

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 Michael R. Fender and Warren S. Tustin

Appeal No. 2006-3283
Application No. 10/606,897
Technology Center 2800

ON BRIEF

Before KRASS, 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 21-39, which are all of the claims pending in this application. Claims 1-20 have been canceled. The rejection of claims 25 and 34 has been withdrawn by the examiner.

We REVERSE.

BACKGROUND

Appellants' invention relates to systems and methods for performing multi-source measurements. An understanding of the invention can be derived from a reading of exemplary claim 21, which is reproduced below.

21. A method comprising:

displaying a first waveform and a second waveform;

displaying a plurality of icons, each icon corresponding to a measurement to be performed of a parameter defining a relationship between the first waveform and the second waveform;

enabling a user to select one of the plurality of icons;

enabling the user to mark a first point on the first waveform;

enabling the user to mark a second point on the second waveform;

performing a measurement based on the selected icon, the first point on the first waveform, and the second point on the second waveform.

PRIOR ART

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

Taraki et al. (Taraki)

5,898,307

Apr. 27, 1999

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 (mailed May 5, 2006) for the reasoning in support of the rejection, and to Appellants' Brief (filed Nov. 18, 2005) and Reply Brief (filed Jun. 29, 2006) for the arguments thereagainst.

OPINION

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

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. See Studiengesellschaft Kohle m.b.H. v. Dart Indus., Inc., 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

Initially, we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of 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. 1987). A prior art reference anticipates the subject 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

Com'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 are claiming, 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).

We must point out, however, that anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. V. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Here, we find that Taraki does not teach all of the limitations as recited in independent claim 21.

Appellants argue that Taraki fails to measure any parameter between two different waveforms and that all of the measurements are based upon an individual waveform (Brief p. 4). Appellants maintains that Taraki fails to disclose a parameter defining a relationship between the icon and first and second waveforms and that the icons in Taraki relate to display modes rather than to a measurement to be performed (Brief p. 5 and Reply Brief pp. 4-5). We agree with Appellants and further find that Taraki does not disclose "performing a measurement based on the selected icon, the first point on the first waveform, and the second point on the second waveform," as recited in independent claim 21. Therefore, we will not sustain the rejections of independent claim 21 and dependent claims 22-24, 26, and 27.

With respect to independent claim 28, we agree with Appellants and further find that Taraki does not disclose "means for measuring a parameter based on the selected icon, the first point, and the second point" as recited in independent claim 28. (Brief p. 7 and Reply Brief p. 6). Therefore, we will not sustain the rejections of independent claim 28 and dependent claims 29-33 and 35.

Appellants maintain that Taraki fails to disclose a parameter defining a relationship between and first and second waveforms and that the icons in Taraki relate to display modes rather than to a measurement to be performed (Brief p. 9 and Reply Brief p. 6). We agree with Appellants and further find that Taraki does not disclose “displaying a plurality of icons, each icon corresponding to a measurement to be performed of a parameter defining a relationship between the first waveform and the second waveform,” as recited in independent claim 36. Therefore, we will not sustain the rejections of independent claim 36 and dependent claims 37-39

CONCLUSION

To summarize, the rejection of claims 21-24, 26-33, and 35-39 under 35 U.S.C. § 102 has been reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
Administrative Patent Judge)	

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