Paper No. 25

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ADEL K. SARRAFZADEH-KHOEE

Appeal No. 1996-1579
Application 08/250,489[1]

ON BRIEF

Before THOMAS, BARRETT and FLEMING, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is a decision on a rehearing request of our original decision mailed February 9, 1999, wherein we sustained only

[1] Application for patent filed May 27, 1994.

the rejection of independent claim 1 on appeal under 35 U.S.C. § 103. Appellant's request for reconsideration of March 15, 1999 is therefore considered a request for rehearing of that earlier decision.[2]

In Lukasiewicz a photosensitive material 12 is taught to be glued to the underlying surface of the structure or body 10 as shown in figures in 1, 3 and 5. On the other hand, in McDonach a 2-dimensional grating structure 12 is attached to the surface 10 of a specimen 10 to be tested.

Claim 1 requires that the laser beams be aimed “at a spot <u>on</u> an object surface to be measured” (emphasis added) where the claimed camera imagers receive “reflected speckle images from the spot.” Claim 1 therefore does not distinguish over the use of materials that are attached to the surface of the object to be measured because claim 1 requires that this spot be <u>on</u> the object surface and that the speckle images are with respect to the spot and not the surface.

[2] The administrative delay in the panel only recently receiving the request for rehearing is regretted.

It is further noted that the imaging in Figures 3 and 5 of Lukasiewicz appears to be in the context of the structure 10 and not with respect to the surface of the photosensitive material 12 placed thereupon. In any event, the claim does not distinguish thereover even if the imaging was with respect to the surface of the glued photosensitive material 12 to the underlying surface of the structure 10 to be examined. Column 2, line 15 of McDonach begins a discussion that teaches that the actual regular surface itself of the object to be examined may alternatively have therein a 2-dimensional periodic pattern rather than relying upon the need for attaching the grating thereto.

In the absence of the surface itself in McDonach providing the regular 2-dimensional periodic pattern, the basic teaching in McDonach is that the sensing is with respect to deformations of the grating. In any event, the teachings in McDonach are still applicable to the subject matter of claim 1 on appeal since we emphasize again that the laser beams illuminate the spot <u>on</u> an object surface to be measured and that the reflected speckle images are from the spot and

not the surface. Therefore, in the context of the majority of the teachings in McDonach, the claimed spot may comprise a laser beam spot on the grating in McDonach.

Therefore, the combined teachings and suggestions of Lukasiewicz and McDonach do not teach or lead the artisan away from the presently claimed invention. The presently claimed invention does not distinguish over, by its own terms, the subject matter taught or suggested to the artisan from both of these references. The claimed invention of claim 1 does not exclude the use of the materials attached to the surface of the object to be measured in either reference.

Appellant's brief and the request for rehearing make much more of McDonach than we did in our original opinion in affirming only the rejection of claim 1 on appeal. We have properly considered the collective teachings and suggestions of both references relied upon and have not improperly considered them from a structural combinability point of view, which is the essence of appellant's arguments. The substance of our affirmance of the rejection of claim 1 is contained between pages 2 through 5 of our original opinion. At page 5,

we began a discussion of why we have reversed the rejection of claims 2 through 11 on appeal. Our reasoning affirming the rejection of claim 1 does not reflect any “obvious to try” standard as expressed at the bottom of page 3 of the request for rehearing.

In view of the foregoing, appellant's request for rehearing is granted to the extent that we have, in fact, reviewed our findings, but is denied as to making any change therein.

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

DENIED

James D. Thomas Administrative Patent Judge	)
Lee E. Barrett Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
Michael R. Fleming Administrative Patent Judge	)

JDT/cam

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