

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID CONCANNON,
JOHN VALA
and GERALD BANKS

Appeal No. 1997-1560
Application 08/257,813

ON BRIEF

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

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 18 through 24.

The disclosed invention relates to a method of illuminating documents in a document-processing system.

Claim 18 is illustrative of the claimed invention, and it reads as follows:

18. A method for illuminating documents in a document-processing system wherein a large number of documents are rapidly, continuously, singly transported past one or more imaging stations, each station having a prescribed image-site, and being illuminated by prescribed source means which projects one or more illumination-beams, one to each station; said method for each said beam comprising:

providing focus means for each said beam;

providing a fibre-optic array intercepting each said beam path, to thereby define an input-beam thereto at or near the approximate focal point of said focus means, while arranging said array to exhibit an entry-portion of prescribed diameter and an exit-portion configured to illuminate the respective image-site relatively uniformly thus defining an output-beam, the fibers of the array being arranged and distributed, in uniform, random fashion completely across this exit portion; and,

with said focus means, de-focusing said input beam to change beam-diameter, at said entry-portion, sufficient to spread the beam sufficiently beyond the entry-portion to thus controllably reduce the amount of the beam entering said entry-portion.

The reference relied on by the examiner is:

Vala et al. (Vala) 5,313,070 May 17, 1994

Claims 18 through 22 stand rejected under the second paragraph of 35 U.S.C. § 112 for indefiniteness.

Claims 18 through 24 stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of enablement.

Claims 18 through 24 stand rejected under 35 U.S.C. § 101 for claiming the same invention set forth in claims 1 through 11 of U.S. Patent No. 5,313,070 to Vala.

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Reference is made to the brief and the answer for the respective positions of the appellants and the examiner.

OPINION

All of the rejections are reversed.

Turning first as we must to the indefiniteness rejection, the examiner indicates (Answer, page 4) that in "[C]laim 18, lines 5-6 'said method for each said beam comprising' is vague and indefinite as to what the method for each said beam is." Appellants argue (Brief, page 6) that "[t]he phrase reads: 'said method for each said beam' and refers to the 'method' cited in line 1, and to the 'one or more illumination beams' in line 6, and, quite evidently, means that the later-recited steps of 'focusing', 'providing', 'defocusing' etc. are to be understood as performed on each (all) of the beams." We agree with appellants' argument that the method steps that follow the questioned phrase are performed on "each said beam." Thus, the indefiniteness rejection is reversed.

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The lack of enablement rejection is reversed pro forma as to claims 18 through 21, 23 and 24 because the lack of enablement rejection only applies to claim 22. With respect to claim 22, the examiner contends (Answer, page 3) that "[t]he original specification fails to teach photopic filter means which is introduced at each station whereby to balance and match the image-spectrum emanating therefrom so that these are essentially the same from all the stations." We agree with appellants' argument (Brief, page 5) that "[t]he specification makes it quite plain that both photopic filters work to give images whose spectrum 'closely matches that of the human eye'. . . ; and since they both match the same spectrum, they match one another" (Specification, page 26, lines 19 through 24). The lack of enablement rejection of claim 22 is likewise reversed.

Turning lastly to the same invention double patenting rejection, we agree with appellants' argument (Brief, page 7) that there are differences between the claims on appeal and the claims found in the patent to Vala. As a result of the

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differences, a same invention double patenting rejection¹
under 35 U.S.C. § 101 is improper, and is reversed.

DECISION

The decision of the examiner rejecting claims 18 through
22 under the second paragraph of 35 U.S.C. § 112 is reversed.
The decision of the examiner rejecting claims 18 through 24
under the
first paragraph of 35 U.S.C. § 112 is reversed. The decision
of

the examiner rejecting claims 18 through 24 under 35 U.S.C. §
101 is reversed.

REVERSED

¹ It appears that a judicially-created, obvious-type double patenting rejection
would have been more appropriate.

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Administrative Patent Judge)	
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Administrative Patent Judge)	APPEALS AND
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