

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte ANTONIUS H. M. HOLTSLAG,  
DERK VISSER, PETER COOPS,  
and JACOBS P. J. HEEMSKERK

---

Appeal No. 2000-1257  
Application 08/861,350

---

ON BRIEF

---

Before THOMAS, DIXON and BARRY, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 11-14 and 17-23.

Representative claim 11 is reproduced below:

11. An optical record carrier having a stack of information layers at different heights in the record carrier, which information layers are separated by spacer layers, said record layer being suitable to be read by means of a focused radiation beam employing a fixed spherical aberration compensation, characterized in that the distance between the highest and lowest



claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure and the teachings of the prior art as it would be by the artisan. Note In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

We have reviewed and considered the examiner's reasons in support of the rejection, but are not convinced that the cited claims fail to comply with the second paragraph of 35 U.S.C. § 112.

The focus of the examiner's concern of each independent claim on appeal is the feature at the end of each independent claim that the value "r is the maximally permissible decrease of the Strehl intensity due to spherical aberration." At page 3 of the answer, the examiner considers this terminology to be subjective rather than objective and the value of "r" is set forth in terms of a desired result. Beginning at page 4 of the answer in the responsive arguments portion thereof, the examiner variously considers the quoted material as not being clearly definable, that the value of "r" may range somewhat between less than infinity down to zero indicating that the metes and bounds of the claimed invention would therefore not be clearly definable, and that the above-quoted claim limitation is based

on a wide ranging unclaimed scanning device with characteristics such that the total thickness value is effectively boundless.

We do not agree with any of these assertions by the examiner. Our study of the specification as filed, which provides the basis on which the claimed invention must be interpreted, agrees with appellants' arguments made in the paragraph bridging pages 9 and 10 of the brief from which we quote:

The decrease of Strehl intensity is not subjective terminology. (1) Strehl intensity is an objectively measurable quantity. The Strehl intensity is the normalized maximum intensity of the radiation distribution of the scanning spot, and is a function of the amount of aberration: no aberration produces a Strehl intensity of 1, and large aberrations produce a Strehl intensity approaching zero (page 5, lines 11-13). (2) Various factors in a player for the record carrier determine what is the maximum permissible decrease in the Strehl intensity. The technical background to this problem is described at page 4, line 30 through page 5, line 4. Lines 5-15 of page 5 describe the standardized parameter known as Strehl intensity, and make clear how it is determined and the significance of various values.

Thus, it appears that the Strehl intensity is well known and somewhat standardized to the artisan in the art in question and therefore would have a reasonably definable meaning to the artisan in light of the above-noted precedent. Of particular note are the features recited in independent claims 22 and 23, which define explicitly the value of "r" to be respectively 0.05

and 0.01. Even though the values of "r" in independent claims 22 and 23 are specifically recited, the even more general recitation in independent claim 11 is not indefinite or fatal in our view since the artisan clearly understands the generalized meaning of the Strehl intensity term to exist from zero to 1. We therefore find that the value of "r" set forth at the end of independent claim 1 on appeal as being the maximally permissible decrease of Strehl intensity due to spherical aberration is set forth with a reasonable degree of precision and particularity when read in light of the disclosed invention and the teachings of the prior art as they would be done by the artisan. Therefore, the rejection of claims 11-14 and 17-23 under the second paragraph of 35 U.S.C. § 112 is reversed.

Turning lastly to the rejection of the claims on appeal under 35 U.S.C. § 102, the examiner makes note of Figure 6(a) of Nishiuchi and the corresponding teachings at column 6 thereof by asserting that the stack thickness mentioned there meets the distance of the equation of the claims on appeal. The examiner also considers the Strehl intensity limitation at the end of these claims to have been inherently met by this reference.

Our study of Nishiuchi leads us to agree with appellants' observation at the bottom of page 13 of the brief:

Nothing in Nishiuchi teaches nor suggests the importance of the permissible decrease of the Strehl intensity due to spherical aberration. Nothing in Nishiuchi refers even obliquely to permissible decrease in Strehl intensity; rather, a full correction is attempted.

There is no discussion at all in Nishiuchi of Strehl intensity. Therefore, the examiner's assertion of inherency cannot be met in any manner. There is nothing in this reference that necessarily may interpreted by the artisan as teaching or indicating the overall formulaic representation of the determination of the value of "2d" as set forth in the claims on appeal let alone the Strehl intensity. Inherency may not be established by probabilities or possibilities since inherency requires a teaching must be necessarily present in the applied prior art. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) relying on In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). These findings are consistent with a more recent case from our reviewing court, In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Therefore, the rejection of claims 11-14 and 17-23 as being anticipated by Nishiuchi is reversed.

Appeal No. 2000-1257  
Application 08/861,350

In view of the foregoing, the decision of the examiner rejecting claims 11-14 and 17-23 under 35 U.S.C. § 102 and under 35 U.S.C. § 112, second paragraph, is reversed.

REVERSED

James D. Thomas	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Joseph L. Dixon	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Lance Leonard Barry	)	
Administrative Patent Judge	)	

JDT/cam

Corporate Patent Counsel  
US Philips Corporation  
580 Withe Plains Road  
Tarrytown, NY 10591