

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 L. CORBEIL,  
TROY MARLAR, MATTHIAS J. SCHMAND  
NIRAJ K. DOSHI and MARK S. ANDREACO

Appeal No. 2006-2314  
Application No. 10/856,225

ON BRIEF

Before KRATZ, FRANKLIN, and, GAUDETTE, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-18, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a method for optically segmenting a target media for use in an imaging device and a detector component formed thereby. In this regard, appellants indicate that a position decoding detector or optically segmented light guide can be formed by using laser technology to segment a specified target media. See, e.g., page 9, numbered paragraph

0024 of appellants' specification. A further understanding of the nature and scope of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

A method for optically segmenting a target media for use in an imaging device, said method including the steps of:

- a) forming a void at a selected location within said target media;
- b) repeating said step of forming a void to form a plurality of voids, said plurality of voids cooperating to define at least one optical boundary, said at least one optical boundary segmenting said target media, wherein said at least one optical boundary assists in control and distribution of scintillation light.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Iversen 3,936,645 Feb. 03, 1976

Claims 1-6, 9-11, 13, 14, 16, and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Iversen. Claims 7, 8, 12, 15, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iversen.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, including consideration of all of

appellants' arguments set forth in the brief, appellants have not persuaded us of reversible error on the part of the examiner. Accordingly, we affirm the examiner's rejections for substantially the reasons set forth by the examiner in the answer. We add the following for emphasis.

§ 102(b) Rejection

Anticipation by a prior art reference does not require that the reference recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. U.S. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)). However, the law of anticipation does not require that the reference teach what the appellants teach in their specification, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781,

789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Anticipation under this section is a factual determination.

See In re Baxter Travenol Labs., 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)).

Appellants argue claims 1-6, 9-11, 13, 14, 16, and 17 as a group. See page 6-11 of the brief. Accordingly, we select claim 1 as the representative claim. See 37 CFR § 41.37(c)(1)(vii).

In the case before us, the examiner has basically determined that Iversen discloses, expressly or inherently, a method for optically segmenting a target media (see, e.g., layer 13, fig. 2) for use in an imaging (x-ray detection) device that includes the step of forming a slot in the target media, and repeating that step to form at least one other slot in the target medium to form a plurality of slots. See, for example, drawing figure 2 and column 6, lines 3-10 of Iversen. The plurality of slots of Iversen combine to form optical boundaries that segment the target media into a cellular structure to assist in the control and distribution of scintillation light therein.

Appellants' principal dispute with the examiner's anticipation determination centers on appellants assertion that the claimed formation of voids within the target media, as set

forth in representative claim 1, does not read on Iversen's formation of slots. In this regard, appellant (brief, page 9) maintains that Iversen does not introduce voids (slots) in the media at a point way from an outer surface thereof. However, the representative claim 1 method is not constrained by such a limitation as to the void (slot) formation.<sup>1</sup>

Appellants further argue that the term "within", as used in representative claim 1, requires the formation of a void at a location within the media that is at some distance from the outside surface. We do not agree with appellants' claim construction.

During examination proceedings, claim terms are given their broadest reasonable interpretation as they would be understood by one of ordinary skill in the art when read in light of appellants' specification. See In re Snead, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). In this regard, see numbered paragraph 0042 at page 15 of appellants' specification, wherein

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<sup>1</sup> See page 9 of the brief and the amendment after final that was not approved for entry by the examiner.

appellants make clear that the claims are not intended to be limited by the illustrative embodiments set forth in the specification. Thus, for reasons set forth by the examiner in the answer (pages 5 and 6), appellants' argument is unpersuasive because representative claim 1 does not preclude removal of material on the outside surface of the target media. When the claim does not recite allegedly distinguishable features, "appellant[s] cannot rely on them to establish patentability."

In re Self, 671 F.2d 1344, 1350-1351, 213 USPQ 1, 7 (CCPA 1982).

For similar reasons, appellants' arguments presented at pages 8 and 9 of the brief are unpersuasive. This is because representative claim 1 does not preclude use of a base for the target media and/or cutting the target media. Nor does representative claim 1 require using a laser, much less focusing such a laser at a particular point. Moreover, representative claim 1 is not limited to the formation of dispersed voids as illustrated in appellants' drawing figure 2 and argued by appellants as a patentable difference. Nor does representative claim 1 require light sharing between adjacent scintillators, as argued. Consequently, appellants' contentions set forth in the brief fail to establish a patentably distinguishing feature that is found in representative claim 1.

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On this record, we affirm the examiner's anticipation  
rejection.

§ 103(a) Rejection

Concerning the examiner's separate obviousness rejection of claims 7, 8, 12, 15, and 18, appellants argue these claims together on the basis of the arguments made against the examiner's anticipation rejection without otherwise challenging the examiner's obviousness position as to any particular one of rejected claims 7, 8, 12, 15, and 18. We select claim 7 as the representative claim and we affirm for reasons set forth above and in the answer.

CONCLUSION

The decision of the examiner to reject claims 1-6, 9-11, 13, 14, 16, and 17 under 35 U.S.C. § 102(b) as being anticipated by Iversen; and to reject claims 7, 8, 12, 15, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Iversen is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (1) (iv) (2004).

AFFIRMED

PETER F. KRATZ )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
BEVERLY A. FRANKLIN ) APPEALS  
Administrative Patent Judge ) AND  
 ) INTERFERENCES  
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LINDA M. GAUDETTE )  
Administrative Patent Judge )

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Application No. 10/856,225

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APPEAL NO. 2006-2314 - JUDGE KRATZ  
APPLICATION NO. 10/856,225

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APJ GAUDETTE

**DECISION: AFFIRMED**

Prepared By: TRACEY FLEMING

**DRAFT TYPED:** 25 Aug 06

**FINAL TYPED:**