

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID FAIRHURST LEWIS,
HSIAO-YI SHIH and
HANETTE ANYUMBA

Appeal 2007-2190
Application 10/229,489
Technology Center 1700

Decided: September 6, 2007

Before CHUNG K. PAK, PETER F. KRATZ, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 4 and 8-18, the only claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

The invention relates to a film for low dose measurement of low energy photons, in particular, for measurement of patient skin exposure

during fluoroscopically guided interventional surgery procedures. (Br. 2).

Claim 18 is illustrative of the invention and is reproduced below:

18. A film media sensitive to low energy x-rays comprising a first support layer of polymeric film which is permeable to low energy x-rays from about 20ke V to 120ke V and a second layer thereon of a composition comprising a microcrystalline dispersion of a substantially crystalline image receptive polyacetylenic compound and selected from the group consisting of pentacosa-10, 12-diynoic acid; tricosa-10, 12-diynoic acid, heneicos-10, 12-diynoic acid and combinations thereof and a compound that selectively absorbs incident low energy photon radiation which is a metal halide and is selected from the group consisting of cesium halides and rubidium halides and which further comprises a chelating agent.

The Examiner relies on the following prior art reference to show unpatentability:

Patel US 5,420,000 May 30, 1995

The Examiner made the following rejection¹:

Claims 4 and 8-18 under 35 U.S.C. § 102(b) as anticipated by Patel.

Appellants' traversal of the anticipation rejection is limited to their contention that Patel fails to disclose or suggest a compound which possesses the property of selectively absorbing incident low-energy photon radiation. (Br. 3). According to Appellants, "Patel, et al. does not disclose the inclusion of a metal halide for this purpose which is selected from the group consisting of cesium halides and rubidium halides. Consequently, Patel, et al. cannot anticipate the present invention as claimed and this rejection should not be upheld." (Br. 3).

¹ The rejection of claims 4 and 8-18 under 35 U.S.C. § 102(b) as anticipated by Lewis has been withdrawn. (Answer 4).

This argument alone is not persuasive in overcoming the Examiner's rejection because it fails to address the Examiner's finding that Patel *does disclose* the use of metal halides such as cesium bromide and cesium iodide in the disclosed radiation sensitive imaging film (Answer 3, referencing Patel, cols. 17-18 and Table 3). When the Examiner has reason to believe that a functional limitation in the claims may be an inherent characteristic of the prior art, the Examiner may require the applicant to prove that the subject matter shown to be in the prior art does not possess that characteristic. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). See *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977) (Where patentability rests upon a property of the claimed material not disclosed within the art, the PTO has no reasonable method of determining whether there is, in fact, a patentable difference between the prior art materials and the claimed material. Therefore, where the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily possess the characteristics of the claimed product.). Appellants have not provided any explanation or evidence which establishes that a converter layer containing cesium bromide or cesium iodide as taught by Patel would not inherently selectively absorb incident low energy photon radiation.

Accordingly, the rejection of claims 4 and 8-18 under 35 U.S.C. § 102(b) as anticipated by Patel is affirmed.²

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(vi)(effective Sept. 13, 2004).

AFFIRMED

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² 37 C.F.R. § 41.37(c)(1)(vii) provides that: “Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown”; *Optivus Technology, Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989, 80 USPQ2d 1839, 1847-848 (Fed. Cir. 2006)(citing *Beckton Dickinson & Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 800, 17 USPQ2d 1097, 1103 (Fed. Cir. 1990))(Issues not raised in an appellant's opening brief are considered waived.)). See *Cross Medical Products v. Medtronic Sofamor Danek*, 424 F.3d 1293, 1321 n.3, 76 USPQ2d 1662, 1683 n.3 (Fed. Cir. 2005)(court declined to address new arguments raised for the first time in a reply brief). See also, *Singh v. Brake*, 317 F.3d 1334, 1340, 65 USPQ2d 1641, 1645 (Fed. Cir. 2003)(finding that the Board was acting properly within its discretion when it refused to consider matters raised in the briefs that could have been, but were not raised at the outset of the interference).

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REED SMITH LLP
599 Lexington Avenue
New York, NY 10022-7650