

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 KURT E. SPEARS and RODNEY C. HARRIS

Appeal No. 2006-2572
Application No. 10/437,569

ON BRIEF

Before RUGGIERO, DIXON and SAADAT, Administrative Patent Judges.

DIXON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 2, and 4-15, which are all of the claims pending in this application. The examiner has withdrawn the rejection of claims 10-15 in the Answer at page 3. Therefore, the rejection of claims 1, 2, and 4-9 remain for our review.

We AFFIRM.

BACKGROUND

The Appellants' invention relates to a compact integrated optical imaging assembly. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. An assembly for an image capture device, comprising:
 - an imaging lens;
 - an optical spacer physically integrated with the imaging lens; and
 - a photo-sensing system physically integrated with the optical spacer, the optical spacer having a plurality of reflective surfaces adapted to receive an image light from the imaging lens and direct the image light toward the photo-sensing system.

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

Mikscha et al. (Mikscha)	6,160,250	Dec. 12, 2000
Hayashi	2003/0184825	Oct. 02, 2003
		(filed Feb. 19, 2003)
Feng	6,775,077	Aug. 10, 2004
		(filed Sept. 22, 2000)
Graber et al. (Graber)	2004/0178373	Sept. 16, 2004
		(filed Mar. 14, 2003)

REJECTIONS

Rather than reiterate the conflicting viewpoints advanced by the examiner and the Appellants regarding the above-noted rejections, we make reference to the examiner's answer

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(mailed 4/14/2006) for the reasoning in support of the rejection, and to Appellants' brief (filed 3/13/06) and reply brief (filed 6/12/06) for the arguments thereagainst.

Claims 1 and 5-9 stand rejected under 35 U.S.C. 103 as being unpatentable over Feng in view of Graber. Claim 2 stands rejected under 35 U.S.C. 103 as being unpatentable over Feng in view of Graber further in view of Miksch. Claim 4 stands rejected under 35 U.S.C. 103 as being unpatentable over Feng in view of Graber further in view of Hayashi.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the examiner. As a consequence of our review, we make the determinations that follow.

We note that Appellants have addressed the examiner's rejection in three groups.

We have reviewed the examiner's statement of the rejection and the relevant claim interpretations made by the examiner. We find that the examiner has interpreted the claim and the prior art in a reasonable manner and find that the examiner has set forth a prima facie case of obviousness of the invention as recited in independent claim 1 (Answer 4-6). Therefore, we look to Appellants' arguments in the briefs to show error in therein.

Appellants' main argument at page 5 of the Brief is that there is no motivation to combine the reference teachings as proposed by the Examiner and that the Examiner has relied upon improper hindsight reconstruction. We disagree with Appellants and find that

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the examiner has set forth a proposed motivation to extend the optical path of the optical system without significantly enlarging the device dimensions as taught by Graber and to provide optical features as appropriate depending on the desired optical path length and device dimensions (Answer 4). We agree with the Examiner's statement of motivation of the combination of the teachings, and we find no specific field of endeavor or intended use which limits the environment of the claimed invention. Therefore, we find that the Examiner has not been unreasonable in the claim interpretation or in the statement of the reasons for the combination of teachings.

From our review of the teachings of Feng, we find that Feng is concerned with the adaptation of the smaller bar code reading system to use conventional/commercially available components (Feng at col. 1). Similarly, Graber is concerned with limiting the size of the physical device. We find the Examiner's rationale for the combined teachings with respect to "An assembly for an image capture device" as recited in the instant claim language to be reasonable. Therefore, we do not find Appellants' argument to the combination to be persuasive.

Appellants argue in the Reply Brief that the Examiner has failed to provide any indication of the structure in Feng that would result from the proposed modification of Feng (Reply at 4). We disagree with Appellants, and we find that the Examiner correlated the spacer in the statement of the rejection to element 420 which is the integrated lens and

spacer/prism. In the combination of the teachings, this would have been the same element with a longer path for the light signal as suggested by Graber.

Appellants argue at page 4 of the Reply Brief that the Examiner fails to indicate how a plurality of reflective surfaces would be incorporated into the prism of Feng and that the optical path change would be negligible. We find that while the small change may be negligible in Appellants' view, we find that a small change in a small device is not necessarily "negligible" as Appellants' maintain. Therefore, Appellants' argument is not persuasive. Furthermore, we find no express limitation as to the path of the light signal or to the specific orientation as to the reflective surfaces. Therefore, Appellants' argument is not persuasive.

Appellants argue at page 5 of the Reply Brief that Feng teaches away from the proposed modification since Feng teaches reducing light signal loss. While we agree with Appellants that Feng does teach this reduction is desirable, we find that the discussion is with respect to the conventional distinct component systems in Figure 3 which is not expressly on point with respect to the embodiment of Figure "5A" and "5B" of Feng which integrates various elements into a single element. Therefore, we cannot agree that Feng teaches away from the combination of the teachings. Therefore, we find that Appellants have not shown error in the *prima facie* case of obviousness as set forth by the Examiner, and we will sustain the rejection of independent claim 1 and its dependent claims 5-9 grouped therewith by Appellants.

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With respect to dependent claim 2, Appellants merely rely upon the arguments with respect to independent claim 1 and have not set forth additional specific arguments. Therefore, Appellants' argument is not persuasive with respect to dependent claim 2, and we will sustain the rejection of dependent claim 2.

With respect to dependent claim 4, Appellants merely rely upon the arguments with respect to independent claim 1 and have not set forth additional specific arguments. Therefore, Appellants' argument is not persuasive with respect to dependent claim 4. Appellants reiterate the argument with respect to light signal loss which we did not find persuasive with respect to independent claim 1 and Appellants have not identified any reason why the additional teachings of Hayashi would support Appellants' argument that Feng teaches away from the combination. Therefore, Appellants' argument is not persuasive, and we will sustain the rejection of dependent claim 4.

CONCLUSION

To summarize, we have sustained the rejection of claims 1, 2, and 4-9 under 35 U.S.C. § 103.

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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

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JOSEPH F. RUGGIERO)
Administrative Patent Judge)
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JOSEPH L. DIXON) **BOARD OF PATENT**
Administrative Patent Judge) **APPEALS AND**
) **INTERFERENCES**
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