

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES R. MEKEMSON
and
NICOLAS GAGARIN

Appeal No. 2005-1862
Application No. 09/799,088

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 14 and 16 to 18. Claim 15, the only other claim pending in this application, has been objected to as depending from a non-allowed claim.

We REVERSE.

BACKGROUND

The appellants' invention relates to an apparatus and method of measuring pavement cross-slope at highway speeds (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Swindall et al. (Swindall)	4,674,327	June 23, 1987
Shoutaro et al. (Shoutaro)	4,700,223	Oct. 13, 1987
Desmarais et al. (Desmarais)	5,467,190	Nov. 14, 1995
Okada	6,268,825	July 31, 2001

Claims 1, 4, 5, 8, 9, 12 to 14 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Swindall in view of Desmarais.

Claims 2, 6, 10 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Swindall in view of Desmarais and Shoutaro.

Claims 3, 7, 11 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Swindall in view of Desmarais and Okada.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed July 13, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed March 22, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 14 and 16 to 18 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to

combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 1, 4, 5, 8, 9, 12 to 14 and 16

We will not sustain the rejection of claims 1, 4, 5, 8, 9, 12 to 14 and 16 under 35 U.S.C. § 103.

The independent claims on appeal (i.e., claims 1, 5 and 9) are drawn to either a pavement cross-slope measuring apparatus or a pavement cross-slope measuring method. These claims recite in one manner or another (1) a ring-laser gyroscope mounted in a vehicle for determining slope of the vehicle with reference to an imaginary horizontal plane; (2) first and second pavement distance measurement devices mounted on opposite sides of the vehicle for determining distance to the pavement on opposite sides of the vehicle and thereby determining vehicle roll; (3) determining the slope of the pavement by comparing the determined vehicle roll with the determined slope of the vehicle; (4) a positional device mounted on the vehicle for determining position of the vehicle on the roadway; and (5) recording the slopes and positions of the vehicle on the pavement being measured.

In the obviousness rejection of claims 1, 5 and 9 before us in this appeal (answer, pp. 3-4), the examiner (1) set forth the pertinent teachings of Swindall and Desmarais; (2) ascertained¹ that Swindall does not disclose the gyroscope is a laser ring gyroscope (LRG); and (3) concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the LRG of Desmarais in the invention of Swindall because it would make the invention of Swindall more accurate and decrease the size and weight as stated on lines 27-28, on column 1, of Desmarais.

We have reviewed the entire disclosure of Swindall and conclude that the examiner did not correctly ascertain the differences between Swindall and claims 1, 5 and 9. Based on our analysis and review of Swindall and claims 1, 5 and 9, it is our opinion that the differences include the following: (1) Swindall does not disclose the gyroscope is a laser ring gyroscope; and (2) Swindall does not disclose determining the slope of the pavement by comparing the vehicle roll determined from height measuring devices with the slope of the vehicle determined from the gyroscope.

¹After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Thus, even if it would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the LRG of Desmarais in the invention of Swindall such would not have arrived at the claimed invention which requires the slope of the pavement be determined by comparing the vehicle roll as determined from distance measurement devices with the slope of the vehicle determined from the gyroscope.

For the reasons set forth above, the decision of the examiner to reject claims 1, 5 and 9, and claims 4, 8, 12 to 14 and 16 dependent thereon, under 35 U.S.C. § 103 as being unpatentable over Swindall in view of Desmarais is reversed.

Claims 2, 3, 6, 7, 10, 11, 17 and 18

We have reviewed the patent to Shoutaro applied in the rejection of dependent claims 2, 6, 10 and 17 and the patent to Okada applied in the rejection of dependent claims 3, 7, 11 and 18 but find nothing therein which makes up for the deficiencies of Swindall in view of Desmarais discussed above regarding claims 1, 5 and 9.

Accordingly, the decision of the examiner to reject claims 2, 3, 6, 7, 10, 11, 17 and 18 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 14 and 16 to 18 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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