

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(2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM E. NELSON, PAUL M. URBANUS,
JEFFREY B. SAMPSELL and ROBERT M. BOYSEL

Appeal No. 1996-2966
Application 08/257,232¹

ON BRIEF

Before THOMAS, JERRY SMITH and BARRY, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed June 09, 1994. According to Appellants, this application is a continuation of 07/824,660, now abandoned.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-20, which constitute all the claims in the application.

The disclosed invention pertains to a method for printing using spatial light modulators.

Representative claim 1 is reproduced as follows:

1. A method of printing using at least one spatial light modulator, said method comprising the steps of:
 - a. establishing a process for printing lines of data, wherein said process further comprises the steps of:
 - i. writing data to the addressing circuitry for said modulator to an image;
 - ii. illuminating said modulator with light from a light source;
 - iii. reflecting said light to a photosensitive media with said modulator such that said light is reflected as said image;
 - iv. writing new data to the addressing circuitry of the entire modulator such that each line of data previously on said addressing circuitry is written to a row of said addressing circuitry adjacent said line's position before said resetting step;
 - b. repeating said process until a predetermined region on said photosensitive media has been completely exposed; and
 - c. repositioning said at least one modulator to expose a different region on said photosensitive media.

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The examiner relies on the following references:

Winsor	4,933,687	June 12, 1990
Gelbart	5,049,901	Sep. 17, 1991
Smith et al. (Smith)	5,121,146	June 09, 1992

(filed Dec. 27,
1989).

Claims 1-20 were finally rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Gelbart in view of Smith. In response to the appeal brief, a new rejection of claims 1-10 was made under 35 U.S.C. § 103 as being unpatentable over the teachings of Gelbart in view of Smith and Winsor. The rejection of claims 11-20 was maintained as set forth in the final rejection.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answers for the respective details thereof.

OPINION

It is our view, after consideration of the record before us, that claims 1-20 fail to particularly point out and distinctly claim the invention in a manner which complies with the second paragraph of 35 U.S.C. § 112. We enter a new

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ground of rejection against claims 1-20 on this basis using our authority under 37 CFR § 1.196(b). We reverse the rejections of claims 1-20 under 35 U.S.C. § 103 on a strictly technical basis as explained below. Accordingly, we reverse the examiner's rejections of the claims under 35 U.S.C. § 103, but we add a new rejection of the claims under the second paragraph of 35 U.S.C. § 112.

Before we consider the examiner's rejections of the claims under 35 U.S.C. § 103, we note a recitation in independent claims 1 and 11 which renders each of these claims indefinite. Specifically, each of the claims in paragraph a. subparagraph iv. recites writing new data to the addressing circuitry "before said resetting step." There is no "resetting step" recited in either claim 1 or claim 11. Since the metes and bounds of a claimed process must be determined by considering the sequence of steps recited in the claimed process, a step which must be performed before a step which has not been recited makes no sense at all. We are not going to try to guess whether "said resetting step" should be something else such as "said repeating step" or whether a resetting step has been unintentionally omitted from the

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claimed invention. The legal standard for definiteness is whether a claim reasonably apprises those of ordinary skill in the art of its scope. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). We are unable to ascertain the scope of the invention as set forth in claims 1 and 11 in view of the failure of the claims to establish a meaning for the resetting step. Since the scope of these claims is not clear, a rejection of independent claims 1 and 11 under the second paragraph of 35 U.S.C. § 112 is appropriate. Since dependent claims 2-10 and 12-20 incorporate the indefiniteness of claims 1 and 11, all the claims are subject to the new ground of rejection under the second paragraph of 35 U.S.C. § 112.

We now consider the examiner's rejections of the claims under 35 U.S.C. § 103. As a general rule, prior art rejections cannot be made where the claimed invention can only be based upon speculation and conjecture as to what is being claimed.

In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). Since we have just determined that the scope of the claimed invention is indefinite and subject to conjecture, a

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prior art rejection of the pending claims is not appropriate. Thus, we do not sustain the rejections of the claims under 35 U.S.C. § 103. Our reversal of the examiner's rejections under 35 U.S.C. § 103 is a technical reversal and is not based on the merits of the rejection, the applied prior art or the arguments of appellants.

Although we have not considered the examiner's rejection of the claims under 35 U.S.C. § 103 on the merits, we offer some general comments which appellants and the examiner might find helpful. The current record does not make a very persuasive case for either the examiner or for appellants. The claimed invention seems to be directed to the replacement of the conventional use of shift registers to move data within an array of spatial light modulators to use of conventional "full frame" xy addressing circuitry for accomplishing the same data movement. We are not fully convinced that the artisan would have modified the structure of Gelbart with the teachings of Smith as asserted by the examiner, however, appellants' attacks against the teachings

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of Gelbart and Smith are also not convincing. If a prior art rejection of the claims continues to be an issue in this case, both appellants and the examiner should consider fortifying this record with better evidence and/or arguments.

In summary, the rejections of the claims under 35 U.S.C. § 103 are technically reversed. We have entered a new rejection of the claims under the second paragraph of 35 U.S.C. § 112 as being indefinite.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR § 1.196(b) provides that "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise

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one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED
37 CFR § 1.196(b)

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Administrative Patent Judge)	
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JS/dm

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