claims 1 through 4, 16, 17 and 21 and reverse the rejection as to claims 5 through 15 and 18 through 20.

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Turning next to the rejections of claims 1 through 12 and 14 through 21 under 35 U.S.C. § 103, we sustain these rejections only as to claims 1, 2, 8 through 11 and 16 through 20.

We sustain the rejection of independent claim 1 on appeal generally for the reasons set forth by the examiner in the answer with the following embellishments.

When the teachings of both Long and Fales are considered collectively within 35 U.S.C. § 103, we are persuaded of the examiner's reasons for combinability as expressed at pages 5 and 6 of the answer because the reasoning presented by the examiner there is consistent with the reasoning provided at column 1 of Fales, which indicates that it would have been highly desirable to the artisan to have utilized a single light source rather than the plural light sources of Long to have provided a simplified manner of displaying a plurality of telltale conditions by means of a single dashboard unit.

However, the more persuasive approach to view the rejection is to have modified Fales in light of the teachings and showings in Long since the claimed driver, generally planar image disc and light source of independent claim 1 on

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appeal are generally shown in Fales in Figures 1-3. The rotatable disc 30 in Figures 2 and 3 of Fales is clearly shown and described as a disc. Although element 42 is disclosed as a bracket or a substrate in Figure 3 of Fales, it would have been obvious to have utilized the printed circuit board fabrication technique of Long onto which the electronic circuits of Figures 4-6 of Fales would have been embodied in integrated circuit form. In response to appellants' views expressed at pages 5-7 of the principal brief on appeal regarding the combinability of Long as a base reference being modified by Fales as requiring a complete reconstruction of Long device, it appears that the more appropriate base reference to begin the analysis would have been Fales rather than Long as just explained.

We agree with the examiner's view as to the subject matter of claim 2 that the single light source 38 of Figures 2 and 3 of Fales provides the claimed directional light source because of the use of the shroud 40 to direct the light outwardly to the images provided in the various windows 34-37 of the disc 30 in Fales.

We reverse the rejection of claim 3 and its dependent

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claims 4 through 7 generally for the reasons set forth by the appellants in the brief and reply brief. We do not agree with the examiner's view that the claimed "light absorbing shield" reads on Shroud 40 in the Figures 2 and 3 showings of Fales because there is no teaching in Fales that this element absorbs any light at all as stated in the rejection of this claim. Appellants' view that the shroud 40 is more like that of a reflector argues against the patentability of claim 2 as we have found earlier.

We sustain the rejection of dependent claim 8 for the reasons set forth by the examiner in the answer that the Figures 2 and 3 showings in Fales clearly show a drive shaft 24 of the air core gauge/driver 10 extending to attach itself to the rotatable disc 30 clearly shown to be mounted about the drive shaft 24. Appellants' arguments as to this claim at pages 7 and 8 are more specific than the recitation itself in referring to Figures 9-15 of the disclosed invention and that the drive shaft is intended to penetrate the disc aperture. All this amounts to an urging that we find patentability on the basis of unclaimed features.

Still considering the initial stated rejection under

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35 U.S.C. § 103 of the combined teachings of Long and Fales, we do not sustain the rejection of claims 14 and 15 for the reasons set forth by appellants in the brief since the combination of the two references provides no teachings or suggestions that the rotatable disc 30 in Fales is made of metal as required by claim 14 on appeal. On the other hand, we do sustain the rejection of claim 16 since the showing in Figure 2 of Fales indicates that a transparent window 36 has an image thereon. The additional reliance upon Whittlesey as to dependent claim 17 in a separate rejection merely buttresses that showing already depicted in Figure 2 of Fales of the opaque nature of the coating disposed thereon to form the image. Whittlesey utilizes a discontinuous coating 24 to provide the basis of the desired symbols or markings 25 on the transparent plate 20 in the Figure 2 showing.

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As to claims 18 and 20, the incandescent lamp 38 in Fales and those lamps shown in Long clearly are a diffusing light source as claimed. The shroud 40 as well as the overhanging part of the disc 30 provide the light box of dependent claim 19. Therefore, the subject matter of claims 18 through 20 on appeal would have been obvious to the artisan.

We do not sustain the rejection of independent claim 21 under 35 U.S.C. § 103 for the same reasons we have reversed the rejection of dependent claim 3 since claim 21 recites the same "light absorbing shield" as recited in claim 3. Also, the art relied upon by the examiner, Long and Fales, does not teach or suggest the claimed light emitting diode required of claim 21.<sup>1</sup>

Page 9 of the brief indicates that appellants have not argued the particulars of dependent claim 9 and the rejection of this claim on the basis of the combined teachings and showings of Long, Fales and Ikeda. Therefore, the rejection of this claim is sustained.

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<sup>1</sup>We note in passing that "said light source" in claim 21 does not have any antecedent basis, but appears to be referring to the claimed "light emitting diode".

The examiner has separately rejected dependent claims 10 through 12 in light of the collective teachings and showings of Long, Fales and Watkins. We sustain this rejection as to claims 10 and 11, but reverse it as to claim 12. We agree with the examiner's rationale expressed at pages 10 and 11 of the answer that it would have been obvious to the artisan to have employed the hub 4 of the drum 3 in Figures 2 and 3 of Watkins to the drive shaft 24 in the Figures 2 and 3 showings of Fales. To increase the ability of the shaft 24 to support the rotatable disc 30 in the Figures 2 and 3 showing of Fales, it would have been obvious to have utilized the teaching of the hub of the drum 3 in Watkins' Figures 1 and 2 to permit the shaft 24 in Fales to mount the rotatable disc 30 thereto in the same manner that Watkins shows that the hub 4 is utilized to mount the drum 3 to the shaft 6. Such an arrangement obviously would have enhanced the stability of the rotatable disc 30 about the shaft 24 in Fales in light of the teachings and suggestions in Watkins. The combined teachings and showings of the references as just noted clearly meet the function of claim 10 for mounting the image disc thereto as recited in claim 10.

Likewise, the features of claim 11 are shown in the combined teachings and showings of the references as just explained. While the showing in Figure 1 of Watkins utilizes spokes as a means of supporting the outer periphery of the drum 3, the figure 9 showing clearly indicates that a planar type of flange is contemplated as well. The integral structure resulting from the combination of teachings of the references is consistent with the single piece shown of appellants' attachment hub 138 in Figures 13-15.

We do not sustain the rejection of dependent claim 12 since there is no indication in the combined teachings of the three references relied upon that the drum 3 of Watkins and the rotatable disc 30 of Fales have a non-circular cross section aperture or opening and a corresponding shape in the drive shaft engaging portion of the hub 4 of Watkins for cooperable engagement of the image disc on the axially extending drive shaft engaging portion as recited in claim 12 on appeal. We note again that the examiner has not rejected the features recited in claim 13 under 35 U.S.C. § 103 which in turn is dependent on claim 12.

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SUMMARY

We have sustained the rejection of claims 1 through 21 under the judicially created doctrine of obviousness-type double patenting only as to claims 1 through 4, 16, 17 and 21. As to the various rejections of claims 1 through 12 and 14 through 21 under 35 U.S.C. § 103, we have sustained only the rejections of

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claims 1, 2, 8 through 11 and 16 through 20. As such, the decision on the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

JAMES D. THOMAS )  
Administrative Patent Judge )  
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) BOARD OF PATENT  
MICHAEL R. FLEMING ) APPEALS  
Administrative Patent Judge ) AND  
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